

ePCT webinar series

ePCT actions and communications with the IB

Webinar 10
Tuesday, May 2, 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 ePCT webinars

Webinar 11. Thursday, May 11, 2023, 10AM Mountain Time. External signatures and PCT declarations.

Webinar 12. Thursday, May 18, 2023, 10AM Mountain Time. Sequence listings and ePCT. Note that this is *not* about how to create a sequence listing. This webinar assumes you already know how to create a sequence listing. This webinar talks about things that you need to know in ePCT that relate to sequence listings.

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Upcoming ePCT webinars

Webinar 13. Thursday, June 1, 2023, 10AM Mountain Time. Docketing of PCT applications and making use of ePCT notifications. Suggested companion purchase: *Oppedahl on PCT Forms and PCT Docketing*.

Using ePCT to e-file in ISAs and IPEAs, filing Demands.
Doing 92*bis* changes.

Publication front page preview, generating reports of outstanding Forms ISA/202, generating reports of applications with outstanding priority documents.

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Upcoming ePCT webinars

How to register? Go to

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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Recordings

- Webinar 1. Thursday, March 2, 2023. Intro to ePCT, why ePCT is important, getting a user ID and password, setting up 2FA. [Download the presentation materials](#). [View the recording](#) (1:13).
- Webinar 2. Thursday, March 9, 2023. Why attorneys need to learn about ePCT, why you cannot simply delegate stuff to support staff. [Download the presentation materials](#). [View the recording](#) (1:05).
- Webinar 3. Thursday, March 16, 2023. Making sure your US priority documents are available to DAS, best practices for filing US priority documents, Certificates of Availability, setting up alerts. [Download the presentation materials](#). [View the recording](#) (1:21).
- Webinar 4. Thursday, March 23, 2023. Handshakes, eOwners, eEditors, eViewers, access rights groups, employee first day of work, employee last day of work. [Download the presentation materials](#). [View the recording](#) (1:20).
- Webinar 5. Thursday, March 30, 2023. Shared address books, collaborative workflow, sharing with clients, sharing with outside counsel. [Download the presentation materials](#). [View the recording](#) (1:10).
- Webinar 6. Tuesday, April 4, 2023. Getting to know your ePCT workbench, portfolios, office profiles, cloning, ePCT actions. [Download the presentation materials](#). [View the recording](#) (1:15).
- Webinar 7. Thursday, April 13, 2023. Getting pending PCT applications into your workbench, going back to January 1, 2009, archiving old applications. [Download the presentation materials](#). [View the recording](#) (0:39).
- Webinar 8. Thursday, April 20, 2023. Filing a new PCT application in RO/US using ePCT. [Download the presentation materials](#). [View the recording](#) (1:13).
- Webinar 9. Thursday, April 27, 2023. Filing a new PCT application in RO/IB using ePCT. [Download the presentation materials](#). [View the recording](#) (1:05).

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Today's topics

- ePCT actions
- communications with the IB

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ePCT actions

- Withdraw International Application
- Withdraw Chapter II Demand
- Withdraw Priority Claim(s)
- Withdraw Election(s)
- Rule 92*bis* change request
- Withdraw Designation(s)
- Observations on close prior art
- Make international application available to DAS
- Licensing Availability Request
- Obtain priority document from DAS
- Submit Chapter II Demand
- Request for Early Publication
- Declarations under Rule 4.17
- Amendments Under Article 19 (text format only)
- Online Payment
- Create Power of Attorney
- Translation for international publication
- Upload Documents
- Prepare and submit indications relating to biological material (RO/134)
- Update File Reference

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ePCT actions

- The IB Processing Teams try to do all of the **ePCT actions** first, and then they turn to other submissions
- If you would like your task attended to first, submit it as an **ePCT action**

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ePCT actions

- If you send in a paper letter or some other communication that is not an “action”, then somebody at the IB has to figure out the correct application to insert the communication into
- What if there is a flyspeck on the IA number in your paper letter?
- One of the big advantages of using an “action” is that it automatically gets inserted into **the correct application**
- This reduces the risk of a document being inserted into an incorrect application

