

The Docketing Excellence Webinar Series



Deadly Mistakes: Missing Paris Convention and PCT National Phase Foreign Filing Deadlines and How to Avoid Them

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INSTITUTE
Building Extraordinary IP Assets

Deadly Mistakes: Missing Paris Convention and PCT Filing Deadlines

- **Presenters and panelists:**
 - Ann McCrackin, President, Black Hills IP, LLC
 - Zhakalazky Carrion, Docketing Manager, Schwegman Lundberg & Woessner, P.A.
 - Kristi Wheeler, Foreign Paralegal, Schwegman Lundberg & Woessner, P.A.

Why is Missing a Paris Convention or PCT Filing Deadline so Deadly?

- These dates are largely determined by requirements of the Paris Convention and Patent Cooperation Treaty
- For the most part, these dates are extremely unforgiving!!
- It is *not possible to get an extension in most countries*
- It is *not possible to revive/reinstate to get a second chance*
- There is essentially *no recourse once you miss a deadline*

Why is Missing a Paris Convention or PCT Filing Deadline so Deadly?

- In short, missing Paris Convention and PCT deadlines can result in the irrecoverable and permanent loss of foreign rights in all inventions disclosed in the subject application
- If the invention is fundamental or otherwise highly valuable, the loss of rights can result in a substantial loss

Paris Convention Dates

- The Paris Convention Treaty gives an applicant the benefit of the priority date of an original filing in the applicant's home country
- Such applications must be filed within
 - 6 months from the filing date of a design patent
 - 12 months from the filing date of a provisional or utility patents
- There are about 26 countries that are member of the Paris Convention but not the PCT such as Argentina, Bahamas, Lebanon, Venezuela, etc.
 - http://www.wipo.int/pct/en/paris_non_pct.html
- Taiwan is not a member of the Paris convention however by treaty it does recognize priority claims to US applications

Patent Cooperation Treaty (PCT)

- The PCT gives an applicant the benefit of the priority date of an original filing in the applicant's home country and preserves the right to file later in currently 151 countries
- PCT applications must be filed within 12 months of the earliest filing date in order to claim priority

Patent Cooperation Treaty (PCT)

- The PCT National Phase Filing Dates are as follows:
 - ...30 months from the first-filed priority, countries like: Brazil, Canada*, Chile, China*, Israel, Japan, Mexico, Peru, Philippines, Thailand.
 - *with relatively small extension fees, Canada allows 42 months and China allows 32 months, in China the full application MUST be translated at time of filing.
 - ...31 months from the first-filed priority, countries like: Australia, Europe, India, Republic of Korea, Singapore, South Africa,
http://www.wipo.int/pct/en/texts/time_limits.html

Category 1: Errors or omissions made in docketing deadlines

- Wrong priority date(s) entered for application
- Common sources of errors:
 - Confusion resulting from multiple priority dates (e.g., multiple provisional apps rolled up into one regular filing)
 - Wrong date supplied by filing attorney or paralegal to docketing department
 - Simple data entry errors – wrong date entered from another document/communication
 - Incorrectly reading of dates (priority date, mail date, etc.)
 - dd/mm/yyyy can be incorrectly read as mm/dd/yyyy
 - Date entered correctly is later edited or removed (e.g., removing a priority date)

Category 2: Errors or omissions made in monitoring deadlines

- Common sources of errors in monitoring deadlines:
 - Orphaned file – responsibility for file is transferred between personnel, and responsibility is not taken up by newly assigned personnel – i.e., the file “falls into a crack”
 - Personnel assigned to monitor the docket is present at work, but fails to check docket, and date is missed
 - Confusion between related files – there are two similar files that get conflated in the mind of the monitoring personnel
 - Monitoring personnel is absent from work, and no one is assigned to back them up.

Category 3: Errors or omissions made in crossing off deadlines

- Instructions from client or co-worker are misunderstood, and item is improperly crossed off docket
- Client sends erroneous instructions
- Instructions are clear, but wrong file is crossed off docket

Category 4: Errors or omissions made in performing a desired foreign filing

- Don't receive foreign filing instructions in time
- Wrong case is foreign filed (can happen if files are similarly named or were filed on same date)
- Paralegal fails to file the application due to distraction or simple mental lapse
- Instructions sent to foreign associate too late –
 - E.g., its already tomorrow in Asia or too late in the day in Europe or India to reach foreign agent/attorney

Strategies/Processes for Avoiding Foreign Filing Misses

- Double docketing of foreign filing deadlines
- Verification of all priority dates
- *Use only paralegals and docketing experts who are proven to be exceptionally reliable*

Strategies/Processes for Avoiding Foreign Filing Misses (cont.)

- At least two parties responsible for cross-offs (e.g., docketing department AND attorney or paralegal verify cross-off)
- All cross-offs also verified in writing by client, especially abandonment instructions
- Docketing team sends reminders to responsible personnel the day before the foreign filing deadline, not day of deadline

Strategies/Processes for Avoiding Foreign Filing Misses (cont.)

- Sufficient notifications of due dates to client and receipt of instructions as early as possible
- Ensure instructions received from client are conveyed to correct personnel (both US and FF paralegal if they are different)
- Provisional filing 12-month deadline is also the deadline for all foreign filings. Require that full foreign instructions are received on provisional application deadlines (not just a US Utility conversion, or even PCT filing but also non-PCT countries must be filed at that time to preserve priority).

Mitigating Foreign Filing Misses

- If no absolute novelty bar, can still file without claiming priority
- PCT countries allow foreign filing up to 31 and 32 months, a few allow extensions.
 - Some countries covered by a European filing cannot enter individually if PCT is filed, i.e., France (and other EP countries) you must file either at 12-months or enter the PCT national phase through the EP to get France, you cannot enter PCT – France.
- If multiple priority dates on a continuation-in-part application, use later priority date to at least gain coverage for CIP material.
 - The Paris Convention only allows you to claim priority from the first application from the invention so long as it is within 12 months of the first filing. A CIP has two filing dates. The first filing date for the first invention from which it claims to be a continuation and a second filing date for the new added matter being the date of the filing of the CIP.
 - You can claim priority from a CIP more than 12 months after the filing date of the parent application but only for the second invention i.e. only for the subject matter added to the CIP. Usually the matter added to the CIP is not substantial enough to be separately claimable and hence it is not worth filing a convention application for it.
- File an alternative application on an improvement to mitigate loss of rights on an earlier filed application

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Thank you for your participation.

Questions?

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Corporate IP Departments that Outsource Prosecution

October 26, 2016 1:00 PM Central