

**Making best use of ePCT
to manage your PCT applications**

Carl Oppedahl

December 3, 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 webinar

Tuesday, December 10, 2024. 11AM to 12:30 PM Mountain time. *Making best use of PCT Declarations in your PCT application.* This webinar will be of potential interest to attendees in all locations.

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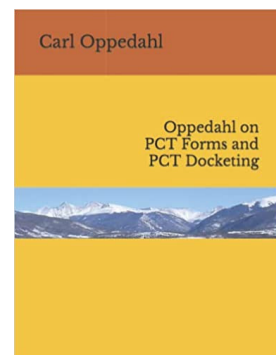
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- Tuesday, January 7 to Thursday, January 9, 2025
- Network with other PCT enthusiasts during the breaks
- Ask questions live and face-to-face
- **Discount coupon expires December 4**
- <https://blog.oppedahl.com/attend-a-2%bd-day-live-in-person-patent-cooperation-treaty-seminar-in-beautiful-colorado/>

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A PCT Form arrives in your PCT case ...

- 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?
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Helpful PCT resources

- WIPO's PCT Distance Learning Course
- WIPO video series (Matthias Reischle)
 - **Learn the PCT: Episode 4 - Declarations under Rule 4.17**
 - <https://www.youtube.com/watch?v=9j8-IZBksbg>
 - Twelve thousand views and 76 "likes"!
- The PCT listserv (email discussion group)
 - https://oppedahl-lists.com/mailman/listinfo/pct_oppedahl-lists.com
 - Over 900 members
- PCT section of the *Ant-Like Persistence* blog

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Goals for today

- In the next hour or so, we hope to summarize some of the “greatest hits” in the benefits of ePCT
- But in Spring of 2023 I presented sixteen webinars about the benefits of ePCT
- This is over nineteen hours of video
- This is over eight hundred presentation slides
- We cannot cover nineteen hours of material in ninety minutes

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Binge watching

- You have an opportunity to binge-watch ***more than nineteen hours of training*** about ePCT. Who would have thought such a thing could be possible? And yet here it is ... recordings for sixteen webinars about ePCT. You can also click to download the presentation materials, which comprise ***more than eight hundred presentation slides***.
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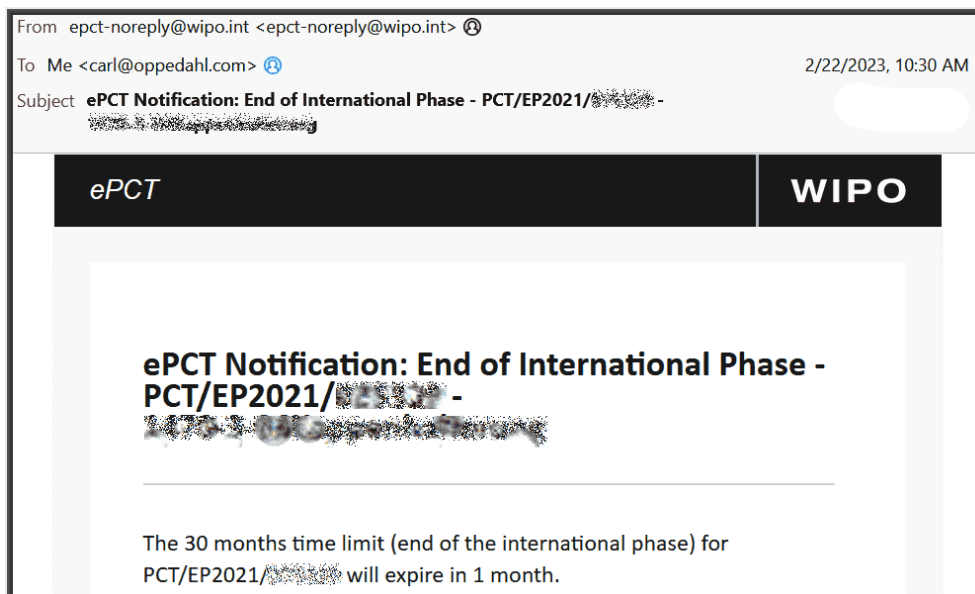
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Wouldn't it be nice?

