

Navigating Patent Deadlines: Understanding the Distinctions and Risks

It is essential to understand the different types of patent deadlines that exist and the level of attention each requires when docketing. This article discusses four types of deadlines: reminders, nonfinal (extendable) deadlines, recoverable final deadlines, and unrecoverable final deadlines. Understanding these deadlines' distinctions and potential liability risks can help you develop appropriate docketing processes based on the type of deadline and prevent costly mistakes.

The first type of deadline is a "reminder" deadline. Reminders are often docketed one or more months before an actual patent office deadline and frequently trigger internal processes such as requesting instructions from a client. There is no liability risk associated with a docketing error for a reminder deadline because nothing is due.

The second type of deadline is a "nonfinal" or "extendable" deadline, such as a three-month response due date for a nonfinal office action in a patent matter. Docketing errors on nonfinal deadlines pose minimal liability risk since extensions of time to respond are available, although extensions typically incur additional costs. Some risk may arise, however, if an error in docketing a nonfinal deadline extends to a corresponding final deadline. For instance, if a docketing system calculates both nonfinal and final deadlines based on the same mailing date, an error in the mailing date entered by the docketer can cause both deadlines to be miscalculated. Also, some docketing systems group nonfinal and final deadlines together for a specific event. If a nonfinal deadline is being extended manually, a docketer must exercise caution to ensure they only dedocket the past due nonfinal deadline and not inadvertently dedocket all future deadlines including the final deadline. Therefore, it is important to have a docketing process for nonfinal deadlines that ensures any errors do not also affect a corresponding final deadline.

The third type of deadline is a "recoverable" final deadline. While docketing errors for a recoverable final deadline pose low liability risks since the deadline can still be recovered, reviving the application incurs additional costs. The error may also lead to a loss of client confidence due to the missed deadline. An example of a recoverable final deadline in the US is the six-month deadline for responding to an office action. If this deadline is missed, the response can still be filed with a fee and a timely filed Petition to Revive. Similarly, in some foreign patent offices like the EPO, an applicant can restore an application through a "further processing" procedure for a fee if they miss a final deadline for responding to an office action. Docketing errors for recoverable final deadlines are often identified when the US Patent Office issues a Notice of Abandonment or a similar notice is issued by a foreign patent office. As long as the receipt of this Notice of Abandonment triggers an internal process to docket a new deadline to revive/restore the application, the liability risk from this type of error will be low. However, if the Notice of Abandonment is not properly docketed, docketing errors for recoverable final deadlines can result in the loss of rights and significant liability risks. Therefore, it is critical to have a docketing process in place that includes a failsafe mechanism

to ensure that a deadline to revive/restore the application is properly docketed if the recoverable final deadline is missed.

The final type of deadline is an "unrecoverable" final deadline. A docketing error for an unrecoverable final deadline can result in significant liability risks, including permanent loss of patent rights. Examples of unrecoverable final deadlines include Paris Convention deadlines, PCT National Phase filing deadlines, and US provisional application benefit restoration deadlines. To reduce the liability risk, it is imperative to have a process in place for both double docketing unrecoverable final deadlines and verifying priority dates used to calculate unrecoverable final deadlines. The combination will considerably lower the risk of a docketing error for an unrecoverable final deadline. For more information on unrecoverable deadlines, watch this webinar on "Top 3 Patent Docketing Vulnerabilities and Unrecoverable Dates" on the Black Hills IP Website.

In conclusion, an understanding of the different types of patent deadlines and the associated liability risks caused by docketing errors for each is essential in developing effective docketing processes. By tailoring docketing processes for each type of deadline to the level of risk involved, you can minimize the potential liability and maintain client confidence.