

The Docketing Excellence Webinar Series



Best Practices and Options for Double Docketing to Reduce Risk of Missed Dates



INSTITUTE
Building Extraordinary IP Assets

Docket Cross-Off Vulnerabilities and Best Practices

- **Presenters and panelists:**
 - Ann McCrackin, President, Black Hills IP, LLC
 - Shelley Cape, Quality Control Manager, Black Hills IP, LLC.

Topics

- Scope of a backup docket
 - Type of docketing and associated risks
 - Riskiest docket items
- Methodologies for a backup docket
 - Overview of dual docketing methodologies

Types of docket dates and associated risks

- Non-final deadlines and reminders – minimal to no risk
- “Recoverable” final deadlines where where PTO notifies applicant of “miss” – minimal to no risk
- “Recoverable” final deadlines where where PTO does not reliably notify applicant of “miss” – high risk
- “Non-Recoverable” final deadlines – high risk

Riskiest/Most Vulnerable Docketing

- Annuity/maintenance fee docketing
- Deadlines to file non-provisional application claiming priority to provisional applications
- Deadlines to file foreign applications/PCT
- File Transfers

Annuity/Maintenance Fees - Risks

- In US and other countries, the patent owner often receives no notification that a payment has been missed, so there is no reliable backstop
- Even if a notice is provided, often it goes to the wrong party, and does not get forwarded
- Some countries, for example Japan, have extremely unforgiving rules regarding recovery of a missed date
- If an annuity file is accidentally marked “drop” or “don’t pay”, notifications of missed payments may be ignored

Deadlines for provisional “conversions” – Risks

- The USPTO does not notify applicant that a provisional has “expired”, so there is no USPTO backstop
- Once you go beyond the two-month grace period, there is no way to recover the original priority date after the 14 month date
- So, accidental cross-offs have to be discovered either shortly before the 12-month deadline or within the two month grace period or there is no chance to keep the original date
- There are not that many USPTO communications concerning a provisional, so if the provisional does not get set up properly on PAIR certificate, it is possible that communications after filing would not be received, which also serve as a backstop to make sure the case is on the docket

Deadlines for foreign filing- Risks

- The USPTO does not notify applicant that a foreign filing deadline is approaching, so there is no USPTO backstop
- Once you go by the one-year foreign filing deadline, there is no way to recover foreign filing rights in most all countries
- So, accidental cross-offs have to be discovered before the one year date, or there is no chance to foreign file off the original priority date
- Foreign filing deadlines for Asian countries must take into account time zones, or the deadline in Asia is already passed on the “last day” in the US

File Transfers

- File transfers are very high risk for several reasons:
 - Files can “fall through the cracks” and not get entered on the new docket at all
 - Dates that are time sensitive may not get added to new docket soon enough to take timely action
 - Abandonment notices and such are often sent to “old” address, so they are not received by new counsel
 - Files are often received in multiple different formats and are not necessarily properly docketed to begin with
 - Time crunch issues as many files need to be ingested at once

Example dual docketing methodologies

- Single electronic docketing system (e.g. CPI, IP Master), with dual/back up docket kept by paralegal on paper or electronic calendar
 - Risks:
 - Benefit of dual docketing only achieved if paralegal independently determines and calculates due dates (some risk they will just copy docketing department dates)
 - Benefits
 - Provided that paralegal is knowledgeable and independently determines back up docket dates, this is a highly effective risk reduction methodology

Example dual docketing methodologies

- Dual electronic docketing systems (e.g. CPI, IP Master), with two trained docketers, with or without back up docket kept by paralegal on paper or electronic calendar
 - Risks:
 - Biggest risk is that both docketers base their docketing on the same erroneous information – at least one should independently check source data
 - Benefits
 - Ultra-low risk to put on docket

Example of dual docketing methodology for cross offs

- Verified docket cross-off – Two people required to remove an item from docket
 - Risks:
 - An error in documenting client’s decision can thwart this system, as the “documentation” of the cross-off is wrong to begin with
 - Benefits
 - Lowers erroneous cross-off risk considerably over single-point-of-failure systems

Example of dual docketing methodology for cross offs

- Verified docket cross-off – Two people required to remove an item from docket, with Client Verification
 - Risks:
 - Requires that “second pair of eyes” be diligent in verifying the cross-off, and client verification is timely obtained
 - Benefits
 - “Second pair of eyes” combined with client confirmation of the cross-off offers a very reliable and very low risk approach to docket cross-off

The Docketing Excellence Webinar Series

Panel Discussion and Questions

The Docketing Excellence Webinar Series

Please join us for our next presentation:

Enter Date