

Learning to be paperless with PCT (Covid-19 issues)

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Format and plans

- Feel free to ask questions as they come to mind – do not feel the need to save questions to the end
- Use the “questions” box in the webinar system

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Format and plans

- When this urgent topic came up, I was not sure how much presentation time was going to be required
- I scheduled 90 minutes on for today and another 90 minutes for tomorrow
- I now see that we can probably cover everything in one day
- We probably will not need tomorrow's session

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Why we are here

- On March 30, 2020 WIPO announced the suspension of sending of PCT documents on paper
- Equivalent measures are being taken in the Madrid and Hague Systems

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Why we are here

- My goal is to help PCT filers adjust to this March 30, 2020 change regarding PCT communications announced by WIPO
- This webinar ***will not address*** the equivalent measures being taken in the Madrid and Hague Systems

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Narrow goal

- The narrow goal is to help you to be paperless with PCT
- Helping you react so that you will not miss out on any communications due to the changes announced March 30, 2020

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Broader goal

- The broader goal is to help you to make best use of the electronic communications systems for PCT
- Learning Best Practices for e-filing and subsequent management of PCT applications

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Side benefits

- With no extra work or effort, these topics will make it possible for you and others in your office to work together in collaborative workflows
- These topics will offer ways to be more efficient and more productive
- These topics will offer ways to save time
- These topics will offer ways to reduce professional liability risk, malpractice risk, and risk of embarrassment in front of the client

Docket benefits

- These topics will permit your docket department to have greater confidence of keeping on top of relevant docket events

Detailed goals

- Learn how to get a WIPO user ID and password for access to ePCT, the electronic system for PCT applications.
- Learn why each person in your office must have his or her own WIPO user ID and password (no sharing)
- Learn how to set up two-factor authentication on your WIPO user ID and password (what WIPO calls “strong authentication”).
- Learn how to do e-handshakes with colleagues in your office so that you can give each other access to files.

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Detailed goals

In your existing and pending PCT applications, maybe you have ***not already provided an email address*** which WIPO and the International Searching Authority and the International Preliminary Examining Authority can use to send you correspondence electronically rather than on paper. In this webinar, learn how to provide such an email address to WIPO for this purpose for your existing and pending PCT applications.

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Detailed goals

The ePCT system has a function that is similar to Private PAIR in that it permits you to see the content and status of your pending PCT applications even if they have not yet been published, just as Private PAIR lets you see the content and status of your pending US application. In this webinar, learn how to gain access to your pending PCT applications in ePCT. In other words, learn how to use the feature of ePCT that is similar to Private PAIR with your existing and pending PCT applications.

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Detailed goals

When you file a new PCT application tomorrow or next week, you simply must file it in such a way that you will be able to see it in the part of ePCT that is similar to Private PAIR. In this webinar, learn what you need to do when you are filing a new PCT application so that you will be able to see it in the part of ePCT that is similar to Private PAIR.

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Detailed goals

Going forward, you absolutely need to not send anything on paper to WIPO. In this webinar, learn how to use the DAS system to send electronic certified copies of priority applications to WIPO (instead of physical certified copies). Learn how to use ePCT to send other communications to WIPO. Learn the difference between “ePCT actions” and “ePCT uploads” and learn which is better for you to use.

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Box IV of the PCT Request

The single most important action item for today’s webinar -- Carefully review Box IV in each of your PCT files that is less than 30 months old. What did you choose for these check boxes?

Box No. IV AGENT OR COMMON REPRESENTATIVE; OR ADDRESS FOR CORRESPONDENCE	
The person identified below is hereby/has been appointed to act on behalf of the applicant(s) before the competent International Authorities as:	
<input type="checkbox"/> agent <input type="checkbox"/> common representative	
Name and address: <i>(Family name followed by given name; for a legal entity, full official designation. The address must include postal code and name of country.)</i>	Telephone No.
	Facsimile No.
	Agent's registration No. with the Office
E-mail authorization: Marking one of the check-boxes below authorizes the receiving Office, the International Searching Authority, the International Bureau and the International Preliminary Examining Authority to use the e-mail address indicated in this Box to send, notifications issued in respect of this international application to that e-mail address if those offices are willing to do so.	
<input type="checkbox"/> as advance copies followed by paper notifications; or <input type="checkbox"/> exclusively in electronic form (no paper notifications will be sent).	
E-mail address:	

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For each particular PCT application, what did you choose for Box IV?

