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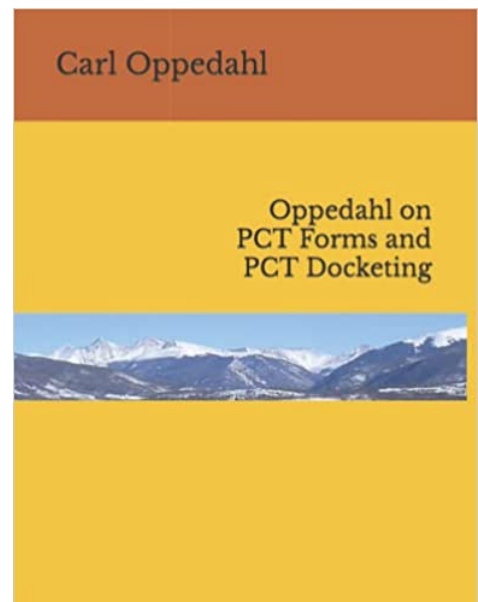
(<https://blog.oppedahl.com>)



A new PCT book: PCT Forms and PCT Docketing (<https://blog.oppedahl.com/?p=7181>)

14th November, 2021 (<https://blog.oppedahl.com/?p=7181>) (<https://blog.oppedahl.com/?author=1>)

(<https://blog.oppedahl.com/wp->



content/uploads/2021/11/31s7k35V84L._SX384_BO1204203200_.jpg)Here is a book that I think you should add to your bookshelf: *Oppedahl on PCT Forms and PCT Docketing*.

You can see it on Amazon here (<https://www.amazon.com/dp/B09LGLN5XK/>).

For each of fifty forms, we discuss what docket should be set or cleared when the form arrives. We discuss what to look for in the form that might indicate that some further action is required or some particular docket needs to be set. We identify combinations of events which require “calling a meeting” because some docket failure has occurred or there is reason to worry that other files in the office might require review to see if a similar failure has occurred. The forms discussed include:

- two Power of Attorney forms

Colorado Supreme Court
Office of Continuing Legal & Judicial Education
1300 Broadway, Suite 510
Denver, CO 80203
(303) 928-7771
www.coloradosupremecourt.us

NOTICE OF ACCREDITATION

The Office of CLJE has accredited the following continuing legal education seminar under Rule 250:

NAME OF SEMINAR	LOCATION	DATE	SPONSOR	GENERAL CREDITS	ETHICS CREDITS
PCT RECEIVING OFFICE	VARIOUS CO	11/17/2021	OPLF	2	

Colorado attorneys and judges who attend the entire seminar may claim the credits indicated. If any Ethics Credits are indicated, they may be claimed by attending those parts of the seminar indicated below the seminar's name. Ethics credits are NOT IN ADDITION TO General Credits. General and Ethics Credits are NOT added to or subtracted from each other. This accreditation is awarded provided the sponsor permits the Office of CLJE's staff to attend the seminar; gives every Colorado attorney and judge attending a copy of this combined notice/affidavit form; accepts at the seminar, this form after it is executed by attending Colorado attorneys and judges; and delivers the executed forms to the Office of CLJE within 10 days after the seminar.

Date Reviewed: 11/16/2021

AFFIDAVIT

INSTRUCTIONS: Colorado attorneys and judges may report CLE Credits earned at this seminar by logging into the Online CLE Transcript. You can access the online entry of Affidavits by visiting <http://www.cletrack.com> Click on CLE Transcripts, login and select Enter Online Affidavits. You can enter your affidavit using the Course ID located at the bottom of this page.

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COURSE ID: 807529

PCT Webinars [continued]			
Date and time	Language of webinar	Nature of webinar; WIPO speakers	Registration
19 November 2021 12:00 – 13:40 (US Mountain Time)	English	“National phase or bypass continuation” Speaker on behalf of WIPO: Mr. Oppedahl (Oppedahl Patent Law Firm LLC)	https://blog.oppedahl.com/?page_id=7106
24 November 2021 14:30 – 15:30 (CET)	German	Exploring the PCT webinar series: Mastering priority claims in PCT applications WIPO speakers: Mr. Henninger and Ms. Schumm	Further information: https://register.gotowebinar.com/register/3382579771973631503 Registration: https://register.gotowebinar.com/register/3382579771973631503
8 December 2021 12:00 – 13:40 (US Mountain Time)	English	“Picking a PCT International Searching Authority” Speaker on behalf of WIPO: Mr. Oppedahl (Oppedahl Patent Law Firm LLC)	https://blog.oppedahl.com/?page_id=7150

