

PCT for Paralegals

Patent Resources Group
Institute for Paralegals
Patent Administration: A Foundation for Success
September 22, 2016
Philadelphia, PA

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Disclaimer

These presentation materials and the accompanying discussion are not legal advice. Reading the materials or attending the presentation do not make you a client of Carl Oppedahl or Oppedahl Patent Law Firm LLC.

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Today's goals ... we will discuss:

- Benefits of and reasons to use PCT
- The various Offices that make the PCT possible
- A typical sequence of events for a PCT application
 - Paris Convention
- Skills and tasks that are often needed to take care of PCT applications

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Skills and tasks that are often needed

- Communicating with the client about non-US filings
- Making use of online and software resources
 - EFS-Web
 - Private PAIR
 - PCT-SAFE
 - ePCT
- Being able to log in to ePCT

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Skills and tasks that are often needed

- Collecting information for the Request
 - Selecting a Receiving Office
 - Selecting an International Searching Authority
 - Identifying the priority application(s)
 - Collecting documents for the PCT application
- Building the Request and e-filing
 - Request for RO/US using PCT-SAFE
 - Request for RO/US using ePCT
 - E-filing the PCT application in RO/US
 - E-filing in RO/IB

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Skills and tasks that are often needed

- Communicating with the client about the filed PCT application
- Docketing PCT
- Receiving and reporting the International Search Report and Written Opinion
 - Client decisions after receiving the ISR/WO

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Skills and tasks that are often needed

- Filing an Article 19 amendment
- Filing a Demand and Article 34 amendment
- Filing a 92*bis* request
- Entry into national phase and regional phase outside of the US

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Skills and tasks that are often needed

- Pursuing US patent protection from a PCT application
 - US national phase
 - Bypass continuation
 - Patent Prosecution Highway
- Getting older PCT applications loaded into ePCT
- Generating useful reports from ePCT
 - Applications with priority documents outstanding
 - Applications with Form PCT/ISA/202 outstanding

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Topics that come up less frequently

- Informal comments to the ISR/WO
- Third-party submissions of prior art
- Applicant disclosures of prior art
- Supplementary International Search
- Restoration of the Right of Priority
- Incorporation By Reference

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Covering all of this in just one day

- To cover all of these topics in just one day, we will cover some topics in more detail and other topics in less detail
- As for tasks carried out in ePCT, you will find that ePCT is often nearly self-explanatory and has good online help
- The PCT Applicant's Guide should be your constant resource
- As for some tasks or topics, these materials will simply identify the task or topic so that you know about it, and you will need to consult the Applicant's Guide for details

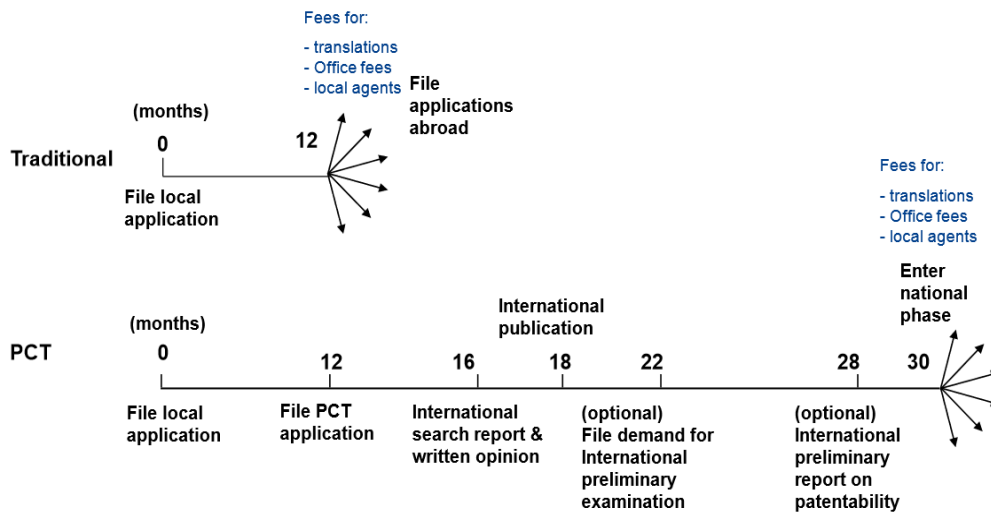
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Benefits of and reasons to use PCT

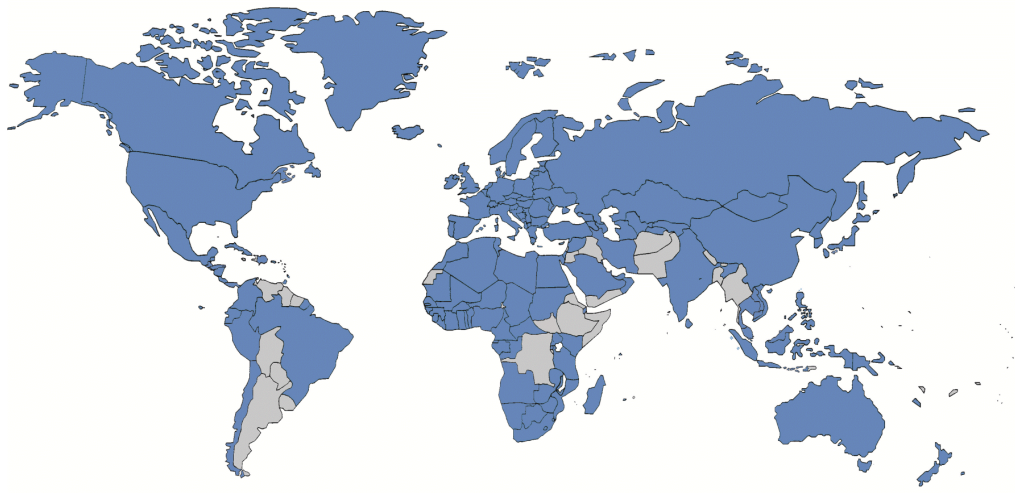
- The PCT offers a prompt and early preliminary indication as to patentability
- The PCT permits postponing expensive and difficult foreign-filing decisions for an extra eighteen months
- The PCT permits a single filing in a single format to be used in multiple offices around the world

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Traditional patent system vs. PCT system



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Picking Paris or PCT?

