

# ePCT webinar series

Making sure your US priority documents are available to DAS, best practices for filing US priority documents, Certificates of Availability, setting up alerts

Webinar 3

Thursday, March 16, 2023, 10AM Mountain Time

Carl Oppedahl

<https://blog.oppedahl.com>

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## Disclaimer

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

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

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## Upcoming webinars

Webinar 4. Thursday, March 23, 2023, **11AM Mountain Time**. Handshakes, eOwners, eEditors, eViewers, access rights groups, employee first day of work, employee last day of work.

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ePCT actions and communications with the IB.

External signatures and PCT declarations.

Sequence listings and ePCT.

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

Doing *92bis* changes.

Docketing of PCT applications and making use of ePCT notifications.

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

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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) ).

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# Best practice

When getting ready to file a US provisional application, minimize professional liability risk by finding out who the applicant or applicants will be in the OSF.

Memorialize the answer.

When filing the US provisional application, use an ADS instead of or in addition to a Provisional Cover Sheet, and establish that the OSF applicant or applicants are the applicant or applicants in the US provisional application.

TYFNIL you will have eliminated the SAOSIT line of attack.

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# Making mistakes

- We all make mistakes.
- It is part of life.
- In the world of patents, most mistakes are fixable if you don't mind paying a bunch of money or you don't mind filing a petition or if you have a really good excuse or you are very sorry.
- When we get somebody new in our office we try to teach them about the particular kinds of mistakes that are not fixable even if you were willing to pay a bunch of money, even if you did not mind filing a petition, even if you had a really good excuse, and even if you were very sorry.
- One of the worst mistakes in this category is messing up a priority claim and failing to catch the mistake until after the passage of the dreaded "4-and-16 date".
- Four months after the Application of Second Filing was filed, and sixteen months after the priority date, whichever is later.
- We tell the new person, please if you are going to screw something up, please pick anything else. Not this. Please pick something else, anything else. Please please please.
- Nonetheless, people screw up things like this all the time. They miss the dreaded 4-and-16 date and only later discover that they made some mistake in a priority claim.
- Wouldn't it be nice if there were something in the PCT system that would protect us from committing malpractice in this area?
- See if you can guess where I am going with this!

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## The 2022 Schwegman lectures in PCT

<b>Session 2</b> – Planning for PCT and Paris, Article 4 of Paris, SAOSIT, Making use of WIPO DAS	<a href="#">video</a>	<a href="#">slides</a>	50:18
<b>Session 5</b> – Preparing a PCT Request – Making use of ePCT and getting benefit of validations, avoiding malpractice on priority claim mistakes	<a href="#">video</a>	<a href="#">slides</a>	53:59
<b>Session 9</b> – Using ePCT for “actions” such as 92bis requests, communicating with ISAs	<a href="#">video</a>	<a href="#">slides</a>	52:32

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# Polling question

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Carl Oppedahl

The 2022 Schwegman  
Advanced PCT  
Training: the  
presentation slides



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# Further reasons to use that ADS

Failing to use an ADS in that US provisional application means that it will not be available to the DAS system.

If it is not available to the DAS system, then you will fail to receive the validation benefit of the priority claim when entering the priority claim in ePCT.

This means that if you had inadvertently gotten a digit wrong in the priority claim in your PCT application, you risk not discovering your mistake until after the dreaded “4 and 16 date”.

If you only discover your mistake after the dreaded “4 and 16 date” then in most Offices around the world it is too late to fix the priority claim and it is irrevocably lost.

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Do you want to be the last practitioner who touched the PCT file prior to irrevocably losing a priority claim?

No I thought not. So let's go through that one again. Let's review the Best Practices:

When you are filing any US patent application that might later serve as a priority application, always use an ADS, so that the application will be available to DAS.

This includes every US provisional patent application that you file.

Make sure that you have established the correct non-inventor applicant or applicants.

Always docket to check later that the application does actually become available to DAS.

Always set up “tracking” in DAS for each such application.

Always obtain a Certificate of Availability from the DAS system for each such application.