- For this particular PCT application, did you choose “paper only”? Then you urgently need to communicate an email address to the IB for this PCT application.
- For this particular PCT application, did you choose “email followed by paper”? You intended the paper to be a redundant communication path in case email got lost. So you need to set up a new redundant communication path for this PCT application.
- For this particular PCT application, did you choose “exclusively in electronic form”? Then for this application you are okay.
- This review process needs to be repeated for every PCT application in your docket that is less than 30 months old.
- This review needs to be carried out without delay.

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You chose “paper only”?

- Then you urgently need to communicate an email address to the IB for this PCT application.
- In addition, get this PCT application into your ePCT workbench (the system that is similar to Private PAIR).

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You chose “paper only”?

- WIPO won't use the fax number that you provided? No, WIPO won't use the fax number that you provided.
- If you chose “paper only” then WIPO will go on a treasure hunt through the file to see if maybe there is some email address someplace listed for the applicant, agent, or address for correspondence
- WIPO will try to use that email address
- Of course this might not be a functioning email address
- Even if it is a functioning email address, it might not be the email address that you really want WIPO to use for this purpose
- Clearly you need to explicitly communicate whatever email address you really want WIPO to use

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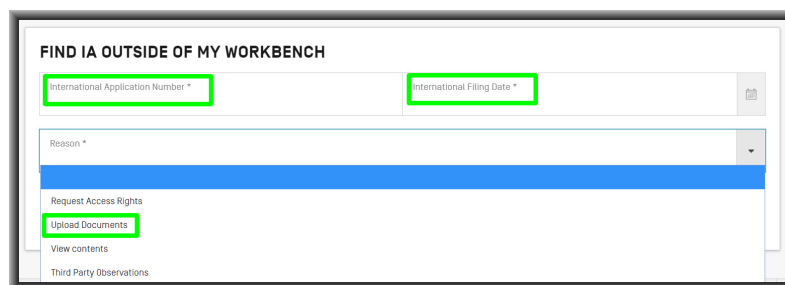
Communicating an email address to the IB for this PCT application

- Maybe you already have this PCT application in your ePCT workbench (the system that is similar to Private PAIR)? If so then you can use ePCT to set up or update the contact email address if necessary.
- Failing that, use ePCT to upload a request to the PCT application file
- As an absolute last resort, send an email to pct.eservices@wipo.int or pct.infoline@wipo.int (keep in mind those email addresses will be swamped with incoming emails)

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Communicating an email address to the IB for this PCT application

- The thing is, there is no choice about it you are going to have to get a WIPO user ID and password.
- Once you have done that, then a Best Practice for communicating an email address to the IB for a particular PCT application will be “find IA outside of my workbench”

A screenshot of a web form titled "FIND IA OUTSIDE OF MY WORKBENCH". The form has two input fields at the top: "International Application Number *" and "International Filing Date *", both highlighted with green rectangles. Below these is a dropdown menu labeled "Reason *". Under the dropdown, there are several links: "Request Access Rights", "Upload Documents" (highlighted with a green rectangle), "View contents", and "Third Party Observations".

This gets the document inserted into the correct application file at WIPO.

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Communicating an email address to the IB for this PCT application

- If you absolutely cannot somehow manage to do “find IA outside of my workbench” ... then use the PCT Contingency Upload Service.
- You to to the “PCT Contingency Upload Service” web page. Enter your email address twice. Click Submit.
- You will be sent an email with a link. Click on the link. Fill in some blanks. Enter the PCT application number and filing date. Upload a document communicating the new email address that you want WIPO to use.
- This gets the document inserted into the correct application file at WIPO.
- But really you might as well face the inevitable and get a WIPO user ID and password and use the “find IA outside of my workbench” e-filing path.
- And you should not lose sight of the medium-term goal of getting that application into your ePCT workbench (the system that is similar to Private PAIR)

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Communicating an email address to the IB for this PCT application

- If you absolutely cannot somehow manage to do “find IA outside of my workbench” and you cannot somehow manage to use the PCT Contingency Upload Service...
- Then as an absolute last resort, send an email to pct.eservices@wipo.int or pct.infoline@wipo.int . This is not at all a Best Practice for at least two reasons:
 - those email addresses are swamped with incoming emails these days, and
 - This communication path fails to insert the document into the application file at WIPO.

