

# ePCT webinar series

## Docketing of PCT applications and making use of ePCT notifications

Webinar 13

Thursday, June 1, 2023, 10AM Mountain Time

Carl Oppedahl

<https://blog.oppedahl.com>

1

# 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.

2

# Upcoming ePCT webinars

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.

3

# Upcoming ePCT webinars

How to register? Go to

[https://blog.oppedahl.com/?page\\_id=8978](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](https://oppedahl-lists.com/mailman/listinfo/pct_oppedahl-lists.com) ).

4

# 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).

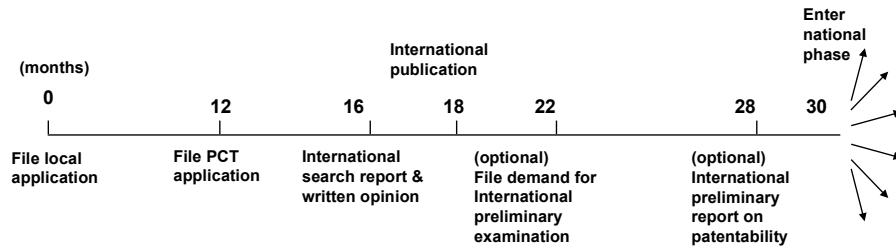
5

# Today's topics

- Docketing of PCT applications
- Making use of ePCT notifications

6

## The PCT time line



7

## One of my favorite things about ePCT

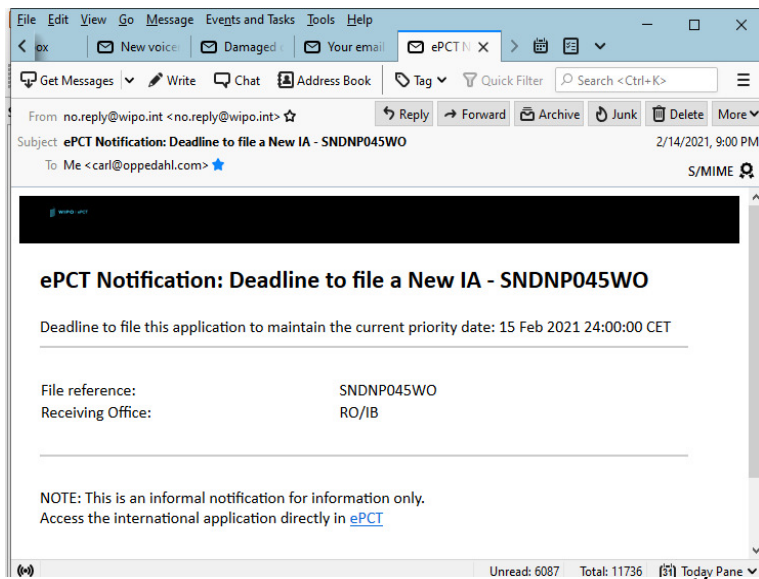
You start preparing a PCT Request and you enter a priority claim for an application that was filed 364 days ago

In other words, the one-year period runs out one day from now

Wouldn't it be nice if some system somewhere would remind you that you have only one day left to get the PCT application filed?

8

## One of my favorite things about ePCT



## A shout-out

A shout-out to the docket clerks who are among our attendees. You are the unsung heroes of your law firms and corporations. You regularly save your firm or corporation from disasters, yet many people seemingly do not know that you exist.

Thank you for being there. I mean that.

## Now to the rest of you

Turning to the rest of you ...

Later after we are done with this webinar, go down the hall (or the work-from-home equivalent) and say “thank you” to your docket clerks. I mean that.

11

## Calculating dates

Often we have to calculate dates

- Priority date plus 30 months (P+30)
- Priority date plus 22 months (P+22)
- Mailing date of International Search Report plus 3 months (ISR+3)
- Date of technical preparations for publication by the International Bureau

We will talk about a way that you can cross-check your calculation with a trusted external source for these dates

12

## Technical preparations for publication day at WIPO

Figure out publication day

This is P+18 except that you have to keep counting until you hit a Thursday (or every now and then a Friday)

Then count back 15 days (usually reaching a Wednesday) which is technical preparations day

Then count back one more day (usually reaching a Tuesday)

Now you know the last day to request withdrawal to prevent publication

ePCT will calculate this for you

13

## Why we care about technical preparations day?

- Last day to hand in the PCT Declarations
- Last day to request withdrawal to avoid publication
- Last day to make an Article 19 amendment (unless ISR+2 gives you more time)
- Last day to hand in certified copies