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Documents Transactions	
Date ▼	Transaction Description
10/17/2022	Email Notification
10/17/2022	Filing Receipt - Replacement
09/08/2022	Email Notification
09/08/2022	Application Is Now Complete
09/08/2022	Filing Receipt
09/07/2022	Application Dispatched from OIPE
09/06/2022	Applicant Has Filed a Verified Statement of Small Entity Status in Compliance with 37 CFR 1.27
08/29/2022	PTO/SB/69-Authorize EPO Access to Search Results
08/29/2022	Applicants have given acceptable permission for participating foreign
08/29/2022	Entity Status Set To Undiscounted (Initial Default Setting or Status Change)
08/29/2022	Initial Exam Team nn

**Applicant(s)** [Redacted] Corporation, San Jose, CALIFORNIA;  
**Power of Attorney:** The patent practitioners associated with Customer Number 57 [Redacted]  
**Permission to Access Application via Priority Document Exchange:** Yes



**2. Opt-Out of Authorizations to Permit Access by a Foreign Intellectual Property Office(s)**

A. Applicant **DOES NOT** authorize the USPTO to permit a participating foreign IP office access to the instant application-as-filed. If this box is checked, the USPTO will not be providing a participating foreign IP office with any documents and information identified in subsection 1A above.

B. Applicant **DOES NOT** authorize the USPTO to transmit to the EPO any search results from the instant patent application. If this box is checked, the USPTO will not be providing the EPO with search results from the instant application.

**NOTE:** Once the application has published or is otherwise publicly available, the USPTO may provide access to the application in accordance with 37 CFR 1.14.

EFS Web 2.2.13

PTO/AIA/14 (02-18)  
Approved for use through 11/30/2020. OMB 0651-0032  
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

<b>Application Data Sheet 37 CFR 1.76</b>	Attorney Docket Number	[REDACTED]
	Application Number	[REDACTED]
Title of Invention	A laser with [REDACTED] for the lasing wavelength	

WIPO Digital Access Service - Applicant Portal [DEMO]

Below application details can be used for demo and test purposes:

IP Right	Office Code and Priority Number	Filing date	Access Code
Utility Model	ES U201230131	2012-02-08	E82D

Workbench Notifications

Items: 20 Filter Priority Documents: All in Workbench

1 record(s) found matching the filter criteria.

	Office Code and Priority Number	Filing date	Access Code	Date of Availability	Last Accessed	Tracked By	Comments
<input type="checkbox"/>	ES U 201230131	2012-02-08	E82D	2013-04-18	2022-08-31 12:39:26.0	[User Icon]	[Edit Icon]

Add Tracking Remove Tracking

To:

carl@oppedahl.com

**CERTIFICATE OF AVAILABILITY OF A CERTIFIED UTILITY MODEL  
DOCUMENT IN A DIGITAL LIBRARY**

The International Bureau certifies that a copy of the utility model application indicated below has been available to the WIPO Digital Access Service since the date of availability indicated, and that the utility model application has been available to the indicated Office(s) as of the date specified following the relevant Office code:

Document details: Country/Office: ES

Filing date: 08 Feb 2012 (08.02.2012)

Application number: U 201230131

Date of availability of document: 18 Apr 2013 (18.04.2013)

The following Offices can retrieve this document by using the access code:  
AR, AT, AU, BE, CL, CN, CO, DK, EE, ES, FI, GE, IB, JP, KR, MX,  
NL, PL

Date of issue of this certificate: 16 Mar 2023 (16.03.2023)

# Polling questions

Do you want to be the last practitioner who touched the PCT file prior to irrevocably losing a priority claim?

Continuing our review of the Best Practices:

When you are getting ready to file your PCT application, find out what application or applications you will be claiming priority from.

Look to see who is listed as the applicant or applicants in that priority application or applications. Compare this with who you are planning to list as the applicant or applicants in your to-be-filed PCT application. If cleanup paperwork is needed to make them match, get it done ***before filing the PCT application.***

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Do you want to be the last practitioner who touched the PCT file prior to irrevocably losing a priority claim?

Continuing our review of the Best Practices:

When you are getting ready to file your PCT application, you will be preparing a PCT Request.

