

Practical Patent Webinar Series

Docketing and Docket Management for US Initial Filing (Provisionals & Regular Apps) Due/Bar Dates, Paris Convention and PCT Deadlines

4-Episode Webinar Series

Episode 01 – Docketing and Docketing Management for US Initial Filing (Provisionals & Regular /Apps)
Due/Bar Dates, Paris Convention & PCT Deadlines
Thursday, April 1st, 2021 at 12:00 PM CT

Episode 02 – Docketing Formalities, Restrictions, Non-Final Office Actions, PCT Actions
Thursday, June 3rd, 2021 at 10:00 AM CT

Episode 03 – Docketing Final Office Actions, Appeals, Continuations, Allowances
Thursday, August 5th, 2021 at TBD

Episode 04 – Docketing Post Issuance Deadlines: Certificates of Correction, Reissues, Patent Term Adjustment Verification, Maintenance Fees
Thursday, October 7th, 2021 at TBD

Before We Get Started...



Recording

A link to the recording and slides will be emailed to all registrants.



Questions

Type questions in the Q&A feature at any time, and we will address them during a Q&A session at the end of the webinar.



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Today's Presenters...



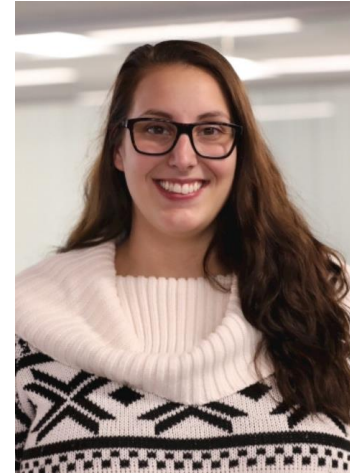
Ann McCrackin

President, Black Hills IP
Patent Attorney
Professor of Law



Zhakalazky Carrion

Docketing Manager
Schwegman, Lundberg &
Woessner



Ellen Franco

Docketing Manager
Black Hills IP

Polling Question

What is your role in your organization?

- Docketer
- Paralegal
- Attorney
- Manager/Administrator
- IT
- Other

Polling Question

What docketing system does your organization use?

- Anaqua
- AppColl
- CPI
- FoundationIP
- Inprotech
- IPFolio
- IP Manager
- Memotech
- Patricia
- Other

Episode Overview

US Initial Application Filings

What deadlines need to be docketed?

How are those deadlines docketed?

The importance of Priority Dates

Terminology

Initial Application Filings: US Provisional Applications and US Nonprovisional Applications

Filing Date: The date the application was filed.

Priority Date: The earliest filing date in a family of applications. If there is only one application, the priority date and the filing date are the same.

Deadlines to Docket

Prefiling Deadlines

- Bar Dates

Post Filing Deadlines

- US Deadlines
 - Deadline to claim priority to U.S. provisional applications
- Foreign Deadlines
 - Paris Convention Deadlines
 - Patent Cooperation Treaty (PCT) deadlines
- National Stage Deadlines
 - 30/31

Prefiling Deadlines

Bar Dates

“In the United States, you have one year from the date of first public disclosure, public use, publication, sale or offer for sale of your invention, in which to file at least a provisional patent application, or you will be forever barred (hence the term “**bar date**”), or prohibited by law, from filing a patent application for your invention.”

(<https://ipatentattorney.com/articles/patent-law/beware-of-the-bar-date/>)

Polling Question

How do you get bar dates on the docket?

- Rely on Attorney to tell docketing department
- Docketing reaches out to Attorney

Post Filing Deadlines

US Deadlines

Provisional Conversation Deadline

- Applications must be filed within a 12-month period from the filing date of the application

Post Filing Deadlines

US Deadlines – Deadlines to claim priority to U.S. provisional applications

- *“a nonprovisional application that was filed more than 12 months after the filing date of the provisional application, but within 14 months after the filing date of the provisional application, may have the benefit of the provisional application restored by filing a grantable petition (including a statement that the delay in filing the nonprovisional application was unintentional and the required petition fee) to restore the benefit under 37 CFR 1.78.” (<http://www.uspto.gov/patents-getting-started/patent-basics/types-patent-applications/provisional-application-patent>)*
- **10 Month Government Conversion Deadline** (*Bayh-Dole Act or Patent and Trademark Law Amendments Act*) – *This deadline applies for inventions that are funded by the federal government. “permit government contractors to retain ownership of inventions developed with federal funding. However, to retain ownership the contractor must take certain actions within certain deadlines. If the contractor misses these deadlines, the government agency can take title to the invention.” (<https://www.foxrothschild.com/publications/government-contractors-federally-funded-inventions-subject-to-new-disclosure-requirements-and-deadlines/>)*

Post Filing Deadlines

Provisional Deadlines

- 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 your customer number, 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.