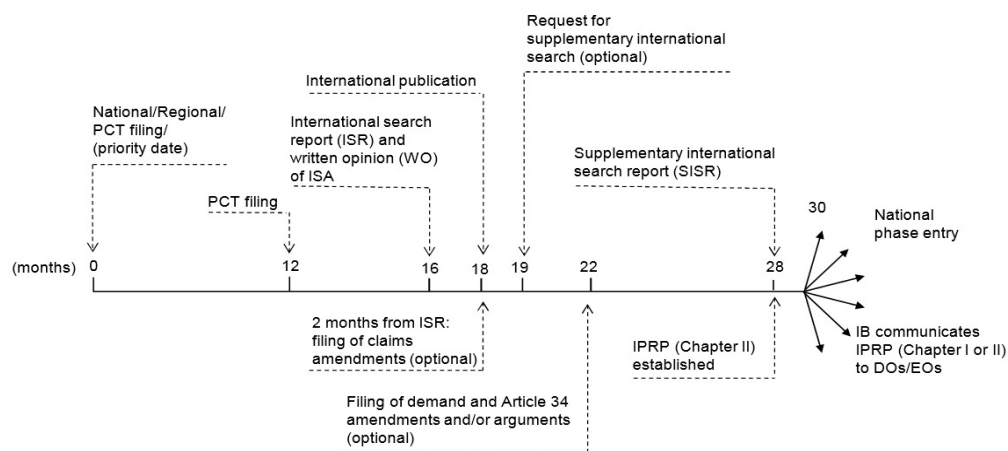
- Client might choose to do Paris filings, that is, direct filings in foreign countries at P+12 (priority date plus twelve months) or sooner
- Or client might choose to do a PCT filing
 - The PCT filing would also be at P+12 or sooner
- Or the client might have filed a PCT filing as the first filing ever

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What PCT is

- PCT is not a “patent granting system”
- PCT is only a “patent filing system”
- Each designated Office makes its own decision whether to grant a patent
- There is no such thing as a “PCT Patent”
 - While we are on the topic of things that do not exist, there is no such thing as a “provisional patent”

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Where is the PCT patent office?

- There are many PCT patent offices
 - Receiving Office
 - International Searching Authority
 - International Bureau
 - International Preliminary Examining Authority
 - Designated Office
 - Elected Office

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Where is the Receiving Office?

- There are about 112 Receiving Offices
- US filers will most often encounter RO/US (the USPTO) and RO/IB (the International Bureau)
- The RO receives your PCT application, gives it an application number, checks the application for formalities, and makes two copies of the application
- The RO sends the Search Copy of the application to the ISA
- The RO sends the Record Copy of the application to the IB

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Where is the International Searching Authority?

- There are twenty-one ISAs
- US filers will most often encounter:
 - ISA/AU (Australian patent office)
 - ISA/EP (European Patent Office)
 - ISA/IL (Israeli patent office)
 - ISA/JP (Japanese patent office)
 - ISA/KR (Korean patent office)
 - ISA/SG (Singapore patent office)
 - ISA/RU (Russian patent office)
 - ISA/US (USPTO)

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What does the ISA do?

- The ISA does many things, the most visible of which are:
 - Receiving the Search Copy from the RO
 - Establishing the International Search Report
 - Establishing the Written Opinion
 - Sending the ISR/WO to the applicant
 - Sending the ISR/WO to the International Bureau

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Where is the International Bureau?

- The International Bureau is in Geneva, Switzerland
- The IB does many things, the most visible of which are:
 - receives the Record Copy from the RO
 - Loads the IA (international application) into Patentscope and into ePCT
 - Receives the ISR/WO from the ISA
 - Carries out the publication of the PCT application on the first Thursday following eighteen months after the priority date

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Where is the International Preliminary Examining Authority?

- There are twenty-one IPEAs, one for each ISA
- US filers will most often encounter:
 - IPEA/AU
 - IPEA/EP
 - IPEA/IL
 - IPEA/JP
 - IPEA/KR
 - IPSA/SG
 - IPEA/RU
 - IPEA/US

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What does the IPEA do?

- In 90% of cases, there is no IPEA connected with the application, because the applicant does not choose to file a Demand
- If the applicant files a Demand then the IPEA considers arguments and/or amendments made by the applicant
- Maybe the result for the applicant will be a more favorable result than the WO of the ISA

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Where is the Designated Office?

- There are about 120 Designated Offices
- A Designated Office is an office in which the applicant chooses to enter the national phase (at a time when no Demand has been filed)

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Where is the Elected Office?

- There are about 120 Elected Offices (one for each Designated Office)
- An Elected Office is an office in which the applicant enters the national phase (at a time when a Demand has been filed)
- Nowadays the terms “Designated Office” and “Elected Office” are used collectively as “DO/EO”

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Function of DO/EO

- The DO/EO office in a particular patent office handles national-phase entry at that patent office
- US filers will most often encounter:
 - DO/US
 - DO/EP
 - DO/JP
 - DO/KR
 - DO/CN

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Which offices are found within the USPTO?