- Imagine that Patent Center would send you a reminder:
 - There are two weeks remaining to respond to that Office Action
 - There are two weeks remaining to pay that Issue Fee





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ePCT provides warnings of upcoming due dates



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ePCT provides warnings of upcoming due dates

From epct-noreply@wipo.int <epct-noreply@wipo.int> 
To @oppedahl.com 
Subject **ePCT Notification: Time Limit for Article 19 Amendments - PCT/IB2022/**

2/12/2023, 6:31 PM

ePCT

WIPO

ePCT Notification: Time Limit for Article 19 Amendments - PCT/IB2022/ **P012WO-3**

The time limit for submitting Article 19 amendments for PCT/IB2022 / will expire in 2 weeks.

Amendments received by the IB after the time limit are still accepted if they have been received before the technical preparations for international publication have been completed.

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ePCT provides warnings of upcoming due dates


From epct-noreply@wipo.int <epct-noreply@wipo.int> 
To @oppedahl.com 
Subject **ePCT Notification: Technical Preparations for Publication - PCT/IB2022/**

2/15/2023, 7:08 PM

ePCT

WIPO

ePCT Notification: Technical Preparations for Publication - PCT/IB2022/ **P058WO2**

Technical preparations for international publication for PCT/IB2022 / are scheduled to close in 2 weeks.

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Wouldn't it be nice?

- Imagine that Patent Center would send you a notification:
 - Somebody changed the access rights to one of your patent applications

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ePCT provides notifications of events of interest

From: epct-noreply@wipo.int <epct-noreply@wipo.int> @

To: carl@oppedahl.com @

2/22/2023, 10:30 AM

Subject: ePCT Notification: Access rights changed by another person - PCT/EP2021/1470 - Carl Oppedaahl

ePCT

WIPO

ePCT Notification: Access rights changed by another person - PCT/EP2021/1470 - Carl Oppedaahl

This is to notify you that Access Rights have been modified as follows for PCT/EP2021/1470 for which you are eOwner.

User Name	New Access Rights	Modified by	Date/Time
carl OPPEDAHL	eOwner	Carl Oppedaahl	22 February 2023 12:44:12 CET
Carl Oppedaahl	eOwner	carl OPPEDAHL	22 February 2023 12:55:17 CET

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Wouldn't it be nice?

- Imagine that Patent Center would send you a notification:
 - The 4-and-16 date is nigh, and we have not yet managed to accomplish retrieving the electronic certified copy of the priority document from DAS

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ePCT provides warnings of failures and problems

- Automatic email warning you if there is a priority document outstanding
 - This helps to save you from the dreaded 4-and-16 date

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To get all of these benefits and much, much more ...

- All you need to do is:
 - Get a WIPO user ID and password
 - Turn on two-factor authentication (“strong authentication”)
 - Get all of your pending PCT applications into your ePCT workbench
 - Have the self-control not to turn off any of the automatic notifications

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Who should do this?

- Everyone in your office
- Not merely the paralegals
- Every attorney should do this
 - Yes, even the dinosaur attorneys
 - It’s not that difficult to do
 - Get a WIPO user ID and password
 - Turn on two-factor authentication

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Important best practices for ePCT

- Make sure that each PCT application in your workbench has ***at least two eOwners***
 - In our office, everybody is an eOwner
- Make sure that each user has set up ***at least two forms of two-factor authentication***

Wouldn't it be nice?

