

ePCT webinar series

Filing a new PCT application in RO/IB using ePCT

Webinar 9

Thursday, April 20, 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 10. **Tuesday**, May 2, 2023, 10AM Mountain Time. ePCT actions and communications with the IB.

Webinar 11. Thursday, May 11, 2023, 10AM Mountain Time. External signatures and PCT declarations.

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.

3

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*.

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).
- Webinar 7. Thursday, April 13, 2023, 10AM Mountain Time. 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, 10AM Mountain Time. Filing a new PCT application in RO/US using ePCT. [Download the presentation materials](#). [View the recording](#) (1:13).

6

Benefits of RO/IB

- Transmittal fee is cheaper in RO/IB than many other ROs
- Record Copy usually reaches the IB very promptly
- Access in ePCT workbench is often very prompt
- No need to wrangle a ZIP file
- No risk of accidentally uploading the wrong ZIP file
- Fee calculations are up to date
- No risk of getting caught up in lengthy security reviews
- RO/IB offers both kinds of RFROROP (request for restoration of right of priority)
- RO/IB fee for RFROROP is zero

7

Keep track of time zones

- US filers need to keep track of time zones when they are using RO/IB
- Often it is an eight-hour difference from RO/US
- In spring and fall it is sometimes not eight hours
 - Subscribe to my blog

8

FEBRUARY 20, 2023 BY OPPEDAHL

An annual ritual for me – scheduled postings about DST

Hello dear readers. There is an annual ritual which I keep hoping would eventually cease to be necessary, but yet again today the ritual presents itself. What I am talking about is the annual scheduling of four blog postings about Daylight Saving Time.

Those who have been subscribed to my blog since it began in 2014 will by now have gotten very familiar with this annual ritual. Each year there are four dates to keep track of:

- the date in March when DST begins in the US but not in Europe
- the date two weeks later in March when DST begins in Europe
- the date in October when DST ends in Europe but not in the US
- the date in November when DST ends in the US

In 2023 those four dates are March 12, March 26, October 29, and November 5.

Polling questions

US filers must consider FFL issues

- Maybe the invention was not made in the US
 - In that case there is no issue with US FFLs
- Maybe the invention was made in the US, and we have an FFL that covers the subject matter of the to-be-filed PCT application
 - In that case there is no issue with US FFLs
- Maybe the invention was made in the US, and we are not sure tht have an FFL that covers the subject matter of the to-be-filed PCT application
 - Then file another provisional a week ago and it provides the needed FFL
 - Ask yourself why you did not file that additional provisional promptly after the additional inventing happened! 11

Polling questions

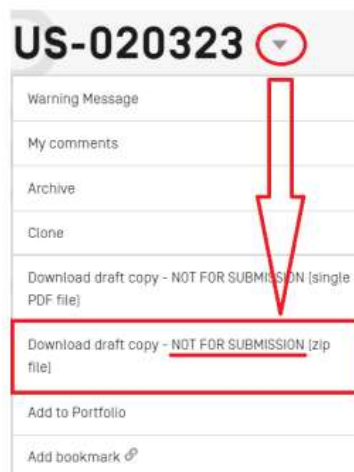
Use an Access Rights Group

- ePCT validates your inputs and saves you from many mistakes and much potential embarrassment
- If you identify an Access Rights Group, then access will also automatically be given to the members of the ARG
- The newly filed PCT application will often be visible in your ePCT workbench very promptly
- The members of your ARG will often gain access very promptly
- This is one of the factors that prompts me to try to use RO/IB whenever I can

13

No need to wrangle ZIP files if you use RO/IB

- You get to avoid making the mistake of doing your EFS-Web or Patentcenter filing using the “draft copy” of the ZIP file



