

Ant-like Persistence®

(<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>)

(

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 INTERNATIONAL SEARCHING	VARIOUS CO	12/8/2021	OPLF	2	

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Date Reviewed: 11/16/2021

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Ant-like Persistence[®]

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Picking a PCT International Searching Authority



(<https://attendee.gotowebinar.com/register/5310554719703292686>) The October 2021 issue of WIPO's PCT Newsletter has a very helpful Practical Advice column entitled *Filing strategies: factors to consider when deciding which International Searching Authority to choose where more than one Authority is competent*. You can read the article here (https://www.wipo.int/pct/en/newslett/2021/article_0014.html). The article, of course, speaks in general terms because the reader might be anywhere in the world. This webinar addresses the particular situation where the filer of the PCT application is from the US.

A PCT filer from the US has eight International Searching Authorities to choose from:

- Australian Patent Office (ISA/AU)
- European Patent Office (ISA/EP)
- Israel patent office (ISA/IL)
- Japanese Patent Office (ISA/JP)
- Korean Intellectual Property Office (ISA/KR)
- Russian patent office (ISA/RU)
- Singapore patent office (ISA/SG)
- United States Patent and Trademark Office (ISA/US)

Is there some particular ISA among these eight ISAs that is always or nearly always the best choice for nearly all PCT filers? (The answer is no!)

What are the advantages and disadvantages of these various International Searching Authorities?
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 ISA?

As a bonus topic we will talk about ways that power users can use ePCT to communicate with ISAs, and we will talk about ways to transfer funds to ISAs.

When and where? Wednesday, December 8, 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 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=7150&action=edit>)

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CATEGORIES

Picking an International Searching Authority

Webinar
December 8, 2021
Noon to 1:40 PM, Mountain Time
Carl Oppedahl
Oppedahl Patent Law Firm LLC
blog.oppedahl.com

Presented with generous support of
the World Intellectual Property Organization

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.

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.

Please note that if you have not already downloaded your presentation materials, you can download them now from a link in the webinar system.

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

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

Free-of-charge recordings of recent webinars:

- National phase or Bypass?
- Picking a Receiving Office

You can find these recordings on 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

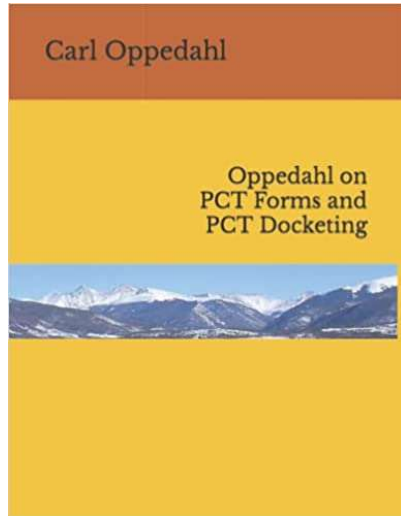
Upcoming webinars:

- 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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There are 23 ISAs
Soon to be 24 ISAs

AT AU BR CA CL CN EG EP ES FI IL
IN JP KR PH RU SE SG TR UA US
XN XV

Soon to add EA

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How you know which ISAs you have to choose from?

The list of ISAs that you have to choose from is determined by your choice of RO

Your range of choices of RO is in turn defined by your applicant list

This might prompt adding an Applicant of Convenience to your applicant list

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Each RO “specifies” one or more ISAs

By far the majority of ROs have specified only a single ISA

This means there are many PCT filers who do not routinely consider any choice of ISA

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The highest number of ISAs that any RO has specified is eight

There are four such ROs

- RO/IN has specified AT, AU, CN, EP, IN, IP, SE and US
- RO/MX has specified AT, CL, EP, ES, KR, SE, SG and US
- RO/US has specified AU, EP, IL, JP, KR, RU, SG and US
- RO/VN has specified AT, AU, EP, JP, KR, RU, SE and SG

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Special case: RO/IB

How do you know which ISAs you have to choose from if you are in RO/IB?