- Imagine that Patent Center would validate your e-filing submission:
 - We notice that you did not correctly e-sign your Application Data Sheet

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Validations

- Some Offices only do validations that benefit the Office
- ePCT does dozens of validations that specifically benefit the filer
- One example – missing signature on e-filed form

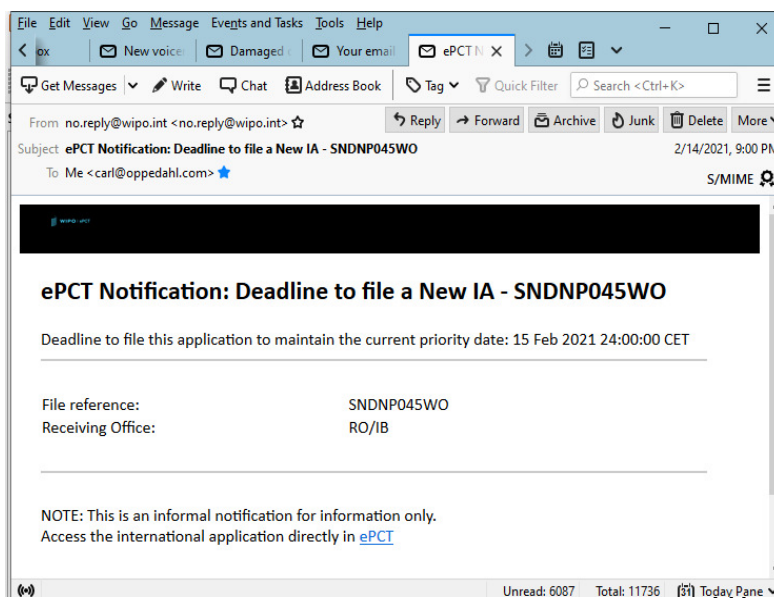
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Wouldn't it be nice?

- Imagine that Patent Center would notice that you filed a provisional application 11½ months ago:
 - We remind you that there are only two weeks remaining to file your US non-provisional application
 - We remind you that there are only two weeks remaining to do foreign filing

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ePCT will remind you of such an upcoming filing due date



Six reasons for the attorney to be very familiar with ePCT

- The attorney needs to supervise the nonlawyer assistant so that proper ethical rules and standards are followed
- The attorney needs to supervise the nonlawyer assistant to maintain service quality
 - This is to minimize risk of embarrassment in front of the client due to making mistakes
 - This is to minimize risk of mistakes leading to professional liability exposure (minimizing malpractice risk)
- How can the attorney possibly accomplish this supervision if the attorney does not know how to do the things that the assistant is doing?
- By participating in ePCT, the attorney can receive reminders about upcoming due dates
- By participating in ePCT, the attorney can keep abreast of events and developments
- What if some task needs to be done and the attorney is the only person available to do it? Surely it is good for the attorney to know how to do the things the assistant usually carries out!

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The attorney needs to supervise the nonlawyer assistant so that proper ethical rules and standards are followed

- DR1-104(C): A law firm shall adequately supervise, as appropriate, the work of ... nonlawyers who work at the firm.
- ABA model guideline: A lawyer is responsible for all of the professional actions of a paralegal performing service at the lawyer's direction. A lawyer must directly supervise paralegals employed by the lawyer to ensure that, in every circumstance, the paralegal is acting in a manner consistent with the lawyer's ethical and professional obligations.
- Rule 5.3(b): A lawyer having direct supervisory authority over the nonlawyer shall make reasonable efforts to ensure that the person's conduct is compatible with the professional obligations of the lawyer.

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The attorney needs to supervise the nonlawyer assistant to maintain service quality

- This is to minimize risk of embarrassment in front of the client due to making mistakes
- This is to minimize risk of mistakes leading to professional liability exposure (minimizing malpractice risk)
- Note that this is not the same as the previous point (ethics). This is simply avoiding getting sued for malpractice and avoiding looking stupid. You could say that this is simply trying to run a business well.

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How can the attorney possibly accomplish this supervision if the attorney does not know how to do the things that the assistant is doing?

- We identified at least three distinct reasons why supervision is necessary:
 - Ethics rules require it
 - Avoiding looking stupid in front of clients
 - Avoiding getting sued for malpractice
- How can the attorney have any chance of doing proper supervision if the attorney does not even know how to do these things (for example use of ePCT)?

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Who is the one who will get sued if the assistant makes some mistake?

- Common sense tells you it is the attorney who will get sued
- The plaintiff will hold the attorney responsible
- How can the attorney have any chance of doing proper supervision if the attorney does not even know how to do these things (for example use of ePCT)?

