

Practical Patent Practice Webinar Series Episode 04

Docketing Post Issuance Deadlines for US Patents

4-Episode Webinar Series

Episode 01 – Docketing and Docketing Management for US Initial Filing (Provisionals & Regular /Apps) Due/Bar Dates, Paris Convention & PCT Deadlines
[Available on demand at slwip.com](https://slwip.com)

Episode 02 – Docketing Formalities, Restrictions, Non-Final Office Actions
[Available on demand at slwip.com](https://slwip.com)

Episode 03 – Docketing Final Office Actions, Appeals, Allowances and Issuance
[Available on demand at slwip.com](https://slwip.com)

Episode 04 – Docketing Post Issuance Deadlines: Certificates of Correction, Reissues, Patent Term Adjustment Verification, Maintenance Fees
Thursday, October 7th, 2021 at 12:00 PM CT

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.



Social

Follow us on LinkedIn or go to SLW Institute on slwip.com and BlackHillsIP.com to see upcoming and on demand webinars.

Today's Presenters...



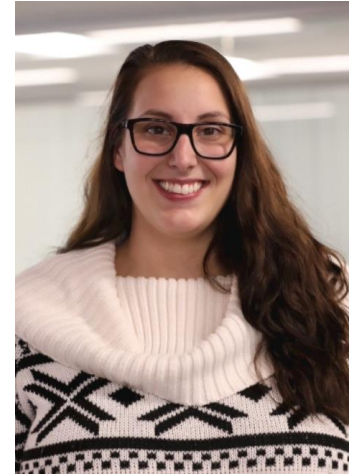
Ann McCrackin

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 primary role in your organization?

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

Polling Question

Who does your US patent docketing?

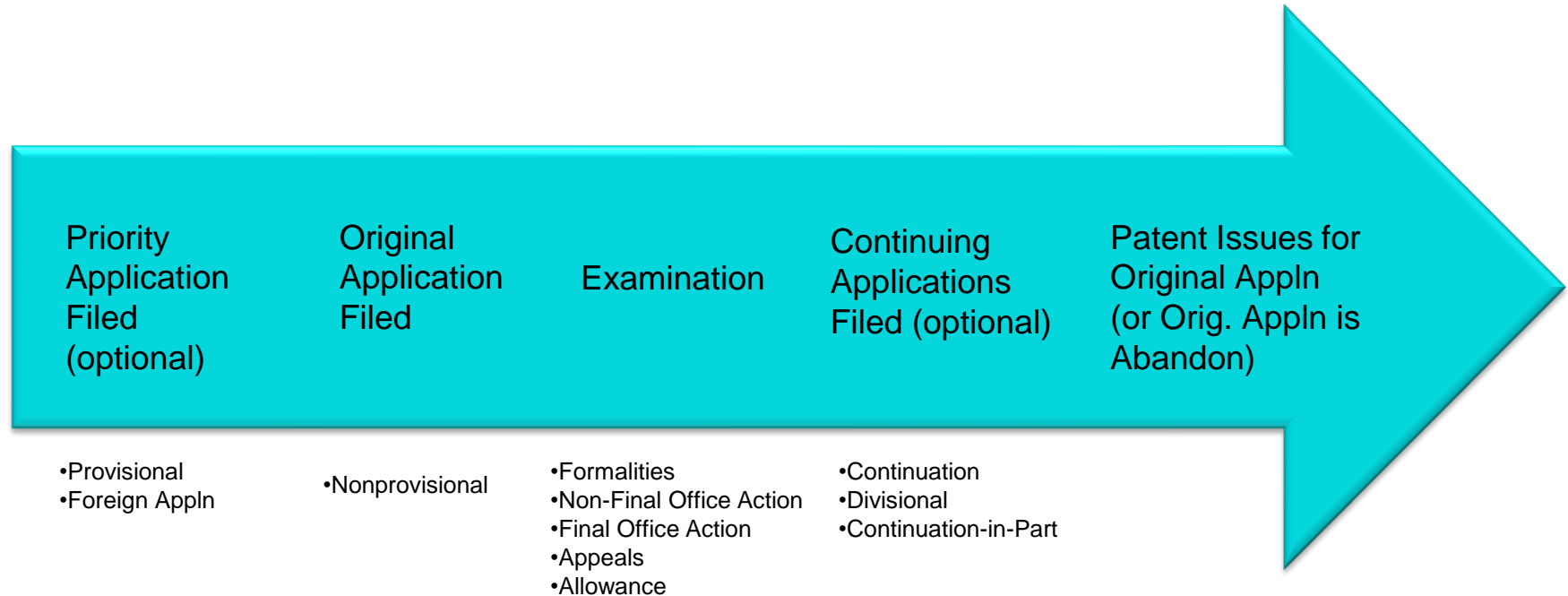
- Internal Docketing Team
- Internal Paralegals
- Outside Vendor
- Outside Counsel updates my docketing system
- No internal docket
- Other