Figure out all the ROs that you could have used based on your applicant list

List all of the ISAs that you could have chosen given all of those ROs

That is your list of available ISAs

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ePCT will help you with this

ePCT will work out for you which ISAs you have to choose from

This can be very helpful particularly when you are in RO/IB

It is good to learn how to use all functions of ePCT

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Some filers are in a rut

They assume that some particular ISA is always the right choice

“we’ve always done it that way”

It is likely that one client may have factors making one ISA a best choice, while a different client may have factors making some other ISA a best choice

It is very unlikely that “one size fits all”

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Selecting an International Searching Authority

Many factors may influence the client's selection of ISA

- Quality
- Cost for first invention
- (a former factor: cost for 2nd through nth inventions)
- Timeliness
- Suitability for later use for PPH purposes
- Possible benefits and interactions with particular national- or regional-phase filing paths
- Paper or electronic communication
- Availability of cited references

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Picking an International Searching Authority

- You are getting ready to file a PCT application
- You (actually, the client) must pick an International Searching Authority (ISA)
- If your habit is always to pick the same ISA, because “we've always done it that way,” then this is an opportunity to provide better service to your client

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Which ISA can you choose?

- The Receiving Office (RO) at which you file determines the available ISAs
 - To be a competent RO, at least one applicant must be a national/resident of the country/region of that RO
 - Any applicant can file at the RO/IB (assuming they can use the PCT at all)
- If you file at the RO/IB, the available ISAs are any that you could have selected if you had filed your application at any of the possible competent national/regional ROs
- If there are joint applicants from different countries, you can file at any competent RO, but the RO you choose will determine the available ISAs
 - Therefore, best to consider available ISAs when selecting the RO
 - If you choose the RO/IB, you get to choose from the combined available ISAs

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Which ISA can you choose?

- You can include an applicant of another nationality for the purpose of enabling filing at another RO (applicant of convenience)
 - The extra applicant can be made an applicant only for one obscure country
- You can use ePCT to prepare your Request. The software will look at the applicants and will tell you if you picked a competent RO, and will tell you which ISAs you can pick
- It is a Best Practice to use ePCT to prepare your Request! Even if you are e-filing in RO/US you should be using ePCT to prepare your Request. (You prepare a ZIP file and you upload it to Patentcenter or to EFS-Web.)

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A brief mention of Patentcenter

- If you have not already done so, you should start using Patentcenter.
- EFS-Web and PAIR each are on the way out.
- You need to start contributing to the beta testing and trouble reporting for Patentcenter.
- Join the Patentcenter listserv. (This is not Ideascale!)

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You picked RO/US?

- There are 23 ISAs in total (soon to be 24)
- Available ISAs if you filed at the RO/US:
 - AU (Australia)
 - EP (EPO)
 - RU (Russia)
 - SG (Singapore)
 - IL (Israel)
 - JP (Japan)
 - KR (South Korea)
 - US (USPTO)

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Factors to Consider in Choosing an ISA

- PPH benefit
- Cost
- Timeliness
- Effect on later national/regional stage
- Characteristics of ISRs from the different ISAs
- Language competency
- Who does the work (outsourcing)
- Provision of cited references
- Subject matter competencies
- Keep in mind that some clients do not care at all about the ISR/WO

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PPH Benefit

- AU, IL, JP, KR, RU, SG, and US are all part of the Global PPH. Positive results from any of those ISAs may form the basis for PPH status in:
 - AT, AU, CA, DE, DK, EE, ES, FI, GB, HU, IL, IS, JP, KR, NO, PT, RU, SE, SG, US
- EP, JP, KR, and US are part of the IP5 PPH. Positive results from any of those ISAs may form the basis for PPH status in:
 - CN, EP, JP, KR, US
- So if you know now in which Offices you might enter national/regional phase, and if you might want PPH benefit in those Offices, this may influence your choice of ISA

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EPO and PPH

- Note that EPO has the PACE program, which offers the opportunity to accelerate search or examination without having to qualify for PPH
- This explains why it almost never happens that an applicant in EPO uses PPH
- Note that in recent years, nearly all EPO cases receive a first Office Action within PACE time anyway, even if the case is not in PACE
- This also explains why EPO applicants usually do not worry about PPH
- But EPO results (including ISA/EP results) are frequently employed to make use of PPH in other Offices

