

ePCT webinar series

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

Webinar 16
Thursday, June 22, 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

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).
- Webinar 10. Tuesday, May 2, 2023. ePCT actions and communications with the IB. Download the presentation materials. View the recording (1:18).
- Webinar 11. Thursday, May 11, 2023. External signatures and PCT declarations. Download the presentation materials. View the recording (1:18).
- 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. Download the presentation materials. View the recording (1:21).
- Webinar 13. Thursday, June 1, 2023, 10AM Mountain Time. Docketing of PCT applications and making use of ePCT notifications. Suggested companion purchase. Download the presentation materials. View the recording (1:05).

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Today's scheduled topics

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

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Publication front page preview

- You can get a preview of the front page of your 18-month PCT publication
- You can get it instantly if you file in RO/IB
- You will have to wait a few weeks to see it, if you file in RO/US

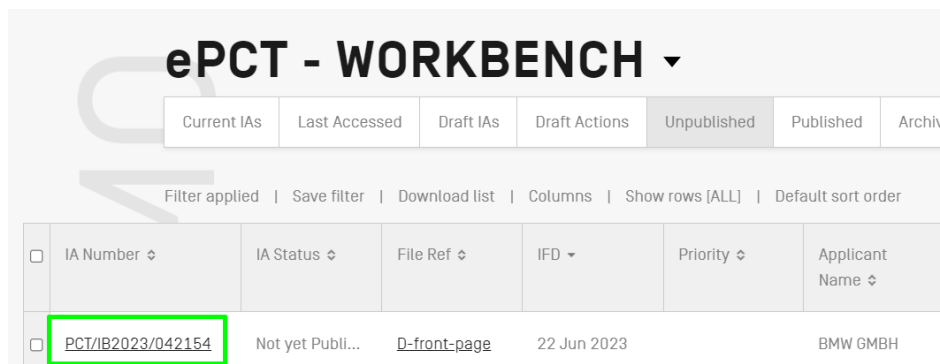
6

How to obtain publication front page preview

- Log in at ePCT
- Go to your ePCT workbench

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Go to your ePCT workbench,
Click on international application
number of interest



ePCT - WORKBENCH ▾

Current IAs | Last Accessed | Draft IAs | Draft Actions | Unpublished | Published | Archiv

Filter applied | Save filter | Download list | Columns | Show rows [ALL] | Default sort order

<input type="checkbox"/>	IA Number ↕	IA Status ↕	File Ref ↕	IFD ▾	Priority ↕	Applicant Name ↕
<input type="checkbox"/>	PCT/IB2023/042154	Not yet Publi...	D-front-page	22 Jun 2023		BMW GMBH

This will be instant if you selected RO/IB
This might take some weeks if you selected RO/US

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Click on "DATA"

GENEVA JUN 22, 2023, 12:19 AM CEST

DATA DOCUMENTS FEES ACTIONS ACCESS RIGHTS TIMELINE NATIONAL PHASE ENTRY NATIONAL PHASE HISTORY

D-FRONT-PAGE PCT/IB2023/042154 ▾

IA Status Not yet Published

Int. Filing Date 22 Jun 2023

Priority Date No Priority Claim

Applicant(s) BMW GMBH

Team at IB PCT RO/IB Team

Language of Filing EN

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Find "International publication" and click on the arrow to expand

▾ DATA

Print

VALIDATION REPORT

Report generated on 22 Jun 2023 at 00:16:00 CET

GENERAL INFORMATION

▶ International Application Number PCT/IB2023/042154

Applicant/agent's file reference D-front-page

INTERNATIONAL PUBLICATION

▶ International Publication Date Not yet published

International Publication Number Not yet published

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Click on “preview publication front page

INTERNATIONAL PUBLICATION

International Publication Date Not yet published
Current target date for international publication 27 Dec 2024
IMPORTANT In most cases international publication will take place on this date, but would be subject to change in any of the following circumstances:
- early publication is requested
- change in the priority date before the completion of technical preparations for international publication
- in exceptional cases only, international publication may be rescheduled for technical reasons.

International Publication Number Not yet published
Publication Language English
Early publication requested No
[Preview publication front page](#)

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(12) INTERNATIONAL APPLICATION PUBLISHED UNDER THE PATENT COOPERATION TREATY (PCT)

(19) World Intellectual Property
Organization
International Bureau



(10) International Publication Number
WO MISSING A2

(43) International Publication Date
27 December 2024 (27.12.2024)

- (51) **International Patent Classification:**
Not classified
- (21) **International Application Number:**
PCT/IB2023/042154
- (22) **International Filing Date:**
22 June 2023 (22.06.2023)
- (25) **Filing Language:** English
- (26) **Publication Language:** English
- (71) **Applicant:** BMW GMBH [DE/DE]; 1
Geschwindigkeitsstrasse, 12345 Munich (DE).
- (81) **Designated States** (unless otherwise indicated, for every kind of national protection available): AE, AG, AL, AM, AO AT AU AZ BA BB BG BH BN BR BW BY BZ.

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Why we care?

- Send to client for review
- Send to inventors for review
- Review within your own firm or corporate patent department

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What was missing?