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You chose “email followed by paper”?

- So the next possibility is that for some particular PCT application in your file review, you find that you chose “email followed by paper.” If so, then your reason for choosing this is that you intended the paper to be a redundant communication path in case email got lost. So you need to set up a new redundant communication path for this PCT application. How can you accomplish this?
- To do this you need to get the application into your ePCT workbench.
- To do this you need to get an ePCT workbench.
- To do this you need to set up “strong authentication” for your WIPO user ID and password.
- To do this you need to get a WIPO user ID and password.
- I promise you these steps are not as daunting as they might seem!
- We will proceed in reverse sequence.

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Getting a WIPO user ID and password

- You go to pct.wipo.int and create an account.
- It sends you an email with a link.
- You click on the link.
- Bob's your uncle.

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No sharing

- WIPO makes clear they do not want you sharing user IDs and passwords.
- Each person should have his or her own user ID and password.

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Setting up “strong authentication” for your WIPO user ID and password

- There are three ways to do this:
 - Authenticator app on your smart phone
 - Text message on your phone
 - Browser certificate
- You should set up at least two kinds of 2FA.

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e-handshakes

- You should freely set up an e-handshake with each and every ePCT user that you have any connection with
 - Within your office
 - At client locations
 - At outside counsel locations
 - House pets
- The important thing here is that doing an e-handshake does not give the other person access to anything at all.
- It does not give the other person access to your PCT applications

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Getting an ePCT workbench

- This part is really easy. It turns out that once you set up the 2FA you automatically get an ePCT workbench.
- Of course at first your workbench is empty which is not very exciting
- Soon your workbench will be filled with all of your pending PCT applications

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Get applications into your ePCT workbench

- One thing is that your colleague might have already gotten the applications into his or her ePCT workbench
- If so then your colleague can give you access in your ePCT workbench with just a couple of mouse clicks
- Or you can take steps to get the applications into your ePCT workbench
- And then give access to your colleagues
- The steps to gain access are different depending on whether the case is in Patentscope or is not yet in Patentscope

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Getting a published case into your ePCT workbench

The screenshot shows the 'WORKBENCH' interface with a top navigation bar containing 'CREATE NEW IA' and 'FIND IA OUTSIDE OF MY WORKBENCH'. Below this is a 'WORKBENCH' header with a dropdown arrow. A filter bar includes tabs for 'Current IAs', 'Last Accessed', 'Draft IAs', 'Draft Actions', 'Unpublished', 'Published', and 'Archived', along with a search bar. Below the filter bar, there are links for 'Show Filter', 'Download list', 'Columns', 'Show rows [ALL]', and 'Default sort order [IFD]'. The main section is titled 'FIND IA OUTSIDE OF MY WORKBENCH' and contains three input fields: 'International Application Number *', 'International Filing Date *', and 'Reason *'. The 'Reason *' field has a dropdown menu with 'Request Access Rights' selected. At the bottom right of the form are 'Cancel' and 'Search IA' buttons.

The system will then send Form PCT/IB/345 by email. This contains a Secret Code Number which you can then use to add the application to your ePCT workbench. Then you should give access rights to your colleagues.

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Getting a not-yet-published case into your ePCT workbench

- Locate Form PCT/IB/301
- It has a Secret Code Number in the lower right corner

This screenshot is identical to the one in slide 31, showing the 'WORKBENCH' interface with the 'FIND IA OUTSIDE OF MY WORKBENCH' form. The form includes input fields for 'International Application Number *', 'International Filing Date *', and 'Reason *' (with 'Request Access Rights' selected). The 'Cancel' and 'Search IA' buttons are at the bottom right.

The system will then give you access in your ePCT workbench. Then give access rights to your colleagues.