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Search Fees

- US non-small entity: \$2180
- EP: \$2091 (from January 1, 2022 – \$2065)
- SG: \$1646 (from January 1, 2022 – \$1652)
- AU: \$1697 (from January 1, 2022 – \$1604)
- JP: \$1476 (from January 1, 2022 – \$1405)
- IL: \$1107 (from January 1, 2022 – \$1104)
- US small entity: \$1090
- KR: \$1036 (from January 1, 2022 – \$1011)
- RU: \$543 (from January 1, 2022 – \$549)
- US micro entity: \$545

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Additional Search Fees in the Event of Lack of Unity of Invention

- Where there is lack of unity, the ISA will only search one invention
- Typically it will turn directly to the first invention
- To have the additional inventions searched, applicant has to pay an additional search fee for each invention
- The fee is paid in the ISA's local currency
- Consider the comparative cost of search if there is a likelihood of lack of unity

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Effect on Later National/Regional Stage

- If you pick ISA/EP and later enter the EP regional phase, you don't have to pay a search fee to the DO/EO/EP
 - EPO "drinks its own Champagne"
- If you pick ISA/US and get a favorable WO, or pick IPEA/US and get a favorable IPRP (Chapter II), and you later enter the US national stage, you get out-of-order examination and reduced (zero) search and examination fees (37 CFR § 1.496)
- If you pick IPEA/AU, you get a reduced examination fee in EO/AU

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Language Competency

- An ISA/AU or ISA/US searcher might read only English
- ISA/EP searchers read at least English, German, and French, and some also read additional languages
- ISA/IL searchers read Hebrew and English and most also read Russian
- ISA/JP searchers read Japanese and English
- ISA/KR searchers read at least Korean and English and most also read Japanese
- ISA/RU searchers read at least Russian and English and some also read additional languages
- ISA/SG searchers read English and Mandarin and some also read additional languages

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Excluded Subject Matter and Subject Matter Not Required to be Searched

- An International Authority may exclude certain subject matter from its agreement with WIPO to act as an ISA and IPEA
 - If all the claims are directed to such subject matter, ISA will issue an Article 17(2)(a) declaration of non-establishment of the ISR
 - Subject matter not required to be searched includes (Rule 39.1)
 - Scientific and mathematical theories
 - Plant or animal varieties or essentially biological processes for the production of plants or animals (except microbiological)
 - Schemes, rules or methods of doing business
 - Methods for the treatment or diagnosis of the human or animal body
 - Mere presentations of information
 - Computer programs

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Subject Matter Not Searched

■ For example:

■ AU

- Methods of treatment
- Plant and animal varieties

■ KR

- Methods of treatment of the human body by therapy

■ RU

- Methods of doing business
- Software *per se*
- But RU does search methods of treatment of the human or animal body by surgery or therapy, as well as diagnostic methods (PCT Rule 39.1(iv))

ISA Competency Considerations

■ ISA/AU

- Not competent to act as ISA for international applications filed by US applicants in RO/US or RO/IB if more than 250 IAs have been received in the relevant fiscal quarter

■ ISA/EP

- will not search claims directed to mere business methods

■ ISA/IL

- Not competent to act as ISA for IAs filed by U.S. applicants in RO/IB
- Numerical limitation of no more than 100 IAs per fiscal quarter

ISA Competency Considerations

■ ISA/JP

■ The following restrictions apply:

- the applications are submitted in the English language;
- Quota has not yet been met
 - Not to exceed 8400 international applications from the USPTO during the 5 year period from July 1, 2018 to June 30, 2023
 - Not more than 300 applications per quarter during the first and second years
 - Not more than 500 application per quarter during the third, fourth, and fifth years

EP: Limitation on Number of Independent Claims in a Category

■ Where there are two or more independent claims in the same category of invention (i.e., product or method) that are in unity of invention:

- ISA/EP may issue an informal communication telling the applicant that the description, claims or drawings fail to comply with the PCT requirements to such an extent that a meaningful search cannot be carried out because the plurality of independent product claims lack conciseness as required by PCT Article 6
- The applicant may need to choose which independent claim should be searched
- Unlike a unity of invention requirement, the applicant cannot pay for the search of the other independent claims in that category
- It is best to ensure that most important independent claim is listed first

Outsourcing

- ISA/US searches are outsourced
 - Continued user concern that USPTO examiners in US national phase may not give full faith and credit to outsourced ISA/US searches and written opinions
 - USPTO focus on ensuring the quality of work from ISA/US contractors

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Provision of Cited References

- Upon payment or free of charge
 - ISA/AU: upon payment of AUD 50 (about \$36) per document
 - ISA/EP: provides copies of cited references
 - ISA/IL: upon payment of ILS 44 (about \$14) per document
 - ISA/JP: upon payment of JPY 1400 (about \$12) per document
 - ISA/KR: provides an ephemeral link to a web page containing electronic copies of cited references
 - ISA/RU: provides copies of cited documents
 - ISA/SG: upon payment of SGD 30 (about \$ 22) per document
 - ISA/US: provides copies of cited non-US patent documents and non-patent literature

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EPO – paper only

- ISA/EP only communicates on paper
- This leads to risk of delays
- Yes you can get extra time for delays but it is a lot of trouble

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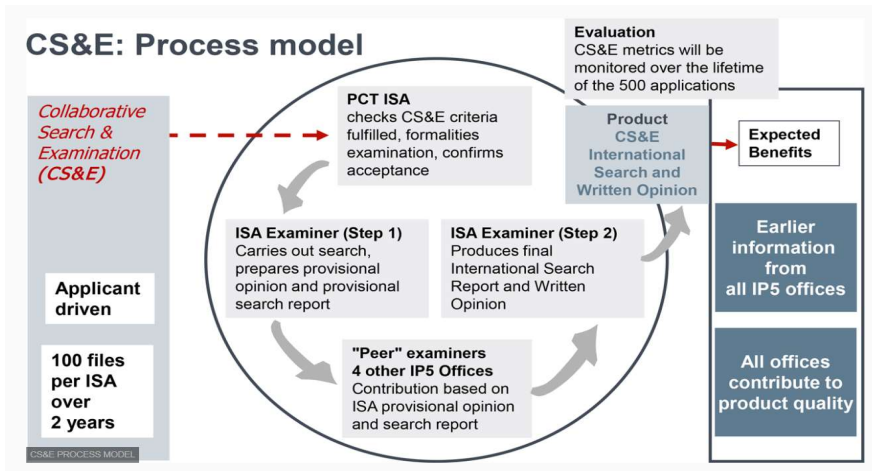
Getting a Super Patent

Global Search and Examination

Getting benefit of five ISAs

Main ISA and four peer ISAs

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Unfortunately GS&E is over for now

Now it is in a followup and study phase

Hopefully it will eventually return

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Later choice of International Preliminary Examining Authority

Your choice of ISA affects your later choice of an IPEA

- AU/EP/IL/JP/SG will be available as IPEA to the US filer in a particular PCT application only if that IPEA was also the ISA
 - Bear this in mind when selecting an ISA

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Deciding what to do if you receive an Invitation to Pay Additional Fees

This is Form PCT/ISA/206 – discussed at page 140 of the *PCT Forms Book*

Clients sometimes complain when they receive an Invitation to Pay Additional Fees

My view is that such an Invitation is actually very good news, not bad news at all

No matter how high the invited fee may be, it is cheaper than filing a bunch of divisional patent applications

I suggest, pay the additional fees!

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How to pay the additional fees to ISA/KR?