PATENTSCOPE Webinars (www.wipo.int/patentscope/en/webinar/)			
Date and time	Language of webinar	Nature of webinar; WIPO speakers	Registration
16 November 2021 17:30 - 18:30 (CET)	English	Building complex queries in PATENTSCOPE WIPO speaker: Ms Amman	https://wipo-int.zoom.us/join/register/WN_wsquvLbFTEONGERXFUv7Pg
18 November 2021 08:30 - 09:30 (CET)	English	Building complex queries in PATENTSCOPE WIPO speaker: Ms Amman	https://wipo-int.zoom.us/join/register/WN_SQ0IAcomTgCjwV2z2n_FQ
14 December 2021 17:30 - 18:30 (CET)	English	PATENTSCOPE: retrospective of 2021 and plans for 2022 WIPO speaker: Ms Amman	https://wipo-int.zoom.us/join/register/WN_UXelZHK7SLmcxBscGtHejw
16 December 2021 08:30 - 09:30 (CET)	English	PATENTSCOPE: retrospective of 2021 and plans for 2022 WIPO speaker: Ms Amman	https://wipo-int.zoom.us/join/register/WN_1IDQAFuoRVGH1OxJHh4YTw



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(<https://blog.oppedahl.com>)



Picking a PCT Receiving Office

**Click Here to
Register**

(<https://attendee.gotowebinar.com/register/8896340314322641678>)

Any would-be PCT applicant that has the ability to use the Patent Cooperation Treaty at all, always has at least two Receiving Offices to choose from. Saying the same thing differently, there is never any situation where a PCT filer only has one Receiving Office available.

There are always some advantages and disadvantages to the various Receiving Offices. It would be a big mistake if any patent practitioner were to assume that it is always the best to use some particular Receiving Office. Even if there are many reasons why some particular RO is nearly always the best choice for a particular filer, it will always turn out that there are some specific situations where a different RO is a better choice. The practitioner who fails to inform himself or herself about the factors that might prompt the selection of an RO that is different from one's "usual" RO does so at his or her peril.

A PCT filer from the US always has at least two Receiving Offices to choose from, including:

- The Receiving Office of the International Bureau (RO/IB)
- The Receiving Office of the USPTO (RO/US)

What are the advantages and disadvantages of these two ROs? What are aspects of a particular patent application that might make a big difference to an applicant in the applicant's process of selecting an RO?

As a bonus topic we will talk about ways that power users can use ePCT when filing in RO/US and in RO/IB, and we will talk about ways to transfer funds to the IB. We will also talk about recording of assignments at the USPTO with respect to PCT applications that have been e-filed in RO/US and RO/IB.

When and where? Wednesday, November 17, 2021, Noon to 1:40 PM Mountain Time

Format: Live webinar

Cost? Thanks to generous support from WIPO, this webinar will be free of charge.

The faculty. Your professor is Carl Oppedahl, the author of the *Ant-Like Persistence* blog. Carl is a partner in Oppedahl Patent Law Firm LLC. He has served as an adjunct professor at University of Denver law school, teaching Patent Prosecution. Carl has been a Fellow of the American Intellectual Property Law Association. He has spent more than twenty-five years serving intellectual property clients.

Here's what some attendees had to say about a recent webinar taught by Professor Oppedahl:

"Great. Concise, to the point and practical." — M.Z., Suffern, NY

"Attorney Oppedahl does an excellent job of explaining procedures before various patent authorities and does so in an effective webinar format." — R.K., Manchester, NH

"This webinar was extremely helpful, very current, and professionally presented. Carl is an excellent presenter, answers as many questions as possible, and speaks with perfect pacing." — S.B., Boston, MA

"Oppedahl Webinars are the best for patent practitioners!" — P.M., Portland, ME

"Very interesting, well presented and topical." — S.M., Ottawa, Canada

In our evaluation questionnaires we usually ask "is there any topic that you would like to see Carl Oppedahl to cover in some future webinar?" Almost always at least one attendee will respond with something along the lines of "any topic that Mr. Oppedahl feels like talking about."

CLE accreditation? CLE accreditation is being requested in Colorado for two CLE units.

What about CLE credit in states other than Colorado? In some states the paperwork for CLE accreditation is extremely burdensome. In some states the required fees are unreasonably high. Many states nowadays try to shift the burden of recordkeeping regarding attendance away from the CLE agency and onto the CLE provider, and require that the CLE provider forward attendance information electronically and in bulk to the CLE agency. For such a state, it is pointless to even think about trying to be a CLE provider unless there is some reason to think that one will regularly get dozens or hundreds of registrations from attendees in that state. We have an impression that in some states, the CLE paperwork and recordkeeping and reporting requirements are set up to favor one or two in-state CLE providers and to tolerate half a dozen big nationwide CLE providers, and to exclude everyone else including small local independent CLE providers such as our firm.