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ePCT actions

- If you send in a paper letter or some other communication that is not an “action”, then somebody at the IB has to hand-key information into IB systems
- What if there is a flyspeck on the information in your paper letter?
- One of the big advantages of using an “action” is that ***the information auto-loads*** into the application
- This reduces risks of errors from hand-keying of information

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ePCT actions

- If you send in a paper letter or some other communication that is not an “action”, then somebody at the IB has to figure out “who is the correct person to work on this task?”
- One of the big advantages of using an “action” is that the request ***automatically lands on the desk*** of the correct person to work on the task
- This gets the request acted upon without delay

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ePCT actions

- If your task can be communicated as an ePCT action, then it is a Best Practice to communicate it as an ePCT action

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Withdraw International Application

WITHDRAW INTERNATIONAL APPLICATION

The signature of all applicants is required for withdrawals. Check that any required powers of attorney are already on file or attach them below.

Current date and time at recipient Office: Monday, 01 May 2023, 18:41 CEST
Deadline to submit draft action: Thursday, 26 September 2024 24:00:00 CEST

Keep in mind that if your reason for withdrawing is to prevent publication, then the deadline is much sooner (technical preparations day)

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Withdraw International Application

IMPORTANT: In order to prevent international publication, the IA must be withdrawn before the close of technical preparations for international publication. If technical preparations have already closed, the system will warn you of this fact at the time of selecting the action to withdraw the IA. You may then decide whether or not to proceed with the request for withdrawal, bearing in mind that the IA will in any case be published.

WITHDRAW INTERNATIONAL APPLICATION

Technical preparations for international publication are now complete. Withdrawing the international application can no longer prevent international publication.

The signature of all applicants is required for withdrawals. Check that any required powers of attorney are already on file or attach them below.

Withdrawal Date 27 Mar 2017

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Withdraw Chapter II Demand

Select Action

Action *

Withdraw Chapter II Demand

No Chapter II Demand has been received at the IB.

Cancel

The Demand must have already been transmitted by the IPEA to the IB, otherwise the system will not allow you to proceed and you should address your notice of withdrawal to the IPEA.

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Withdraw Priority Claim(s)

WITHDRAW PRIORITY CLAIM[S]

The signature of all applicants is required for withdrawals. Check that any required powers of attorney are already on file or attach them below.

Current date and time at recipient Office: Monday, 01 May 2023, 18:46 CEST
Deadline to submit draft action: Thursday, 26 September 2024 24:00:00 CEST

Date of Withdrawal 01 May 2023

PRIORITY CLAIM[S]

Filing Date 26 Mar 2022	Office/Country US	Withdraw
Priority date used to compute PCT time limits		
Application Number 63/324,100		

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Withdraw Priority Claim(s)

IMPORTANT: In order to delay international publication, the priority claim must be withdrawn before the close of technical preparations for international publication. If technical preparations have already closed, the system will warn you of this fact and you may then decide whether or not to proceed with the request for withdrawal of the priority claim, bearing in mind that the international publication date will not be affected.

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Withdraw Election(s)

▼ ACTIONS

Select Action

Action *

Withdraw Election(s)

No Chapter II Demand has been received at the IB.

Cancel

▼ ACTIONS

Select Action

Action *

Withdraw Election(s)

The time limit to withdraw election(s) has already expired.

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Rule 92bis change request

- This will be discussed in detail in webinar 15

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Withdraw Designation(s)

SELECT THE DESIGNATION(S) TO BE WITHDRAWN

Designations
None Deselect all Select all

National Designations

AE	AG	AL	AM	AO	AT	AU	AZ	BA	BB	BD	BN	BR	BW	BY	BZ	CA	CH	CL	CN	CO	CR	CU	CV	CZ	DE	DJ	DK	DM	DO	DZ	EC	EE	EG		
ES	FI	GB	GD	GE	GH	GM	GT	HN	HR	HU	ID	IL	IN	IQ	IR	IS	IT	JM	JO	JP	KE	KG	KH	KN	KP	KW	KZ	LA	LC	LK	LR	LS	LU		
LV	MA	MD	MG	MK	MN	MW	MX	MY	MZ	NA	NG	NI	NO	NZ	OM	PA	PE	PG	PH	PL	PT	QA	RO	RS	RU	RW	SA	SC	SD	SE	SG	SK	SL	ST	
SV	SY	TH	TJ	TM	TN	TR	TT	TZ	UA	UG	US	UZ	VC	VN	WS	ZA	ZM	ZW																	

