

# ePCT webinar series

## Sequence listings and ePCT

Webinar 12  
Thursday, May 18, 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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## What this webinar is not about

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*.

**Webinar 14.** Thursday, June 8, 2023, 10AM Mountain Time. Using ePCT to e-file in ISAs and IPEAs, filing Demands.

**Webinar 15.** Thursday, June 15, 2023, 10AM Mountain Time. Doing *92bis* changes.

**Webinar 16.** Thursday, June 22, 2023, 10AM Mountain Time. Publication front page preview, generating reports of outstanding Forms ISA/202, generating reports of applications with outstanding priority documents.

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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 topic

- Sequence listings and ePCT
- Note that my degree is in physics
- Not biology
- I won't be able to answer detailed questions about what it takes to generate a sequence listing in particular real-life cases

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## What is the point of the SL?

- The idea is that if we upload the SL, which is in a computer-readable format, then the patent office does two things with it:
  - Loads the SL into searchable databases so that others might be denied a patent because maybe their claims are not patentable
  - Uses the SL as part of working out the patentability of our pending claims, compared with what is in those searchable databases

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# Many places you can search

The screenshot shows the WIPO PATENTSCOPE search results page. At the top left is the WIPO logo. To the right are links for 'Help' and 'English'. Below the logo is a breadcrumb trail: 'Home > PATENTSCOPE > Search'. On the right side of the page, there are links for 'Feedback', 'Search', 'Browse', and 'Tools'. The main heading is 'SEARCH SEQUENCE LISTINGS'. Below this heading, there is a text box stating: 'This data is also available for bulk download via anonymous ftp from [ftp://ftp.wipo.int/pub/published\\_pct\\_sequences/publication/](ftp://ftp.wipo.int/pub/published_pct_sequences/publication/)'. Below that, another text box reads: 'Published Nucleotide and/or Amino Acid Sequence Listings Contained in Published PCT Applications (WinZIP 8.0)'. At the bottom right of the page, the number '9' is displayed.

## Big Bang day July 1, 2022

- Used to be the SL was in ST.25 format which ends with “txt”
- Now the SL is in ST.26 format which ends in “xml”
- Sometimes a filer will “zip” the xml file to reduce its file size

# Big Bang day July 1, 2022

- Absolutely the only thing that matters is the filing date of the application involved
- Not anything about a priority or domestic benefit filing date
- Recall that the filing date for a national-phase case is legally the same as the filing date of the PCT application that it came from

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## What's inside the SL

```
<?xml version="1.0" encoding="UTF-8"?>
<!DOCTYPE ST26SequenceListing PUBLIC "-//WIPO//DTD Sequence Listing 1.3//EN" "ST26SequenceListing_V1_3.dtd">
<ST26SequenceListing dtdVersion="V1_3" fileName="2023-cle-webinar-2.xml" softwareName="WIPO Sequence"
softwareVersion="2.3.0" productionDate="2023-05-17">
  <ApplicationIdentification>
    <IPOfficeCode>US</IPOfficeCode>
    <ApplicationNumberText>PCT/IB2023/042126</ApplicationNumberText>
    <FilingDate>2023-05-17</FilingDate>
  </ApplicationIdentification>
  <ApplicantFileReference>C025.P0001 153955-I-US-RY</ApplicantFileReference>
  <EarliestPriorityApplicationIdentification>
    <IPOfficeCode>CN</IPOfficeCode>
    <ApplicationNumberText>201510829241.1</ApplicationNumberText>
    <FilingDate>2015-11-25</FilingDate>
  </EarliestPriorityApplicationIdentification>
  <ApplicantName languageCode="zh">Wang, Renzhi</ApplicantName>
  <InventionTitle languageCode="en">A Chimeric Antigen Receptor hCD87-CAR and Applications
Thereof</InventionTitle>
  <SequenceTotalQuantity>2</SequenceTotalQuantity>
  <SequenceData sequenceIDNumber="1">
    -----
  </SequenceData>
</ST26SequenceListing>
```