Do not do this by filling in a fillable PDF form.

Do not do this by using PCT-SAFE.

The only correct way to do this is by using ePCT.

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Do you want to be the last practitioner who touched the PCT file prior to irrevocably losing a priority claim?

Continuing our review of the Best Practices...

For each of the applications for which you plan to make a priority claim, check to make sure that you have a Certificate of Availability in the DAS system.

As you enter each priority claim into ePCT, you will be entering the application number, the filing date, and the identity of the OFF into ePCT.

ePCT will ask how you plan to provide a certified copy of the priority application to the IB.

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Do you want to be the last practitioner who touched the PCT file prior to irrevocably losing a priority claim?

Continuing our review of the Best Practices:

ePCT will ask how you plan to provide a certified copy of the priority application to the IB.

Here is the important part. You should tell ePCT that you want to retrieve an electronic certified copy from a digital library.

This is geek talk and it means “retrieve it from the DAS system”.

This means that ePCT will cross-check the application number that you entered, and the filing date that you entered, and the identity of the OFF that you entered, against the DAS system, ***in real time and before your very eyes.***

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## PRIORITY CLAIMS

Identification of parent application or patent grant can be added in the Designations section, e.g., 'continuation' or 'continuation-in-part' for US. To add click [here](#)

Type National	Filing Date 29 August 2022	Application number 63/373.8
Country/Office US	Priority document IB to obtain from a digital File Name	
DAS access code 27	library	Restoration



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Type *	National	Option(s) for providing the priority document to the IB *
Country/Office *	US - United States of America	<input type="radio"/> Receiving Office to prepare and transmit to the International Bureau
Filing Date *	29/08/2022	<input type="radio"/> To be provided by the applicant
Application number *	63/373.8	<input type="radio"/> An electronic copy of the priority document is attached (certified by the issuing Office)
Accepted format(s) 08/999,999		<input checked="" type="radio"/> International Bureau to obtain from a digital library (DAS)
		DAS access code *
		27
		access code incorrect.

Cancel

Update

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## ▼ ACTIONS

Select Action

Action \*

Obtain priority document from DAS

Priority document(s) already received by the IB - no priority documents outstanding.

Cancel

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### ePCT Action: Request to obtain priority document from DAS

IA Number:

PCT/IB2022/060

International Filing Date:

October 2022

Date of Request:

13 January 2023

The following priority document has been requested:

Country/Office:

US

Filing Date:

20 September 2021

Application number:

63/261,3

DAS access code:

98

Date: 13 January 2023 15:42:02 CET

User Name: carl OPPEDAHN

Authentication: Sign-in with strong authentication

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Do you want to be the last practitioner who touched the PCT file prior to irrevocably losing a priority claim?

Continuing our review of the Best Practices...

This means that ePCT will cross-check the application number that you entered, and the filing date that you entered, and the identity of the OFF that you entered, against the DAS system, ***in real time and before your very eyes.***

- Let's suppose you got a digit wrong in the application number.
- Let's suppose you entered April 6 when you meant June 4 (you know, a metric month instead of an American month).

**ePCT will catch your mistake! You have just been saved from a malpractice lawsuit or worse.**

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## **You have just been saved from a malpractice lawsuit or worse**

By the way what does that even mean “or worse”?

For this cross-checking to save you from the risk of irrevocably losing a priority claim, what Best Practices did you need to follow?