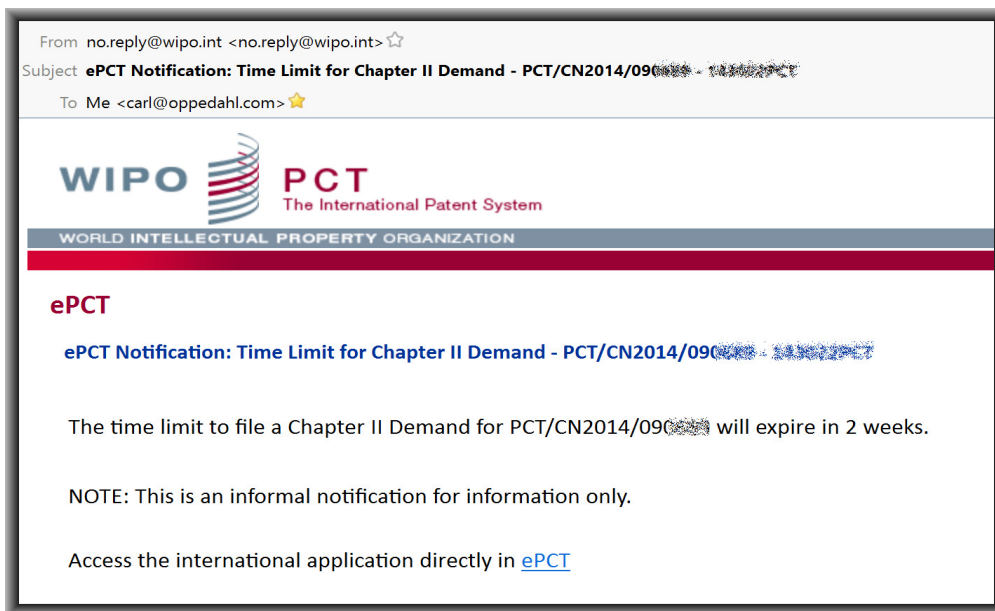
32

Why we care?

- Once it is in your workbench, you get all these benefits

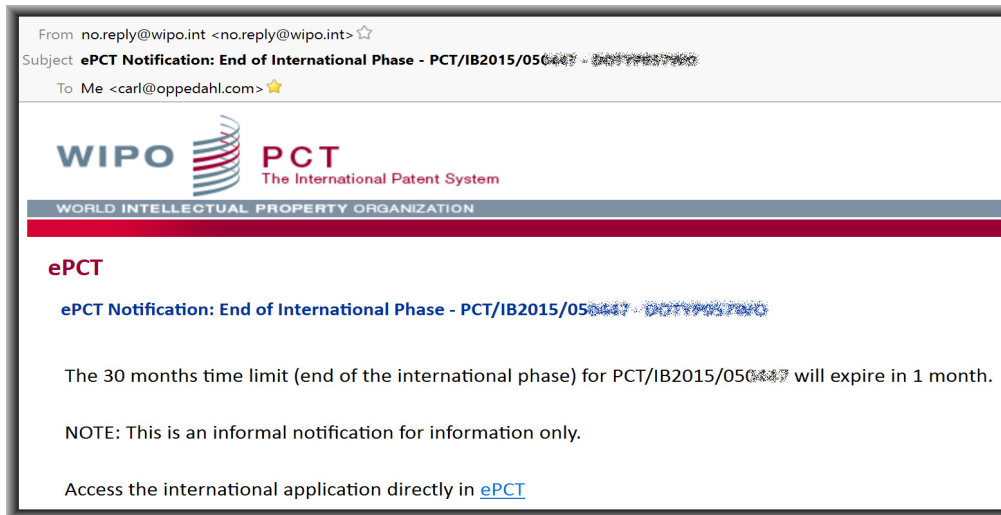
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e-notifications



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e-notifications



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Access rights

- eViewer
- eEditor
- eOwner

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Getting newly filed PCT application into your workbench

- How you make this work depends on which RO you pick
- RO/US
- RO/IB

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Getting newly filed RO/US PCT application into your workbench

- When you are filing in RO/US, this means you are filing in EFS-Web

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Using a typewriter


- Strictly speaking it is possible to prepare a PCT Request using a typewriter, and to file a PCT application using such a Request
- The typewriter will not warn you when you are making a mistake
- Given the availability of sophisticated software that can be used to prepare a PCT request, that carries out hundreds of validations, it is tantamount to malpractice to prepare a PCT Request using typewriter
- We will discuss how to prepare a PCT Request using the software