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Get all of your previously filed PCT applications into your workbench

- Clearly it is a Best Practice to get every one of your previously filed PCT applications into your ePCT workbench
- Then you get the benefit of automatic notifications and warnings

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Any time you are getting ready to file a new PCT application ...

- Do not use a fillable PDF form
 - That would be tantamount to malpractice
- Do not use PCT-SAFE
 - That software has not been updated in over a year
- Only use ePCT

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Only use ePCT when filing a new PCT application

- When filing in RO/IB (preferred), use ePCT to click “submit”
- When filing in RO/US (not preferred but sometimes the only option) use ePCT to generate a ZIP file
 - Upload the ZIP file to Patent Center

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As you get ready to create a PCT Request ...

- Ensure that each priority application was previously made available to DAS
- Ensure that “tracking” was previously set up in DAS for each priority application
- Ensure that a Certificate of Availability from DAS was previously obtained for each priority application

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When you are preparing a PCT Request ...

- Do not use a fillable PDF form
- Do not use PCT-SAFE
- Use ePCT
 - Do not select “Receiving Office is requested to transmit certified copy to the IB”
 - Do select “International Bureau is requested to retrieve electronic certified copy from DAS”
 - This will validate the priority claim against the DAS system
 - This will reduce risk of malpractice with a defective priority claim

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Carrying out difficult tasks

- How easy or difficult is it to update your inventor list at the USPTO?
- How easy or difficult is it to update your applicant list at the USPTO?
- How easy or difficult is it to update an inventor address at the USPTO?
- How easy or difficult is it to update an applicant address at the USPTO?

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Updating such things in a PCT application ...

- If it is a PCT application instead of a US application, how do we update such things?
- A PCT Rule 92*bis* request
 - Specifically as an ePCT “action”

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How do do things completely wrong, example 1

- Take something that should be sent to the IB, and send it somewhere else, for example to a Receiving Office
- The Receiving Office might take days or weeks to forward it to the IB
- By then it could be too late for the IB to act on it

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How do do things completely wrong, example 2

- Take something that should be sent to the IB as an ePCT “**action**”, and send it as a mere ePCT “upload”, or worse yet, by some path that is not ePCT
- This will introduce delays
- This risks the document getting placed in an incorrect file
- This forces somebody to hand-key information

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E-filing follow-on documents with ISAs and IPEAs

- What are the ISAs and IPEAs most commonly selected by US applicants?
 - ISA/EP and IPEA/EP
 - ISA/KR and IPEA/KR
 - ISA/US and IPEA/US

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	Can Send ePCT Messages?	Can upload Documents?	EDI or instant?
ISA/AU	yes	yes	instant
ISA/EP	no	yes	EDI
ISA/IL	no	no	neither
ISA/JP	no	no	neither
ISA/KR	no	yes	EDI
ISA/RU	no	yes	EDI
ISA/SG	no	yes	EDI
ISA/US	no	no	neither

How trendy, modern and up-to-date are the ISAs?

(It is exactly the same for the IPEAs.)

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Who is trendy, modern, and up-to-date?

- ISA/EP and IPEA/EP – yes TMAUTD
- ISA/KR and IPEA/KR – yes TMAUTD
- ISA/US and IPEA/US – no

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How to file follow-on documents at ISA/US or IPEA/US if PCT was not filed in RO/US?

- Use USPTO Form PTO-2248 to associate the PCT application with a customer number
- Call the EBC to get the confirmation number

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What if you picked ISA/EP or IPEA/EP?

- If you have not already done so, set up an EPO mailbox
- Associate it with the correspondence email address of your PCT applications

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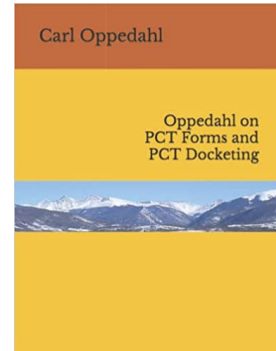
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Please complete the evaluation questionnaire

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Thank you!

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