

Best practices for filing a PCT application in RO/US

Carl Oppedahl

November 7, 2024

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Disclaimer

This is not legal advice. Reading these slides or attending this seminar 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.

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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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Polling question

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Why you did not have to pay?

- The reason you did not have to pay is the sponsorship of WIPO
- Maybe you know somebody at WIPO
- If so, maybe drop them a thank-you note
- If nothing else, find an email address on one of the documents that you received from the IB, and drop a note of thanks

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Ask yourself why it might be that WIPO is willing to pay for your registration for this webinar?

- A **first** reason is that lots of US filers make mistakes
- Some mistakes lead to phone calls to the PCT Help Desk at the IB in Geneva
 - +41 22 338 8338 (PCT Information Service)
 - +41 22 338 9523 (PCT e-services)
- Sometimes the mistake falls into the category of a mistake that the Help Desk people cannot solve
- Imagine what this is like for the people at the Help Desk
- This is part of why WIPO pays for your registration

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Ask yourself why it is that WIPO is willing to pay for your registration for this webinar?

- A **second** reason is that lots of US filers make mistakes
- Sometimes this is the kind of mistake that gets noticed by a processing team (“PT”) at the IB in Geneva
- The PT then must mail out a Form
- Sometimes the response from the filer does not really fix the mistake
- The PT must then go back and forth with the filer
- Imagine what this is like for the PT people
- Most often this work by the PT people is not directly covered by any fees
- This is part of why WIPO pays for your registration

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Ask yourself why it is that WIPO is willing to pay for your registration for this webinar?

- Imagine the prospect of US filers making far fewer mistakes going forward
- Clearly everyone involved in the PCT process benefits from this happy situation
- This is part of why WIPO pays for your registration

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Upcoming webinars

- Tuesday, November 12, 2024. 10AM to 11:30 AM Mountain Time. (**Note different time of day.**) *Best practices for presentation of priority claim in a PCT application.* This webinar will be of potential interest to attendees in all locations.
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- Tuesday, January 7 to Thursday, January 9, 2025
- Network with other PCT enthusiasts during the breaks
- Ask questions live and face-to-face
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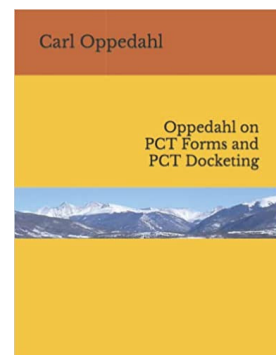
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Helpful PCT resources

- WIPO's PCT Distance Learning Course
- 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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Our main points today, part 1

- When filing in RO/US, **do not** upload your Request as a PDF
- When filing in RO/US, **do not** upload your Request as a ZIP file from PCT-SAFE
- When filing in RO/US, **always** upload your Request as a ZIP file from ePCT

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Our main points today, part 2

- When preparing your Request, **do not** ask the RO to forward the certified copy of the priority document to the IB
- When preparing your Request, **always** ask the IB to retrieve the certified copy of the priority document from DAS
- This is discussed in greater detail in *Best practices for presentation of priority claim in a PCT application*, Tuesday, November 12, 2024.

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Our main points today, part 3

- When filing your priority application (for example a US provisional), **do not** merely use a provisional cover sheet
- When filing your priority application (for example a US provisional), **always** also use an ADS
- This is discussed in greater detail in *Best practices for presentation of priority claim in a PCT application*, Tuesday, November 12, 2024.

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What do patent applications cost to file?

- Suppose a patent application has already been written in English. Now you are going to file it, let's say, in the IP5. What does that cost? (Very roughly!)
 - China – maybe \$9K
 - EPO – maybe \$9K
 - Japan – maybe \$11K
 - Korea – maybe \$11K
 - US – maybe \$4K
- ... fees to local agents, translation costs, government fees

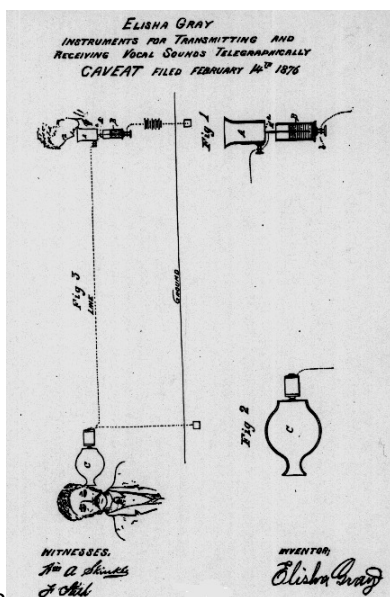
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What it was like before 1883?