Post Filing Deadlines

Foreign Filing Deadlines

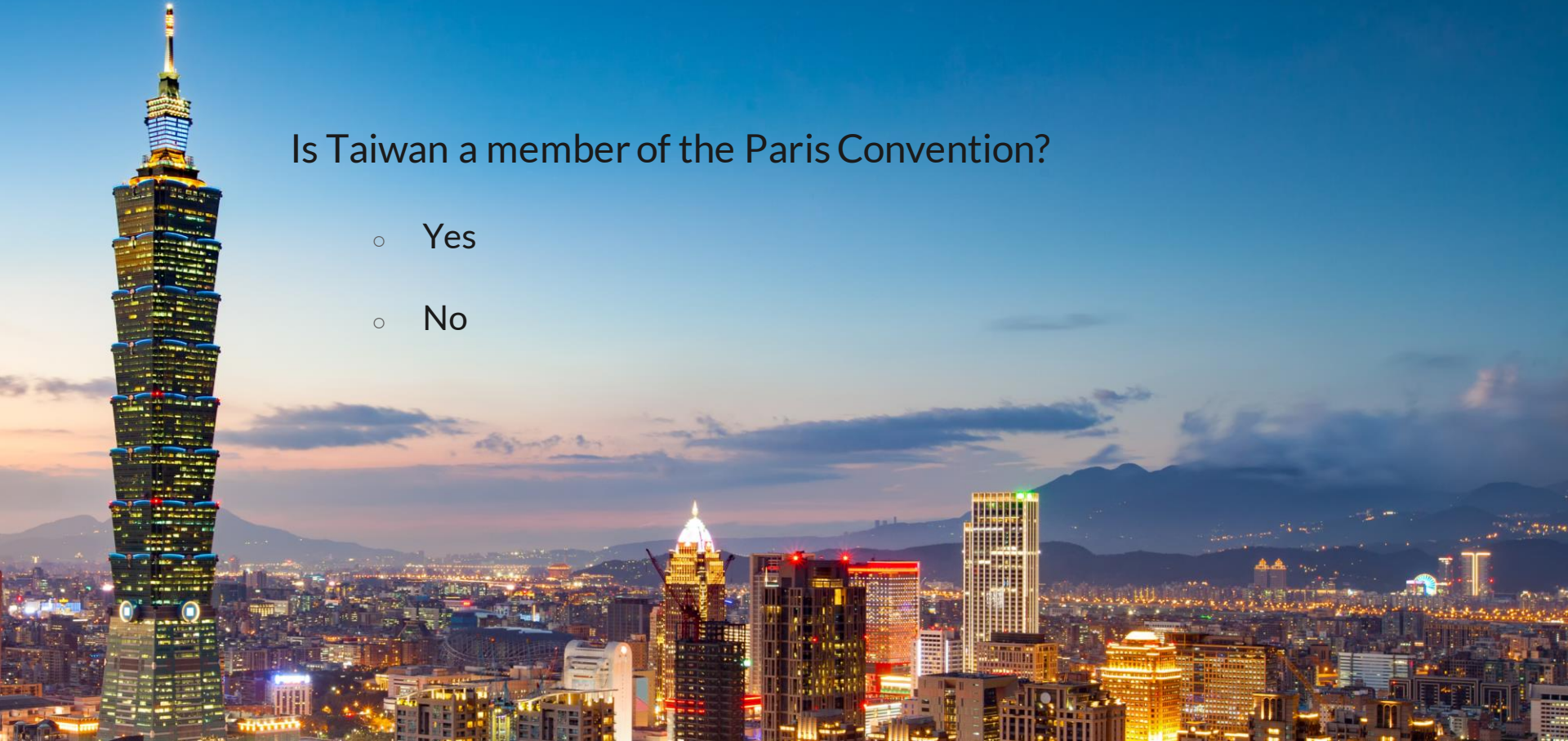
- **Paris Convention Deadline** -- The Paris Convention for the Protection of Industrial Property provides that once you file an application in one country party to the Convention, you are entitled to claim priority for a period of twelve months and the filing date of that first application is considered the “**priority date.**” Therefore, when you apply for protection in other member countries of the Paris Convention during those twelve months (depending on the patent type), the filing date of your first application is considered to have “priority” over other applications filed after that date.
- **Patent Cooperation Treaty (PCT) deadlines** -- Applications must be filed within a 12-month period from the filing date/ priority date of the application.



