

Choosing an International Searching Authority for your PCT application

Carl Oppedahl

November 19, 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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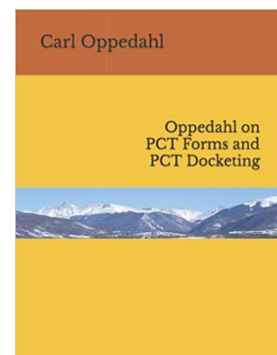
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- Tuesday, January 7 to Thursday, January 9, 2025
- Network with other PCT enthusiasts during the breaks
- Ask questions live and face-to-face
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- What docket, if you had not previously set, should 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?
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- What next steps should be carried out?
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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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Outline for today

Review the background for selection of ISAs

Discuss factors that might influence your choice of an ISA

Best Practices for communicating with ISAs (via ePCT)

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US focus

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

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

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There are 25 ISAs

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

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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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Example: maybe you are accustomed to only being able to pick ISA/EP

Example: applicant is from AL, AT, BA, BW, CH, CY, DE, EE, FR, GB, GR, HR, IE, IT, LU, ME, MK, MT, MW, NL, PT, SC, SI, TN

This would normally mean the only choice for ISA is ISA/EP

Suppose your claims are very close to being pure business methods or are very close to being pure software implementations

ISA/EP might not be your best choice for an ISA

Maybe add an Applicant of Convenience for one designation (my favorite is Malawi) who is from the US

Now you can also pick ISA/AU, ISA/IL, ISA/JP, ISA/KR, ISA/SG, ISA/RU, ISA/US

Some applicants in this situation pick ISA/KR

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

- RO/SA has specified CA, CN, EG, EP, JP, KR, RU, SA, SG and US

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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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A brief mention of Patentcenter

- You need to start contributing to the testing and trouble reporting for Patentcenter.
- Join the Patentcenter listserv. (This is not Ideascale!)

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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: \$1989
- SG: \$1633
- AU: \$1407
- JP: \$1173
- IL: \$1066
- KR: \$879
- US small entity: \$872
- PH: 600
- RU: \$549
- US micro entity: \$436

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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 phase, 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/PH 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 Chinese 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))

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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

- Numerical limitation of no more than 100 IAs per fiscal quarter for US-based filers

■ ISA/PH

- Numerical limitation of no more than 75 IAs per fiscal quarter for US-based filers

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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

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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/PH: free if ISA is provided by email
 - 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 – get a mailbox

- ISA/EP only communicates on paper
- Except that you ought to set up a mailbox

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The ISA might cite references in its own tongue

- Some practitioners report receiving lots of Russian-language references from ISA/RU
- Some practitioners report receiving lots of Chinese-language references from ISA/CN
- Those practitioners tell me they don't like having to pay to get the references translated into English
- “Doctor, it hurts when I move my arm like this!” “So, don't move your arm like that!”

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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/PH/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 (right?)

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

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

This is discussed in the *PCT Forms* book at pages 10 and 132

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

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ePCT saves the day

ePCT can generate a report listing all
pending PCT cases that are still awaiting
Form PCT/ISA/202

Maybe generate this report once a month

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Docketing relating to the ISA

Maybe you receive the Invitation to Pay Additional Fees (Form PCT/ISA/206 (*PCT Forms* 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

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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

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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

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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

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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 that 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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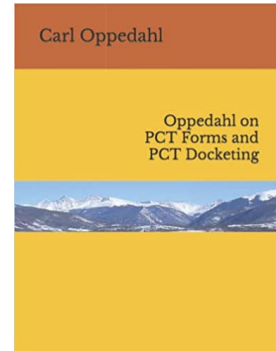
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Please complete the evaluation questionnaire

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Thank you!

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