African Regional Intellectual Property Organization (ARIPO)

BW	CV	GH	GM	KE	LR	LS	MW	MZ	NA	RW	SD	SL	ST	TZ	UG	ZM	ZW
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Eurasian Patent Office (EAPO)

AM	AZ	BY	KG	KZ	RU	TJ	TM
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European Patent Office (EPO)

AL	AT	BE	BG	CH	CY	CZ	DE	DK	EE	ES	FI	FR	GB	GR	HR	HU	IE	IS	IT	LT	LU	LV	MC	ME	MK	MT	NL	NO	PL	PT	RO	RS	SE	SI	
SK	SM	TR																																	

African Intellectual Property Organization (OAPI)

BF	BJ	CF	CG	CI	CM	GA	GN	GQ	GW	KM	ML	MR	NE	SN	TD	TG
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Confirm

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Withdraw Designation(s)

In order for the withdrawal of designations to be reflected in the international publication, the designations must be withdrawn before the close of technical preparations for international publication. The system will warn you if this is not the case.

WITHDRAW DESIGNATION(S)

WARNING Technical preparations for international publication are now complete. Withdrawing designations can no longer prevent them from being included in the international publication.

Date of Withdrawal 27 Mar 2017

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Observations on close prior art

OBSERVATIONS BY OR ON BEHALF OF THE APPLICANT ON CLOSEST PRIOR ART

This function allows you to enter references to documents which are considered to be close prior art and, optionally, to comment on how the claims differ from them.

You may submit observations [10 documents maximum per observation] up until 26 Sep 2024

Observations submitted to the International Bureau via this online function do **not** constitute a formal response to a written opinion of the ISA or IPEA. If you wish to respond formally to a written opinion and receive further examination, you must write directly to the International Preliminary Examining Authority as part of international preliminary examination procedure.

To submit informal comments in PDF format, use the Upload Documents function and select as the document type either **Informal Comments by Applicant on WO-ISA** or **Applicant Comments on Third Party Observations**, as appropriate.

The observations will be notified to the ISA (if the international search report has not yet been received by the IB), to the IPEA (if applicable and the international preliminary report on patentability has not been received by the IB) and to DOs. It is up to the individual Offices to decide what use to make of an observation.

- The observations (excluding copies of cited documents) will be made publicly available on PATENTSCOPE.

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Make international application available to DAS

REQUEST TO MAKE INTERNATIONAL APPLICATION AVAILABLE TO DAS

Current date and time at recipient Office: Monday, 01 May 2023, 18:55 CEST

Date of Request 01 May 2023

Note that the normal time to make an IA available to DAS is in the PCT Request.

But yes you can do this later as well.

You will receive the DAS Access Code in Form PCT/RO/132 (page 92 of *Oppedahl on PCT Forms*)

Next step will be to set up tracking in DAS and obtain a *Certificate of Availability*

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Make international application available to DAS

The system will warn you if this request is not possible, namely, the IA must have been filed with the International Bureau as receiving Office (RO/IB)

Select Action

Action *

Make international application available to DAS

The IB can only make available to DAS copies of international applications for which it acts as receiving Office (RO/IB)

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Licensing Availability Request

PATENTSCOPE > Search

Feedback

FIELD COMBINATION ▾

	Field		Value
	Front Page	▾	
Operator	Field		Value
AND	Licensing availability	▾	

You can specify:

- the places where licensing is available
- whether the license would be exclusive or non-exclusive
- additional licensing terms
- whom to contact

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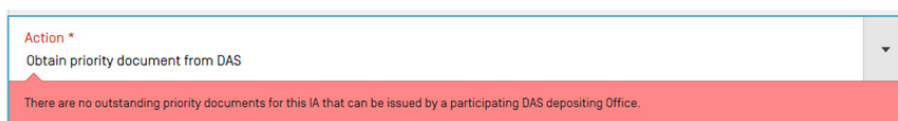
Obtain priority document from DAS

- Typical situation – priority document was not available in DAS at the time the PCT application was filed
- Now it is available in DAS
- Of course you have already set up tracking in DAS
- Of course you have already obtained a Certificate of Availability
- Now you can enter the DAS Access Code into the ePCT action
- The ePCT action cross-checks your inputs in real time against DAS, thereby catching many possible mistakes and protecting you from malpractice