- USPTO has RO/US
- USPTO has ISA/US
- USPTO has IPEA/US
- USPTO has DO/EO/US

These are different departments within the USPTO

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A first typical sequence of events for a PCT application

- Provisional patent application filed (“P” filing date)
- PCT application filed at P+12 (priority date plus three months)
- RO sends the Search Copy to the International Searching Authority (“ISA”)
- RO sends the Record Copy to the International Bureau

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A first typical sequence of events for a PCT application

- The ISA establishes the International Search Report and Written Opinion at about P+16
- The IB publishes the PCT application at about P+18
- Just before P+30, the applicant enters the national phase in the US, China (“CN”), and Japan (“JP”)
- Just before P+31, the applicant enters the national phase in EPO (“EP”) and South Korea (“KR”)
- Each of these Offices (US, CH, JP, EP, and KR) is termed a “Designated office”

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A second typical sequence of events for a PCT application

- Provisional patent application filed (“P” filing date)
- PCT application filed at P+12 (priority date plus three months)
- RO sends the Search Copy to the International Searching Authority (“ISA”)
- RO sends the Record Copy to the International Bureau

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A second typical sequence of events for a PCT application

- The ISA establishes the International Search Report and Written Opinion at about P+16
- The applicant files a Demand and an Article 34 amendment
- The IB publishes the PCT application at about P+18
- The International Preliminary Examining Authority establishes an International Preliminary Report on Patentability under Chapter II of the Treaty at about P+28

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A second typical sequence of events for a PCT application

- Just before P+30, the applicant enters the national phase in the US, China (“CN”), and Japan (“JP”)
- Just before P+31, the applicant enters the national phase in EPO (“EP”) and South Korea (“KR”)
- Each of these Offices (US, CH, JP, EP, and KR) is termed an “Elected office”

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Paris Convention

- Article 4 of the Paris Convention links a first application with a second application
- For Article 4 to provide its benefit, the two applications must have been filed in non-identical patent offices
- The second application must have been filed by the same applicant (as the applicant in the first application) or a “successor in title”
- Some Offices take the view that this “same applicant” requirement must be satisfied *prior to the filing* of the second application

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Paris Convention

- For Article 4 to provide its benefit, the first application must be the *earliest application* directed to the invention
- A first example:
 - Provisional A1 filed September 22, 2014
 - US non-provisional A2 filed September 22, 2015
 - PCT application A3 filed September 22, 2016(all three applications directed to the same invention)
- PCT priority to A2 will fail

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Paris Convention

- A second example:
 - Provisional A1 filed September 22, 2014 disclosing invention B
 - US non-provisional A2 filed March 22, 2015 disclosing inventions B and B'
 - How late can applicant file PCT application A3 with claims directed to B?
- September 22, 2015

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Paris Convention

- A third example:
 - Provisional A1 filed September 22, 2014 disclosing invention B
 - US non-provisional A2 filed March 22, 2015 disclosing inventions B and B'
 - How late can applicant file PCT application A3 with claims directed only to B'?
- March 22, 2016

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Paris Convention

- Article 4 of the Paris Convention permits resetting the 12-month period
- The first would-be priority application would have to be expressly abandoned “leaving no rights outstanding” prior to the second would-be priority application

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Expressly abandoned

Example:

- Provisional application A1 filed March 1, 2014
- February 28, 2015 applicant expressly abandons A1 leaving no rights outstanding
- Provisional application A2 filed March 2, 2015
- PCT application A3 can be filed when?
- March 2, 2016

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Communicating with the client about non-US 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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Making use of online and software resources

- EFS-Web
- Private PAIR
- PCT-SAFE
- ePCT
- Patentscope
- PCT Applicant's Guide
- WIPO's PCT Distance Learning Course

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EFS-Web

- Web-based resource
- Filers use EFS-Web to file papers in the USPTO
- This includes filing in RO/US (filing new PCT applications)
- This includes filing in IPEA/US (filing a Demand and Article 34 Amendment)
- This includes filing in DO/EO/US (filing entry into the US national phase)
- This includes filing bypass continuations

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Private PAIR

- Web-based resource
- We use this to see our pending US patent applications
- This includes a PCT application if it was filed in RO/US
- This includes a 371 (US national phase) application
- This includes a bypass continuation

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PCT-SAFE

- This is software from WIPO which you install on your computer
- It works only on Windows computers
- You use it to create a ZIP file (Request) for e-filing in RO/US (in EFS-Web)
- You use it to e-file in RO/IB
- PCT-SAFE will eventually be retired in favor of ePCT

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ePCT

- You use it to create a ZIP file (Request) for e-filing in RO/US (in EFS-Web)
- You use it to e-file in RO/IB
- You use it to see your pending PCT applications
- You use it to see your older PCT applications
- You use it for Article 19 amendments
- You use it for filing a Demand and Article 34 amendment in any non-US IPEA
- You use it for *92bis* changes

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Being able to log in to ePCT

- For ePCT you need a WIPO user ID and password and cryptographic certificate.
- Each person should have his or her own WIPO user ID and password.
- Go to the WIPO web site and click on “PCT” and then click on “ePCT” and then click on “getting started”. Follow the steps, culminating in uploading the cryptographic certificate to the ePCT system.

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Patentscope

- Patentscope provides detailed information on PCT applications that have been published
- It also permits searching patent collections from many other patent offices
- For a published PCT application, Patentscope provides a “permalink”
- Right-click on it and save the location
- Use this in emails and docketing systems



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PCT Applicant's Guide

- Available online in the PCT section of the WIPO web site
- This Applicant's Guide should be your constant resource

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WIPO's PCT Distance Learning Course

- Go to WIPO web site
- Click on PCT
- Click on *PCT Distance Learning Course*

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Collecting information for the Request

- Selecting a Receiving Office
- Selecting an International Searching Authority
- Identifying the priority application(s)
- Collecting other bibliographic data
 - Title
 - Abstract
 - Applicant
 - Inventors

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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 EFS-Web. For such filers it is comfortable to use RO/US because the filing path is through EFS-Web.
- Filers who are familiar with EFS-Web 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

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Advantages of using RO/US

- 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

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Using RO/IB

- 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
- Keep track of time zones if you need a same-day filing date
- RO/IB may be your best choice if you need ROP

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Selecting an International Searching Authority

