

ePCT webinar series

Filing a new US PCT application in RO/US using ePCT

Webinar 8

Thursday, April 20, 2023, 10AM Mountain Time

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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 9. Thursday, April 27, 2023, 10AM Mountain Time. Filing a new US PCT application in RO/IB using ePCT.

Webinar 10. **Tuesday**, May 2, 2023, 10AM Mountain Time. ePCT actions and communications with the IB.

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3

Upcoming ePCT webinars

Webinar 13. Thursday, June 1, 2023, 10AM Mountain Time. Docketing of PCT applications and making use of ePCT notifications.

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

Doing *92bis* changes.

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

4

Upcoming ePCT webinars

How to register? Go to

https://blog.oppedahl.com/?page_id=8978.

How to learn of future webinars? Subscribe to my blog (<https://blog.oppedahl.com/>), or subscribe to the PCT listserv (https://oppedahl-lists.com/mailman/listinfo/pct_oppedahl-lists.com).

5

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, 10AM Mountain Time. Getting to know your ePCT workbench, portfolios, office profiles, cloning, ePCT actions. [Download the presentation materials](#). [View the recording](#) (1:15).

6

Getting ready to file the PCT application

- A first question is “which Receiving Office should we use?”
- It is easy to get in a rut and always file in the same RO (for example RO/US)
- Serving the client well includes thinking about whether to use RO/US next time

7

Picking Receiving Office

- If you pick RO/US instead of RO/IB you miss out on many potential benefits:
 - Transmittal fee is higher in RO/US
 - Record Copy might take 4-5 weeks to get transmitted from RO/US to the IB
 - Access in ePCT workbench might get delayed by 4-5 weeks due to selection of RO/US
 - Extra e-filing steps are required such as wrangling the ZIP file
 - Risk of accidentally uploading the wrong ZIP file
 - Fee calculations in USPTO systems don't match the ePCT fee calculations
 - Applications can get caught up in lengthy security reviews
 - RO/US offers fewer choices for RFROROP (request for restoration of right of priority)
 - RO/US fee for RFROROP is much higher

8

Reasons to pick RO/US

- We've always done it that way, or
- we are nervous about learning how to file in RO/IB, or
- it's the last day and midnight already came and went in Geneva, or
- the invention was made in the US, and:
 - We are unsure whether our FFL covers the subject matter of the to-be-filed PCT application, or
 - We don't have an FFL, or
- we've always done it that way.

9

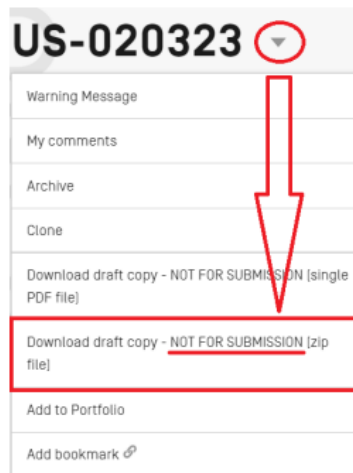
Be sure to upload a ZIP file

- Be sure to follow the EFS-Web or Patentcenter filing path that includes uploading a ZIP file from ePCT
- You are probably already doing this (uploading a ZIP file) because it is malpractice not to do so
- ePCT validates your inputs and saves you from many mistakes and much potential embarrassment
- The ZIP file will automatically set up the application so that you will eventually have access in ePCT
- If you identify an Access Rights Group, then access will also automatically be given to the members of the ARG
- Note that in recent times, RO/US has often taken 4-5 weeks to transmit the Record Copy to the IB
- The PCT application will be visible in your ePCT workbench only after the RO/US transmits the Record Copy to the IB
- This is one of the factors that prompts me to try to use RO/IB whenever I can

10

PCT applications that get filed in the future at RO/US

- Don't make the mistake of doing your EFS-Web or Patentcenter filing using the "draft copy" of the ZIP file



11

Today's topics

- We will talk about e-filing of the PCT application
- We will talk a little about the docketing that you do after you file a PCT application