Polling Question

What is the primary docketing system that you use?

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

Overview of a Patent Prosecution Process for a US Patent Application



Program Objectives

1. Identify required and optional events in the life of a patent that happen after a patent issues
2. Understand what deadlines are associated with those events
3. Test Your Knowledge of the post grant docketing with a series of polling questions

Episode Overview

1. Patent Term and Expiration Date
2. Required Post Grant Deadlines
3. Optional Post Grant Deadlines

Patent Term and Patent Expiration Date



US Utility Patents

- For U.S. utility applications filed after June 7, 1995, the term of a patent is **20 years** from the date on which the application was filed in the U.S. or, if, the application contained a specific reference to an earlier filed application or applications under 35 USC 120, 121 or 365(c), twenty years from the filing date of the earliest of such application.

US Design Patents

- U.S. design patents resulting from applications filed on or after May 13, 2015 have a **15 year** term from issuance.

Test Your Knowledge

What is the term for a US design patent that was filed before May 13, 2015?

- 14 years from issuance
- 15 years from issuance
- 16 years from issuance
- 17 years from issuance

Is there a notification from the PTO that provides the patent expiration date?

No; The USPTO does not calculate expiration dates for patents.

How is the expiration date of a patent calculated?

The factors to consider when calculating the expiration date of a patent include:

- type of application (utility, design);
- filing date of the application;
- the grant date of the patent;
- benefit claims under 35 U.S.C. § 120, 121 or 365(c);
- patent term adjustments and extensions under 35 U.S.C. § 154;
- patent term extensions under 35 U.S.C. § 156;
- terminal disclaimer(s); and
- timely payment of maintenance fees.

Patent Term Calculator

- The USPTO has a free downloadable patent term calculator to help the public estimate the expiration date of a patent.
- The calculator is available at:
- <https://www.uspto.gov/patents/laws/patent-term-calculator#heading-5>

Other Resources

- For general questions on patent term, USPTO's Office of Patent Legal Administration help line at 571-272-7702 is available as a resource.



PATENT TERM CALCULATOR

If this estimate is for either a **reexamination** or a **reissue** you must use the **original** patent's information.

NOTE: If you wish to save this file for future reference, please retype the date in this calculated field.

Today's date is:

For what type of patent are you calculating a term?

(NOTE: If a **reexamination** or **reissue**, base calculations on the **original** patent's information)

What is the filing date of the patent (U.S. or 371 International Date, if applicable)?

Domestic Benefit

Does the patent claim any domestic benefit?

If the patent claims any domestic benefit, what is the Earliest Effective Filing Date?

Domestic Benefit = Continuation, Continuation-in-Part, or Divisional

What is the grant date of the patent?

How much 154 PTA is the patent entitled to (days)? If none, enter '0'

How much 156 PTE is the patent entitled to (days)? If none, enter '0'

Terminal Disclaimers

Does the patent have any terminal disclaimers?

If there are any terminal disclaimers, what is the earliest TD-based expiration date?

