

Selecting a Receiving Office, RO/US versus RO/IB

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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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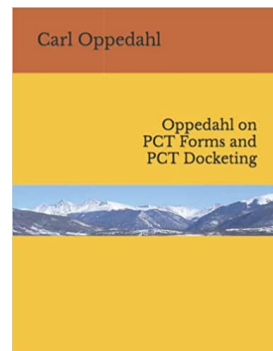
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- What docket may you clear because the PCT Form has arrived?
- What docket, if you had not previously set, should count as a warning of a docket failure?
- What dates and check-boxes should you closely review on the PCT Form and what is not so important to review on the PCT Form?
- What new dockets should you set?
- What next steps should be carried out?
- What, if anything, needs to be reported to the client?



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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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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

10 Request

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 is in Patentcenter

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If you are a US filer, you are using Patent Center

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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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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I will now ask our US filers ... 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 Patentcenter?

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
Patentcenter and is like the old 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 Patentcenter and the
old 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 Patentcenter and 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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Threshold issue in picking an RO

Figure out who is on 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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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

You get to control your applicant list!

You can make your applicant list into whatever you want

We call this “applicant of convenience”

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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” nine of the 24 possible ISAs

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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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Advantages of using RO/US

- Many filers are very familiar with Patent Center. For such filers it is comfortable to use RO/US because the filing path is through Patent Center.
- Filers who are familiar with Patent Center 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
- 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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E-Filing

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

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Filing fee reductions

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

- \$120 – e-filed (Patentcenter) but the Request is not a ZIP file
- \$219 – e-filed (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:

- \$219 – e-filed (ePCT)
- \$329 – e-filed and the application body is in XML

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Transmittal Fee

- RO/US: \$260, but:
 - \$104 if filing as a small entity
 - \$52 if filing as a micro-entity
- RO/IB: \$117

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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
 - \$840 if filing as a small entity (\$420 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, PH, 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?
- It is unwise to use “RO to forward”, why?
- RO/IB: you can use WIPO’s DAS system
- Either approach is free of charge

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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 likely 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"

But good news! The most recent version of ePCT will usually catch this and force the filer to use the mere "address for correspondence" status, thus saving this embarrassment of being demoted

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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

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 Patent Center and the old 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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Countries where the only RO available is RO/IB

United Arab Emirates (AE)
Antigua and Barbuda (AG)
Angola (AO)
Barbados (BB)
Dominica (DM)
Guatemala (GT)
Kuwait (KW)
Laos (LA)
Saint Lucia (LC)
Sri Lanka (LK)
Madagascar (MG)
Nigeria (NG)
Saint Vincent and the Grenadines (VC)

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Okay I give up. What exactly is “the PCT system that is like Patent Center or the old 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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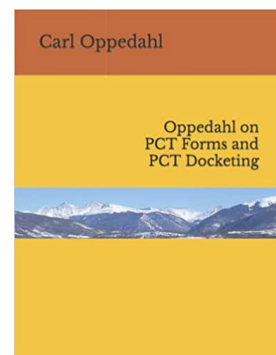
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Please complete the evaluation questionnaire

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Thank you!

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