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EFS-Web screen

This is the application data associated with your filing. If any information is incorrect, please click on the link to edit it.	
Title of Invention	Chocolate dispenser
Applicant Name	The Chocolate Factory
Customer Number, Correspondence Address	57380 Oppedahl Patent Law Firm LLC 12000 Pecos Street #252 Westminster CO 80234 US +1 303 252 8800
Filed By	Carl Oppedahl
Attorney Docket Number	WONKA.P-001
Application Type	International Application (PCT) for filing in the US receiving a

Are you attaching a PCT-EASY zip file? ☒ Yes ☐ No

Files to be Submitted 

No file selected.

When attaching a PCT-EASY Zip file, you must also attach your application parts (Specific

"No" is tantamount to malpractice "Yes" is the Best Practice

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Where to get a ZIP file?

- There are two ways to make a ZIP file
 - PCT-SAFE
 - ePCT
- If you are very comfortable with PCT-SAFE, keep using that for now, but migrate to ePCT as soon as you can
- Otherwise just start using ePCT

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The ZIP file

- The ZIP file means that you did receive the benefit of the validations in the software
- This reduces greatly the risk of embarrassment in front of the client
- This reduces greatly the risk of malpractice
- Two ways to make the ZIP file
 - PCT-SAFE
 - ePCT

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Choosing between PCT-SAFE and ePCT

- ePCT validates all the same things that PCT-SAFE validates, plus more
- ePCT also validates your priority application information
- ePCT cross-checks your priority claim against DAS

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Getting newly filed RO/IB PCT application into your ePCT workbench

- It turns out that if you use ePCT to prepare and e-file a PCT application at RO/IB, then it will automatically become available in your ePCT workbench
- This is in fact a Best Practice
- Of course if the invention was made in the US, then you need to make sure you already have a Foreign Filing License

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DAS

- how to use the DAS system to send electronic certified copies of priority applications to WIPO (instead of physical certified copies).

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DAS

- The main point of DAS is not even that it saves you from physical certified copies
- The main point of DAS is that it enables real-time validation of your priority claims when you are creating your Request.

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Worst mistakes that cannot be fixed later?

- Priority claims
- 4-and-16

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DAS

- Any time you file any application that might later be a priority application, make sure you make it available to DAS
- This enables the data validation at PCT filing time

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DAS

- This means using an ADS, not a provisional cover sheet, when filing a US provisional application

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DAS

Transaction History	
Date	Transaction Description
01-04-2020	Case Docketed to Examiner in GAU
06-28-2019	Correspondence Address Change
06-17-2019	Case Docketed to Examiner in GAU
06-06-2019	Email Notification
06-06-2019	Application ready for PDX access by participating foreign offices
06-05-2019	Application Dispatched from OIPE
06-05-2019	FITF set to YES - revise initial setting
06-06-2019	Application Is Now Complete
06-06-2019	Application Is Now Complete
06-06-2019	Filing Receipt
06-03-2019	170/32/03 Authorize EPO Access to Search Results
06-03-2019	Applicants have given acceptable permission for participating foreign
06-05-2019	Applicant Has Filed a Verified Statement of Small Entity Status in Compliance with 37 CFR 1.27
06-04-2019	Cleared by OIPE CSR
06-03-2019	IFW Scan & PACR Auto Security Review
06-03-2019	ENTITY STATUS SET TO UNDISCOUNTED (INITIAL DEFAULT SETTING OR STATUS CHANGE)
06-03-2019	Initial Exam Team nn

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DAS

CERTIFICATE OF AVAILABILITY OF A CERTIFIED INDUSTRIAL DESIGN DOCUMENT IN A DIGITAL LIBRARY

The International Bureau certifies that a copy of the industrial design application indicated below has been available to the WIPO Digital Access Service since the date of availability indicated, and that the industrial design application has been available to the indicated Office(s) as of the date specified following the relevant Office code:

Document details: Country/Office: US

Filing date: 29 Jun 2016 (29.06.2016)