Timely Payment of Maintenance Fees

NOTE: For patents that are not designs or plants, maintenance fees must be paid on time to preserve the full patent term. Maintenance fees are due three times during the life of a patent, and may be paid without surcharge 3 to 3.5 years, 7 to 7.5 years, and 11 to 11.5 years after the date of

MM DD YYYY
10 6 2021

utility

MM DD YYYY
1 1 2019

☐ Yes ☒ No

MM DD YYYY

MM DD YYYY
10 1 2021

0 days of 154 PTA

0 days of 156 PTE

☐ Yes ☒ No

MM DD YYYY

Clear

Available
A
th

Timely Payment of Maintenance Fees

NOTE: For patents that are not designs or plants, maintenance fees must be paid on time to preserve the full patent term. Maintenance fees are due three times during the life of a patent, and may be paid without surcharge 3 to 3.5 years, 7 to 7.5 years, and 11 to 11.5 years after the date of issue and cannot be paid early. Maintenance fees may also be paid with a surcharge during the "grace periods" of 3.5 to 4 years, 7.5 to 8 years, and 11.5 to 12 years after the date of issue.

The dates below reflect the latest possible payment date, including grace periods.

Your first Maintenance Fee should be paid no later than 4 years after issue:

MM	DD	YYYY
10	1	2025
▼		

Your second Maintenance Fee should be paid no later than 8 years after issue:

MM	DD	YYYY
10	1	2029
▼		

Your third Maintenance Fee should be paid no later than 12 years after issue:

MM	DD	YYYY
10	1	2033
▼		

NOTICE: This calculator is only an educational tool. It was developed based on assumptions that may or may not apply in a particular case. It does not provide a determination of any kind by USPTO. It is not intended to, and does not, create any right or benefit, substantive or procedural, enforceable at law or in equity by a party against the United States, its departments, agencies, instrumentalities, entities, officers, employees or agents, or any other person.

The calculated expiration date for this patent is

MM	DD	YYYY
1	1	2039

Required Post Grant Deadlines

The background of the slide is a solid blue color. Overlaid on this background is a repeating pattern of white line-art icons. These icons are related to time and scheduling, including various styles of clocks (analog, digital, alarm), calendars, hourglasses, and symbols for time management like a checkmark on a calendar and a clock with a plus sign.

- Maintenance Fees

Maintenance Fees

- Maintenance fees are required to keep in force all utility and reissue utility patents in the US.
- Maintenance fees are not required for a design or plant patents.
- Maintenance fees must be paid in all utility patents to maintain a patent in force beyond 4, 8 and 12 years after the date of grant

Test Your Knowledge

What is the earliest date that the first US maintenance fee can be paid?

- Any time after grant
- 2.5 years after grant
- 3 years after grant
- 3.5 years after grant

What is the PTO deadline to docket?

- Maintenance fees are due 3.5, 7.5 and 11.5 years from Grant Date of the Patent.
- There is no surcharge for payments made during the 3 to 3.5 year window, 7 to 7.5 year window, and 11 to 11.5 year.

Is the deadline extendable?

- Yes, but there is a surcharge for payments made during the "grace periods" at 3.5 to 4 years, 7.5 to 8 years, and 11.5 to 12 years after the date of issue.
- If the maintenance fee is not paid within the first six months in the year in which it can be paid, a *Maintenance Fee Reminder* notice is sent to the fee address or correspondence address on record.
- **WARNING: If maintenance fees and any applicable surcharges are not paid the patent protection lapses and the rights provided by a patent are no longer enforceable.**



United States Patent and Trademark Office

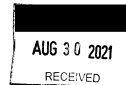
Office of the Commissioner for Patents

Customer Number

[REDACTED]

[REDACTED]

MINNEAPOLIS, MN 55402-0938



Date Printed
08/23/21

MAINTENANCE FEE REMINDER

According to the records of the U.S. Patent and Trademark Office (USPTO) the maintenance fee for the patent(s) listed below (for which the above address is on record as the fee address under 37 CFR 1.363) has not been paid within the six-month period set forth in 37 CFR 1.362(d). THE MAINTENANCE FEE MAY STILL BE PAID WITH THE APPLICABLE SURCHARGE SET FORTH IN 37 CFR 1.20(h), WITHIN THE SIX-MONTH GRACE PERIOD SET FORTH IN 37 CFR 1.362(e). (Note: the six-month grace period is not based on the printed date of this notice.)

