

Best practices for presentation of priority claim in a PCT application

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November 12, 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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Upcoming webinars

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<https://blog.oppedahl.com/pct-webinars/>

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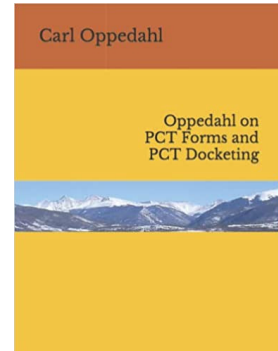
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- What docket may you clear because the PCT Form has arrived?
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- What new dockets should you set?
- What next steps should be carried out?
- What, if anything, needs to be reported to the client?



<https://shop.oppedahl.com>

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

Our main points in previous webinar

- 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

- 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

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Our main points today

- 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

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Note that these Best Practices apply to all Receiving Offices

- These best practices for handling of priority claims and priority documents apply to RO/US and RO/IB and all other Receiving Offices

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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

Making mistakes

We all make mistakes.

It is part of life.

In the world of patents, most mistakes are fixable if you don't mind paying a bunch of money or you don't mind filing a petition or if you have a really good excuse or you are very sorry.

When we get somebody new in our office we try to teach them about the particular kinds of mistakes that are not fixable even if you were willing to pay a bunch of money, even if you did not mind filing a petition, even if you had a really good excuse, and even if you were very sorry.

One of the worst mistakes in this category is messing up a priority claim and failing to catch the mistake until after the passage of the dreaded “4-and-16 date”.

Four months after the Application of Second Filing was filed, and sixteen months after the priority date, whichever is later.

We tell the new person, please if you are going to screw something up, please pick anything else. Not this. Please pick something else, anything else. Please please please.

Nonetheless, people screw up things like this all the time. They miss the dreaded 4-and-16 date and only later discover that they made some mistake in a priority claim.

Wouldn't it be nice if there were something in the PCT system that would protect us from committing malpractice in this area?

See if you can guess where I am going with this!

Further reasons to use that ADS

Failing to use an ADS in that US provisional application means that it will not be available to the DAS system.

If it is not available to the DAS system, then you will fail to receive the validation benefit of the priority claim when entering the priority claim in ePCT.

This means that if you had inadvertently gotten a digit wrong in the priority claim in your PCT application, you risk not discovering your mistake until after the dreaded “4 and 16 date”.

If you only discover your mistake after the dreaded “4 and 16 date” then in most Offices around the world it is too late to fix the priority claim and it is irrevocably lost.

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Do you want to be the last practitioner who touched the PCT file prior to irrevocably losing a priority claim?

No I thought not. So let's go through that one again. Let's review the Best Practices:

- When you are filing any US patent application that might later serve as a priority application, always use an ADS, so that the application will be available to DAS.
- This includes every US provisional patent application that you file.
- Make sure that you have established the correct non-inventor applicant or applicants.
- Always docket to check later that the application does actually become available to DAS.
- Always set up “tracking” in DAS for each such application.
- Always obtain a Certificate of Availability from the DAS system for each such application.

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Learning about DAS

- Go to <https://blog.oppedahl.com>
- Search “DAS quiz”

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<https://blog.oppedahl.com/see-if-you-can-pass-a-simple-quiz-on-the-das-system/>

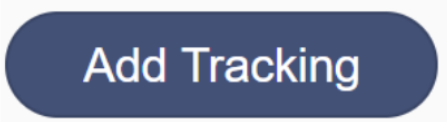
JUNE 2, 2018 BY CARL

See if you can pass a simple quiz on the DAS system

Here's a simple quiz about the DAS system. Pass this quiz and it means you know quite a bit about DAS.

Okay so we are working with US application number 62/411,157 which was filed October 21, 2016. The confirmation number is 7609.

Part 1 of the quiz is for you to “add tracking” in DAS so that you would hear about it if a patent office were to

A dark blue rounded rectangular button with the text "Add Tracking" in white.

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Action steps

- Identify every application in your portfolio that has a chance of becoming a priority document
- Check to see if you already have a Certificate of Availability in the DAS system
- If you don't, get one!
- To do this, set up "tracking" in the DAS system

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Patent Offices that are not a "Depositing Office" for utility applications

- Of the ten biggest patent offices, who is missing from the list of Depositing Offices?
- Only Germany (fifth largest, but not a Depositing Office)

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PCT Receiving Offices that are not a “Depositing Office”

- Of the ten biggest Receiving Offices, who is missing from the list of Depositing Offices?
- RO/US (first place, but not a Depositing Office)

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Do you want to be the last practitioner who touched the PCT file prior to irrevocably losing a priority claim?

Continuing our review of the Best Practices...

- For each of the applications for which you plan to make a priority claim, check to make sure that you have a Certificate of Availability in the DAS system.
- As you enter each priority claim into ePCT, you will be entering the application number, the filing date, and the identity of the OFF into ePCT.
- ePCT will ask how you plan to provide a certified copy of the priority application to the IB.

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Do you want to be the last practitioner who touched the PCT file prior to irrevocably losing a priority claim?

Continuing our review of the Best Practices:

- ePCT will ask how you plan to provide a certified copy of the priority application to the IB.
- Here is the important part. You should tell ePCT that you want to retrieve an electronic certified copy from a digital library.
- This is geek talk and it means “retrieve it from the DAS system”.
- This means that ePCT will cross-check the application number that you entered, and the filing date that you entered, and the identity of the OFF that you entered, against the DAS system, ***in real time and before your very eyes.***

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Do you want to be the last practitioner who touched the PCT file prior to irrevocably losing a priority claim?