If we were to set a goal of doing the paperwork and recordkeeping and reporting for all of the states that have CLE accreditation procedures, we would have to charge registration fees of hundreds of dollars per program and even then I suspect we would lose money on some programs. Instead, by

leaving it to you to try to navigate the paperwork burden in your state, we are able to keep our registration fees much lower.

What we have heard is that some attendees from some states other than Colorado have successfully gotten credit in their own state by handing in the Uniform Certificate of Attendance that we provide. Some attendees have kindly reported back to us about their successes as you can see here (https://blog.oppedahl.com/?page_id=7135).

CLE assistance? Please note that to keep our prices as low as possible, the registration fee *does not include* assistance from our office in attempting to obtain CLE credit from your state CLE agency. We will provide a Uniform Certificate of Attendance and related material, and it is up to you to attempt to obtain the CLE credit from your state CLE agency. If you wish assistance from our office in attempting to obtain CLE credit from your state CLE agency, please understand that (a) there will be an extra charge for such assistance; (b) our assistance will be limited to answering questions and filling out forms for you, but it will be up to you to communicate with your state CLE agency directly, and (c) we cannot make any assurances of successful CLE credit in any state in which we have not promised to provide CLE accreditation.

More than one location? This registration is *per login computer or smart phone or tablet location*. If your firm or corporation wishes to make it possible for people to attend at two or more locations or at two or more computers or smart phones or tablets, you should make a registration for each location or computer or smart phone or tablet so that each location or computer or smart phone or tablet can have its own login credentials to the webinar system.

In the past, we have heard of some attendees attempting unsuccessfully to use Citrix or other desktop sharing applications to share the audio and video from one location to a second location. We have heard that this does not work well. We urge you to avoid problems by registering individually for each intended login computer location.

In case we did not make this clear, you need to understand that the login link that you will receive is good for only one login. If you try to use it for logging in at two or more locations, it is extremely likely that at least one of the login attempts will fail and it would not be surprising if the second login attempt would make some sort of problem for the first login attempt.

Will the webinar be recorded? Many people ask this question. The answer is that maybe we will successfully record the webinar, and maybe we will fail to successfully record it. We hope we will succeed, and we hope we can post a recording of the webinar for later viewing.

Keep in mind that if you were to view a recording, this would not include the ability to ask questions. A live webinar offers the opportunity to ask questions through a “question” function.

How to sign up? To register for this program, click on the big button above. After you register, you should receive a confirming email message. *If you do not receive the confirming email message, consider the possibility that you might have mistyped your own email address when paying the money.* Another possibility is that you may have asked the GotoWebinar company (also known as LogMeIn) not to send you any emails at all, by clicking “unsubscribe” links in the past when receiving past emails from the GotoWebinar company. If you did that, then you have no one but yourself to blame if the GotoWebinar company is not sending you any emails at all.

How may I receive the webinar materials? On the day of the webinar, you will receive at least two email messages with a link for downloading the materials for the webinar. One such email message should arrive about an hour before the starting time of the webinar, and another such email message should arrive about three hours before the starting time of the webinar. If you do not see such email messages, ask yourself whether you received a confirming email message back when you registered for the program. If you did not, then maybe you mistyped your own email address when you paid the money to register. If so, then this would explain why you are not receiving the expected email messages on the day of the webinar.

The webinar materials will include a set of the presentation slides as well as a copy of the program brochure and a Uniform Certificate of Attendance for use in seeking CLE credit.

Keep in mind too that if you register for the webinar with less than an hour to go before the starting time of the webinar, then you will not receive the email message about downloading the materials that is supposed to reach you an hour before the starting time.

Format. This program is a webinar, meaning a seminar offered over the Web. It is anticipated that at some law firm and corporate locations, the presentation-slide content of the webinar will be projected upon a screen in a conference room. The projection-screen approach can provide a nice way for several people to attend.

Other attendees will view the presentation by themselves, on their own computers or smart phones or tablets.

Participants will be able to submit typed questions through a “question” function in the webinar system.

After the webinar has finished, participants will be requested to complete an online evaluation form.

For users who attend by means of a computer, audio will be provided through the attendee’s choice of either computer speakers or a dial-in telephone number. A user with a computer headset can use the headset to listen to the audio. Many attendees will find it convenient to receive the audio through their computer speakers, which is free of any per-minute charge. It will also be possible to dial in to a telephone conference bridge to receive the audio; this will be a toll call with regular per-minute long-distance telephone charges.

You may find it convenient to use a USB speakerphone to broadcast the audio in your conference room.