Polling Question

Is Taiwan a member of the Paris Convention?

- Yes
- No



Post Filing Deadlines

Foreign Filing Deadlines

- 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, it is difficult to recover foreign filing rights in most countries.
- So, accidental cross-offs have to be discovered before the one-year date, or you may not be able 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.

Post Filing Deadlines

30/31 Month National Phase deadlines (PCT Chapter I or II)

➤ “The **National Phase Application** is an application filed for obtaining a grant of patents in different countries simultaneously based on a single International/PCT application that is filed within 12 months from the priority date (or filed directly).” (<https://www.globalpatentfiling.com/services/national-phase-filings>)

How to Docket Deadlines?

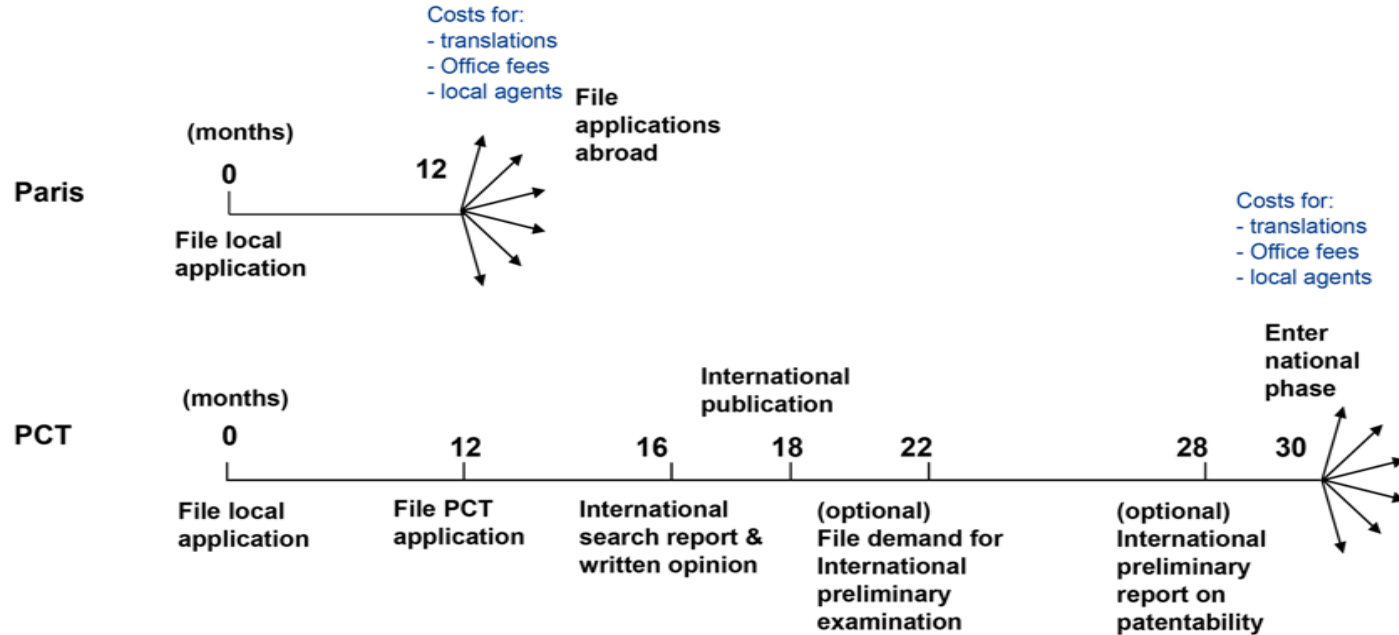


Image source : <http://www.wipo.int/pct/en/faqs/faqs.html>

How are these deadlines docketed?

The post filing deadlines are based on the earliest priority date (or the filing date if there is no priority date.)

