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“Tip of the Month”

Devil in the Docketing Details

A very common misperception after a patent is granted is that there is nothing left to do. However, the United States Patent and Trademark Office (USPTO) requires further maintenance in order to keep the patent alive. Many inventors quickly discover the benefits of engaging maintenance services, also called docketing services. Why?

Detail #1: Many inventors need reminders when their fees are due. The USPTO sometimes, but not always, provides a single reminder. That reminder, when it is sent, is always during the surcharge period. The only notice the USPTO does send is a *Notice of Patent Expiration*, which is too little, too late and only after the inventor has missed a deadline for filing a required fee.

Detail #2: The USPTO is a stickler for details. An overlooked detail can result in early termination of your patent. There are a lot of details to pay attention to because the USPTO maintenance fee system is rather eccentric.

- USPTO fees can be more complicated to determine than your taxes. USPTO fees are based on projected future gain. Further, patent fees are not set at the time the patent issues, but instead vary based on several factors: the renewal period you are in; your entity status; the relevant CFR section (37 CFR 1.20 (e), (f), (g)); and the underlying USPTO Fee Schedule Fee Codes (1551-1558, 2551-2558, 3551-3558).
- USPTO fees can only be paid during specific maintenance fee payment “windows,” which are only “open” at 3 to 4 years, 7 to 8 years, and 11 to 12 years after the patent issues with the later 6 months of each window being the surcharge period.
- Missing the payment window results in a revival fee that is far *more* than the original fee.
- If you make an error in payment, the USPTO requires you to fix your filing fee error without prompting. Failure to pay the correct fee can result in early *termination of the patent* altogether.

Detail #3: The need for attention to details never ends because the advent of the internet also brought the advent of internet-based scams. Patent owners who try to handle maintenance fees themselves can be targets to internet scam artists because patent correspondence addresses are publicly available on the USPTO database. In fact, fraudulent solicitations from entities *appearing to be the USPTO* have resulted in patent owners paying the ‘maintenance fee’ to these fraudulent entities. The result is that the corresponding patents expire for failure to pay the *proper* maintenance fee.

In view of all the risk and hassle involved, it’s not surprising that inventors request help with their docketing needs. If you have any questions about docketing services, feel free to give us a call at 603-668-1971 or contact us by e-mail at *mailbox @ biz-patlaw.com*. We are here to help.

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