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# What's inside the SL

```
</INSDQualifier>
</INSDFeature_qual>
</INSDFeature>
</INSDSeq_feature-table>
<INSDSeq_sequence>
ggcgtgaagctgcagcagagcggcccggagtggtgaagcccggcgcagcgtgaagatcagctgcaaggccagcggctacagcttcaccaacttctacatccactgggtgaag ;
cagcgcggccggccagggcctggagtggtcggctggatcttccacggcagc-gacaacaccgagttacaacgagaagttcaaggacaaggccacacctgaccgccgacaccagcagc ;
agcaccgctacatgcagctgagcagcctgaccagcgaggacagcgcctgtacttctgcggcggggcccccactgggtacttgcagctgtggggccagggcaccaccgtg ;
accgtgagcagc</INSDSeq_sequence>
</INSDSeq>
</SequenceData>
</ST26SequenceListing>
```

The important part

# What's inside the SL

```
<INSDSeq_division>PAI</INSDSeq_division>
<INSDSeq_feature-table>
  <INSDFeature>
    <INSDFeature_key>source</INSDFeature_key>
    <INSDFeature_location>1..118</INSDFeature_location>
    <INSDFeature_qual>
      <INSDQualifier>
        <INSDQualifier_name>mol_type</INSDQualifier_name>
        <INSDQualifier_value>protein</INSDQualifier_value>
      </INSDQualifier>
      <INSDQualifier id="q1">
        <INSDQualifier_name>organism</INSDQualifier_name>
        <INSDQualifier_value>synthetic construct</INSDQualifier_value>
      </INSDQualifier>
    </INSDFeature_qual>
  </INSDFeature>
  <INSDFeature>
    <INSDFeature_key>REGION</INSDFeature_key>
```

tags always come in pairs

pairs

pairs

Sort of like parentheses in a math formula ...

The closing tag starts with a virgule ("/")

## It is important to know how to edit these things in Notepad

- Sometimes you will be in a crunch and Notepad will be the perfect way to fix some little problem
- Always revalidate it in WIPO Sequence afterwards

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## Converting from ST.25 to ST.26

- Yes the WIPO Sequence software will do this, to the extent that it is able to do so
- But ST.26 calls for a few additional bits of information that won't be found in the old ST.25 file

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## Filing a PCT application in RO/US after July 1, 2022

- It will have to be an ST.26 sequence listing
- The sequence listing cannot be filed through EFS-Web
- The sequence listing will need to be filed through Patentcenter
- If you manage to do it all the same day, you could do part of the filing in EFS-Web and the sequence listing in Patentcenter

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## Filing a PCT application in RO/IB after July 1, 2022

- It will have to be an ST.26 sequence listing
- ePCT makes it easy to upload the ST.26 sequence listing

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# A few years ago

- A few years ago it was unfortunately all too easy to accidentally fail to say that the SL is “part of the description”
- A few years ago WIPO changed ePCT so that it is extremely difficult to make such a mistake

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# Adding the sequence listing

PRIORITY DESIGNATIONS NAMES SEARCH DECLARATIONS BIOLOGY DOCUMENTS FEES SIGNATURE Save draft Preview R0/101 Close Review & File

**IMPORTANT - YOU ARE LOGGED INTO THE DEMO VERSION OF ePCT - DO NOT ATTACH ANY CONFIDENTIAL DOCUMENTS AS PART OF THIS DEMO FILING**

IMPORTANT - If the documents making up the International application have been prepared by conversion from a different document format, you are advised to attach a zip file containing the documents in the pre-conversion format, e.g., as WORD files. Including the pre-conversion documents is free of charge and may be used to perform automated validation checks for expedited processing by the receiving Office.

[Add pre-conversion files](#) [Learn More](#)

The specification is attached as: PDF format - separate files for description, claims, abstract, drawings

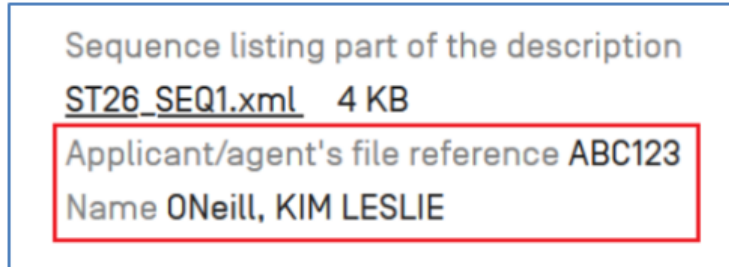
Description [cert\\_775779230049140589763450613-1683503383275.pdf](#) EN - English (1 page) 57.6 KB [View document as it will be rendered at the IP](#) - [View document](#)

Claims [cert\\_7702583778715866455U201230131-1678923668737.pdf](#) EN - English (1 page) 57.6 KB [View document as it will be rendered at the IP](#) - [View document](#)

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## Filing a PCT application in RO/IB after July 1, 2022

**Sequence listings in ST.26 format:** At the time of adding a sequence listing file in ST.26 format, the applicant/agent's file reference and the applicant name is extracted and *temporarily* displayed in the interface to help the user spot if perhaps the wrong file was added in error.



