

The Docketing Excellence Webinar Series



Common US Docketing Mistakes, and How to Avoid Them



INSTITUTE
Building Extraordinary IP Assets

Docket Cross-Off Vulnerabilities and Best Practices

- **Presenters and panelists:**
 - Ann McCrackin, President, Black Hills IP
 - Shawn Hise, Operational Excellence Manager, Black Hills IP
 - Carrie Steward Valades, International Docketing Specialist, Black Hills IP

Topics

- Foreign Filing Deadlines for Multiple Provisional Roll-Ups
- Accelerated Examination
- Inter-Partes Reexamination
- Docketing Multiple Options for Responding to Final Office Actions
- Docketing Deadlines for Challenging Patent Term Adjustment Calculations
- Docketing Deadlines for Submission of Prior Art
- Deadlines for Claiming Priority

Foreign Filing Deadlines for Multiple Provisional Roll-Ups

- Challenge: More than one provisional is rolled-up into a single non-provisional US filing. What are the best practices for docketing each foreign filing deadline that arises from any new matter in each provisional?
- Discuss Possible Solutions

Accelerated Examination

- Challenge: Accelerated examination does not permit applicant's to take extensions of time. How do you make sure that the non-extended due dates are treated as hard deadlines and not accidentally rolled forward on a busy attorney's docket?
- Discuss Possible Solutions

Inter-Partes Reexamination

- Challenge: Inter-Partes Reexamination requires specialized docketing that is unconventional and for some firms, not often encountered. How do you make sure that the docketing gets done correctly without upsetting normal docketing safeguards?
- Discuss Possible Solutions

Docketing Multiple Options for Responding to Final Office Actions

- Challenge: There are many options for responding to a final office action, and failure to properly execute one of them will cause an abandonment. What are some best practices for docketing all the possible options?
- Discuss Possible Solutions

Docketing Deadlines for Challenging Patent Term Adjustment Calculations

- Challenge: Failure to challenge a patent term adjustment within the prescribed time period can potentially result in loss of valuable patent term. How can you make sure that this is properly docketed and dealt with in an expeditious manner.
- Discuss Possible Solutions

Docketing Deadlines for Submission of Prior Art

- Challenge: Submitting information disclosure documents is a critical component of US prosecution. Often, however, prior art is often received in corresponding filings at inconvenient times late in prosecution. What are the best options for docketing the submission of late discovered art?
- Discuss Possible Solutions

Other ...

- Not all Notice of Allowance received are straight forward to docket and the Examiner's can be confusing at times. Differences between, **Notice of Allowance, Notice of Allowability, Supplemental Notice of Allowability and Corrected Notice of Allowance.**
- Discuss Possible Solutions

The Docketing Excellence Webinar Series

Panel Discussion and Questions

The Docketing Excellence Webinar Series

Please join us for our next presentation:

Patent Annuity Pricing Analytics – Deconstructing Patent Annuity
Service Pricing

December 8, 2016