12

One of my favorite things about ePCT

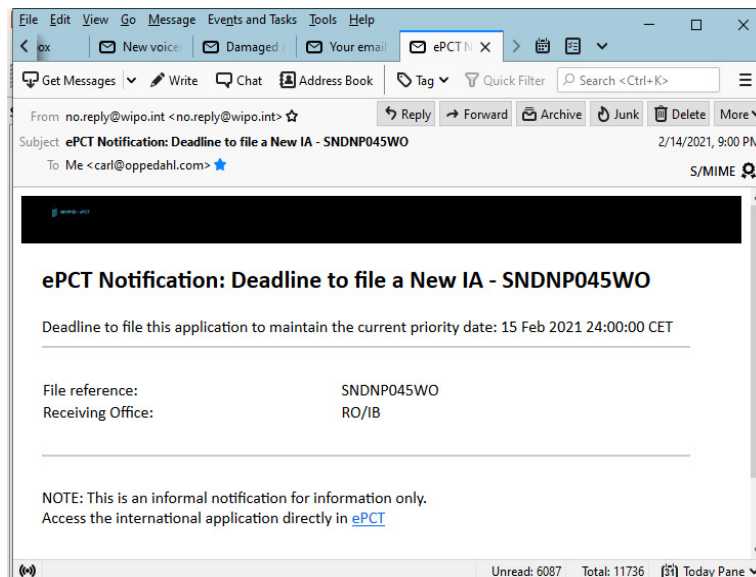
You start preparing a PCT Request and you enter a
priority claim for an application that was filed 364
days ago

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?

13

One of my favorite things about ePCT



14

The e-filing process

- In the old days we would prepare a paper Express Mail package and we would take it to the Post Office
- Two people licked their fingers and flipped through the pages one at a time
- Every page got looked at
- Mistakes got caught

15

The e-filing process

- These days the e-filing might be carried out by one person, clicking away in isolation
- One hour before midnight in Alexandria, Virginia
- The last of the client instructions came in only earlier the same day
- Extreme time pressure
- Maybe there is a second pair of eyes, maybe not

16

How I do it

- If I am filing the PCT application in EFS-Web or Patentcenter, I ***do not pay the fees!***
- I wait until I have had an opportunity to look closely to see if I screwed up and uploaded the wrong version of the application from yesterday, or the wrong drawings from another case
- Then if I see that I did not screw it up, I actually pay the fees

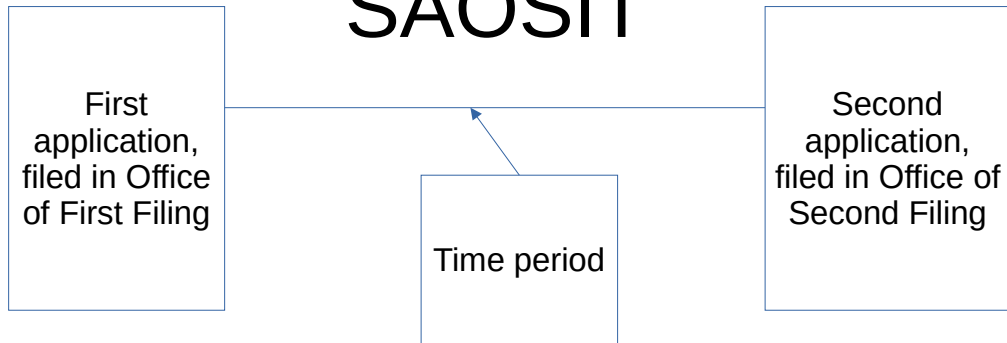
17

Drawings

- Do not file informal drawings
- Do not use color
- Do not use gray scale

18

SAOSIT



Any **person who has duly filed an application** for a patent, or for the registration of a utility model, or of an industrial design, or of a trademark, in one of the countries of the Union, **or his successor in title**, shall enjoy, for the purpose of filing in the other countries, a right of priority during the periods hereinafter fixed.

19

Is SAOSIT an acronym?

- No. It is a mere initialism.

20

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.***

21

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.

22

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.

23

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**.

24

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.

25

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.

26

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

27

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?