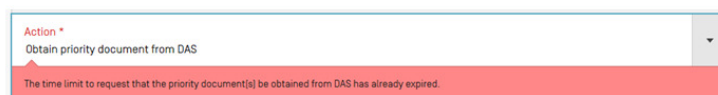
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Obtain priority document from DAS

The system will warn you if there are no priority claims in the IA for which a DAS request can be made or if the time limit has already expired:



A screenshot of a web form with a dropdown menu. The dropdown is open, showing the text "Obtain priority document from DAS". Below the dropdown, a red warning message reads: "There are no outstanding priority documents for this IA that can be issued by a participating DAS depositing Office."



A screenshot of a web form with a dropdown menu. The dropdown is open, showing the text "Obtain priority document from DAS". Below the dropdown, a red warning message reads: "The time limit to request that the priority document(s) be obtained from DAS has already expired."

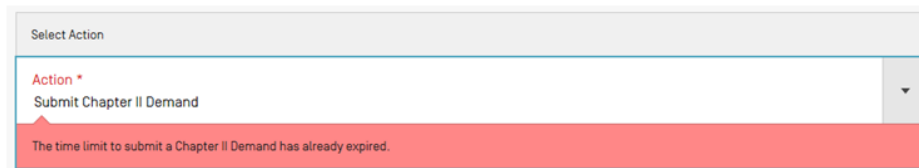
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Submit Chapter II Demand

- This ePCT action will pre-populate many fields in the Demand form
- This saves you time and reduces risk of mistakes
- This ePCT action carries out many validations of your inputs
- This reduces risk of mistakes and malpractice

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Submit Chapter II Demand



Select Action

Action *
Submit Chapter II Demand

The time limit to submit a Chapter II Demand has already expired.



Select Action

Action *
Submit Chapter II Demand

A Chapter II Demand was already filed on 13 Apr 2012.

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Submit Chapter II Demand

PCT Rule 59.3(e). Where the demand is transmitted to a competent International Preliminary Examining Authority [by the IB], it shall be considered to have been received on behalf of that Authority on the date marked on it [by the IB], and the demand so transmitted shall be considered to have been received by that Authority on that date.

If the selected IPEA accepts Demands filed directly via ePCT, in cases where the time limit has already expired at that IPEA (e.g. IPEA/AU), but the current date and time at the IB in Switzerland is still within the time limit, the Demand will be routed automatically to the IB for subsequent transmittal to the IPEA with Form PCT/IB/368. (*Oppedahl on PCT Forms*, page 124)

When the Demand gets e-filed, docket to check for receipt of Form PCT/IB/368.

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Submit Chapter II Demand

Maybe you don't know how to e-file documents directly with your selected IPEA. This ePCT action saves you from having to figure out how to e-file documents with the IPEA.

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Request for Early Publication

REQUEST FOR EARLY PUBLICATION

A special publication fee of 200 CHF is due (the ISR or Article 17(2)(a) Declaration has not yet been received by the International Bureau) [Modes of payment of special fees to the International Bureau](#)

Current date and time at recipient Office: Tuesday, 02 May 2023, 00:27 CEST
Deadline to submit draft action: Monday, 7 August 2023 24:00:00 CEST

Date of Request 02 May 2023

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Request for Early Publication

Select Action

Action *

Request for Early Publication

International publication is scheduled to take place on 06 Apr 2017. Earlier publication is not possible.

Select Action

Action *

Request for Early Publication

Technical preparations completed and/or international application already published.

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Declarations under PCT Rule 4.17

- We will discuss this in detail in webinar number 11

Amendments Under Article 19 (text format only)

This action enables you to submit to the IB amendments to the claims under Article 19 in text format (DOCX or text-based PDF files). For Article 19 amendments that are not in text format, the Document Upload function is to be used, however, applicants are encouraged to submit Article 19 amendments in text format order to facilitate processing by the IB in preparation for international publication.