Application number: 29569603













Date of availability of document: 27 Feb 2018 (27.02.2018)

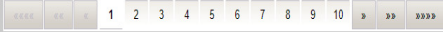
The following Offices can retrieve this document by using the access code:

AU, CA, CL, CN, ES, GE, IN, JP, KR, NO, US

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DAS

IP Right	Priority Number	Filing date	Access Code	Date of Availability	Last Accessed	Tracked By	Comments
Design	JP 2020-006765	2020-01-09		2020-01-10			 WADA
Design	US 29652002	2020-01-05		2020-01-21			 BM D098-3
Design	US 29652009	2019-08-27		2019-08-30			 LX01.D009
Design	CN 2019301423	2019-07-03		2019-12-27	2020-01-03 10:20:11.0		 C02 D001
Design	US 296935	2019-06-03		2019-06-06			 LX01 D010



Add Tracking Remove Tracking

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DAS

<input type="checkbox"/>	Subject	IP Right	Priority Number	Received
<input type="checkbox"/>	This document is also tracked by following user(s): 'carl@ppedahl.com'.	Design	US 2965202	2020-03-31 00:46:59.0
<input type="checkbox"/>	This document is also tracked by following user(s): 'a@mtiplaw.com'.	Patent	US 62411157	2020-03-30 21:02:06.0
<input type="checkbox"/>	This document is also tracked by following user(s): 'p12@sheppardmullin.com'.	Patent	US 62411157	2020-03-30 19:13:33.0
<input type="checkbox"/>	This document is also tracked by following user(s): 'ard@s@mtiplaw.com'.	Patent	US 62411157	2020-03-30 17:11:41.0
<input type="checkbox"/>	This document is also tracked by following user(s): 'tabo@a@mtiplaw.com'.	Patent	US 62411157	2020-03-30 17:01:05.0
<input type="checkbox"/>	This document is also tracked by following user(s): 'p12@n@dsiplaw.com'.	Patent	US 62411157	2020-03-30 16:42:25.0
<input type="checkbox"/>	Accessing office 'IB' successfully retrieves this document.	Patent	US 627040	2020-03-30 11:02:58.0
<input type="checkbox"/>	Accessing office 'IB' successfully retrieves this document.	Patent	US 6282501	2020-03-30 10:51:22.0

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DAS

Retrieval History for Priority Document Number: CN 201931508231		
RETRIEVAL DATE	AUTHORIZED OFFICE	COMMENTS
2020-01-03 10:20:11	US	Retrieved successfully
Close		

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e-filing follow-on papers

- “ePCT actions” and “ePCT uploads”
- An ePCT action carries out almost all of the data manipulation steps
- An ePCT upload is only slightly better than sending a fax
- Clearly the Best Practice is to use an “action” when that path is available

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e-filing follow-on papers

- Secret tip about prioritization of workflow at the International Bureau

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Using ePCT to send things to the ISA

- Yes ePCT can be used for electronically sending communications to the International Searching Authority
- This is most helpful in those cases where the ISA that you selected is an ISA other than ISA/US

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Using ePCT to send things to the IPEA

- Yes ePCT can be used for electronically sending communications to the International Preliminary Examining Authority
- This is most helpful in those cases where the IPEA that you selected is an IPEA other than IPEA/US

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Another PCT Best Practice

- No informal drawings!
- Always file formal drawings, not informal drawings, when you file a PCT application
- In general you will frustrate yourself if you file informal drawings and try to get formal drawings into the application

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Resources at WIPO

- WIPO's ePCT help desk
- +41 22 338 9523
- (Monday to Friday 09:00–18:00 CET)
- See online help for ePCT (it is actually quite good)

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Next few webinars

- Get Patents Fast
- Don't end up like the owner of that CRISPR patent
- Docketing PCT
- Picking a PCT Searching Authority
- Picking a PCT Receiving Office
- Making smart use of PCT Declarations
- National phase or bypass continuation?
- Sequence listings

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Additional resources

- Subscribe to the *Ant-Like Persistence* Blog
- Subscribe to the PCT Listserv

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Thank you

- Yes I will circulate these slides later as a handout by email
- Be sure to complete the evaluation form
- Thank you!