

## ***How to Prevent Costly Docketing Errors for US Provisional Applications***

Failing to correctly docket the deadline for filing a nonprovisional application 12 months after the date on which a US provisional application was filed can be a very costly docketing error. This article explains the 12-month deadline to file a nonprovisional application and offers best practices to minimize the risk of missing it.

A US provisional patent application has a pendency lasting 12 months from the date the provisional application is filed. If a nonprovisional application is not filed by the 12-month deadline and the delay was unintentional, the nonprovisional application can still be filed and claim the benefit of the provisional application if it is filed within 2 months of the 12-month deadline. A petition and a fee must be filed along with a statement that the delay was unintentional. See 37 CFR 1.78(b) for more information on restoring the benefit of a provisional application and filing a nonprovisional application within two months of the expiration of the provisional application. However, if more than 14 months has passed since the provisional application filing date, then nothing can be done to correct the error. This is an unrecoverable deadline, which if missed results in a lost priority claim and potentially loss of patent rights in the invention.

A common reason for missing this deadline is human error entering either the filing date or the filing type in the docketing system. In many IP docketing systems, the 12-month deadline is automatically calculated based on the provisional filing date entered. If the docketer enters the wrong filing date, the system will generate an incorrect nonprovisional application deadline. Additionally, the country law applied to a matter may depend on the filing type entered in the docketing system (e.g., provisional, nonprovisional, continuation, reexamination, etc.). If the docketer selects the wrong filing type, such as using a nonprovisional filing type instead of a provisional filing type, some docketing systems may not even create a deadline for filing the nonprovisional application.

Another reason for missing this deadline can be a docketing process that involves adding a single docket entry to cover both the nonprovisional filing and the foreign filing deadline, as they both occur 12 months after the filing date. If the docket entry for the 12-month deadline is removed because the foreign filing is complete or not needed, there is no record of the upcoming nonprovisional application deadline, and it may be missed.

Overall, it is important to be diligent and proactive when managing provisional patent application deadlines. Failing to do so can result in losing the original priority date and potentially losing patent rights in the invention. The following best practices will minimize the risk of missing a 12-month nonprovisional application deadline. First, a deadline for filing a nonprovisional application in the US and a deadline for foreign filing should be docketed as separate non-extendable deadlines 12 months from a provisional application filing date. Second, always docket a non-extendable deadline 14 months from the provisional application filing date to restore the benefit of the provisional application. Third, implement a process to double docket all unrecoverable deadlines, including this deadline. The process should have different people track the nonprovisional application deadline in different systems, such as a docketer entering the deadline in an electronic docketing system and another person, such as an attorney, paralegal, or secretary/admin, entering the deadline in a second electronic system or calendar. By following these best practices, you can significantly reduce the risk of missing the 12-month nonprovisional application deadline.