Amendments Under Article 19 (text format only)

▼ ACTIONS

Select Action

Action *

Amendments Under Article 19 (text format only)

The ISR has not yet been received at the International Bureau. It is premature to submit amendments to the claims under Article 19

Select Action

Action *

Amendments Under Article 19 (text format only)

The time limit to amend the claims under Article 19 has expired

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Amendments Under Article 19 (text format only)

▼ ACTIONS

AMENDMENTS UNDER ARTICLE 19 [TEXT FORMAT ONLY]

Date 20 Mar 2017

Language of International Publication English

Amended claims already received at the IB (not yet processed).

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Amendments Under Article 19 (text format only)

In order to comply with Article 19 and Rule 46, you must submit a letter accompanying the amended claims that explains the amendments. If an accompanying letter has already been prepared it is possible to attach it in PDF format, however, it is recommended to prepare a standardized accompanying letter with the help of the interface in order to ensure that all the amendments are explained.

LETTER ACCOMPANYING THE AMENDED CLAIMS

Accompanying letter under Article 19: It is recommended to prepare a standardized accompanying letter with the help of the interface in order to ensure compliance with Article 19 and Rule 46.

Prepare a standardized accompanying letter

Attach accompanying letter

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Amendments Under Article 19 (text format only)

It is optional to include a Statement under Article 19 when submitting amended claims. If a Statement has already been prepared it is possible to attach it in PDF format, however, it is recommended to use the 'Prepare a statement' feature in order to type the text of the Statement directly into the interface for automatic formatting and rendering.

STATEMENT UNDER ARTICLE 19 [OPTIONAL]

Statement Under Article 19: The statement should not exceed 500 words and must not contain disparaging comments on the international search report or on the relevance of the citations contained in that report.

Prepare a statement

Attach a statement

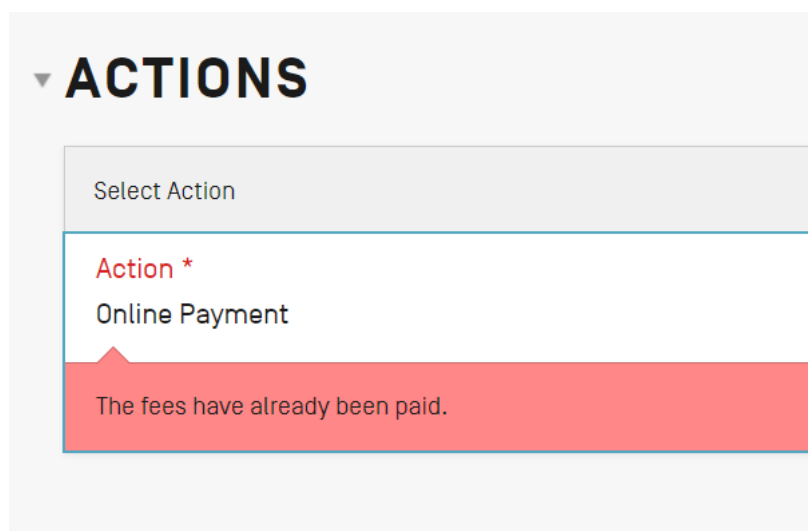
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Online Payment

- This Action may be used post-filing in order to pay the fees due for filing a new application to RO/IB by way of an online transaction. For other receiving Offices, please contact the RO directly for any payment-related information.

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Online Payment



▼ **ACTIONS**

Select Action

Action *

Online Payment

The fees have already been paid.

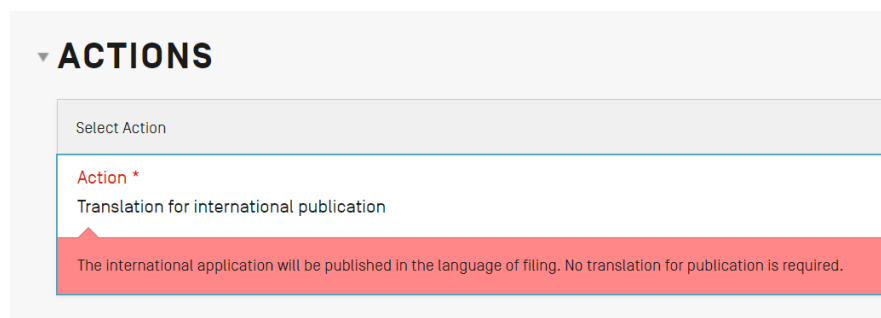
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Create Power of Attorney

- Provided that there is at least one Agent or a Common Representative recorded for an IA, a Power of Attorney can be prepared online using the bibliographic data on record at the IB.
- Select the name of the Agent(s) to be appointed and select to add the Applicant(s) appointing the selected Agent. The signature of each applicant must be indicated either by typing a text string signature which can be done by sharing access rights to the IA with the Applicant(s) concerned, or by attaching an image signature.