Many factors may influence the client's selection of ISA

- Quality
- Cost for first invention
- Cost for 2nd through n-th inventions
- Timeliness
- Suitability for later use for PPH purposes
- Possible benefits and interactions with particular national- or regional-phase filing paths

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Identifying the priority application(s)

- Many of the mistakes which a practitioner could make in filing a PCT application are fixable later
- One category of mistake that is impossible or nearly impossible to fix later is an omitted or incorrectly cited priority application
- It is extremely important to avoid overlooking or omitting a would-be priority claim
- It is extremely important to copy and paste from a trusted source, rather than hand-keying a priority application number

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Collecting other bibliographic data

- Title
- Abstract
- Applicant
- Inventors

You will need the citizenship and domicile of the Applicant

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Collecting documents for the PCT application

- Specification
- Claims
- Abstract
- Drawings
- (maybe) sequence listing
- (maybe) biological deposit information
- (maybe) Declarations

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Drawings

- Many difficulties can arise after filing if informal drawings are filed
- It is ***very important*** to file formal (not informal) drawings when filing a PCT application

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Building the Request

- General aspects of building the Request
- Request for RO/US using PCT-SAFE
- Request for RO/US using ePCT
- Request for RO/IB

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General aspects of building the Request

- You will indicate to the software that you wish to build a Request
- You will enter your file number (docket number)
- You will indicate which Receiving Office you are planning to use
- You will indicate which International Searching Authority the client has selected
- You will indicate the language of filing (usually English)

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General aspects of building the Request

- You will enter the title (all capital letters)
- You will probably skip over the “States” or “Designations” section
- See the PCT Applicant's Guide for details about “States” or “Designations”
- In the “Names” section, you will enter the Applicant, the Inventors, and the Agent
- It will be necessary to enter the citizenship and domicile of the Applicant
- In the “Agent” section you will pick whether to receive communications exclusively by email or both paper and email

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General aspects of building the Request

- In the “Priority” section, you should copy and paste your priority application information
- You will need to worry about getting a certified copy of the priority application into the hands of the IB
- The way you do this will differ depending on the Receiving Office and the type of software being employed to build the Request

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Using a typewriter

- Strictly speaking it is possible to prepare a PCT Request using a typewriter, and to file a PCT application using such a Request
- The typewriter will not warn you when you are making a mistake
- Given the availability of sophisticated software that can be used to prepare a PCT request, that carries out hundreds of validations, it is tantamount to malpractice to prepare a PCT Request using typewriter
- We will discuss how to prepare a PCT Request using the software

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General aspects of building the Request

- In the “Biology” section ...
- Some PCT applications require a “deposited microorganism or other biological material”
- Some PCT applications require a “nucleotide or amino acid sequence listing”
- If so, then you would indicate it in this section
- See the PCT Applicant's Guide for details

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General aspects of building the Request

- In the “Declarations” section ...
- There are five types of Declarations which you might wish to provide with the PCT application
- See the PCT Applicant's Guide for details about PCT Declarations

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General aspects of building the Request

- In the “Contents” section ...
- Depending upon the software being used and RO being used ...
 - you may indicate numbers of pages of the contents of the patent application ...
 - or you may upload PDF files of the contents of the patent application

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General aspects of building the Request

- In the “Fees” section you will calculate fees to pay
- You may indicate how you plan to pay the fees
- There will be a place to e-sign the Request
- There will be an opportunity to print out the Request in draft for proofreading purposes

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Request for RO/US using PCT-SAFE

- Note that the chief goal of using PCT-SAFE (if you are e-filing in RO/US) is to generate a ZIP file which will be uploaded to EFS-Web
- In the near term you may wish to use PCT-SAFE for this purpose
- USPTO plans a rules change that will smooth the path for use of ePCT instead
- Eventually PCT-SAFE will be phased out
- It is thus to your advantage to gradually get accustomed to using ePCT to generate this ZIP file that gets uploaded to EFS-Web

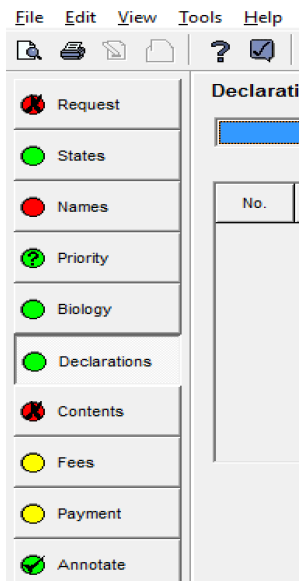
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Request for RO/US using PCT-SAFE

- We will first give an overview of the process of using PCT-SAFE to generate a Request
- Then we will go through the PCT-SAFE process in greater detail

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Request for RO/US using PCT-SAFE



- It is important that you be running the most recent version of PCT-SAFE
- You run PCT-SAFE
- Pick the PCT/RO/101 template
- Follow the sequence of tabs
- Gradually they will change from red to yellow to green
- You can click on the “validation” button at any point along the way to validate the information that you have entered
- Save your work frequently

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Request for RO/US using PCT-SAFE

- The first tab is the “Request” tab
- Pick “US” from drop-down list for Receiving Office
- Client already selected the ISA. Pick the selected ISA from the drop-down list
- Language of filing will be English
- Enter the title

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Request for RO/US using PCT-SAFE

- As discussed earlier, you will probably skip over the “States” tab
- In the “Names” tab, you will enter the Applicant, the Inventors, and the Agent
- If you already have one or more of these names in your PCT-SAFE Address Book then you can simply drag and drop the name into the Request

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Request for RO/US using PCT-SAFE

- In the “Priority” tab, you should copy and paste your priority application information
- If the priority application was filed in the USPTO, then check the box to ask RO/US to transmit an electronic certified copy to the IB
- If the priority application was filed in some other Office, then see whether you can use DAS to get an electronic certified copy to the IB
- Otherwise you will need to obtain a physical certified copy and send it to the IB