Continuing our review of the Best Practices...

This means that ePCT will cross-check the application number that you entered, and the filing date that you entered, and the identity of the OFF that you entered, against the DAS system, ***in real time and before your very eyes.***

- Let’s suppose you got a digit wrong in the application number.
- Let’s suppose you entered April 6 when you meant June 4 (you know, a metric month instead of an American month).

ePCT will catch your mistake! You have just been saved from a malpractice lawsuit or worse.

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Making sure your priority application found its way into DAS

- Which in turn required using an ADS, not just a Provisional Cover Sheet, if the application you were filing was a US provisional
- Which calls for you to check to make sure the patent office really did make the application available to DAS
- That is, making sure that you can get a Certificate of Availability
- While you are there, you might as well set up "tracking" in DAS

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Troubleshooting the availability to DAS

- in the Transaction History ("TH") tab in Private PAIR, it says "Applicants have given acceptable permission for participating foreign", and
- in the Filing Receipt ("FR"), it says "A proper Authorization to Permit Access to Application by Participating Offices (PTO/SB/39 or its equivalent) has been received by the USPTO."

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Note that for USPTO to make the priority application available to DAS, three things need to have happened:

- you gave permission using the ADS or the Form PTO/SB/39, and
- the USPTO gave an official Filing Date to the application, and
- the USPTO granted a Foreign Filing License ("FFL").

Filing receipt example

Inventor(s)

None

Applicant(s)

Power of Attorney:

Carl Oppedahl--32746

Permission to Access Application via Priority Document Exchange: Yes

Permission to Access Search Results: Yes

Applicant may provide or rescind an authorization for access using Form PTO/SB/39 or Form PTO/SB/69 as appropriate.

If Required, Foreign Filing License Granted: 06/07/2022

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is **US 63/365,497**

Projected Publication Date: None, application is not eligible for pre-grant publication

Transaction history example

06/17/2022	Change in Power of Attorney (May Include Associate POA)
06/08/2022	Electronic Review
06/08/2022	Email Notification
06/08/2022	Email Notification
06/08/2022	Application ready for PDX access by participating foreign offices
06/08/2022	Notice Mailed--Application Incomplete--Filing Date Assigned
06/08/2022	Filing Receipt
05/30/2022	PTO/SB/69-Authorize EPO Access to Search Results
05/30/2022	Applicants have given acceptable permission for participating foreign
05/30/2022	Entity Status Set To Undiscounted (Initial Default Setting or Status Change)
05/30/2022	Initial Exam Team nn

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Digital Access Service
(DAS)



To:

carl@oppedahl.com

CERTIFICATE OF AVAILABILITY OF A CERTIFIED PATENT DOCUMENT IN A DIGITAL LIBRARY

The International Bureau certifies that a copy of the patent application indicated below has been available to the WIPO Digital Access Service since the date of availability indicated, and that the patent application has been available to the indicated Office(s) as of the date specified following the relevant Office code:

Document details: Country/Office: US

Filing date: 20 Sep 2021 (20.09.2021)

Application number: 63261359

Date of availability of document: 25 Sep 2021 (25.09.2021)

The following Offices can retrieve this document by using the access code:

AR, AT, AU, BE, BR, CA, CL, CN, CO, DK, EA, EE, EP, ES, FI, GB, GE, IB, IE, IL, IN, JP, KR, LV, MA, MX, NL, NO, NZ, PL, SE, US

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To:

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Document details: Country/Office: CN

Filing date: 06 Sep 2021 (06.09.2021)

Application number: 2021305872055

Date of availability of document: 06 Dec 2021 (06.12.2021)

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IN, IT, JP, KR, LT, MC, MX, NO, PL, US

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Form PCT/IB/304

- Obtention
- The dreaded “NR”
- Page 99 of PCT Forms book

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PATENT COOPERATION TREATY

PCT

NOTIFICATION CONCERNING SUBMISSION,
OBTENTION OR TRANSMITTAL
OF PRIORITY DOCUMENT

(PCT Administrative Instructions, Section 411)

From the INTERNATIONAL BUREAU

To:

Date of mailing (day/month/year)			
Applicant's or agent's file reference			
International application No.	IMPORTANT NOTIFICATION		
International publication date (day/month/year)	International filing date (day/month/year)		
	Priority date (day/month/year)		
Applicant			
<p>The applicant is hereby notified of the date of receipt (or of obtaining by the International Bureau) of the priority document(s) relating to all earlier application(s) whose priority is claimed. Unless otherwise indicated by the letters "NR", in the right-hand column or by an asterisk appearing next to the date of receipt, the priority document concerned was submitted or transmitted to or obtained by the International Bureau in compliance with Rule 17.1(a), (b) or (b-bis). This Form replaces any previously issued notification concerning submission, transmittal or obtaining of priority documents.</p>			
Priority date	Priority application No.	Country or regional Office or PCT receiving Office	Date of receipt of priority document
_____	_____	_____	_____

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ePCT notification

EPCT will notify you of outstanding priority documents
This might save you from embarrassment or worse

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ePCT reports

- You can generate a report of all PCT cases having outstanding priority documents
- This can save you from embarrassment or worse

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Live demo

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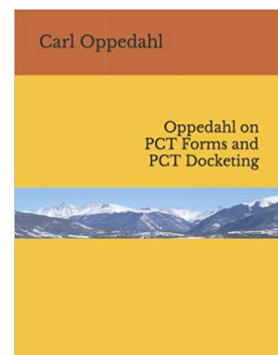
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Please complete the evaluation questionnaire

Thank you!