

## How to Prevent Costly Errors with Foreign Filing Deadlines

One of the costliest patent docketing errors is a missed foreign filing deadline. A foreign filing deadline is a deadline for filing a patent application in a foreign country. This article discusses the importance of foreign filing deadlines and the consequences of missing them.

The deadline for filing a patent application directly in foreign country, in a regional patent office such as the European Patent Office, or through the Patent Cooperation Treaty (PCT) is based on the Paris Convention. The Paris Convention is an international treaty which gives an applicant the benefit of a priority date of a patent application filed in the applicant's home country. The priority date is the date on which the patent application was first filed. The foreign filing deadline is different for design and utility patents applications. For a design patent application, the foreign filing deadline is six months from the priority date. For a utility patent application, the foreign filing deadline is twelve months from the priority date.

Missing the foreign filing deadline can cause irrecoverable and permanent loss of foreign rights for all inventions disclosed in the application. A missed foreign filing deadline can happen due to a variety of reasons such as miscommunication, human error, or simply not having the necessary docketing processes in place to ensure the deadline is met. The consequences of missing a foreign filing deadline are severe. When a foreign filing deadline is missed, the opportunity to file a patent application in most foreign countries is lost forever.

One strategy for avoiding missed foreign filing deadlines is to double docket these deadlines. The most important characteristic of a successful double docketing process is to have different people tracking the foreign filing deadline in different systems. A common approach to double docketing is to use an electronic docketing system as the primary docket and a paper docket as a secondary docket. Typically, a docketer maintains the deadline in the electronic docketing system and someone else (e.g., attorney, paralegal, or secretary/admin) maintains the deadline in a paper docket book or calendar.

Another strategy for avoiding missed foreign deadlines is to verify all priority dates. If the wrong priority date is entered, the docketing system will calculate the wrong foreign filing deadline. The priority dates can be verified by checking them against the original application documents, manually looking them up in a public database such as the USPTO's Patent Center, or electronically auditing them individually or in a batch process. It is important to note that correcting a priority date in a docketing system does not always recalculate the foreign filing deadline though. Some docketing systems are not designed to automatically update the foreign filing deadline in response to a change made to the priority date. Therefore, it is always best to verify the foreign filing deadline after changing the priority date in the docketing system to make sure the correct foreign filing deadline has been recalculated.

In conclusion, a missed foreign filing deadline can cause irrecoverable and permanent loss of foreign rights for all inventions disclosed in a patent application. To avoid this costly mistake, it is important to have a system in place to both double docket the foreign filing deadlines and to

verify priority dates. The combination will considerably lower the risk of a docketing error in a foreign filing deadline. For more information, watch this webinar on “Best Practices and Options for Double Docketing to Reduce Risk of Missed Dates” on the Black Hills IP Website.