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## Incorporation by reference?

- Suppose filer failed to provide a required ST.26 sequence listing when filing a PCT application (on or after July 1, 2022)  
...
- And suppose the priority application (presumably filed on or after July 1, 2022) contained the required ST.26 sequence listing ...
- And suppose the filer did include in the Request the “magic words” for rule-based IBR ...
- Then the filer could bring the ST.26 sequence listing into the IA from the priority application without adding new matter ...
- And the filing date of the IA would be preserved

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# Incorporation by reference?

- Suppose filer failed to provide a required ST.26 sequence listing when filing a PCT application (PCT filing date on or after July 1, 2022) ...
- And suppose the priority application (filed before July 1, 2022) contained an ST.25 sequence listing ...
- And suppose the filer did include in the Request the “magic words” for rule-based IBR ...
- Then the filer would hope to be able to bring the ST.25 sequence listing into the IA from the priority application without adding new matter ...
- Nope, it would not work

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# Invitation to furnish

- The ISA might notice that you should have provided a sequence listing but failed to do so
- The ISA might look at a sequence listing that you provided, and might decide you did not do it correctly
- Either way, you will receive an *Invitation to furnish*

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# The invitation

- Form PCT/ISA/225 – Invitation to Furnish Nucleotide and/or Amino Acid Sequence Listing and to Pay, Where Applicable, Late Furnishing Fee (page 145 of *Oppedahl on PCT Forms and PCT Docketing*)

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## Why you received the invitation

- One way to screw it up would be to provide the sequence listing only in human readable form; in which case, this form PCT/ISA/225 is inviting you for the first time to provide your sequence listing in computer readable form
- Another possibility is that you did provide it in computer readable form, but the searching authority thinks you didn't provide it in proper computer readable form

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# Invitation to furnish

- If you receive an *Invitation to furnish* from an ISA, must you furnish?
- No. You can decline the invitation.
- Declining the invitation does not lead to the IA being deemed withdrawn
- The ISA will search as best it can, if it can
- This might lead to *no claims being searched*

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# Late furnishing fee

- **ISA/US (large) – USD 320**
- **ISA/EP – EUR 255 (about \$277)**
- ISA/XV – EUR 230 (about \$250)
- ISA/FI – EUR 200 (about \$217)
- **ISA/IL – ILS 491 (about \$134)**
- **ISA/US (small) – USD 128**
- ISA/PH – USD 200 (or USD 100)
- **ISA/KR – KRW 112500 (about \$84)**
- **ISA/US (micro) – USD 64**
- **ISA/RU – RUB 4000 (about \$50)**
- ISA/EA – RUB 4000 (about \$50)
- ISA/IN – INR 4000 (about \$49) or (INR 1000)
- ISA/BR – BRL 180 per page (about \$35) (or if on paper, BRL 270 per page)
- ISA/CN – CNY 200 (about \$29)
- ISA/TR – TRY 200 (about \$10)
- ISA/EG – EGP 200 (about \$7)

No late furnishing fee

- ISA/CL
- ISA/UA
- ISA/AT
- **ISA/AU**
- ISA/CA
- ISA/ES
- **ISA/JP**
- ISA/SE
- **ISA/SG**

ISA/XN – unknown

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## Trap for the unwary

- If you are paying a Late Furnishing Fee to ISA/US at small entity rate, but have not previously established small entity status ...
- You will need to expressly establish small entity status
- Merely paying the small entity Late Furnishing Fee does not count as establishing small entity status

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## Trap for the unwary

- If you are paying a Late Furnishing Fee to ISA/US at micro rate, but have not previously established micro status ...
- You will need to expressly establish micro status
- Is it worth \$64 to go to this trouble?

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## Sequence listing for purposes of search

- Pursuant to PCT Rule 13ter.1(e) any sequence listing submitted for purposes of international search shall be accompanied by a statement to the effect that the sequence listing does not go beyond the disclosure in the international application as filed

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## How to deliver the SL to the ISA?