- Light bulb blinks on over the inventor's head
- Scramble around to file patent applications everywhere in the world in a big hurry!
- Many thousands of dollars spent in a big hurry

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Why the hurry? Elisha Gray, that's why.
Who is Elisha Gray? I'm glad you asked.



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Elisha Gray is the other person who invented the telephone, and who who got to the patent office **after** Alexander Graham Bell.

It turns out to be a big problem if somebody else got to the patent office before you did.

Paris Convention

for the Protection of Industrial Property of **March 20, 1883**,

as revised at Brussels on December 14, 1900,

at Washington on June 2, 1911,

at The Hague on November 6, 1925,

at London on June 2, 1934,

at Lisbon on October 31, 1958,

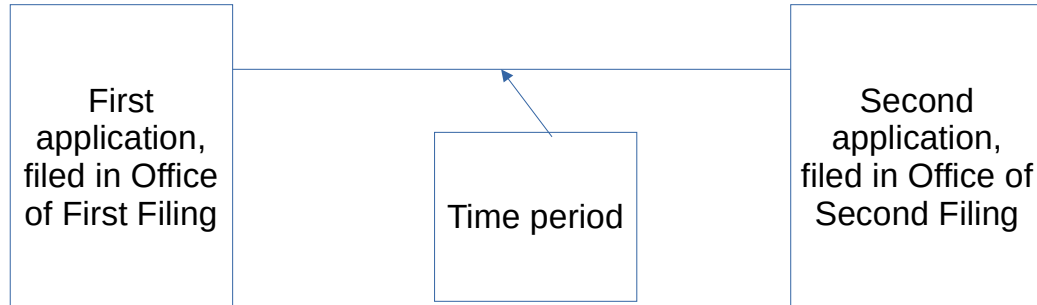
and at Stockholm on July 14, 1967,

and as amended on September 28, 1979.

1883

- First electric lighting system with overhead wires
- Oxygen liquified for the first time
- Brooklyn Bridge opened to traffic
- First operation of the train *The Orient Express*
- Cholera bacillus discovered
- Work begins on the even now not-yet-completed *Sagrada Família* Cathedral in Barcelona

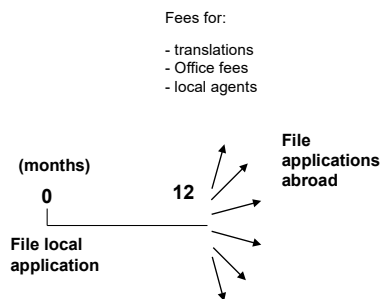
Priority applications



- First application cannot be an application for a license plate for an automobile
- “*whatever may be the subsequent fate* of the application”
- “shall be recognized as giving rise to *the right of priority*”

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Paris Convention



This is a traditional path that has been available since 1883. The expensive and difficult decisions about foreign filing may be postponed until almost 12 months.

But at 12 months you may not yet know whether the invention is patentable.

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12 months?

- Twelve months for patents (and utility models)
- Six months for industrial designs
- Six months for trademarks

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Back to utility patents

- 12 months from your first priority filing
- You can start the 12 months over again
- EALNRO
- If the would-be priority application has been expressly abandoned leaving no rights outstanding, before the filing of the next would-be priority application, then you get to restart the clock

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Is EALNRO an acronym?

- No. You can only call something an acronym if it is capable of being pronounced as a word.
- NATO. NASA. WIPO. These are acronyms.
- EALNRO is merely an *initialism*.