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Request for RO/US using PCT-SAFE

- As discussed earlier, if the PCT application requires a “deposited microorganism or other biological material” or requires a “nucleotide or amino acid sequence listing” then you would indicate these things in the “Biology” section
- If you are going to include one or more Declarations, then you would indicate this in the “Declarations” section

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Request for RO/US using PCT-SAFE

- In the “Contents” section you will enter the page counts for the description and claims.
- You will paste the text of the Abstract into the software.
- Indicate a suggested figure for publication
- Click “calculate” to add up the page count for the PCT application

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Request for RO/US using PCT-SAFE

- In the “Fees” section you will enter information for the “fee calculation” page
- EFS-Web will carry out its own fee calculations, which will control for purposes of the actual fee payment
- It doesn't hurt to try to make this PCT-SAFE fee calculation match the EFS-Web fee calculation
- In the “Payment” section you may indicate how you plan to pay the fees, but the EFS-Web selections will control
- This means the “Fees” and “Payment” sections in PCT-SAFE are not of crucial importance

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Request for RO/US using PCT-SAFE

- When you are ready to e-sign the Request, click “File” and “Save as ready for signing”
- Go to “Annotate” and click on “Signature of Applicant or Agent”
- Select the signatory (probably the Agent) and click “add signatory”

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Request for RO/US using PCT-SAFE

- log in at Private ePCT
- click on “eOwnership”
- click on “Request eOwnership Code”
- A Customer ID and eOwnership code will appear

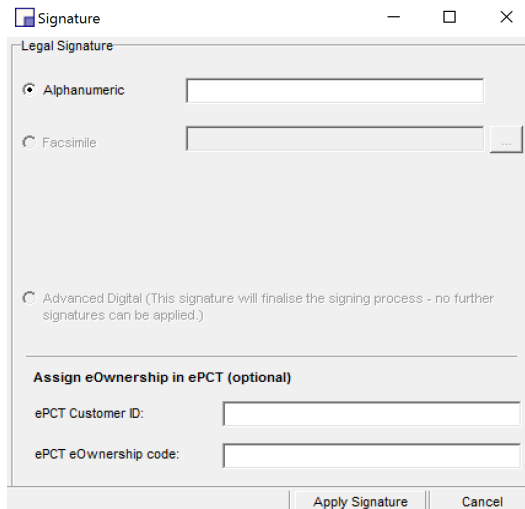
Request eOwnership Code

For use at the time of filing a new application

Request Code

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Request for RO/US using PCT-SAFE



Alpha e-signature
should be like
/name 123456/
(reg no)

copy and paste the
ePCT Customer ID
and ePCT eOwnership
code from ePCT

click “Apply Signature”

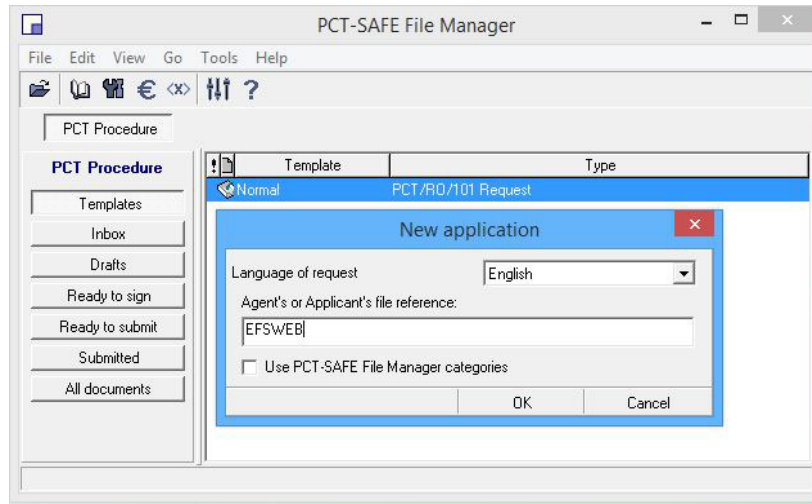
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Request for RO/US using PCT-SAFE

- Save the project
- Click on “Ready to Submit” and double-click on the project
- Pick a place to save the resulting ZIP file

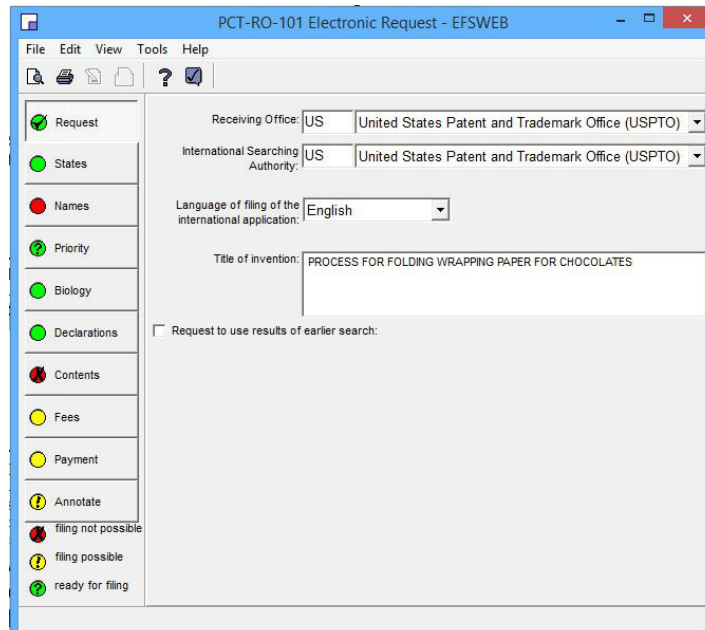
80

Click to start a new Request
Enter the file reference
Periods not permitted
Limited to 12 characters



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Pick the RO which will be RO/US
pick the ISA in this example ISA/US
Paste in the title
It will scold you if you do not use all capital letters for the title!