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Translation for international publication



▼ **ACTIONS**

Select Action

Action *

Translation for international publication

The international application will be published in the language of filing. No translation for publication is required.

The way this would arise is that the PCT application was filed in a language that is not one of the publication languages.

This would be unlikely to arise for most US filers given that they would probably be filing in English.

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Upload Documents

▼ **ACTIONS**

UPLOAD DOCUMENTS

Recipient *
IB

Electronic routing method: ePCT Immediate access to IB
Current date and time at recipient Office: Tuesday, 02 May 2023, 00:51 CEST

Document Type *

▼ **ACTIONS**

UPLOAD DOCUMENTS

Recipient *
ISA

Electronic routing method: PCT Electronic Data Interchange Daily online batch (max 24 hour delivery time)
Current date and time at recipient Office: Tuesday, 02 May 2023, 07:52 KST

Document Type *



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Upload Documents

- In general if you can use an ePCT action that is more specific than the very general “upload documents” action, you should use the more specific action.
- There are at least two benefits to using the “upload documents” action:
 - It gets loaded into the appropriate IA file automatically (no risk of it getting loaded into the wrong file)
 - You can tag the document type, which routes the task to the correct Processing Team person in an automatic way (no need for some human being to spend time figuring out who is the right person to receive it)
- The time required to process a document depends on the type of document and the workload at the International Bureau. However, once uploaded, a document can be viewed immediately in ePCT, including while it is pending processing.

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Prepare and submit indications relating to biological material (RO/134)

Page *	Date of Deposit * 
Line *	Accession No
Depository Institution * 	Additional Indications
	1000 characters remaining.
Separate Furnishing of Indications	
1000 characters remaining.	
Designated State(s) for which indications are made (if the indications are not for all Designated States):	
<input checked="" type="radio"/> All	
<input type="radio"/> Specific designations	

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Update File Reference

Locking device PRIVATE VIEW

Attorney Docket #
BMLP.P016 1468-3/04a [Edit](#)

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Update File Reference

UPDATE APPLICANT/AGENT'S FILE REFERENCE

Current date and time at recipient Office: Tuesday, 02 May 2023, 01:01 CEST
Deadline to submit draft action: Thursday, 26 September 2024 24:00:00 CEST

Date 02 May 2023

EDIT FILE REFERENCE

Applicant/agent's file reference *
R031-P014W02

Data currently on file : R031-P014W02

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Communications with the IB

ENTRY HISTORY

SEND EPCT MESSAGE

3/052144 ▾

Close

ISA/KR Search copy sent [24 Mar 2023]

Send ePCT message!

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Communications with the IB

SEND EPCT MESSAGE

Select recipient *

IB

Select subject *

- ePCT access rights
- DAS assistance
- Processing status of a document
- Fees & payments
- International publication
- ISR & Written opinion
- Chapter II Demand/IPEA
- Translation
- Other

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Upcoming webinars

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Webinar 12. Thursday, May 18, 2023, 10AM Mountain Time. Sequence listings and ePCT. Note that this is **not** about how to create a sequence listing. This webinar assumes you already know how to create a sequence listing. This webinar talks about things that you need to know in ePCT that relate to sequence listings.

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Upcoming webinars

Webinar 13. Thursday, June 1, 2023, 10AM Mountain Time. Docketing of PCT applications and making use of ePCT notifications. Suggested companion purchase: *Oppedahl on PCT Forms and PCT Docketing*.

Using ePCT to e-file in ISAs and IPEAs, filing Demands.

Doing 92bis changes.

Publication front page preview, generating reports of outstanding Forms ISA/202, generating reports of applications with outstanding priority documents.

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Upcoming webinars

How to register? Go to

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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Please complete the evaluation questionnaire

- Yes please complete it
- Pay it forward

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Thank you

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