- No inventors
- No agent

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Send to client for review Send to inventors for review

- This might smoke it out if there is some disagreement about sequence of inventor names
- This might smoke it out if some name got misspelled
- Once last chance to try to get the client to make up its mind about priority claims

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Review within your own firm or
corporate patent department

Opportunity to review bibliographic
data

- Names
- Priority claims
- Title

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What if client never caught on that this
application will get published?

- If the client had not previously caught on that this application will get published ...
- Showing the front-page preview to the client will hammer home that the application will get published
- It will be much harder for the client to play dumb that it never had any idea the application will get published

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Generating reports of outstanding Forms PCT/ISA/202

- Why we care?
- If the ISA never received the Search Copy, then you will never receive the ISR/WO
- If the ISA mistakenly thinks it never received the Search Copy, then you will never receive the ISR/WO
- Maybe you would prefer to receive the ISR/WO

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Log in at ePCT, go to ePCT workbench
click on “advanced search”

ePCT - WORKBENCH ▾

Current IAs | Last Accessed | Draft IAs | Draft Actions | Unpublished | Published | Archived | Search

Advanced search | Download list | Columns | Show rows [ALL] | Default sort order

IA Number ▾	IA Status ▾	File Ref ▾	IFD ▾	Priority ▾	Applicant Name ▾	My Rights ▾
RO to assign	New IA - Dow...	DEMO-KTTest1			SHIELD RESTRAINT SYSTEMS, INC	eViewer
RO to assign	New IA - Dow...	DEMO-SR-4			LEVY, Joseph	eOwner

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In “advanced search”, see
downarrow for “search criteria”

Advanced search | Download list | Columns | Show rows [ALL] | Default sort order

Extend filter to archived IAs

Search criteria *

Reset | Add criteria | **Apply Filter**

22

Receipt of Search Copy at ISA confirmed to the IB

- main or more than priority
- Status**
- Publication
 - Withdrawn
 - Access suspended
 - Receipt of Search Copy at ISA confirmed to the IB
 - New IA - Draft
 - New IA - Downloaded
 - New IA - RO Phase
- Documents**
- With document(s) not yet processed by the IB
 - With document(s) not taken into account by IB
 - With outstanding priority document(s)
 - With new documents received
 - With document type
- Access rights**
- Where I am the sole eOwner
 - Where my access rights are
 - Where my access rights were modified on

23

“Receipt of Search Copy at ISA confirmed to the IB” appears twice – why?

Advanced search | Download list | Columns | Show rows [ALL] | Default sort order

Extend filter to archived IAs

Search criteria *
Receipt of Search Copy at ISA confirmed to the IB

Receipt of Search Copy at ISA confirmed to the IB *

Reset Add criteria Apply F

24

You gotta pick “yes” or “no”, that’s why

Advanced search | Download list | Columns | Show rows [ALL] | Default sort order

Extend filter to archived IAS

Search criteria *
Receipt of Search Copy at ISA confirmed to the IB

Receipt of Search Copy at ISA confirmed to the IB *

Yes
No

Reset Add criteria Apply

25

Now you must click “Apply Filter”

Advanced search | Download list | Columns | Show rows [ALL] | Default sort order

Extend filter to archived IAS

Search criteria *
Receipt of Search Copy at ISA confirmed to the IB

Receipt of Search Copy at ISA confirmed to the IB *

No

Reset Add criteria Apply Filter

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Note “Filter applied”
You can click “Save filter”

ePCT - WORKBENCH ▾

Current IAs | Last Accessed | Draft IAs | Draft Actions | Unpublished | Published | Archi...

Filter applied | **Save filter** | Download list | Columns | Show rows [ALL] | Default sort order

IA Number ▾	IA Status ▾	File Ref ▾	IFD ▾	Priority ▾	Applicant Name ▾
PCT/IB2023/042154	Not yet Publi...	D-front-page	22 Jun 2023		BMW GMBH
PCT/IB2023/042126	Not yet Publi...	D-binford8	17 May 2023		BMW GMBH
PCT/IB2022/040067	Not yet Publi...	D-20220222...	22 Feb 2022		CANDY WRAP UNLIMITED

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Give it a name (“ISA/202 missing”) and save it

Filter applied | **Save filter** | Download list | Columns | Show rows [ALL] | Default sort order

SAVE FILTER

Filter Name *

Cancel Save filter

28

Study the report

- In some cases there is an innocent explanation, like you filed the case just a couple of days ago
- But maybe the explanation is you foot-dragged paying the fees
- Time to pay the fees!

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Study the report

- What if the RO slipped up?
- What if the ISA misplaced the search copy?

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What you don't want

- What you don't want is the client being the first to notice that the ISR/WO never showed up
- And you never noticed that the Search Copy never reached the ISA
- And the client was more on top of things than you were
- You can avoid this embarrassment by checking this report from time to time
- But of course you should also have been docketing to check for receipt of Form PCT/ISA/202
- But what if you failed to docket to check for receipt of Form PCT/ISA/202?
- What if you did docket to check for receipt of Form PCT/ISA/202 but then you failed to follow up on it?
- You can avoid this embarrassment by checking this report from time to time

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Generating reports of applications with outstanding priority documents

- Why we care?
- We prefer to avoid malpractice with a defective priority claim
- That's why we care
- If an IA shows up on this report, maybe it is a case where we made a mistake in the priority claim
- This can be malpractice
- We need to catch such mistakes well before the end of the dreaded 4-and-16 date
- Did I mention that we prefer to avoid malpractice with a defective priority claim?