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You can click on “contents” and you will see that because you selected RO/US, the “type of filing” has changed to

PCT-EASY for EFS-Web



Now let's go back to “States”

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The “states” page lets you pick and choose which states you will designate

Most US filers will have no reason to check any of the boxes on this page

However,

- DE Germany is not designated for any kind of national protection
- JP Japan is not designated for any kind of national protection
- KR Republic of Korea is not designated for any kind of national protection

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Now enter the applicant name in all capital letters ...
nationality and residence are important

Legal entity Natural person This person is also inventor

Name: Registration No.
First Name:

Country or territory:

Address:

City:

Postal code:

Telephone:
Facsimile:
e-mail:

The competent PCT Authorities are authorized to use this e-mail address, if the Authority so wishes, to send notifications issued in respect of this international application:

as advance copies followed by paper notifications
 exclusively in electronic form (no paper notifications will be sent)

State of Nationality:
State of Residence:

The person is applicant for:

All designated States
 Certain designated States only

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Name:
First Name:

Country or territory:

Address:

City:

Postal code:

Next enter the inventors

Note that there is no place to enter residence and citizenship
Family name should be all capital letters

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Now enter the agent
Including registration number
Best Practice: provide email address and check one of the boxes
Family name should be all capital letters

<input type="radio"/> Legal entity	<input checked="" type="radio"/> Natural person
Name: <input type="text"/>	Registration No. <input type="text"/>
First Name: <input type="text"/>	
Country or territory: <input type="text"/> <input type="text"/>	Telephone: <input type="text"/>
Address: <input type="text"/>	Facsimile: <input type="text"/>
	e-mail: <input type="text" value="docket@docket.com"/>
City: <input type="text"/>	The competent PCT Authorities are authorized to use this e-mail address, if the Authority so wishes, to send notifications issued in respect of this international application:
Region: <input type="text"/>	<input type="checkbox"/> as advance copies followed by paper notifications
Postal code: <input type="text"/>	<input checked="" type="checkbox"/> exclusively in electronic form (no paper notifications will be sent)

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Applicant, inventors, agent ...

There is an address book

If you already have an applicant or inventor or agent in the address book, you can add it to the Request with a few mouse clicks

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Now **copy and paste** the priority information
Priority claim, if done wrong, cannot be fixed after 4-and-16

National Regional International (PCT)

Country: ▼

Filing date:

Number:

The International Bureau is requested to obtain from a digital library a certified copy of the above-identified earlier application.

Access code:

The receiving Office is requested to prepare and transmit to the International Bureau a certified copy of the above-identified earlier application.

The receiving Office is requested to restore the right of priority

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Receiving Office requested?

If the priority document was filed in the same Office as the RO, then check the box “Receiving Office is requested to transmit ...”

If the priority document was filed in some other Office, you may be lucky enough that that Office belongs to DAS

AU, DK, CN, ES, FI, GB, IB, JP, KR, SE, US

In which case check the “obtain from digital library” box

Otherwise you will have to provide physical certified copies yourself

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Biology tab and Declarations tab

Indications Relating to Deposited Microorganism or Other Biological Material

Nucleotide and/or amino acid sequence listing

The description contains a sequence listing

Declaration as to identity of the inventor
Declaration as to applicant's entitlement to apply for and be granted a patent
Declaration as to applicant's entitlement to claim priority of earlier application
Declaration of inventorship (only for the purposes of the USA)
Declaration as to non-prejudicial disclosures or exceptions to lack of novelty

You can create one or more of these Declarations and then upload them as PDFs in EFS-Web

91

Paste the Abstract into the system
Which figure should accompany the Abstract?
Provide page counts

Be sure to "recalculate"

The screenshot shows the PCT-RO-101 Electronic Request - EFSWEB interface. The main window displays a table of documents with the following data:

Document	Details	Pages	Electronic File	Val.
Request (including declaration sheets)		4		✓
Description		25		✓
Claims		3		✓
Abstract		1	EZABST00.TXT	✓
Drawings	Fig. No. 3	4		✓

Below the table, there is a section for international applications with a similar table structure. At the bottom, there is a 'Recalculate' button and a summary: 'total: 37 pages'. Below that, there are fields for 'International Application' (6 documents) and 'Accompanying Items' (0 files).

92

Fees page ... you can indicate small entity or micro entity
 Best Practice is to cross-check these fees with those in the EFS-Web fee page

Fee Calculation

Currency: Fee schedule valid from:

Fee	Currency	Amount	X	Total	Small Enti...	Micro Entity
Transmittal fee	USD	240	1	240	<input type="checkbox"/>	<input type="checkbox"/>
Search fee	USD	2,080	1	2,080	<input type="checkbox"/>	<input type="checkbox"/>
International Filing Fee	USD	1,384	1	1,384		
Supplement per sheet over 30	USD	16	0	0		
Electronic Filing reduction (Image)	USD	-208	0	0		
Fee for priority document	USD	0	0	0		
Fee for restoration of right of priority	USD	1,700	0	0	<input type="checkbox"/>	<input type="checkbox"/>

93

Payment page

Payment

Mode of Payment:

Specify:

In addition, indicate current account authorization:

- The Receiving Office (RO/US) is hereby authorized to charge any deficiency or credit any overpayment in the total fees to my current account
- The receiving Office (RO/US) is hereby authorized to charge the fees for preparation and transmittal of the priority document to the International Bureau of WIPO to my current account

Current account number:

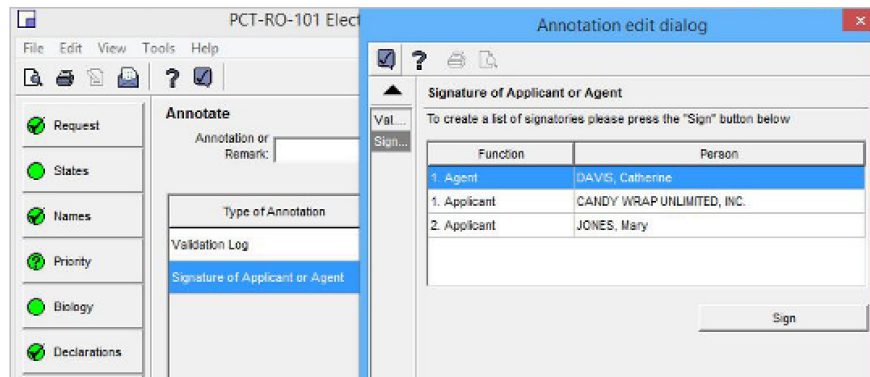
Authorized User Name:

Sign

14

SIGNING THE REQUEST FORM

On the Annotate page select 'Signature of Applicant or Agent' and double-click to open. The Annotate edit dialog will display a list of all applicants and agents as indicated on the Names page. Select the name of the (first) person who will sign the request form, then click 'Sign'.



System will force you to preview the Request before allowing you to e-sign

95

INDICATING THE NAME OF THE SIGNATORY(IES)

Select the name of the signatory from the list of applicants/representatives. In the case of a legal entity, when the company name is selected from the list, please indicate the name of the person signing on behalf of the company and their capacity in the fields next to the 'Add signatory' button.

Once the signatory has been selected click the 'Add signatory' button.



96

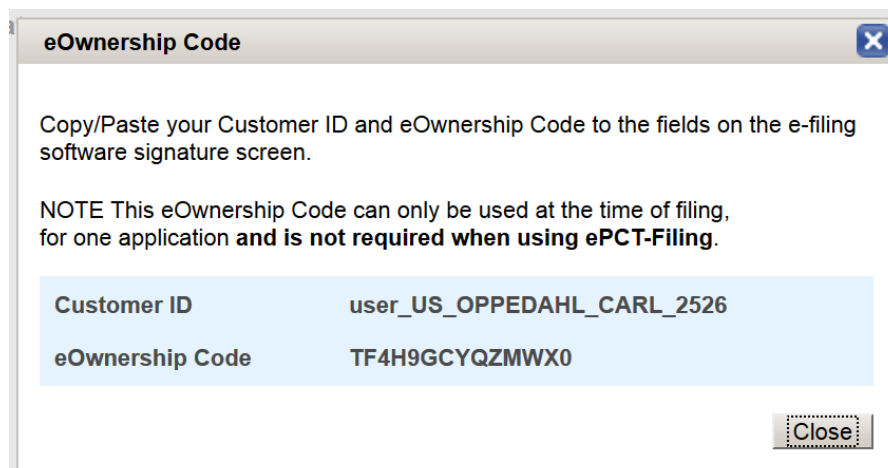
Are you trendy, modern, and up-to-date?

If you don't yet have access to “private” ePCT, you
will have to skip the next step

97

Now go to “private” ePCT and get an eOwnership code

Click “eOwnership” and “request code” ...



98

Copy and paste the ePCT codes into the signature window

Apply alphanumeric signature containing both name and registration number

Signature

Legal Signature

Alphanumeric /Catherine Davis, Reg. No. 44,111/

Facsimile

Advanced Digital (This signature will finalise the signing process - no further signatures can be applied.)

Assign eOwnership in ePCT (optional)

ePCT Customer ID: user_US_DAVIS_CATHERINE_9999

ePCT eOwnership code: GJ7KZPVVE2QVZ0

Apply Signature Cancel

Click "Apply Signature"

99

PCT Power of Attorney?

These days many PCT applications go from start to finish without any PCT Power of Attorney being filed

The software lets you create a POA on-screen which you then print as a PDF and you will later upload into EFS-Web

Or prepare a traditional pen-and-ink POA and scan it and upload it later into EFS-Web

100

Throughout the process, at any point you can click the “validate” icon to obtain a Validation report

Type of Annotation	Entity	Details
Validation Log	Annotate	
Signature of Applicant or Agent		

Do this frequently, as you finish each window, until you get used to the process

Eventually you will get used to the process and you can wait until the end to validate the entire Request

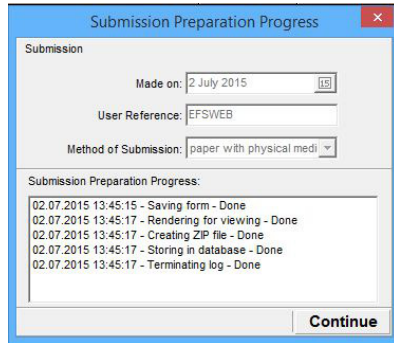
101

Save as ready for Signing

Annotation	Entity	Details
	Annotate	
	ent or Agent	

102

When it is done, click "Continue"

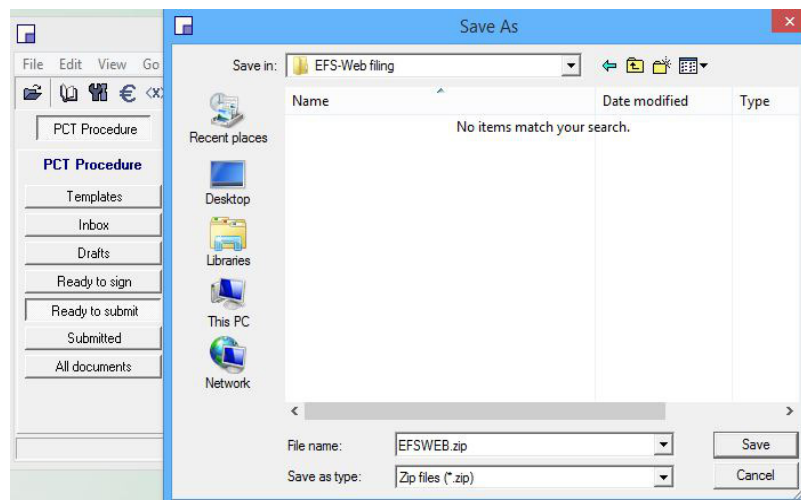


The form is then moved to the 'Ready to Submit' folder.