Unless payment of the maintenance fee and the applicable surcharge is received in the USPTO within the six-month grace period, THE PATENT WILL EXPIRE AS OF THE END OF THE GRACE PERIOD. 35 U.S.C. 41(b).

The total payment due is the amount required on the date the fee is paid (and not necessarily the amount indicated below). All USPTO fees (including maintenance fees) are subject to change. Customers should refer to the USPTO website at www.uspto.gov/PatentMaintenanceFees or call the Maintenance Fee Branch at 571-272-6500 for the most current fee amounts for the correct entity status before submitting payment. The total payment due indicated below is based on the entity status according to current Office records (shown below).

Timely payment of the total payment due is required in order to avoid expiration of the patent. The payment can be timely made by paying online (Eastern Time) or using the certificate of mailing or transmission procedure set forth in 37 CFR 1.8.

Patent Number	Application Fee Number	Maint. Amount	Issue Surchg	Issue Date	Filing Date	Payment Year	Entity Status	Total Pymt Due	Attorney Docket Number
[REDACTED]	[REDACTED]	[REDACTED]	[REDACTED]	[REDACTED]	[REDACTED]	[REDACTED]	[REDACTED]	[REDACTED]	[REDACTED]

The maintenance fee and the applicable surcharge can be paid quickly online at www.uspto.gov by credit and debit card, electronic funds transfer (EFT), or USPTO deposit account payment methods. The mailing address for all maintenance fee payments not submitted online (and any questions about this notice) is: Mail Stop Maintenance Fee, Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450.

NOTE: This notice was automatically generated based on the amount of time that elapsed since the date a patent was granted. It is possible that the patent term may have ended or been shortened due to a terminal disclaimer that was filed in the application. Also, for any patent that issued from an application filed on or after June 8, 1995 containing a specific reference to an earlier filed application or applications under 35 U.S.C. 120, 121, or 365(c), the patent term ends 20 years from the date on which the earliest such application was filed, unless the term was adjusted or extended under 35 U.S.C. 154 or 156. Patentee should determine the relevant patent term for a patent before paying the maintenance fee.

Optional Post Grant Deadlines

The background of the slide features a repeating pattern of various time-related icons in a light blue color. These icons include analog and digital clocks, calendars, alarm clocks, hourglasses, and circular arrows, all set against a blue gradient background.

Optional Deadlines

- PTA Reconsideration
- Certificate of Correction Request
- Reissue Applications
- Deadline to File Post Grant Review

Request for Reconsideration of a PTA

- A Patent Term Adjustment ("PTA") is a number of additional days of patent term that is owed to the Applicant beyond the initial 20 years to offset delays caused by the USPTO during the prosecution of the patent application.
- Any patent filed on or after May 29, 2000, is eligible for a PTA
- The PTA amount can be found in the Issue Notification, in PAIR under the "Patent Term Adjustments" tab, and on the face of the Original Letters Patent.
- If patentee wants the USPTO to reconsider its patent term adjustment determination, the patentee must use the procedures set forth in 37 CFR 1.705(b) for requesting reconsideration of a patent term adjustment determination.

Test Your Knowledge

How many months can the deadline to file a request for reconsideration of a PTA determination be extended?

- 2 months
- 3 months
- 4 months
- 5 months
- None of the above. This deadline is not extendable.

What is the PTO deadline to docket?

- 2 months from grant date.
 - Docket extendable due date two months from issue date for filing request for Reconsideration of PTA

Is the deadline extendable?