Are you a smart phone or tablet user? If so, you may wish to try attending using a Gotowebinar app. Before the date of the webinar, please do at least one test webinar as mentioned on the technical support page (https://shop.oppedahl.com/?page_id=392). On the date of the webinar, please log in at least ten minutes early so that you will have time to try to solve any problems. Plan ahead so that if you cannot get the app to work, you will be able to switch to an ordinary computer connection to attend the webinar.

Group viewing. We hear from our attendees that one of the most pleasant and productive ways to attend one of our webinars is by means of group viewing. Pick a conference room or some other comfortable setting. *Make sure, of course, to have a writing surface available for each attendee, since this is required by most state CLE accreditation rules.* Set up a large-screen monitor with an

HDMI cable to display the program, or use a computer data projector to show the program on a big screen. Use a USB speakerphone to broadcast the audio. Keep a keyboard handy so that when attendees have questions, somebody can type in the questions in the “ask questions” box in the webinar system.

Beverages during the group viewing? The plain fact is that most of the topics upon which we provide presentations have the potential to be very dry. You do not know the full meaning of “very dry” until you have suffered through the first thirty minutes or so of a discussion of some of the finer points of the Patent Cooperation Treaty or the Paris Convention for the Protection of Industrial Property, and then you glance at a clock and you realize that there are another seventy minutes to go before we are done. You may thus find it helpful to plan ahead and to arrange to be well rested for the webinar. One approach for a beverage is to consume some caffeinated beverages ahead of time and to have refills available during the program. Another approach for a beverage during the group viewing would be to provide half a glass of wine to all attendees at about the half-way point. This is very much a matter of personal choice.

Technical support on the day of the program. Sometimes when we host a webinar, we receive frantic telephone calls on the day of the webinar from people who have problems. Usually the cause of the problem is something that we cannot help with in any way. Please see our technical support page (https://shop.oppedahl.com/?page_id=392) for technical support.

Cutoff time for registrations. Please plan ahead and register with at least one hour to spare before the webinar. We can offer no assurances that an attempted webinar registration will succeed if you try to do it with less than one hour remaining before the starting time of the webinar.

Other educational programs? You can see other upcoming educational programs (https://blog.oppedahl.com/?page_id=7066) from Oppedahl Patent Law Firm LLC.

Edit (<https://blog.oppedahl.com/wp-admin/post.php?post=7157&action=edit>)

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Copyrights (<https://blog.oppedahl.com/?cat=4>) (26)

Industrial Designs (<https://blog.oppedahl.com/?cat=9>) (252)

Hague Agreement (<https://blog.oppedahl.com/?cat=10>) (61)

Picking a Receiving Office

Webinar, November 17, 2021

Noon to 1:40 PM

Carl Oppedahl

Oppedahl Patent Law Firm LLC

blog.oppedahl.com

With kind sponsorship of the
World Intellectual Property Organization

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Disclaimer

This is not legal advice. Reading these slides or attending this webinar or viewing a recording does not make you my client and does not make me your lawyer. This is an educational program. If you want legal advice, consult competent counsel who can learn your detailed situation and can give you advice about your situation.

2

How we will proceed

Feel free to ask questions in the questions box in the webinar system. No need to save up questions until the end.

Please please please complete the evaluation questionnaire.

3

A word about your presenter

Yes I am often a consultant for WIPO, teaching this and many other PCT programs, live and recorded ...

in person and via webinar ...

I am also an opinionated private practitioner

Please join me in recognizing that I wear two hats from time to time during the webinar

When you hear me expressing opinions, then I am not speaking on behalf of WIPO, and instead I am merely speaking as a private practitioner

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Helpful PCT resources

WIPO's PCT Distance Learning Course

The Schwegman lectures (Youtube, yours truly speaking)

WIPO video series (Matthias Reischle)

WIPO's PCT Applicant's Guide

The PCT listserv (email discussion group)

PCT section of the *Ant-Like Persistence* blog

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Helpful PCT resources

WIPO's PCT Help Desk

+41 22 338 83 38

USPTO's PCT Help Desk

+1 571 272 4300

Make sure you are subscribed to WIPO's *PCT Newsletter*

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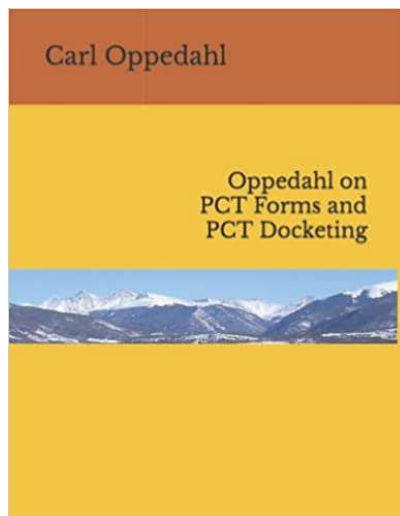
Helpful PCT resources

Upcoming webinars:

- National phase or bypass continuation? (Friday, November 19, 2021)
- Picking a PCT International Searching Authority (Wednesday, December 8, 2021)
- Docketing of PCT
- Making use of PCT Declarations

To hear about such webinars, subscribe to the *Ant-Like Persistence* blog

Helpful PCT resources



Published November 14, 2021!

