

ePCT webinar series

Why attorneys need to learn about
ePCT, and why you cannot simply
delegate things to support staff

Webinar 2

Thursday, March 9, 2023, 10AM Mountain Time

Carl Oppedahl

<https://blog.oppedahl.com>

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Disclaimer

Watching this webinar, or reading these slides, does not make you my firm's client and does not make me your attorney. This webinar is intended to be educational.

At times I will wear either of two hats. At times I will be presenting purely factual information, the same way that a WIPO person might present. At other times I will be sharing opinions and preferences. Please join me in appreciating these two distinct hats.

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Upcoming webinars

Webinar 3. Thursday, March 16, 2023, 10AM Mountain Time. Making sure your US priority documents are available to DAS, best practices for filing US priority documents, Certificates of Availability, setting up alerts.

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https://blog.oppedahl.com/?page_id=8978.

How to learn of future webinars? Subscribe to my blog (<https://blog.oppedahl.com/>), or subscribe to the PCT listserv (https://oppedahl-lists.com/mailman/listinfo/pct_oppedahl-lists.com).

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The attorney and ePCT

- There is nothing quite like the good feeling that one gets from having served a client well
- Making use of ePCT is part of serving clients well

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The attorney and ePCT

- Surely we all want to be trendy, modern, and up-to-date
- Making use of ePCT is part of being trendy, modern, and up-to-date

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Six reasons for the attorney to be very familiar with ePCT

- The attorney needs to supervise the nonlawyer assistant so that proper ethical rules and standards are followed
- The attorney needs to supervise the nonlawyer assistant to maintain service quality
 - This is to minimize risk of embarrassment in front of the client due to making mistakes
 - This is to minimize risk of mistakes leading to professional liability exposure (minimizing malpractice risk)
- How can the attorney possibly accomplish this supervision if the attorney does not know how to do the things that the assistant is doing?
- By participating in ePCT, the attorney can receive reminders about upcoming due dates
- By participating in ePCT, the attorney can keep abreast of events and developments
- What if some task needs to be done and the attorney is the only person available to do it? Surely it is good for the attorney to know how to do the things the assistant usually carries out!

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The attorney needs to supervise the nonlawyer assistant so that proper ethical rules and standards are followed

- DR1-104(C): A law firm shall adequately supervise, as appropriate, the work of ... nonlawyers who work at the firm.
- ABA model guideline: A lawyer is responsible for all of the professional actions of a paralegal performing service at the lawyer's direction. A lawyer must directly supervise paralegals employed by the lawyer to ensure that, in every circumstance, the paralegal is acting in a manner consistent with the lawyer's ethical and professional obligations.
- Rule 5.3(b): A lawyer having direct supervisory authority over the nonlawyer shall make reasonable efforts to ensure that the person's conduct is compatible with the professional obligations of the lawyer.

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The attorney needs to supervise the nonlawyer assistant to maintain service quality

- This is to minimize risk of embarrassment in front of the client due to making mistakes
- This is to minimize risk of mistakes leading to professional liability exposure (minimizing malpractice risk)
- Note that this is not the same as the previous point (ethics). This is simply avoiding getting sued for malpractice and avoiding looking stupid. You could say that this is simply trying to run a business well.

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How can the attorney possibly accomplish this supervision if the attorney does not know how to do the things that the assistant is doing?

- We identified at least three distinct reasons why supervision is necessary:
 - Ethics rules require it
 - Avoiding looking stupid in front of clients
 - Avoiding getting sued for malpractice
- How can the attorney have any chance of doing proper supervision if the attorney does not even know how to do these things (for example use of ePCT)?

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Who is the one who will get sued if the assistant makes some mistake?

- Common sense tells you it is the attorney who will get sued
- The plaintiff will hold the attorney responsible
- How can the attorney have any chance of doing proper supervision if the attorney does not even know how to do these things (for example use of ePCT)?

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By participating in ePCT, the attorney can receive automated reminders about upcoming due dates

- Attorney says “but that is why we have a docket department!”
- See next few slides

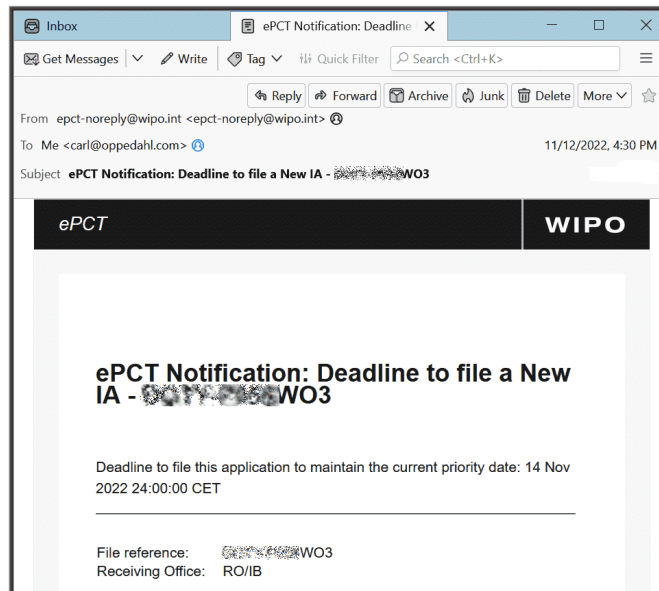
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ePCT provides warnings of upcoming due dates

- Note that PAIR and Patentcenter fail to provide such warnings
- This can run in parallel with the protections that come from your docket systems
 - Automatic warning of imminent end of the 30-month period
 - Automatic warning of due date for filing Demand
 - Automatic warning of due date for withdrawing to prevent publication
 - Automatic warning of due date for Article 19 amendment
 - Automatic warning of 12-month priority period almost expired

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End of 12 months is imminent!