- Yes – up to 5 months.
 - Docket non-extendable deadline seven months from issue date for filing Request for Reconsideration of PTA amount.

Is there a notification from the PTO regarding a PTA Reconsideration?

No

Certificate of Correction

- After a patent issues, a patentee can petition for a correction of “clerical or typographical nature, or of minor character” or clear mistake by the USPTO.
- Errors are typically identified by proofreading the issued patent.
- There is no fee if the error is a USPTO mistake and currently a \$160 fee for correcting applicant-mistakes (no small/micro entity fee reduction).

Test Your Knowledge

What is the deadline for filing a certificate of correction?

- 6 months from the grant date.
- 1 year from the grant date.
- 2 years from the grant date.
- None of the above.

What is the PTO deadline to docket?

- None.

Suggested Practice:

- Docket a deadline to proofread the patent 1 month from the grant date.
- Docket a deadline to file a certificate of correction 2 months from the grant date.

Is the deadline extendable?

N/A

Polling Question

Do you proofread your issued patents?

- We proofread for at least some of our clients
- We use an outside vendor to proofread
- We do not proofread our patents
- Other

Reissue Applications

- A reissue application is filed to correct an error in the patent, where as a result of the error, the patent is deemed wholly or partly inoperative or invalid.
- The most common reasons for filing a reissue application are:
 - (A) the claims are too narrow or too broad;
 - (B) the disclosure contains inaccuracies;
 - (C) applicant failed to or incorrectly claimed foreign priority; and
 - (D) applicant failed to make reference to or incorrectly made reference to prior copending applications.

Test Your Knowledge

What is the deadline to file a reissue application enlarging (broadening) the scope of the claims?

- 9 months from the grant date.
- 1 year from the grant date.
- 2 years from the grant date.
- None of the above.

What is the PTO deadline to docket?

- 2 years from grant date of the original patent if the scope of the claims will be broadened
- No deadline to docket for a nonbroadening reissue

Is the deadline extendable?

No, the 2-year deadline is not extendable.

Is there a notification from the PTO regarding Reissue?

No

Post Grant Review

- Post grant review (PGR) is a trial proceeding conducted at the Patent Trial and Appeal Board (PTAB) to review the patentability of one or more claims in a patent. Post grant review process begins with a third party who is not the patent owner filing a petition.

Polling Question

What is the deadline to file a post grant review petition (PGR)?

- 3 months after the patent grants
- 9 months after the patent grants
- 1 year after the patent grants
- 2 years after the patent grants
- None of the above.

What is the PTO deadline to docket?

9 Months from grant date.

Is the deadline extendable?