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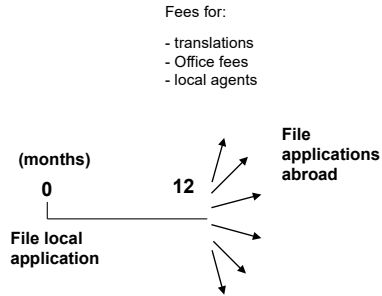
Communicating with the client about foreign filings

- Whenever you file any patent application that has a chance of serving as a priority document for later foreign filings ...
- It is important to write to the client about the need to keep track of the 12-month priority period
- It is important to docket the 12-month priority period

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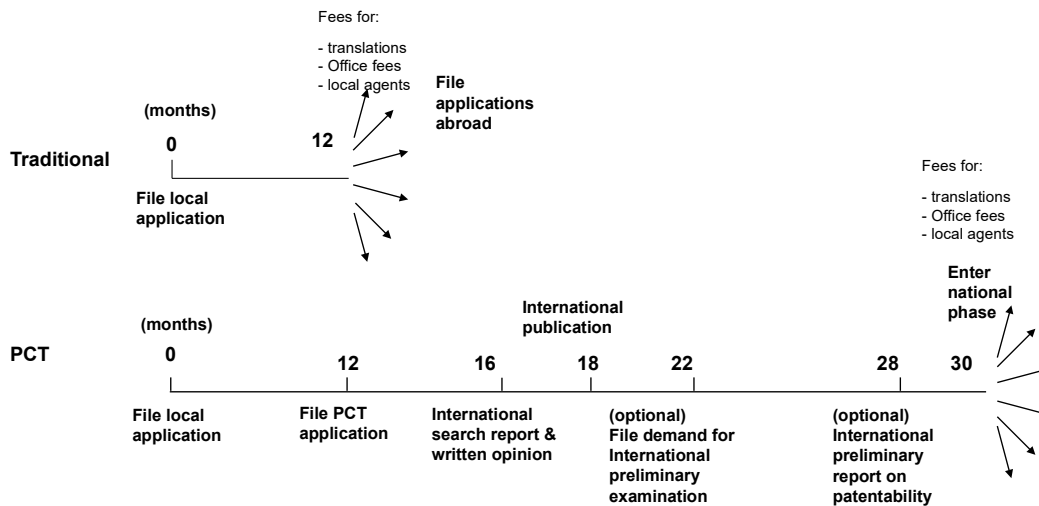
Purchasing \$44K worth of lottery tickets

Wouldn't it be nice to know whether or not the lottery tickets are going to be winners, **before** you spend the money to purchase the lottery tickets?



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Traditional patent system vs. PCT system



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Purchasing \$44K worth of lottery tickets

With PCT, you have at least a little bit of an idea whether or not the lottery tickets are going to be winners, **before** you spend the money to purchase the lottery tickets!

You have an International Search Report and a Written Opinion from the International Searching Authority

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What you would like to see

WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY				International application No. PCT/US2016/027448
Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement				
I. Statement				
Novelty (N)	Claims	1-17		YES
	Claims	NONE		NO
Inventive step (IS)	Claims	1-17		YES
	Claims	NONE		NO
Industrial applicability (IA)	Claims	1-17		YES
	Claims	NONE		NO

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What is the significance of a favorable Written Opinion?

A Written Opinion from an International Searching Authority is a document from somebody who “does not have a dog in this fight”.

It is a document from a neutral party.

Even if somebody is skeptical of many things, they will have no particular reason to be skeptical about a Written Opinion from an ISA

Back to using ePCT

- Yes it is a good idea to use ePCT

Using ePCT to create your Request

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

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Polling question

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Threshold issue when you are getting ready to file in RO/US

Is the RO/US “competent” to handle the PCT application that you are getting ready to file?

Figure out who is on your 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

Work out whether RO/US is “competent”

Avoid embarrassment – do not file in RO/US and find out later that you picked an RO that is not “competent”

Guess what – ePCT will validate this for you and will protect you from such embarrassment!

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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	Guyana
Andorra	Haiti
Argentina	Holy See
Bahamas	Kiribati
Bangladesh	Lebanon
Bhutan	Nepal
Bolivia	Pakistan
Burundi	Paraguay
Congo	Suriname
Fiji	Tonga
	Uruguay (will take effect soon)
	Venezuela
	Yemen

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

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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

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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

We realize that it is your RO that determines which ISA or ISAs 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”

It would take more than an hour to cover “applicant of convenience” thoroughly

Attend my live in-person seminar for this topic

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Is there non-English text in the PCT application that you are getting ready to file?

If there is, then the RO/US will not be “competent”.

You will be embarrassed later.

Guess what? ePCT might help you to avoid this embarrassment. If you tell ePCT that the application is not entirely in English, then ePCT will warn you that the RO/US will not be “competent”

Did I mention that it is good to be using ePCT?