14

# Docketing of PCT applications

See also ***Session 7 – E-Filing of the PCT Application and docketing of PCT thereafter*** at [https://blog.oppedahl.com/?page\\_id=7703](https://blog.oppedahl.com/?page_id=7703)

15

## Docketing PCT

When you file a PCT application, docket to check for these forms:

- Form PCT/RO/105, which memorializes the filing date and application number (page 60 of *PCT Forms*)
- Form PCT/RO/102, which memorializes that proper fees were paid (page 53 of *PCT Forms*)
- Form PCT/IB/301, which memorializes that the International Bureau has received the Record Copy from the RO (page 97 of *PCT Forms*)
- Form PCT/IB/304, which memorializes that the International Bureau has received the certified copy of the priority document (page 99 of *PCT Forms*)
- Form PCT/ISA/202, which memorializes that the International Searching Authority has received the Search Copy (page 132 of *PCT Forms*)

16



## Docketing PCT

- Docket P+22 (priority date plus 22 months) for filing of a Demand and Article 34 amendment (note that this may change later)
- Docket P+30 for entry into the national phase
- Docket tech-prep day for Article 19 amendment (note that this may change later)
- Docket tech-prep day for withdrawal to prevent publication

17

## Docketing PCT

- After Form PCT/IB/301 arrives, check to make sure that you have access to the PCT application in the ePCT system (page 97 of *PCT Forms*)
- After Form PCT/ISA/202 arrives, docket three months to check for receipt of the International Search Report and the Written Opinion (ISR/WO) (or P+9 if later, depending upon which ISA the applicant selected) (page 132 of *PCT Forms*)

18

Note that ePCT will also calculate all these same dates

Look in the ePCT "time line"

You can cross-check the dates from the ePCT time line with your own dates

19

What about your cases that you filed a year ago?

Cases that you filed a year ago that are not yet in ePCT?

You need to get them loaded into ePCT

20

## ePCT

Did I mention that it is good to be using  
ePCT?

21

## ePCT

ePCT has a function that is somewhat like Private PAIR and Patentcenter

It lets you see the content and status of your pending PCT applications, just as Private PAIR and Patentcenter let you see the content and status of your pending US applications

But does Private PAIR send you warnings of upcoming due dates? No!

Does Patentcenter send you warnings of upcoming due dates? No!

ePCT sends you warnings of upcoming due dates!

Does Private PAIR maintain a time line for each application, listing upcoming due dates?  
No!

Does Patentcenter maintain a time line for each application, listing upcoming due dates?  
No!

ePCT maintains a time line for each application, listing upcoming due dates.

It would be daft not to make full use of the automatic warnings that ePCT sends you for your upcoming due dates on your PCT applications.

Right?

22

## ePCT

Clearly you are going to want to make sure that all of your pending PCT applications are visible to you in ePCT, just as all of your pending US applications are visible to you in Private PAIR and Patentcenter.

It would be daft not to make it so. Right?

23

## ePCT

This means that you need to do what it takes to make it so that each new PCT application that you file automatically gets loaded into the part of ePCT that is like Private PAIR and Patentcenter

This means that you need to do what it takes to get all of your old pending PCT applications loaded into the part of ePCT that is like Private PAIR and Patentcenter

24

## ePCT time line

- The time line might change from one day to another:
  - Arrival of ISR/WO
  - Withdrawal of priority claim

25

## Arrival of ISR/WO

- The ISR/WO might arrive late enough that it changes some “last possible dates”
  - It might change the last date for an Article 19 amendment
  - It might change the last date for filing a Demand
- The ePCT system can only carry out those recalculations *after it receives its own copy of the ISR/WO*
- You might receive the ISR/WO before the IB receives it
- This would mean that you learn of these changed dates before the ePCT system has the opportunity to recalculate such dates

26

## Withdrawal of priority claim

- Withdrawal of a priority claim might lead to a recalculation of dates in the ePCT time line
  - This happens only if the priority claim being withdrawn is the “oldest one”
  - The only dates that will get recalculated are dates for things that have not yet happened

27

## Making use of ePCT notifications

- ePCT provides a wealth of warnings and notifications that can assist in the docketing process