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Generating reports of applications with outstanding priority documents

- Why we care?
- We also care because we would prefer not to have to pay foreign counsel \$1000 to drop a certified copy of the priority document in the mail to the foreign patent office
- Once for each foreign patent office in which we enter the national/regional phase
- Could be many thousands of dollars
- But that is fixable with money, so who cares? What we care about is mistakes that re not fixable with money! The defect mentioned on the previous slide **is not fixable with money** if we let the dreaded 4-and-16 date to slip by without having noticed the defect yet

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Log in at ePCT, go to ePCT workbench click on “advanced search”

ePCT - WORKBENCH ▾

Current IAs | Last Accessed | Draft IAs | Draft Actions | Unpublished | Published | Archived | Search

Advanced search | Download list | Columns | Show rows [ALL] | Default sort order

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RO to assign	New IA - Dow...	DEMO-SR-4			LEVY, Joseph	eOwner

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In “advanced search”, see downarrow for “search criteria”

Advanced search | Download list | Columns | Show rows [ALL] | Default sort order

Extend filter to archived IAS

Search criteria *

Reset Add criteria Apply Filter

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With outstanding priority documents

- ...and so on from priority
- Status**
- Publication
 - Withdrawn
 - Access suspended
 - Receipt of Search Copy at ISA confirmed to the IB
 - New IA - Draft
 - New IA - Downloaded
 - New IA - RO Phase
- Documents**
- With document(s) not yet processed by the IB
 - With document(s) not taken into account by IB
 - With outstanding priority document(s)
 - With new documents received
 - With document type
- Access rights**
- Where I am the sole eOwner
 - Where my access rights are
 - Where my access rights were modified on

With outstanding priority documents

Advanced search | Download list | Columns | Show rows [ALL] | Default sort order

Extend filter to archived IAs

Search criteria *
With outstanding priority document(s)

Reset Add criteria **Apply Filter**

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Note “Filter applied”
You can click “Save filter”

ePCT - WORKBENCH ▾

Current IAs | Last Accessed | Draft IAs | Draft Actions | Unpublished | Published | Archi...

Filter applied | **Save filter** | Download list | Columns | Show rows [ALL] | Default sort order

IA Number ↕	IA Status ↕	File Ref ↕	IFD ▾	Priority ↕	Applicant Name ↕
PCT/IB2023/042154	Not yet Publi...	D-front-page	22 Jun 2023		BMW GMBH
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PCT/IB2022/040067	Not yet Publi...	D-20220222...	22 Feb 2022		CANDY WRAP UNLIMITED

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Give it a name (“priority documents missing”) and save it

Filter applied | Save filter | Download list | Columns | Show rows [ALL] | Default sort order

SAVE FILTER

Filter Name *

Cancel Save filter

39

Study the report

- In some cases there is an innocent explanation, like you filed the case just a couple of days ago and you have not yet provided the DAS access code to ePCT
- Or the DHL or Fedex package has not yet reached the IB
- But sometimes there is no innocent explanation

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Lack of innocent explanation

- We transposed a couple of digits in the priority application number?
- We entered the date as June 4 instead of April 6?
- We used the wrong two-letter country code for the OFF (“office of first filing”)?
- This is a malpractice problem in the making

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Lack of innocent explanation

- But this problem (outstanding priority document because of a mistake) should not happen
- We should have used “retrieve from DAS”
 - This would have smoked out the transposed digits
 - This would have smoked out the backwards month-and-day
 - This would have smoked out the wrong two-letter country code for the OFF

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When we generate the report “IAs that are missing priority documents” ...

- Nothing on the report ought to have been a surprise to us
- Surely we were already docketing to check for arrival of Form PCT/IB/304!
- Surely we closely scrutinized each newly received Form PCT/IB/304 to see if it contains “the dreaded NR”!
- But what if we slipped up in our docketing or scrutiny? This report might save us from malpractice!

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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*)

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Checking for “the dreaded NR”

- In your firm or corporate patent department, whose job is it exactly to scrutinize every received Form PCT/IB/304 to look for “the dreaded NR”?
- Do you know who it is?
- Have you ever met this person?
- What if they overlook a “dreaded NR”?

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Still a missing priority document should never be a surprise, right?

Automatic email warning you if there is a priority document outstanding

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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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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

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What if somebody turned off that notification?

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

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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

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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

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Maybe generate each report about once a month?

- Maybe this is the backstop that the corporate patent department could use to catch slipups by outside patent counsel?
- Maybe this is the backstop that the supervising attorney could use to catch slipups by those whom the attorney supervises?

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There are myriad more very helpful reports in ePCT

- I simply listed my two favorite reports
- Take a look to see other reports that might also save you from embarrassment or malpractice

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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

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Upcoming webinars

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