- Maybe you are in the US and the ISA is the ISA/US ...
- In which case you might as well use Patentcenter to deliver it
- You can't use EFS-Web to deliver it

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## How to deliver the SL to the ISA?

- Maybe the ISA is in some other place
- For example ISA/EP or ISA/KR
- In which case you might not be familiar with how to e-file in EPO or KIPO
- ePCT saves the day!

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## Upload action

DATA DOCUMENTS FEES ACTIONS ACC

### UPLOAD DOCUMENTS

Recipient \*

IB  
ISA

Document Type \*

Attach document \*

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# Upload to ISA

Recipient \*  
ISA

Electronic routing method: PCT Electronic Data Interchange Daily online batch (max 24 hour de  
Current date and time at recipient Office: Wednesday, 17 May 2023, 14:44 CEST

Document Type \*

**Rectification of Obvious Mistakes [Rule 91]**  
Request for Rectification  
Rectified Sheets  
Sequence Listing - Rectification

**Sequence listing [Rule 13ter]**  
Sequence listing for the purposes of international search [Rule 13ter]  
Statement relative to Seq List for the purposes of international search [Rule 13ter]  
Translation of Sequence Listing for the purposes of international search  
Sequence Listing - Rectification - Rule 13ter

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# Upload sequence listing

**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: Wednesday, 17 May 2023, 14:44 CEST

Document Type \*  
Sequence listing for the purposes of international search [Rule 13ter]

Attach document \*

Add document [.xml or .zip]

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## We have uploaded the sequence listing

**DOCUMENTS ATTACHED FOR UPLOAD**

Sequence listing for the purposes of international search [Rule 13ter]  
[2023-cle-webinar.xml](#) 4.2 KB  
Applicant/agent's file reference C025.P0001 153955-I-US-RY  
Name Wang, Renzhi

IMPORTANT - The version of the WIPO Sequence software used to create the sequence listing has significant known bugs. Check if your sequence listing might be affected and find more details at <https://www.wipo.int/standards/en/sequence/index.html>

But as you see I had created it a long time ago with an old version of WIPO Sequence

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## So I run WIPO Sequence

NEW PROJECT IMPORT PROJECT IMPORT SEQUENCE LI

**TS**

Update found (2.3.0)

Update found, do you want to update now?

Yes No

Applicant file reference Applicant name Invention title

Of course I want to update now! So I click "yes".

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# I generate the SL again

**SUCCESS:** The ST.26 sequence listing file has been generated successfully at 'C:\temp\2023-cle-webinar.xml'

Next, I upload the newly generated SL a second time into ePCT for sending to the ISA

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Now there is no warning about an outdated version of WIPO Sequence having been used

Now we can check to see if we uploaded the wrong file

**DOCUMENTS ATTACHED FOR UPLOAD**

|   |    |
|---|----|
| Sequence listing for the purposes of international search (Rule 13ter)<br>2023-cle-webinar-2.xml 4.2 KB<br>Applicant/agent's file reference C025/P0001153955-I-US-RY<br>Name Wang, Renzhi | 🗑️ |
|---|----|

Add Informal message

Signature type

- Text signature
- Image signature
- Document(s) signed by Applicant/Agent included in the attachment(s)
- External Signature