No

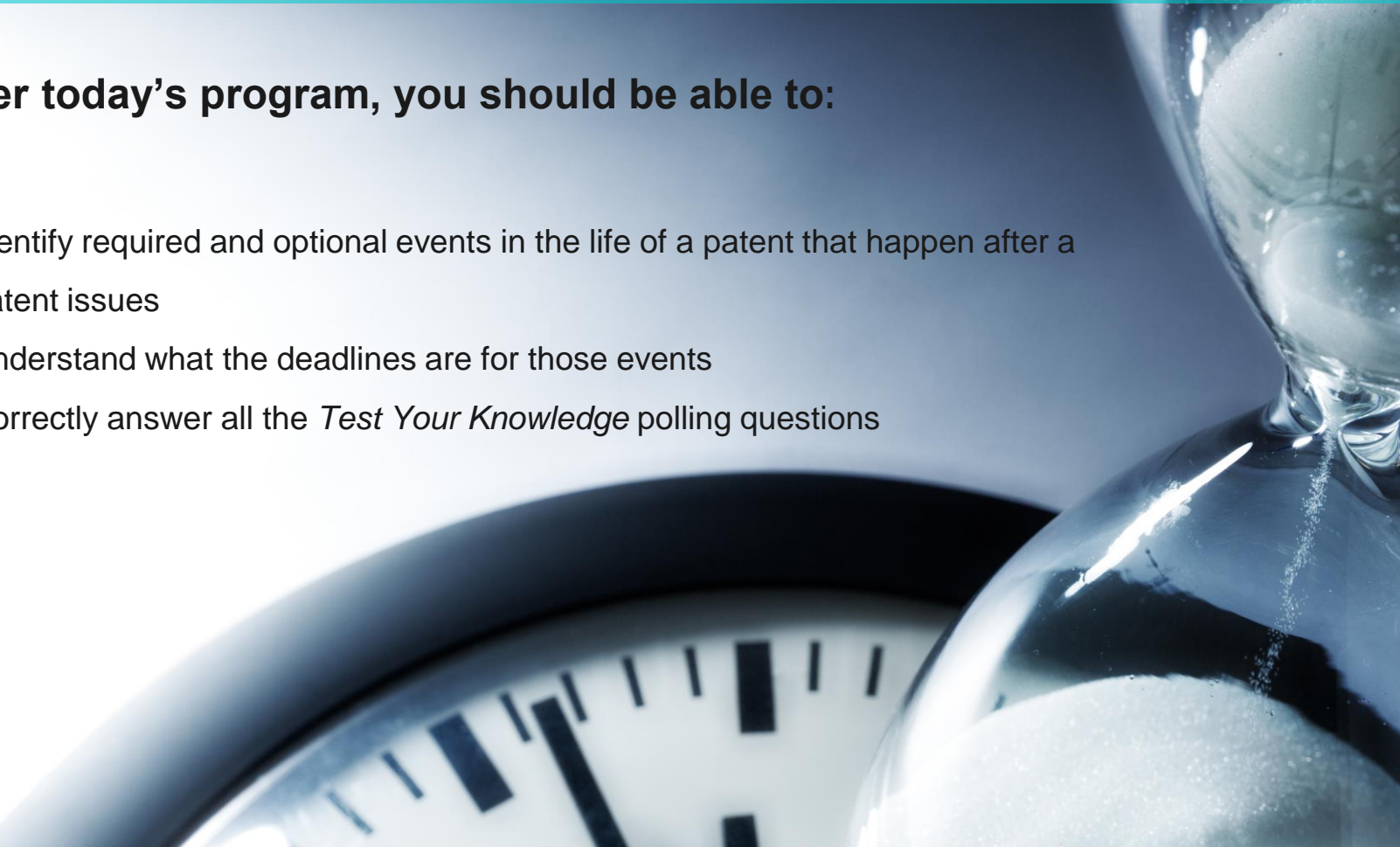
Is there a notification from the PTO regarding Deadline to File Post Grant Review?

No

Summary

After today's program, you should be able to:

1. Identify required and optional events in the life of a patent that happen after a patent issues
2. Understand what the deadlines are for those events
3. Correctly answer all the *Test Your Knowledge* polling questions



Coming Soon ...

Hear more from Z and Ellen in ...

Black Hills IP Webinar:

How Automation and AI are Changing Professional Opportunities in the IP Profession

Tuesday, October 19 at 12 p.m. Central

The introduction of automated legal decision-making systems and increasing automation of document authoring and generation are slowly but surely reconfiguring both the staffing of positions such as docketing, paralegal and attorneys, and also professional opportunities in the future. Our speakers will discuss the exciting new career opportunities and fading career options in the AI-driven legal industry at present and in the future.

Keep an eye out for the email invitation, or register at:

https://slwip.zoom.us/webinar/register/WN_mh76vtOtSACxhHzUPvtLOQ

Thank you for your interest.

Questions?



Contact Information

Jim Brophy

VP of Sales

Black Hills IP

Jbrophy@blackhillsip.com



Michelle Forsberg

Marketing Administrator

Schwegman Lundberg &
Woessner

mforsberg@slwip.com



These materials are for general informational purposes only. They are not intended to be legal advice and should not be taken as legal advice. They do not establish an attorney-client relationship.