At our firm we use Wise Business (the company formerly known as Transferwise)

see *Ant-Like Persistence* blog

- Recipient Bank Name: NongHyup Bank (농협은행) [011]
- Account number: 67601011484

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Communicating with ISAs through ePCT

This works for ISA/AU, ISA/EP, ISA/KR, ISA/RU, ISA/SG

Of course your PCT application is already in your ePCT workbench

You click on “upload documents” and pick “to ISA”

You will get credit for what time it is at the ISA

You do not need to figure out how to e-file directly at the ISA

Very handy for sequence listings and responses to invitation to pay additional fees

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Requests for rectification

Some filers try to get an ISA to grant a request for rectification

Recall the standard for grant of such a request

That no other correction could possibly be correct other than the correction you are asking for

Many requests are likely to fail this standard

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Informal drawings at time of filing of PCT application

Some filers think they can get away with handing in formal drawings after filing day

They hand in informal drawings when filing the PCT application

It is the ISA that will receive any request to enter the formal drawings (The RO is unable to make decisions about entering formal drawings)

ISAs don't like these requests very much

Often the requests get turned down

Yes you can get the request and the turn-down published if you do not mind paying a fee

It is much better to simply hand in formal drawings on filing day

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Docketing relating to the ISA

Docket to check for Form PCT/ISA/202

If you don't receive it, figure out why

If you do receive it, pay attention to the expected date for the ISR/WO

Keep an eye out for the ISR/WO

Docketing relating to the ISA

Keep an eye out for the ISR/WO

What you do not want is the client asking "where is the ISR/WO?" and it is way late and you did not notice it was way late

If necessary, you may need to badger the ISA

Docketing relating to the ISA

Maybe you receive the Invitation to Pay Additional Fees
(Form PCT/ISA/206 (book page 140))

If so, docket to make sure you pay the fees

You may wish to docket to make sure somebody asks the
client for instructions

When the fees get paid, you can clear that docket

There is no reason to foot-drag on paying these fees

The sooner you pay the fees, the sooner you will receive
the ISR/WO

Docketing relating to the ISA

When the ISR/WO arrives ...

Keep in mind the arrival date of the ISR/WO might make a
difference in the due date for filing a Demand

(ISR/WO+3 might be later than P+22)

ePCT will help with this

Docketing relating to the ISA

When the ISR/WO arrives ...

Keep in mind the arrival date of the ISR/WO might make a difference in the due date for making an Article 19 amendment

(ISR/WO+2 might be later than P+16 and tech-preparations date)

ePCT will help with this

Docketing relating to the ISA

When the ISR/WO arrives ...

Maybe docket to check to make sure the ISR/WO gets reported to the client

Ideally the client has been set up as an eViewer in ePCT for the pending PCT application

In that case, the client will automatically be told of the arrival of the ISR/WO

Next steps after the ISR/WO arrives

For some of our clients we have standing orders that when a favorable ISR/WO arrives, we do the following:

- Enter the US national phase
- File papers to get on the PCT/PPH
- Do it later the same day after the ISR/WO arrives

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Next steps after the ISR/WO arrives

File an ADS in EFS-Web to trigger creation of US application number for a US national-phase application

There is no need to pay any fees in the new US application

There is no need to file inventor declaration

Prepare and file an IDS that discloses the references from the ISR/WO

This protects you from any risk of forgetting to file the IDS in that US national-phase application

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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

Free-of-charge recordings of recent webinars:

- National phase or Bypass?
- Picking a Receiving Office

You can find these recordings on 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

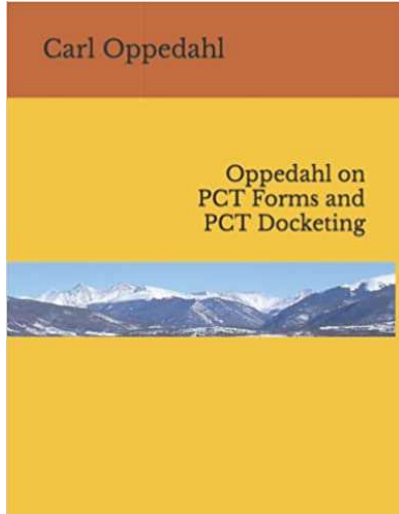
Upcoming webinars:

- 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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Remember to fill out the evaluation questionnaire

Thank you!

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