Signatory \*

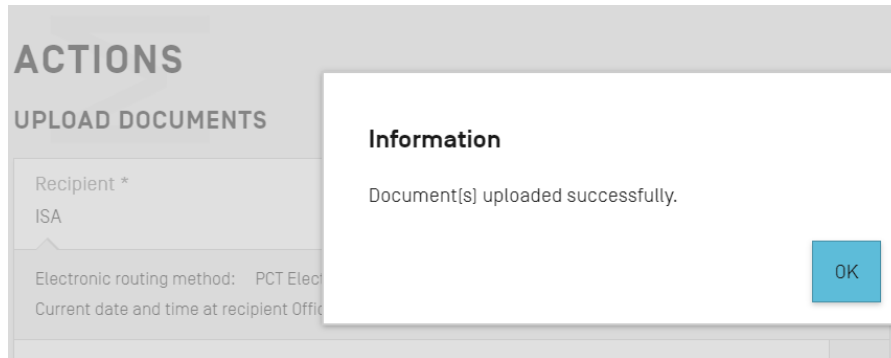
Signature [should include name] \*

/ /

Cancel Save draft Preview Upload

40

# Document uploaded successfully



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|        | Can Send ePCT Messages? | Can upload Documents? | EDI or instant? |
|--------|-------------------------|-----------------------|-----------------|
| ISA/AU | yes                     | yes                   | instant         |
| ISA/EP | no                      | yes                   | EDI             |
| ISA/IL | no                      | no                    | neither         |
| ISA/JP | no                      | no                    | neither         |
| ISA/KR | no                      | yes                   | EDI             |
| ISA/RU | no                      | yes                   | EDI             |
| ISA/SG | no                      | yes                   | EDI             |
| ISA/US | no                      | no                    | neither         |

How trendy, modern and up-to-date are the ISAs?

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# EDI or instant?

- EDI is slower to reach the ISA
- Batched once a day
- Even if the EDI reaches the ISA past midnight at the ISA, you will get credit for what time it was at the ISA when you submitted it to ePCT

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## IPEA might invite you to furnish a sequence listing

- Maybe the RO snoozed through it ...
- And maybe the ISA snoozed through it ...
- And maybe the IPEA was the first to notice the need for a sequence listing ...
- Then you will have to provide a sequence listing to the IPEA
- The type of listing to be provided (ST.25 or ST.26) will be determined by the PCT filing date
- This might be any IPEA, not just the IPEA/US
- Note that the IPEA may require payment of a Late Furnishing Fee

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# Invitation to furnish

- If you receive an *Invitation to furnish* from an IPEA, must you furnish?
- No. You can decline the invitation.
- Declining the invitation does not lead to the IA being deemed withdrawn
- The IPEA will examine as best it can, if it can
- Keep in mind the IPEA will likely decline to examine any claims that were not searched by the ISA
- This might lead to *no claims being examined*

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# Article 34 amendment?

- Anybody who files a Demand can do an Article 34 amendment if they wish
- They can try to amend the specification, claims, or drawings
- This can include trying to amend or add a sequence listing
- This only works if the IPEA agrees you are not adding new matter
- The way you know you succeeded is that the amendment becomes an Annex to the IPRP-II

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# Entering national phase

When you are entering the national phase, should it be ST.25 or ST.26?

- What controls this is when the PCT application was filed
  - PCT was filed on or after July 1, 2022? then it should be ST.26.
  - PCT was filed before July 1, 2022? then it should be ST.25.
- But usually you will not need to think about this because the DO/EO will simply download the SL from the WIPO database and it will presumably be in the correct format

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# Filing bypass continuation

When you are filing a bypass continuation at the USPTO, should it be ST.25 or ST.26?

- What controls this is when the bypass continuation gets filed
  - Bypass continuation gets filed on or after July 1, 2022? then it should be ST.26.

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## Bypass continuation or national phase?

PCT was filed before July 1, 2022?

Today's date is after July 1, 2022?

- Then if you do a national-phase entry today, you get to keep using the ST.25 sequence listing and you don't have to create an ST.26 sequence listing
- But if you do a bypass continuation today, you have to create an ST.26 sequence listing

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## Early US national phase entry

- Suppose the PCT application was not filed with the USPTO as receiving Office ...
- And at the time of US national-phase entry, the PCT application has not yet been published by the International Bureau ...
- And the international phase application (PCT) discloses sequences and contains a sequence listing as "forming part of the international application", as required under PCT Rule 5.2(a) ...
- Then you will have to provide the sequence listing as part of the US national-phase entry submission.

(Note that you will also need to provide a copy of the Request.)

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# Non-English free text?

- Suppose the PCT application was filed with an ST.26 sequence listing as “forming part of the international application” ...
- And the values of one or more qualifiers in the sequence listing that contain language-dependent free text were provided only in non-English languages ...
- And you are entering the US national phase ...
- Then you must provide a translation of the sequence listing into English

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## DO/EO might ask for a sequence listing

- Maybe the RO snoozed through it ...
- And maybe the ISA snoozed through it ...
- And maybe the IPEA snoozed through it (if a Demand was filed) ...
- And maybe the DO/EO was the first to notice the need for a sequence listing ...
- Then you will have to provide a sequence listing to the DO/EO
- The type of listing to be provided (ST.25 or ST.26) will be determined by the PCT filing date
- This might be any national-phase entry Office, not just the DO/EO/US

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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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