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ePCT provides warnings of upcoming due dates




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ePCT provides warnings of upcoming due dates

From epct-noreply@wipo.int <epct-noreply@wipo.int> 

To @oppedahl.com 

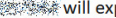
2/12/2023, 6:31 PM

Subject **ePCT Notification: Time Limit for Article 19 Amendments - PCT/IB2022/**

ePCT

WIPO


ePCT Notification: Time Limit for Article 19 Amendments - PCT/IB2022/ **P012WO-3**



The time limit for submitting Article 19 amendments for PCT/IB2022 / will expire in 2 weeks.

Amendments received by the IB after the time limit are still accepted if they have been received before the technical preparations for international publication have been completed.

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ePCT provides warnings of upcoming due dates

From epct-noreply@wipo.int <epct-noreply@wipo.int> 

To @oppedahl.com 


2/15/2023, 7:08 PM

Subject **ePCT Notification: Technical Preparations for Publication - PCT/IB2022/**

ePCT

WIPO

ePCT Notification: Technical Preparations for Publication - PCT/IB2022/ **P058WO2**

Technical preparations for international publication for PCT/IB2022 / are scheduled to close in 2 weeks.

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ePCT provides notifications of events of interest

From: epct-noreply@wipo.int <epct-noreply@wipo.int>

To: carl@oppedahl.com

2/22/2023, 10:30 AM

Subject: ePCT Notification: Access rights changed by another person - PCT/EP2021/1470

ePCT

WIPO

ePCT Notification: Access rights changed by another person - PCT/EP2021/1470

This is to notify you that Access Rights have been modified as follows for PCT/EP2021/1470 for which you are eOwner.

User Name	New Access Rights	Modified by	Date/Time
carl OPPEDAHL	eOwner	carl OPPEDAHL	22 February 2023 12:44:12 CET
carl OPPEDAHL	eOwner	carl OPPEDAHL	22 February 2023 12:55:17 CET

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ePCT provides warnings of failures and problems

- Automatic email warning you if there is a priority document outstanding
 - This helps to save you from the dreaded 4-and-16 date

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Helpful reports can be generated

- With a few mouse clicks, a report of cases with certified copies of priority documents outstanding
- With a few mouse clicks, a report of cases with Form PCT/ISA/202 outstanding

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What is the 4-and-16 date?

- If you are going to pick anything to screw up, pick something other than the 4-and-16 date!
- Irrevocable loss of priority claim in many patent offices around the world
- Guess what? ePCT can reduce this risk

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What if some task needs to be done and the attorney is the only person available to do it?

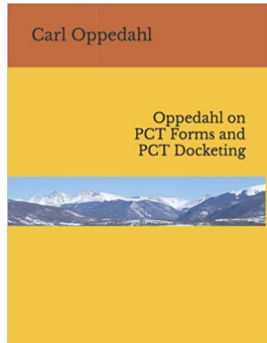
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Be careful in becoming too complacent with relying upon nonlawyers in your office.

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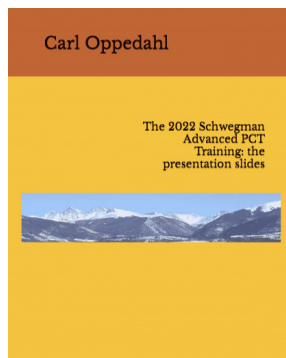
Helpful resource



- Helpful for the attorney
- Helpful for the non-attorney assistant

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Helpful resource



- Helpful for the attorney
- Helpful for the non-attorney assistant
- Helps you stay awake during fifteen free-of-charge recorded webinars about PCT

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ePCT permits you to see contents and status of pending PCT applications even if they are not published (like PAIR and Patentcenter)

- You use PAIR and Patentcenter many times daily for such information
- You need similar capabilities for your PCT applications
- This can save time and trouble as well for clients and inventors and foreign patent firms

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ePCT facilitates collaborative workflow within your office and with external parties such as clients and foreign patent firms

- With a click of a mouse you can enable a foreign patent firm to move forward on a task (e.g. national-phase entry)
- Obtain e-signatures from inventors and applicants who are trendy, modern and up-to-date
- Easy passing of saved submissions back and forth between the attorney and the non-attorney assistant
- Facilitates work-from-home
- Facilitates colleagues being active at varied times of day
- Helps with obtaining e-signatures from dinosaur participants

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Validations

- Some Offices only do validations that benefit the Office
- ePCT does hundreds of validations that specifically benefit the filer
- One example – missing signature on e-filed form
- Another example – catching mistakes in priority claims (the dreaded 4-and-16 date)

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Helpful videos



<https://www.wipo.int/pct/en/epct/tutorials.html>

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Possible live demo

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Please complete the evaluation questionnaire

- Yes please complete it
- Pay it forward

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Thank you

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