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In the PCT application that you are getting ready to file, are you on the verge of trying to select an ISA that makes no sense given your fact pattern?

If you file by uploading a PDF request, you will not get the benefit of any validation against this mistake.

ePCT, on the other hand, will carry out a validation that will prevent you from trying to select an ISA that makes no sense given your fact pattern.

This will avoid embarrassment.

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In the PCT application that you are getting ready to file, are you on the verge of making a mistake in your priority claim?

If you file by uploading a PDF request, you will not get the benefit of any validation against this mistake.

Of course you should use ePCT! But even if you use ePCT you might choose “RO is requested to provide”, in which case you would not get the benefit of any validation of your attempted priority claim.

When you use ePCT, choose “IB is requested to retrieve the certified copy of the priority document from DAS”. ePCT will then validate the correctness of your priority claim information

This will avoid embarrassment.

(This is discussed in greater detail in *Best practices for presentation of priority claim in a PCT application*, Tuesday, November 12, 2024.)

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Polling question

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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, but 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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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

(Reminder: this will be covered in greater detail in *Best practices for presentation of priority claim in a PCT application*, Tuesday, November 12, 2024.)

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Polling question

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How badly can the practitioner screw up and still not lose the PCT filing date?

Failing to sign the Request?

This will not lose the PCT filing date!

Failing to properly sign the Request?

This will also not lose the PCT filing date.

But guess what? One of the ePCT validations is that it will warn you if it looks like you maybe failed to sign your Request

Suppose your way of providing your Request is to upload a PDF Request. Guess what? Patent Center **will not warn you** that you failed to sign your Request.

Did I mention that it is a good idea to use ePCT?

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How badly can the practitioner screw up and still not lose the PCT filing date?

Failing to pay the fees?

This will not lose the PCT filing date!

Failing to pay the correct amount of fees?

This will also not lose the PCT filing date.

But guess what? One of the ePCT functions is that it will try to work out what fees will need to be paid. If you wish, you can cross-check this with the total that you get in the Patent Center fee payment page.

Suppose your way of providing your Request is to upload a PDF Request. Guess what? Patent Center **will not** provide this cross-check opportunity.

Did I mention that it is a good idea to use ePCT?

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How badly can the practitioner screw up and still not lose the PCT filing date?

In ordinary domestic US patent practice, is it fatal to fail to provide at least one claim in your patent application?

No!

But the PCT treaty and rules are different. (It would require agreement of 158 contracting States to change them.) If it were to turn out that the would-be PCT patent application failed to contain at least one element which on the face of it appeared to be a claim, then it would turn out that the filer did not really file a PCT patent application.

Don't let this happen to you!

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Incorporation By Reference

There are many US patent practitioners who let themselves get into a bad habit of relying upon US-style IBR. By this we mean including IBR language in the body of their US patent applications.

The PCT system has 158 members. Most of them do not recognize US-style IBR.

The best practice is to avoid any reliance on US-style IBR when drafting a PCT application. If you think you need some text to support your PCT claims, do not mistakenly think you can just “bring in” that text from some other source using US-style IBR. It won’t work in most of the 158 places where you might later decide you want to try to get a patent from your PCT application.

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Incorporation By Reference

There is a specific narrow type of IBR in the world of PCT. It is called “rules-based IBR”.

To make it work, you must include “magic words” in the priority-claim section of your PCT request.

Your PDF Request might fail to include those magic words

Guess what? If you use ePCT to generate your Request, it automatically includes the magic words.

Did I mention that it is good to be using ePCT?

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Incorporation By Reference

What can “rules-based IBR” do for you?

If you fail to provide a figure or a page in your just-filed PCT application, you might get lucky and that missing figure or page might be present in a priority filing.

If so, then you might be able to use the rules-based IBR to “bring in” that missing figure or page from the priority filing from the priority document.

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Maximizing the potential scope of rules-based IBR

Sometimes the PCT application that I am getting ready to file has substantial disclosure beyond what was filed 11 months ago in the provisional

When this happens I will often take the to-be-filed PCT application and file it as a second provisional

This gives much greater potency to the rules-based IBR

But this also likely gives me a foreign filing license in this second provisional, thus removing any question of the availability of RO/IB.