The fifty PCT forms that you are most likely to encounter

Which dockets to set or clear when these forms arrive

What dates and check boxes to check on the forms

Warning signs that you can detect from the forms

CLE accreditation

This program is accredited in Colorado for 2 CLE units. You hopefully have already downloaded a copy of the program materials, which include a copy of the Notice of Accreditation. This may be helpful to you in obtaining CLE credit in states other than Colorado.

General goals

Making best possible use of the Patent Cooperation Treaty from tactical and strategic points of view

Learning and following Best Practices to minimize embarrassment and malpractice

Outline for today

Review the background for selection of ROs

Remind ourselves of some Best Practices about auto-loading bibliographic data to the ROs

Discuss factors that might influence your choice of an RO

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US focus

Many of today's comments will be very focused on the situation of a US-based applicant

Some of the points discussed today will nonetheless be of interest to applicants in other locations

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What is “bibliographic data”?

This is for example:

- Who are the inventors?
- Who is the applicant?
- What is the title?
- Are we claiming priority?
- Which Searching Authority did we pick?
- Is an agent representing the applicant?

This is what we mean by “bib data”

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Common sense tells you ...

... that no matter which patent office we are talking about,
no matter where in the world, of course there needs to be
some way that the filer communicates the bib data to the
patent office

In the USPTO, the name we give to the thing that
communicates bib data to the patent office is ...

... wait for it ... the Application Data Sheet

In PCT world, the name we give to the thing that
communicates bib data to the patent office is ... the
Request

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Communicating bib data to a patent office

It is very much in your interest to do *whatever it takes* to make sure that your bib data get ***auto-loaded*** into the patent office system

It is crucially important to deny the patent office any opportunity to hand-key your bib data

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Ensuring that ADS bib data get auto-loaded into USPTO's systems

Make sure your ADS is not image-based
(make sure it is computer-readable)

Make sure it is in the e-filed submission *in which you do not yet know* your application number

This can be in your choice of EFS-Web or Patentcenter

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EFS-Web or Patentcenter?

You need to be using Patentcenter

USPTO is going to shut down EFS-Web Real Soon Now

Patentcenter is very buggy and needs features

You need to contribute to cleaning up Patentcenter

To do this, you need to be using Patentcenter

And you need to join and participate in the Patentcenter listserv

This is not the same as Ideascale

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Polling question

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Ensuring that PCT bib data get auto-loaded into PCT patent office systems

Make sure you do not hand in your Request as a PDF

If you are using RO/US (USPTO) then make sure you communicate your bib data by means of a ZIP file

Failing to hand in a ZIP file means you are risking malpractice

Astonishingly, in about half of all PCT filings in the USPTO, the filer fails to hand in a ZIP file

This means the filer is ...

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Ensuring that PCT bib data get auto-loaded into PCT patent office systems

Make sure you do not hand in your Request as a PDF

If you are using RO/IB it is simply a matter of using ePCT to file the PCT application

This causes auto-loading of the bib data into the PCT patent office systems

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What is it that you do to make it so that the patent application you are about to file at the USPTO will be visible to you in Private PAIR?

Yeah, what?

(attendee scratches his or her head ... it has something to do with customer numbers ... yeah, we just make sure to use the right customer number or something ... hmm ...)

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PCT world has a thing that is like Private PAIR

Okay so when you are filing a new PCT application you ought to do what it takes to make it so that the PCT application you are about to file will be visible to you in the thing that is like Private PAIR

What is that thing? Customer number? No, it can't be that. Hmmm.

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When you are filing a new PCT application, what do you do so that the PCT application you are about to file will be visible to you in the thing that is like Private PAIR?

It's different depending on whether you are filing at RO/US or filing at RO/IB

- At RO/US, the thing you do is upload a ZIP file that you created in ePCT
- At RO/IB, the thing you do is e-file using ePCT

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Did I mention that you need to learn to use every feature of ePCT if you have not done so already?

You need to learn to use every feature of ePCT if you have not done so already.