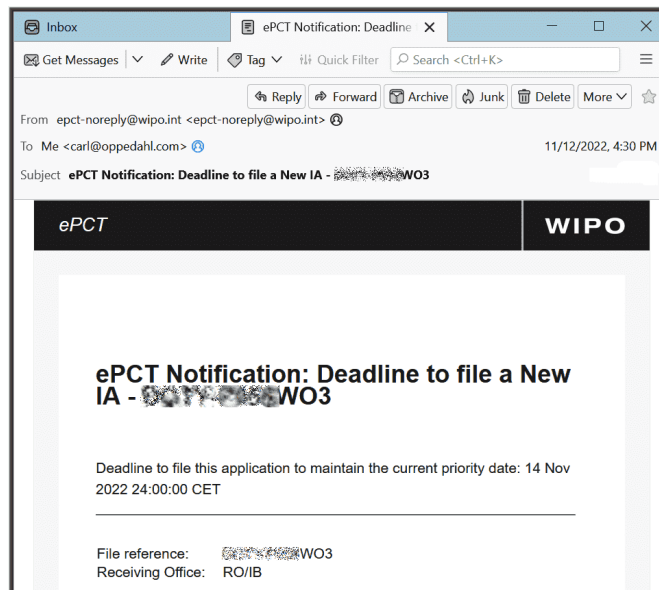
28

# 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


29


## End of 12 months is imminent!

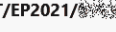



30


# ePCT provides warnings of upcoming due dates

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

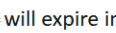
To Me <carl@oppedahl.com>  2/22/2023, 10:30 AM

Subject **ePCT Notification: End of International Phase - PCT/EP2021/****-**  


<b>ePCT</b>	<b>WIPO</b>
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**ePCT Notification: End of International Phase - PCT/EP2021/****-**  




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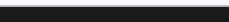
The 30 months time limit (end of the international phase) for PCT/EP2021/ will expire in 1 month.

31


# 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/****-**  


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

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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.

32



# ePCT provides warnings of upcoming due dates

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

To carl@oppedahl.com

2/15/2023, 7:08 PM

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

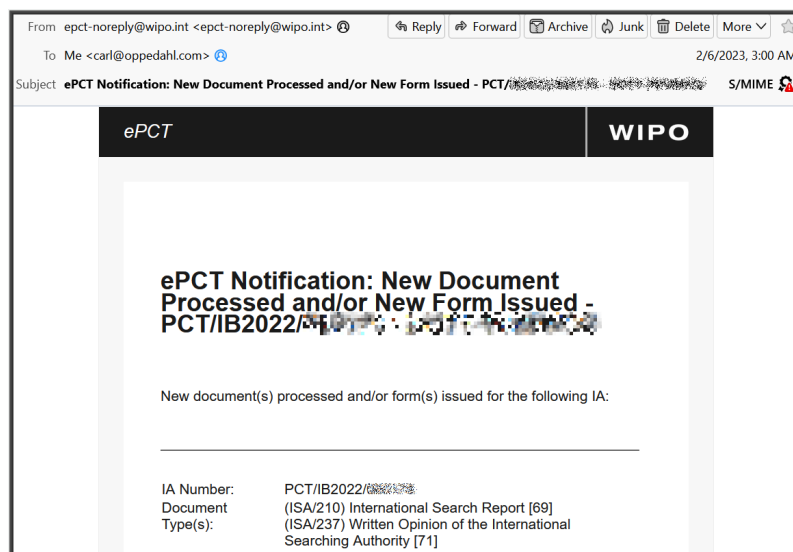


## ePCT Notification: Technical Preparations for Publication - PCT/IB2022/ P058WO2

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

33

ePCT notifies you of **all** new documents whether inbound or outbound (PAIR and Patentcenter only tell you of outgoing documents)



34

# 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

35

# 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

36

# Customizing your notifications

WIPO

Help English carl OPPEDAHL

Home > PCT System > ePCT

GENEVA MAY 31, 2023, 4:26 PM CEST

## NOTIFICATIONS

Close

By default the 500 most recent results are displayed. Select and clear notifications to display the next 500 results.  
IMPORTANT - Notifications are automatically archived one year after the date of receipt and can be retrieved upon request to the ePCT [Help Desk](#).

