

STRATEGIES, RECOMMENDATIONS AND SOLUTIONS

# The ultimate guide to docketing

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# Understanding IP docketing

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In judicial operations, a docket is a log containing a complete history of every case handled by a specific court during a given term. It includes chronological entries that summarize all primary and [supplementary court proceedings](#).

Intellectual Property (IP) docketing is a little different, as the docket functions more like a calendar of official deadlines. When an organization wishes to establish a portfolio of trademarks, patents, designs, copyrights or other IP assets, it must prosecute each exclusive right according to the regulations of every relevant jurisdiction. This process can take a substantial amount of time and requires responding to correspondence from government IP offices with the appropriate legal actions within deadlines.

IP docketing is a necessity for businesses seeking to organize and maintain their IP protections. With so many elements involved in managing IP rights, keeping track of all the details can be challenging. Depending on how many protections are being managed, a designated IP docketer or a team of docketing specialists will benefit any organization. Being experienced with various jurisdictions' regulations, they will be able to navigate key prosecution processes smoothly and confidently. By contrast, failing to stay organized during the filing process can result in rejected applications for valuable IP rights, resulting in a loss of time, money and labor.

## Contents

02	Understanding IP docketing
03	How organizations are improving their docketing processes
04	Docketing in today's market
05	Docketing strategies to support the IP life cycle
06	Avoid making assumptions
07	Incorporate notes throughout docketing
08	Tips and tricks from your docketing team
09	Answering common IP docketing questions
10	Key considerations when selecting a docketing service
11	Onboarding with Denne Meyer: FAQ
12	Denne Meyer's IP docketing solutions

## How organizations are improving their docketing processes

Docketers process upcoming deadlines for all types of IP, including responses to office actions, requests for additional documentation (drawings, updated claims, classes, seizure notices, etc.) and other essential correspondence. An IP management system (IPMS) allows docketing teams to store conveniently and securely any required bibliographic data associated with office actions, infringements, cancellations, prior art, information disclosure statements (IDSs), renewals and much more.

” By centralizing all of these legal activities, correspondence and other data in one IP management system, docketing teams ensure that all official deadlines can be met with the appropriate documentation in hand.

In addition, incoming IP-related emails are assigned to the relevant asset and due date. Using a sophisticated docketing solution makes it easy to create templated or custom reports for various assets within the IP portfolio on a regular or ad hoc basis. Docketing is essential for any organization that wants to establish and maintain a streamlined, systematized prosecution process.



## Docketing in today's market

Implementing a docketing solution can offer a significant number of distinct advantages — benefits that any organization or internal IP team should wish to realize. Some of the most notable gains include:

- ① **Increased efficiency and productivity:** Docketing systems streamline workflows, freeing up time that can be better spent on more strategic tasks.
- ② **Reduced costs:** Using a docketing system grants the benefits of having an extended team member without the additional costs of a direct employee.
- ③ **Improved accuracy:** The human touch is irreplaceable and allows for comprehensive data checking in response to incoming material. People working in this field understand the complex legal rules that apply to IP and think creatively to solve problems.
- ④ **Dependability:** Working with process experts with a proven track record means you can depend on them to collaborate and integrate into your workflows and procedures.



# Docketing strategies to support the IP life cycle

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## Leverage expertise to empower personnel

While technology is making the docketing process faster and more straightforward, organizations cannot depend solely on digital tools.

Many elements go into docketing and the whole life cycle of IP. For instance, keeping track of all deadlines during M&A activities can be a significant challenge. As such, organizations must always have staff available who can spearhead the docketing process. IP experts with substantial training and experience in docketing can apply their analytical and critical-thinking skills to address complex matters, knowing they have the support of their digital tools for centralized record-keeping, data validation, correspondence management and other responsibilities.

## Define responsibilities properly

It is also essential to allocate costs and resources correctly. Docketing staff should focus on tasks best suited to their skills: entering IP records and new filings into the docket, recording office actions and other official correspondence, uploading docketing records into the IPMS and reporting on progress. Docketers should not be handling paralegal responsibilities such as preliminary research, clearance and prior art searches and analyses; preparing for, drafting and filing patent and trademark applications, managing filing-related correspondence, exchanging with foreign agents and outside counsel and communicating with clients through the various stages of the IP life cycle.



## Avoid making assumptions

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As docketers receive and review documents throughout the IP life cycle, there are several occasions where guesswork can creep into the picture. However, assumptions can lead to critical errors that disrupt docketing and delay IP protections. Some such risks are illustrated in the following cases:

### Closing deadlines without proof

As noted earlier, an IP docket serves as a calendar of important deadlines in the IP life cycle. If a team member hears that a colleague filed, for example, a required affidavit of use for a trademark application but does not see proof of that action in the IPMS, they should not mark the task as completed without the supporting evidence.

### Prematurely marking cases as inactive

Imagine an IP law firm does not respond to an office action from an IP office. Eventually, this will cause the office to send a notice of abandonment, withdrawal or lapse, which will later be entered into the IP docket. Docketers should keep the case open until explicitly instructed to close it by a paralegal or attorney. If the docketer is made aware of abandonment, for instance, by a foreign agent, they should always consult with the overseeing paralegal or attorney on what action to take.