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Most mistakes are fixable if you don't mind paying money or filing a petition or whatever

What is not fixable?

The absolute worst mistake that is not fixable is making a mistake in a priority claim and not catching it within the 4-and-16 time period

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If you previously loaded your priority application into DAS ...

Then when you are preparing your PCT Request in ePCT ...

ePCT will cross-check your priority claim with DAS ...

And if you got a digit wrong in the priority claim, it will catch it

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I think I forgot to mention, it is good to learn to use every feature of ePCT

It is good to learn to use every feature of ePCT, including the feature where it cross-checks your priority claim information against what is already in the DAS system and catches your mistakes

Thereby saving you from malpractice or worse

Or worse????

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Threshold issue in picking an RO

Figure out what is our applicant list

For each applicant, figure out where the applicant is a citizen

For each applicant, figure out the applicant's domicile

Make a combined list of all of the citizenship locations and all of the domicile locations

Avoid embarrassment – do not pick an RO that does not work for this combined list

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The risk of embarrassment goes far beyond picking an RO that does not work for the combined list of applicant citizenships and domiciles

What if the combined list is only Argentina?

Afghanistan	Iraq
Andorra	Jamaica
Argentina	Lebanon
Bahamas	Mauritius
Bangladesh	Nepal
Bhutan	Pakistan
Bolivia	Paraguay
Burundi	Suriname
Congo	Tonga
Guyana	Uruguay
Haiti	Venezuela
Holy See	Yemen

(States that belong to the Paris Convention but do not (yet) belong to the PCT)

How to avoid getting this wrong?

Use ePCT to prepare your PCT Request

ePCT will warn you if your applicant list fails to provide an entitlement to make use of the Patent Cooperation Treaty

ePCT will warn you if you attempt to make use of an RO that does not work given your applicant list

How about PCT-SAFE?

Nope, not good enough

PCT-SAFE is no longer a Best Practice

You need to be using ePCT

ePCT checks your priority claims, PCT-SAFE does not

ePCT is always up to date

ePCT offers many collaborative workflow benefits that PCT-SAFE does not

But what about that Federal Register notice from May 6, 2016?

You might go to prison if you use ePCT, said the USPTO. (I am exaggerating!)

Later, USPTO walked it back! Using ePCT will not get you into such trouble.

PCT-SAFE will eventually be discontinued

Back to your applicant list

We realize that it is your applicant list that determines
whether or not you can even use the PCT at all

We realize that it is your applicant list that determines
which RO or ROs you are permitted to choose from

You get to control your applicant list!

You can make your applicant list into whatever you want

We call this “applicant of convenience”

Applicant of convenience

My personal favorite is Malawi

Some filers use an AOC so that a client that otherwise could not use the PCT at all can make use of the PCT

Some filers use an AOC so that a client can make use of an ISA (international searching authority) that would otherwise not be available

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Applicant of convenience

The Best Practice is that the AOC should be an applicant only for one particular designation

Not for all designations

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Now to pros and cons of particular ROs

The RO that you pick determines which ISAs you can choose from

Each RO “certifies” one or more ISAs

RO/US has “certified” eight of the 23 possible ISAs

(Soon to be 24!)

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Which ISAs can you choose from if the RO you pick is RO/IB?

You make a list of all of the ROs that you could use given your applicant list and the resulting list of applicant citizenships and applicant domiciles

You make a list of all of the ISAs that all of those ROs would have permitted you to choose from

That is the list of all of the ISAs that the RO/IB will permit you to choose from

ePCT will calculate all of this for you

Did I mention it is good to learn to use ePCT?

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There is a further consequence from this

The ISA you pick will in turn put limits on the list of IPEAs that you can choose from if you later decide you want to file a Demand

And the range of ISAs you can choose from is a function of the RO that you pick

So this is another reason to choose wisely when choosing your RO

Maybe you are certain you won't be filing a Demand, in which case you can ignore this further consequence

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Selecting a Receiving Office

- Most US filers choose RO/US, that is, the Receiving Office at the USPTO
- Sometimes it is better to use RO/IB, that is, the Receiving Office at the International Bureau of WIPO
- If you are seeking Restoration of the Right of Priority, RO/IB may be your best choice

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Sometimes your case will get bounced from RO/US to RO/IB

Why? Because RO/US “lacks competence to be the RO”

This is not the same as being “incompetent”

It could be that there is no applicant in the applicant list that is a citizen or domiciliary of the US

Or maybe there is some non-English text in the application

Like maybe in a figure, bet you never thought of that!