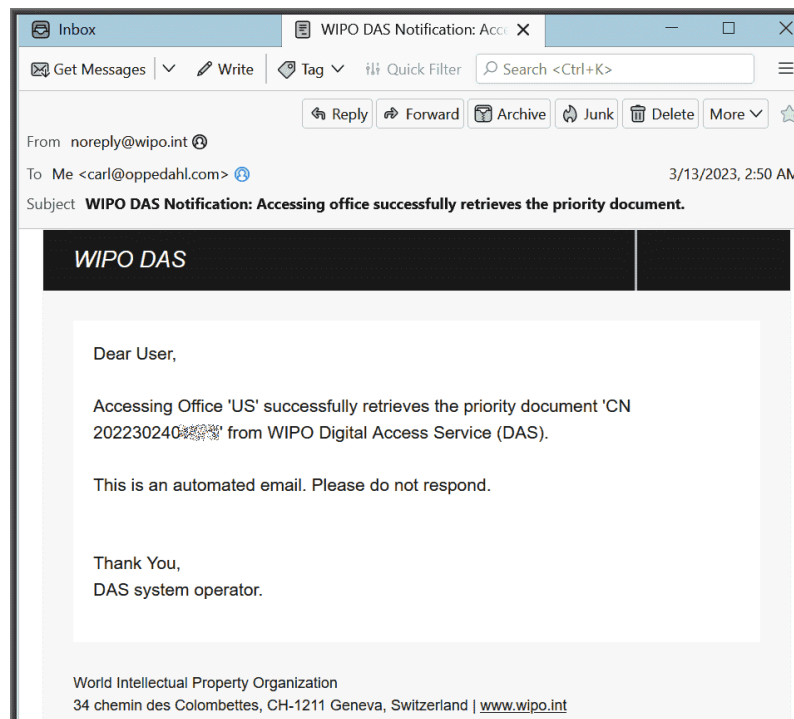
- Making sure your priority application found its way into DAS.
- Using ePCT to create your Request.

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# Making sure your priority application found its way into DAS

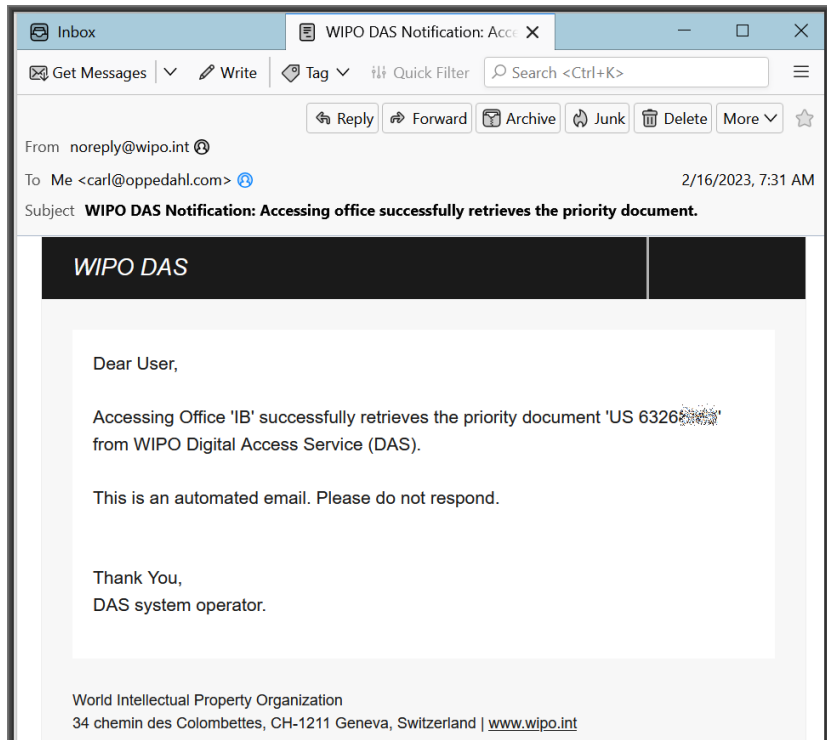
- Which in turn required using an ADS, not just a Provisional Cover Sheet, if the application you were filing was a US provisional
- Which calls for you to check to make sure the patent office really did make the application available to DAS
- That is, making sure that you can get a Certificate of Availability
- While you are there, you might as well set up “tracking” in DAS