28

If you are filing in RO/US

- A reminder that you need to be uploading a ZIP file Request
- Not a PDF Request
- It is malpractice not to upload a ZIP file

29

If you are filing in RO/US

- A reminder that your ZIP file needs to come from ePCT
- Not from PCT-SAFE
- It is malpractice not to use ePCT to generate your ZIP file

30

If you are filing in RO/US

- A reminder that when you indicate how your priority documents should get from the RO to the IB, do not pick “RO to transmit to IB”
- Pick “IB to retrieve from DAS”
- Only if you make this selection will ePCT cross-check your priority claims with DAS

31

The screenshot displays the 'VALIDATION' tab of the ePCT interface. The navigation bar includes: PRIORITY, DESIGNATIONS, NAMES, SEARCH, DECLARATIONS, BIOLOGY, DOCUMENTS, FEES, SIGNATURE, VALIDATION, and ACCESS RIGHTS. The 'VALIDATION' tab is active and highlighted with a red box. Below the navigation bar, there is a table of validation errors:

International search	Prevents filing: [27.25] The indication of the ISA is missing. Go to issue
Signature	Requires correction: [37.03] The Request is not signed. Go to issue
Documents	Information only: [local] [D-file.pdf] PDF document appears to be greyscale. Please view document to check contents. Go to issue

At the bottom of the interface, there is a dropdown menu showing 'MYREF-12345' and three buttons: 'Save draft', 'Preview RO/101', and 'Review & File'.

32

PRIORITY CLAIMS

2 issues

[6.18] [EP - 31 Mar 2015 - 16345678.9] Priority claim is not valid: the filing date is earlier than 14 months from today's date.

[6.41] [EP - 31 Mar 2015 - 16345678.9] The priority claim application number does not appear to match the year of the corresponding priority filing date. Please check that the date and number have been indicated correctly.

▶ Regional, EP Filing Date 31 March 2015 16345678.9



33

GENEVA APR 20, 2023, 4:22 PM CEST

NEW IA

Pick an
Access Rights Group

Close

Applicant/agent's file reference *
today

Select Receiving Office *
US - United States Patent and Trademark Office [USPTO]

Access rights *

[Look up national security requirements](#)

carl OPPEDAHL
DEFAULT
one other person.

Select Portfolio

34

Type *	National	Option(s) for providing the priority document to the IB * <input type="radio"/> Receiving Office to prepare and transmit to the International Bureau <input type="radio"/> To be provided by the applicant <input type="radio"/> An electronic copy of the priority document (certified by the issuing Office) will be submitted with this data package at the time of filing <input checked="" type="radio"/> International Bureau to obtain from a digital library (DAS)
Country/Office *	US - United States of America	
Filing Date *		
Application number		DAS access code *
Accepted format(s) 08/999.999		

35

Application Type [International Application \(PCT\) for filing in the US receiving office](#)

Are you attaching a PCT-EASY zip file? Yes No

Files to be Submitted

No file chosen

When attaching a PCT-EASY Zip file, you must also attach your application parts (Specification, Claims, Abstract

36

Fees might not match

- Right now some of the fees won't match as between ePCT and EFS-Web or Patentcenter
- Patentcenter won't let you pick the "ZIP file" fee
- Workaround – pay separately in EFS-Web

37

Communicating with the client about the filed PCT application

- Client must be clearly told about the "30-month date"
- Client should also be told that the PCT application will be published at P+18
- 10% of the reason for doing this is so that the client will hear these things
- 90% of the reason for doing this is to protect your situation

38

Communicating with the client about the filed PCT application

- When the PCT application becomes visible to you in ePCT ...
- You may wish to download the publication preview page and send it to the client for review
- This gives the client a chance to let you know if there has been any mistake or misunderstanding about inventors, priority, applicant name etc.

39

Communicating with the client about the filed PCT application

- You may want to tell the client once about the “two-country” docket
- For TZ and LU if you want to postpone a direct national phase filing until 30 months, you will have to file a Demand by P+19
- Even if you do not file a Demand by P+19, you can still reach any of these countries by means of a regional-phase entry

40

Now you have filed your PCT application

- Whew!
- What next?
- Docketing! That is what is next!

41

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.

42

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.

43

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

44

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

45

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

46

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*)

47

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 P+19 or tech-prep day for Article 19 amendment (note that this may change later)
- Docket tech-prep day for withdrawal to prevent publication

48

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*)

49

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

50

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51

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52

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53

Please complete the evaluation questionnaire

- Yes please complete it
- Pay it forward

54

Thank you