## Incorporate notes throughout docketing

Docketing is nothing if not a complex and multifaceted process — evidenced by the sheer amount of documentation that accompanies every step. But all that material may not, by itself, paint a full picture of the IP life cycle. Detailed note-taking fills in any gaps that may be present in a case's docket.

While docketers should feel free to incorporate the details that make the most sense for each unique docketing action, there are some general best practices worth following:

- **Write clearly and succinctly:** There should be no confusion about the meaning of docket notes, and they only need to include essential information.
- **Be accurate and grammatically correct:** Docket inaccuracies can endanger the integrity of the IP itself. On top of this, even seemingly trivial transpositions of dates and numbers or spelling and grammatical errors can generate confusion.
- **Add notes in sequential order:** Placing the most recent comments at the top allows for an easier review of the case.
- **Avoid obscure references or abbreviations:** IP has jargon that industry specialists will understand, but beyond that, abbreviations, references or acronyms with unclear meanings will only puzzle the reader. Be consistent!

Thorough, precise and specific notes provide context to critical activities — context that is informative because it has passed through the lens of a skilled docketer.



## Tips and tricks from your docketing team

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### Use open deadlines for active applications

Keeping an open deadline on the docket calendar reminds IP professionals that a matter is still active. With a dedicated system to track critical deadlines, such cases are easy to manage and keep up to date.

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### Perform docketing actions with official documents to serve as evidence

In most instances, an action in the docketing process should be supported by official documentation — e.g., submissions to IP offices or communications from those offices.

3

### Double-check after completing a record

To ensure your docketing actions are accurate, it is always wise to have a quality control system in place. This may involve producing reports and cross-referencing the information or having a designated person responsible for performing checks.





## Answering common IP docketing questions

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### What parties control IP docketing deadlines?

The IP office for the country or jurisdiction where an organization wishes to obtain IP protection may update filing statuses on the docket. This can result in new deadlines for IP professionals to address. As such, it is vital to ensure the docketing team can meet necessary deadlines, manage prosecutions and apply statutory or procedural provisions.

### What is the difference between IP docketing and data entry?

By nature, docketing involves data entry — but it takes a professional docketer to understand what data needs to be entered into the system. A clerk or another person in a similar role is unlikely to know (and should not be expected to know) which documents to add to the docket.

### What does the docketing process involve?

IP docketing involves all of the following tasks at numerous stages:

- Entering application or case details for each IP asset
- Reviewing incoming correspondence in a timely fashion
- Ensuring proper notes accompany actions
- Preparing docket reports (in accordance with deadlines)
- Generating and distributing status reports for stakeholders

## Key considerations when selecting a docketing service

- ① **Provider experience with IP management:** Organizations must be sure they are entrusting their docketing to professionals who are experienced, fully knowledgeable in IP law and capable of overseeing the process from start to finish.
- ② **Onboarding:** Before an organization begins offloading its docketing to a new IP service provider, the provider should offer training that thoroughly details the workflow, confirming that it meets the customer's needs.
- ③ **Compatibility with business needs:** A docketing partner should be able to provide timely services, enhance clients' operations and empower its customers to secure the IP protections they need.
- ④ **Contingency planning:** The docketing services provider should designate a point of contact who will be available to tackle problems and provide ongoing assistance to the client throughout each IP life cycle.





## Onboarding with Dennemeyer: FAQ

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### Will you be able to work with my software?

Our teams have experience in various software currently being used in the IP industry. If a customer has unique software specific to their organization, our team will dedicate time to train and prepare in advance of your start date.

### Can you help me to establish a docketing procedure?

We have established procedures that can be tailored to your specific needs and are able to provide best practices should you have a preferred docketing approach. If you wish for Dennemeyer to create a new docketing procedure for you, we can put you in contact with our consultants.

### What does the onboarding process look like?

As part of your docketing service, you will have a dedicated contact who will work with you from the initial onset of determining your docketing requirements to ensure a smooth transition.

### How do I know much docketing support I need each month?

A series of questions will be discussed in the initial survey call that will aid us in determining how many FTE (full-time equivalent) hours are needed to support you with your monthly docketing / paralegal efforts.

## Denne Meyer's IP docketing solutions

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As a global leader in IP solutions, Denne Meyer provides docketing services to businesses worldwide across many industries.

Through our technical expertise and optimized processes, we give our clients comprehensive control over their docketing needs. We can help you proficiently manage your IP portfolio and ensure you receive and preserve critical protection for your inventions, unique branding elements, original works and other intangible assets.

### The Denne Meyer team offers:

- Docketing professionals who have experience working with numerous IP software solutions (and can quickly adapt to new tools as needed)
- Support from a dedicated IP professional committed to ensuring a smooth onboarding experience
- An established docketing procedure with the versatility to adjust to your organization's needs
- A global network of specialists allowing you to compete in a fast-paced market
- Transparent pricing based on an agreed scope of work

Learn more about our effective and cost-efficient docketing solutions now.





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[dennemeyer.com](https://dennemeyer.com)