- Provisional Conversation deadlines
 - Twelve months from earliest priority date.
- Foreign Filing deadlines based on Paris Convention
 - Six months from earliest priority date for design patents.
 - Twelve months from earliest priority date for utility patents (Continuation in Parts, applications with New Matter).
 - States bound by the Paris Convention but not the PCT
 - https://www.wipo.int/pct/en/paris_non_pct.html
- PCT Chapter II deadlines
 - Thirty months from earliest priority date
 - Some countries allow more time
 - 31 Months Countries (EP, AU, KR), 32 Months (CN) & 34 Months (BA)
 - http://www.wipo.int/pct/en/texts/time_limits.html

Polling Question

Which dates are entered by the docketer in an electronic docketing system?

- I. Filing date
- II. Priority date
- III. Provisional Conversion deadline
- IV. Foreign filing deadline

- A. I only
- B. I and II only
- C. I, II, and III
- D. I, II, III, and IV

Docketing Checklist for New Application

- Verify File Type to ensure it matches with the type of application that is being docketed.
- Enter Earliest Priority Application Number and Date (if applicable).
- Enter Application Number and Filing Date.
- Verify Foreign Filing deadline launched (1 year from earliest priority, or if application has new matter, then 1 year from filing date).
- Verify Non-Provisional/Conversion deadline launched (1 year from earliest priority) (if applicable).

The Importance of Priority Dates

Where and **when** do priority date errors frequently occur?

- **File opening process**
- **File transfer / intake process**



The Importance of Priority Dates

CAUTION!

When there are multiple priority dates for single new application due to multiple provisional filings, make sure the earliest priority date is entered.

Polling Question

Assume you are opening a file in your docketing system for a new US nonprovisional application filed on April 1, 2021 which claims priority to the following three applications. Which one should be entered as the priority date in the docketing system?

- U.S. provisional application filed September 15, 2020
- U.S. provisional application filed June 1, 2020
- Australian application filed May 1, 2020

The Importance of Priority Dates

Preventative Measures

- For docketing of foreign filing deadlines, verify all priority dates used to calculate the deadlines.
- Consider auditing the priority dates in your docketing system.
- For cross-offs, verify all cross-offs of post-filing deadlines, to be certain there is not a single point of failure.
- Back up docket for these nonrecoverable post-filing deadlines.
- Automate your docketing process!

Polling Question

What type of backup docket do you use?

- Another electronic docketing system
- Paralegal Docket Book (Paper)
- Spreadsheet
- Outlook
- Other
- I do not have a backup docket

Polling Question

Assume you filed a US provisional application one year ago on April 1, 2020 and you are filing the US nonprovisional application with no new matter today (April 1, 2021) that claims priority to the provisional application. What is the correct due date for the foreign filing deadline?

- April 1, 2021
- April 1, 2022
- October 1, 2022

Summary



US Initial Application Filings

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Thank you for your interest.

Questions?



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Digital Transformation of the Legal Industry Webinar Series

Episode 01 – What is Digital Transformation for Law Practices?

Thursday, February 11th, 2021 at 12:00 PM CT

Episode 02 – SLW Digital Transformation Case Study: Overview of SLW systems, tools, data lake, processes, teams and personnel.

Thursday, March 11th, 2021 at 12:00 PM CT

Episode 03 – SLW Digital Transformation Case Study: Application Preparation – Disclosure intake and docketing, application drafting tools, production management

Thursday, April 8th, 2021 at 12:00 PM CT

Episode 04 – SLW Digital Transformation Case Study: Prosecution I – Receiving & Reporting PTO Correspondence – docketing, data/document storage, work packets, drafting and filing papers and responses; reporting to clients

Thursday, May 13th 2021 at 12:00 PM CT

Episode 05 – SLW Digital Transformation Case Study: Prosecution II – Claim tracking, reference analysis tools and reports, prosecution landscape tools and reports, examiner/prosecution analytics, IDS management

Thursday, June 10th, 2021 at 12:00 PM CT

Episode 06 – SLW Digital Transformation Case Study: Due Diligence, Freedom to Operate Studies, Landscape Studies, Portfolio Curation, Portfolio Analytics, Landscape Analytics, Examiner and Attorney Analytics

Thursday, July 8th, 2021 at 12:00 PM CT

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