See *Choosing a Receiving Office for your PCT application*.
Thursday, November 14, 2024.

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Provisional applications of limited quality

How often has each of us, from time to time, filed a provisional application that is of limited quality?

“Oh by the way,” the client says in a telephone call at 4:45 PM, “we are going to tell our invention to the world in a slide show tomorrow. Should I do anything about patent protection?”

And the provisional that gets filed is a document of limited quality from the point of view of being support for the claims of a subsequent patent application.

So let’s not just docket 12 months for filing that subsequent non-provisional patent application.

Maybe docket one or two months for the preparation and filing of a quality document.

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Polling question

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Docketing that 12 months

So we filed our first provisional. We docket:

- 12 months for filing our US non-provisional application
- 12 months for foreign filing (for example, a PCT application)

I suggest not filing that US non-provisional. Just file the PCT. Why spend money on the US non-provisional at a time when you don't yet know whether it is patentable? Later from the PCT process you will have an indication as to patentability. Then maybe spend money toward trying to get a US patent.

And by the way when that time comes, you can get the US case onto the Patent Prosecution Highway!

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Picking the timing of your PCT filing

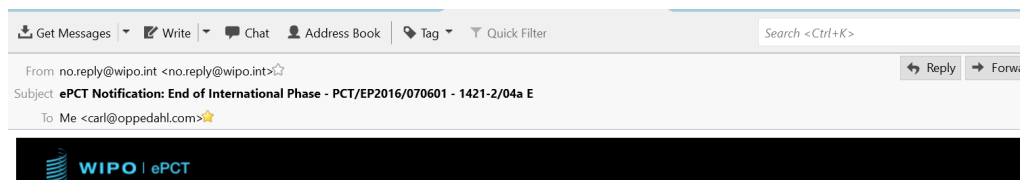
How often do we find ourselves filing our PCT application on ***the last possible day?***

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Polling question

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Isn't it nice?



ePCT Notification: End of International Phase - PCT/EP2016/070601 - 1421-2/04a E

The 30 months time limit (end of the international phase) for PCT/EP2016/070601 will expire in 1 month.

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How I do it

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

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Same-day corrections

- Keep in mind that if it is not yet midnight at the RO/US, and if you forgot Figure 7, you might be able to e-file it later the same day

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Drawings

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

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Color drawings

- Some practitioners think they are smarter than everybody else, and they have figured out how to use color drawings in PCT applications
- They are not smarter than everybody else
- There are over a hundred patent offices where you can enter the national or regional phase from a PCT
 - Over 90 of them simply refuse to honor color drawings
- You need to have the self-control to avoid trying to file color drawings in PCT applications
- Yes of course it is very hard work to do it, but you must find ways to communicate what you want using pure black and white
 - Clearly you need to do this hard work many months before PCT filing day. Do not postpone this hard work until just a few days before PCT filing day
 - Probably you need to address this at the time of filing the priority application
- Maybe use words in addition to the pure black and white drawings
- Maybe use completely different ways to portray what you want to portray
- Maybe use stippling (which means each pixel is either pure black or pure white)
- Do not try to rely upon color drawings in your PCT applications
- All of the above comments apply equally to the use of gray scale

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How to index drawings

- You can index drawings as B/W or non-B/W
- You might as well index them as non-B/W
- Can't hurt, might help

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What about the \$400 non-DOCX penalty?

- Wouldn't it be nice if there were a way to avoid absolutely all of the many malpractice risks of filing using DOCX, while nonetheless successfully avoiding having to pay the \$400 non-DOCX penalty?

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Wouldn't it be nice?

- The \$400 non-DOCX penalty does not apply to the filing of a new PCT application in the RO/US
- It likewise does not apply to the filing of papers for entry into the US national phase from a PCT application
- This is true even if the PCT application was filed in the RO/US
- This is a way to avoid completely all of the many malpractice risks of DOCX filing, whilst successfully avoiding having to pay the \$400 non-DOCX penalty

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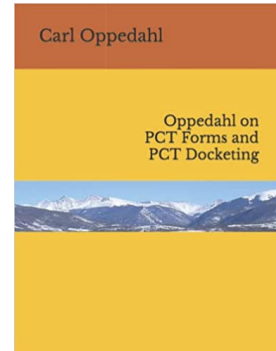
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Please complete the evaluation questionnaire

Thank you!