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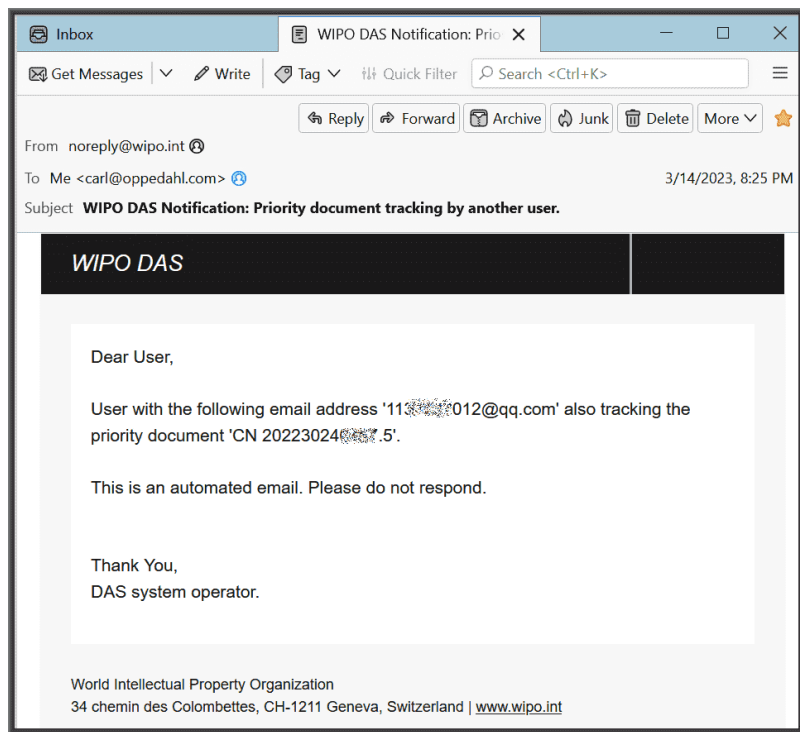


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# Using ePCT to create your Request

- Which means having the self-control not to use a fillable PDF to create your PCT Request
- And which means having the self-control not to use PCT-SAFE to create your PCT Request
- And which means you need to check the box that says you want to retrieve your priority document from a digital library
- Only if you check that box will ePCT cross-check your data entry with the DAS system
- Only if you check that box will ePCT catch it if you entered a digit wrong
- Only if you check that box will ePCT have the opportunity to save you from that category of malpractice lawsuit
- Did I mention that it is a good idea to use ePCT?

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## SAOSIT

- Is SAOSIT only a thing to get wrong if you are filing a PCT application?
- No.
- You can also get this just as wrong (SAOSIT) if the application of second filing is an ordinary domestic patent application filed in a second patent office.
- Remembering the CRISPR cases, if The Broad and MIT and Harvard had filed an ordinary EP patent application on December 12, 2013 instead of a PCT application designating EP, they would have faced exactly the same problems and risks as we have discussed here.

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# Polling question

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# Important next steps

Get a copy of Bodenhausen if you do not have a copy already.

Read it if you have not read it already.

Go back through all of your previously filed applications that might serve as priority applications, and make sure they are all available to DAS.

If necessary, do whatever is needed in your patent office to get them made available to DAS. (In the USPTO, this is Form PTO/SB/39.)

Set up “tracking” in DAS for all of your previously filed applications that might serve as priority applications.

Obtain a Certificate of Availability for each of your previously filed applications that might serve as a priority application.

If necessary, take the “DAS Quiz” at *The Ant-Like Persistence* blog.

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## Important next steps

Find out if anybody in your office is using anything other than ePCT to generate PCT Requests.

For example are they using fillable PDF forms? PCT-SAFE?

If so, make them stop. We are talking about malpractice avoidance.

When a priority claim is being entered into ePCT, always check the box that says “retrieve from a digital library” to force ePCT to cross-check the priority claim against DAS. We are talking about malpractice avoidance.

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## Important next steps

Find out if anybody in your office is filing US provisionals and not using an ADS on filing day.

If so, make them stop. We are talking about malpractice avoidance.

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# Important next steps

Find out if anybody in your office is filing a US patent application that might later serve as a priority application, and is not asking around to find out who the applicant would be or who the applicants would be in a later non-US application of second filing. (Maybe it is a PCT or maybe not.)

If so, make them start asking around. We are talking about malpractice avoidance.

The US patent application needs to be filed in a way that establishes a non-inventor applicant or non-inventor applicants to match what will be done later in the non-US application of second filing. A mere provisional cover sheet is not good enough for this.