Then you get a new and different PCT application number

This might make you look sort of dumb in front of the client

Better if you explained ahead of time to the client that the bounce is going to happen

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Advantages of using RO/US

- Many filers are very familiar with EFS-Web. For such filers it is comfortable to use RO/US because the filing path is through EFS-Web.
- Filers who are familiar with EFS-Web know when it will be midnight in Virginia, so they know when to get the e-filing done to get a same-day filing date
- Of course you should not be using EFS-Web at all, you should be using Patentcenter, since EFS-Web is going to get cut off and you need to be finding and reporting the bugs in Patentcenter
- But anyway, most US filers pretty much always use RO/US mostly because of habit and inertial and laziness

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Foreign filing license considerations

- If you would need a Foreign Filing License to file outside of the US, but do not yet have an FFL, then RO/US is a good choice because RO/US will carry out a security review before transmitting the application outside of the US
- If your invention was made in the US, you will need to get an FFL before filing a PCT application in RO/IB
- If the priority application is substantively identical, and if it was filed in the USPTO, then maybe you already have an FFL for the subject matter of the to-be-filed PCT application

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Alexandria or Geneva?

Express Mail provisions (not a Best Practice)

Or hand-carry to the patent office?

RO/US: Yes, but \$400 or \$200 penalty

RO/IB: No, filing date will be actual date of receipt at the RO/IB

Let's forget about courier and hand-carry

And no, you cannot fax any more to the IB

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E-Filing

- RO/US: EFS-Web or Patentcenter by midnight in Alexandria (now 99.6% of cases get e-filed)
- RO/IB: ePCT by six hours earlier (usually six hours)

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Filing fee reductions

Filing Fee Reductions for e-filing in RO/US:

- \$109 – e-filed (EFS-Web or Patentcenter) but the Request is not a ZIP file
- \$218 – e-filed (EFS-Web or Patentcenter) and the Request is a ZIP file (Best Practice)
- And note that when you e-file, you avoid a penalty of \$400 or \$200
- No the \$400 non-DOCX penalty will not apply to PCT filings

Filing fee reductions for e-filing in RO/IB:

- \$218 – e-filed (ePCT)
- \$327 – e-filed and the application body is in XML

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Transmittal Fee

- RO/US: \$260, but:
 - \$130 if filing as a small entity
 - \$65 if filing as a micro-entity
- RO/IB: \$109

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Alexandria or Geneva? Restoration of the Right of Priority

RO/US: unintentional criterion only

RO/IB: unintentional criterion or in spite of due care (important for later filings in AM, BH, BW, CH, CR, DK, EE, EG, EP, ES, FI, GT, HR, HU, IL, IS, JP, LT, NZ, PE, PL, PT, RS, RU, SE, SK)

Fee for Requesting Restoration of the Right of Priority

- RO/US: \$2100
 - \$1050 if filing as a small entity (\$525 micro-entity)
- RO/IB: None

IF YOU NEED TO RESTORE PRIORITY, THINK RO/IB!

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Alexandria or Geneva? Languages Accepted

RO/US: English

RO/IB: Any language, but

If the language is not accepted by the ISA, the applicant will have to furnish a translation. If the language is not a language of publication, the applicant will have to furnish a translation of the application into one of the languages of publication.

How would the filer even remember to pay attention to this? Guess what? ePCT will remind you at Request-prep time? It is good to learn to use ePCT.

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Alexandria or Geneva? ISA Choices

- RO/US: AU, EP, IL, JP, KR, RU, SG, US
- RO/IB: For a US filer, RO/IB offers at least as many choices as RO/US, but may have additional choices depending on whether there is any non-US nationality or residence among the applicants

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Alexandria or Geneva?

Certified copies of US priority documents

- RO/US: very easy – you just check a box in the Request (“RO to forward”) or use DAS
- It is better to use DAS, why?
- RO/IB: you can use WIPO’s DAS system
- Either approach is free of charge

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Best Practice for filing a priority document

- Make sure the priority application is made available to PDX and DAS
- In USPTO, this may be done in the ADS (default setting)
- A US provisional might not be filed with an ADS
- If so, then Form PTO/SB/39 may be used
- Similar steps should be followed for a priority document that is being filed in a non-US patent office
- This is a Best Practice

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Polling question

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Alexandria or Geneva? Risk of security review delay?