Add filter | Columns | Preferences

37

# Customizing your notifications

Notify me about events in IAs where my access rights are

- eEditor
- eOwner
- eViewer

Method of Notification \*

- Email + Notifications list in ePCT
- Email
- Notifications list in ePCT

Notify me about the following events for all IAs in my workbench

- I am eOwner and access rights are changed by another person
- Priority document(s) still outstanding and international publication is scheduled to take place in 2 weeks
- Priority document(s) still outstanding and the time limit under Rule 17.1(a) has expired
- Time limit for submitting Article 19 amendments expires in 2 weeks
- Technical preparations for publication scheduled to close in 2 weeks
- Time limit for submitting Rectification of Obvious Mistakes to ISA Office [Rule 91.1] expires in 2 weeks
- Republication event has been scheduled by the IB
- Time limit to request supplementary international search expires in 2 weeks
- Time limit to file Chapter II Demand expires in 2 weeks
- 30 month time limit (end of the international phase) expires in 1 month
- IA Warning added/modified
- New document processed and/or new form issued
- ePCT-Filing confirmation - documents and bibliographic data available in ePCT

38

I am eOwner and access rights are changed by another person

- Tips you off if somebody is improperly given access to a PCT application

39

Priority document(s) still outstanding and international publication is scheduled to take place in 2 weeks

- This is a backstop for Form PCT/IB/304 (page 98 of *PCT Forms* book) and the dreaded “NR”
- We care about this for two reasons:
  - Being tipped off that we mistyped a priority claim, and
  - Avoiding having to pay foreign counsel to hand in the certified copy at national-phase time

40

Being tipped off that we mistyped a priority claim

- The assumption is that we followed Best Practices by choosing “request from DAS” rather than “RO to provide”
- The explanation for the priority document being missing at the IB might be that we mistyped a priority claim
- Last chance to avoid malpractice for a mistyped priority claim

41

Priority document(s) still outstanding and the time limit under PCT Rule 17.1(a) has expired

- This might be bad news or it might be incredibly bad news
  - Bad news if it merely means that foreign counsel will need to be paid to send in a certified copy of the priority document
  - Incredibly bad news if it means we mistyped a priority claim

42

## Time limit for submitting Article 19 amendments expires in 2 weeks

- This might be driven by the mailing date of the ISR/WO (ISR + 3) (Form PCT/ISA/220, page 155 of *PCT Forms*)
- Or this might simply be driven by the priority date (technical preparations day) (Form PCT/RO/105 and Form PCT/IB/301, pages 59 and 96)

43

## Technical preparations for publication scheduled to close in 2 weeks

- Last chance for presenting a priority claim
- Last chance for getting the application withdrawn to avoid publication
- Maybe last chance for Article 19 amendment
- Last chance to hand in PCT declarations
- Best practice is to cross-check this with the date that we already docketed for technical preparations day

44

Time limit for submitting Rectification of Obvious Mistakes to ISA Office (Rule 91.1) expires in 2 weeks

- The competent authority shall authorize the rectification under this Rule of a mistake if, and only if, it is obvious to the competent authority that, as at the [filing date], something else was intended than what appears in the document concerned **and that nothing else could have been intended** than the proposed rectification.
- Spec said “2+2=5”
- What else could have been intended?
  - “2+3=5”?
  - “2+2=4”?

45

Republication event has been scheduled by the IB

- Maybe this is an A3 publication because the ISR/WO was late
- Maybe this is a republication because an Article 19 amendment happened

46

## Time limit to request supplementary international search expires in 2 weeks

- SIS is only rarely requested these days
- Nonetheless, if the client wants SIS, this reminder can be helpful

47

## Time limit to file Chapter II Demand expires in 2 weeks

- This might be P+22
- This might be ISR+3
- Demands only get filed in about 10% of cases nowadays
  - But it could be really smart to file a Demand in some cases

48



30 month time limit (end of the international phase) expires in 1 month

- This is super important

49

## IA Warning added/modified

- The idea is that somebody else might have put a warning onto some particular PCT application
- Of course you are going to want to know about this!

50

New document processed and/or new form issued

- Of course you are going to want to know about this!

51

ePCT-Filing confirmation - documents and bibliographic data available in ePCT

- This is tipping you off that there is a new PCT application now visible in your workbench

52

# Four upcoming webinars

- Eighteen most frequently encountered forms from the Receiving Office
- Fourteen most frequently encountered forms from the International Bureau
- Nine most frequently encountered forms from the International Searching Authority
- Eight most frequently encountered forms from the International Preliminary Examining Authority

53

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54

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55

# Please complete the evaluation questionnaire

- Yes please complete it
- Pay it forward

56

Thank you