14

One of my favorite things about ePCT

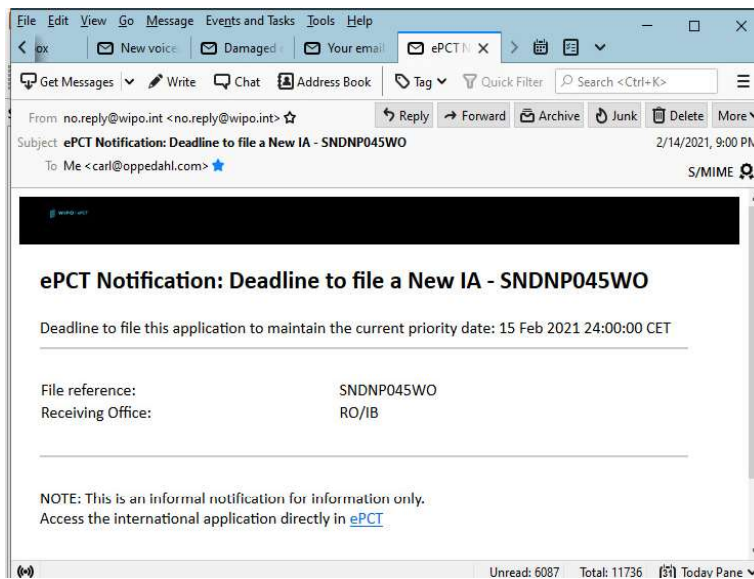
You start preparing a PCT Request and you enter a
priority claim for an application that was filed 364
days ago

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?

15

One of my favorite things about ePCT



16

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

17

The e-filing process

- These days the e-filing might be carried out by one person, clicking away in isolation
- 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

18

How I do it

- When I file the PCT application, 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

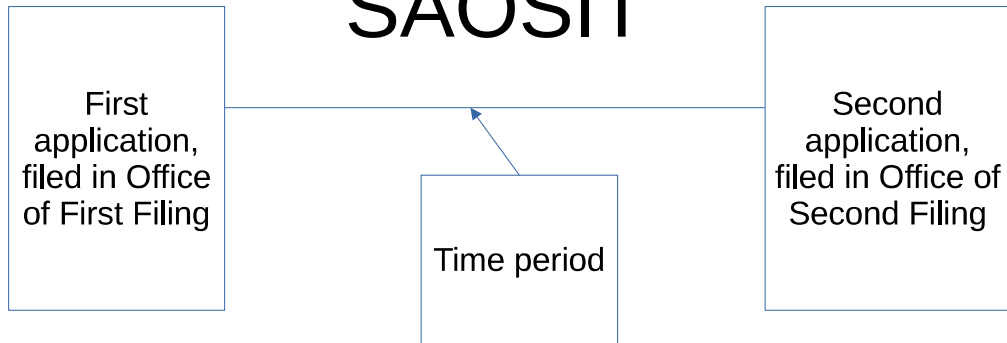
19

Drawings

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

20

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.

21

Is SAOSIT an acronym?

- No. It is a mere initialism.

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:

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.***

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...

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.

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:

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.**

25

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.

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

Polling question

28

PRIORITY DESIGNATIONS NAMES **SEARCH** DECLARATIONS BIOLOGY DOCUMENTS FEES SIGNATURE **VALIDATION** ACCESS RIGHTS

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

MYREF-12345 ▼ Save draft Preview R0/101 Review & File

PRIORITY CLAIMS 2 issues

[0.10] [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	
----------------	---------------------------	------------	--

GENEVA APR 22, 2023, 11:50 PM CEST

← Time of day in Geneva!

NEW IA

Choose an ARG

Close

Applicant/agent's file reference *

Webinar-9

Select Receiving Office *

IB - International Bureau of WIPO

Access rights *

[Look up national security requirements](#)

Select the access rights to be assigned to the New IA

IMPORTANT - It is recommended to assign eOwner access rights to at least one other person.

Select Portfolio

Cancel

Import New IA

Create

31

Type *

National

Country/Office *

US - United States of America

Filing Date *



Option(s) for providing the priority document to the IB *

Receiving Office to prepare and transmit to the International Bureau

To be provided by the applicant

An electronic copy of the priority document (certified by the issuing Office) will be submitted with this data package at the time of filing

International Bureau to obtain from a digital library (DAS)

Application number

DAS access code *

Accepted format[s] 08/999.999

32

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

33

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.

34

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

35

Now you have filed your PCT application

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

36

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

37

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

38

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

39

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*)

40

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

41

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*)

42

**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

43

Possible live demo

44

Upcoming webinars

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

Webinar 11. Thursday, May 11, 2023, 10AM Mountain Time. External signatures and PCT declarations.

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.

45

Upcoming 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*.

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.

46

Upcoming 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).

47

Please complete the evaluation questionnaire

- Yes please complete it
- Pay it forward

48

Thank you