- Sometimes RO/US will encounter a delay in the security review
- If your to-be-filed PCT application is substantively identical to your US priority document ...
- And if your US priority document already has an FFL ...
- Then consider filing in RO/IB rather than RO/US, so as to eliminate the risk of a security review delay

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Alexandria or Geneva? Processing time

- Recall that one of the tasks of the Receiving Office is to transmit the Record Copy to the International Bureau (IB)
- Common sense tells us that probably the RO/IB is pretty good at transmitting the Record Copy to the IB
- The RO/US has a recent track record of transmitting the Record Copy to the IB just as fast as RO/IB's track record (the exception being cases that get slowed down in a security review)

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Alexandria or Geneva? Delay before case becomes visible in the PCT system that is like Private PAIR

- If you pick RO/US (or any RO other than RO/IB) then it will take weeks for the newly filed PCT application to be visible to you in the PCT system that is like Private PAIR
- If you pick RO/IB, then your newly filed PCT application will be visible to you in the PCT system that is like Private PAIR ***instantly***
- This is one of the reasons that I personally try to e-file in RO/IB whenever I can

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Why would you ever not pick RO/IB?

Maybe it is past midnight in Geneva

Then yes, file in RO/US

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Why would you ever not pick RO/IB?

Maybe you do not feel like being trendy, modern, and up-to-date

Then yes, file in RO/US

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Why some US practitioners end up in RO/IB

Saying it nicely ... they have a client outside the US, and they don't want to share any professional fees with counsel in the place where the client is located

They file in RO/US and it gets transferred to RO/IB

Or they plan ahead and avoid embarrassment and file directly in RO/IB

Either way they end up in RO/IB

See next slide

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US practitioner ends up in RO/IB with non-US client, having tried in the Request to be the agent

RO/IB will send a letter to US counsel telling them they can't be the agent

This is embarrassing

US counsel can then demote himself or herself to a mere "address for correspondence"

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US practitioner ends up in RO/IB with non-US client, having planned ahead better

US counsel prepares the Request from the outset so that US counsel never attempts to be anything more than a mere “address for correspondence”

US counsel explains this to the non-US client

This avoids embarrassment in front of the client

Any later papers, for example at the ISA, will need to be ghost-written for signature by the client

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Best Practices

Get every would-be priority application into DAS

Set up “alert” in DAS for every would-be priority application

Get a Certificate of Availability from DAS for every would-be priority application

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Best Practices

Use ePCT to prepare every PCT Request

Not PCT-SAFE

Do not use “RO to forward certified copy”

Use “IB to retrieve from DAS”

This forces the cross-check of accuracy of
the priority claim

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Best Practices

If you do choose RO/US, be sure you are
uploading a ZIP file

Make sure the source of the ZIP file is ePCT,
not PCT-SAFE

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Best Practices

Make use of the PCT system that is like Private PAIR to manage your PCT applications during the time after they have been filed

Get the benefit of many automatic notifications and warnings in your pending PCT applications

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Okay I give up. What exactly is “the PCT system that is like Private PAIR”?

I thought you’d never ask. It is ... wait for it ... ePCT!

Specifically it is the part of ePCT called “your Workbench”

Did I mention it is important to learn to use all functions in ePCT?

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Helpful PCT resources

WIPO's PCT Distance Learning Course

The Schwegman lectures (Youtube, yours truly speaking)

WIPO video series (Matthias Reischle)

WIPO's PCT Applicant's Guide

The PCT listserv (email discussion group)

PCT section of the *Ant-Like Persistence* blog

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Helpful PCT resources

WIPO's PCT Help Desk

+41 22 338 83 38

USPTO's PCT Help Desk

+1 571 272 4300

Make sure you are subscribed to WIPO's *PCT Newsletter*

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Helpful PCT resources

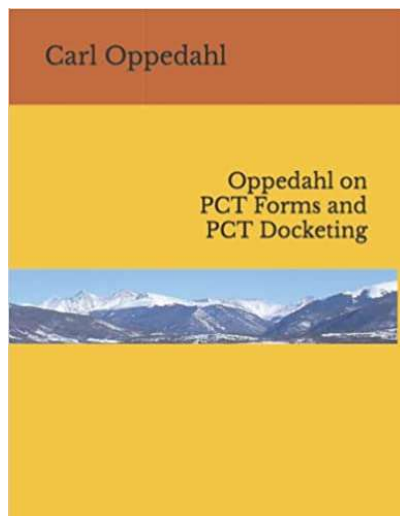
Upcoming webinars:

- National phase or bypass continuation? (Friday, November 19, 2021)
- Picking a PCT International Searching Authority (Wednesday, December 8, 2021)
- Docketing of PCT
- Making use of PCT Declarations

To hear about such webinars, subscribe to the *Ant-Like Persistence* blog

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Helpful PCT resources



Published November 14, 2021!

The fifty PCT forms that you are most likely to encounter

Which dockets to set or clear when these forms arrive

What dates and check boxes to check on the forms

Warning signs that you can detect from the forms

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Again a reminder ...

Be sure to fill out the evaluation
questionnaire.

Thank you!