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## Important next steps: Use ePCT

We have mentioned a couple of reasons to be using ePCT.

It will not surprise you to hear that there are dozens of other good reasons to be using ePCT.

We will be presenting future webinars in which this is discussed in great detail.

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Important next steps: Subscribe to my blog and read all of the back articles about PCT

Anybody who is a regular reader of *The Ant-Like Persistence* blog is likely already aware that every point made in today's webinar was previously covered, in many cases twice over, in past articles in my blog.

A chief practice tip is thus to subscribe to my blog.

A related practice tip is thus to read all of the back articles about PCT.

This can also be helpful as a cure for insomnia.

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## Ways to be smart about DAS

- Somebody hands you a DAS access code. What do you do with it? Send it to the USPTO? Send it to foreign patent counsel? Use it in a PCT Request?
- The problem is how do you know if that purported DAS access code is accurate?
- What you do next is go to DAS and add the application to your DAS workbench. You set up "tracking" and you obtain a Certificate of Availability.
- After that is when you rely upon that DAS access code.

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## Ways to be smart about DAS

- USPTO reports that its attempt to retrieve an electronic certified copy from DAS was a failure.
- How do you know whose fault this failure is?
- Did foreign counsel get it wrong when they told you the purported DAS code?
- The problem is how do you know if that purported DAS access code was accurate?
- What you should have done, days or weeks earlier, was to go to DAS and add the application to your DAS workbench. And then you should have set up “tracking” and you obtain a Certificate of Availability.

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## Ways to be smart about DAS

- When you look in your application file for some US provisional application, what should appear there is a Certificate of Availability from DAS.
- Somebody needs to notice if the DAS cert is missing from the file.
- Somebody needs to speak up when they notice the DAS cert is missing from the file.

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## Docketing and DAS

- A new US provisional application gets filed.
- A docket needs to be set to check for a Certificate of Availability from DAS.
- If and when the DAS cert is obtained, then somebody needs to check it for accuracy.
- After that, the docket can be cleared.

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## Docketing and DAS

- A new US application gets filed that claims priority from some non-US application.
- A docket needs to be set to check for a Certificate of Availability from DAS for the priority application.
- If and when the DAS cert is obtained, then somebody needs to check it for accuracy.
- After that, the docket can be cleared.
- Now we get to set a docket to check for receipt of the tripwire email from DAS indicating that the USPTO did retrieve the electronic certified copy.
- And a docket to check for the electronic certified copy showing up in the IFW for that US application.
- And a docket to check for box 4 or box 12 being checked to indicate the Examiner has acknowledged that the electronic certified copy is in the file.

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# Being smart about DAS

- An Office Action arrives.
- Somebody needs to check box 12 to see that the Examiner has acknowledged that the electronic certified copy is in the file.
- A Notice of Allowance arrives.
- Somebody needs to check box 4 to see that the Examiner has acknowledged that the electronic certified copy is in the file.

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## Priority under 35 U.S.C. § 119

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

### Certified copies:

a)  All

b)  Some\*\*

c)  None of the:

1.  Certified copies of the priority documents have been received.

2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*\* See the attached detailed Office action for a list of the certified copies not received.

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4.  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

**Certified copies:**

a)  All      b)  Some\*

c)  None of the:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

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### THIRTY-ONE PATENT PRACTITIONERS

By Priority Mail 9405503699300264124305

Drew Hirshfeld  
Commissioner for Patents  
USPTO  
P O Box 1450  
Alexandria, VA 22313-1450

February 22, 2020

Dear Commissioner Hirshfeld:

In this letter, the undersigned patent practitioners ask that the USPTO discontinue its present practice of intentionally and actively aging PDX and DAS retrieval requests. We ask instead that going forward, the USPTO retrieve priority documents from PDX and DAS *at the time that the applicant requests such retrieval*. We also ask that USPTO *discontinue the PDX*

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## Possible live demo

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Handshakes, eOwners, eEditors, eViewers, access rights groups, employee first day of work, employee last day of work.

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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) ).

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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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