103

From the 'Ready to Submit' folder, click on the file name and then select 'Submit' from the righthand mouse button command menu. A 'Save As' screen will open.

Select the folder to which you wish to save your PCT-EASY .zip then click Save



104

Need to go back and make changes?

Should it be necessary to make corrections or other changes to the Request form at this stage, right-click the application in the 'Submitted' folder and select the option "Return to drafts". Modify the form as appropriate and then go through the submission process again.

Or you can create an entirely new submission package that uses this package as a template

105

Attach zip file
The rest of the workflow is familiar EFS-Web workflow
attach all of the usual files – specification, claims, abstract, drawings
pay fees through EFS-Web as usual

This is the application data associated with your filing. If any information is incorrect, please click the edit icon.

Title of Invention	Chocolate dispenser
Applicant Name	The Chocolate Factory
Customer Number,	57380
Correspondence Address	Oppedahl Patent Law Firm LLC 12000 Pecos Street #252 Westminster CO 80234 US +1 303 252 8800
Filed By	Carl Oppedahl
Attorney Docket Number	WONKA.P-001
Application Type	International Application (PCT) for filing in the US receiving c

Are you attaching a PCT-EASY zip file? Yes No

Files to be Submitted

No file selected.

When attaching a PCT-EASY Zip file, you must also attach your application parts (Specific

106

Continuation? CIP?

If your PCT application is intended to be treated in the US as a continuation or CIP ...

Then use the Supplemental Box

107

This page will then be uploaded into EFS-Web as a PDF file

Supplemental Box (lower part)

- (iv) if, in addition to the agent(s) indicated in Box No. IV, there are **further agents**: in such case, write "Continuation of Box No. IV" and indicate for each further agent the same type of information as required in Box No. IV;
- (v) if, in Box No. VI, there are **more than three earlier applications whose priority is claimed**: in such case, write "Continuation of Box No. VI" and indicate for each additional earlier application the same type of information as required in Box No. VI.
2. If the applicant intends to make an indication of the wish that the international application be treated, in certain designated States, as an application for a patent of addition, certificate of addition, inventor's certificate of addition or utility certificate of addition: in such case, write the name or two-letter code of each designated State concerned and the indication "patent of addition," "certificate of addition," "inventor's certificate of addition" or "utility certificate of addition," the number of the parent application or parent patent or other parent grant and the date of grant of the parent patent or other parent grant or the date of filing of the parent application (Rules 4.11(a)(i) and 49bis.1(a) or (b)).
3. If the applicant intends to make an indication of the wish that the international application be treated, in the United States of America, as a continuation or continuation-in-part of an earlier application: in such case, write "United States of America" or "US" and the indication "continuation" or "continuation-in-part" and the number and the filing date of the parent application (Rules 4.11(a)(ii) and 49bis.1(d)).

Continuation of Box No. IV:
WALTERS, Susan 56,334
JOHNSON, Albert 63,889

US, continuation, 13/987,654 filed 8 April
2015 (08.04.2015)

108

Request for RO/US using ePCT

- As mentioned earlier, PCT-SAFE will eventually be phased out
- It is thus important to start learning how to use ePCT to generate the Request for e-filing in RO/US
- ePCT carries out many more validations than PCT-SAFE
- ePCT is always up to date
- ePCT runs on all operating systems (not only Windows)

109

Request for RO/US using ePCT

- Log in to Private ePCT
- Click on “ePCT filing”
- Enter file reference (docket number)
- Select “US” as Receiving Office

110

Request for RO/US using ePCT



- You will now click through these thirteen tabs
- You can go back and forth as you wish
- You can save your work
- You can validate your inputs at any point during the process
- It is a Best Practice to give Access Rights to colleagues in your office

111

Request for RO/US using ePCT

- In the “Priority claims” tab, click “add” and copy and paste your priority application information
- If the priority application is from the USPTO, check the box “Receiving Office to transmit to the IB”

112

Request for RO/US using ePCT

- If the priority application is from some Office other than USPTO, hopefully you can check the box “International Bureau to obtain from a digital library”
- This means DAS
- Otherwise you will need to provide a physical certified copy to the IB

113

Request for RO/US using ePCT

- As discussed above, you will probably skip over the “Designations” tab
- If you have any Declarations to attach, you will use the “Declarations” tab
- If you have an indication regarding a deposit of a microorganism, you will use the “Biology” tab
- You will use the “International Search” tab to indicate the ISA that the client selected

114

Request for RO/US using ePCT

- In the “Names” tab, you will enter the Applicant, the Inventors, and the Agent
- If you already have one or more of these names in your ePCT Address Book then you can simply drag and drop the name into the Request
- Note that ePCT permits you to share your Address Book with other users and they can share their Address Book with you
- This can be very convenient

115

Request for RO/US using ePCT

- In the “IA Contents” tab, you will enter the page counts for the description and claims and abstract and drawings
- Optionally you may indicate the Title
- Indicate a suggested figure for publication

116

Request for RO/US using ePCT

- In the “Fees” tab you will enter information for the “fee calculation” page
- EFS-Web will carry out its own fee calculations, which will control for purposes of the actual fee payment
- It doesn't hurt to try to make this ePCT fee calculation match the EFS-Web fee calculation
- In the “Payment” section you may indicate how you plan to pay the fees, but the EFS-Web selections will control
- This means the “Fees” and “Payment” sections in ePCT are not of crucial importance

117

Request for RO/US using ePCT

- In the “Summary and Download” tab you have an opportunity to review the Request
- When everything is correct, click the button “Download ePCT filing data package”
- This means the ZIP file
- Save it to your computer for later upload to EFS-Web

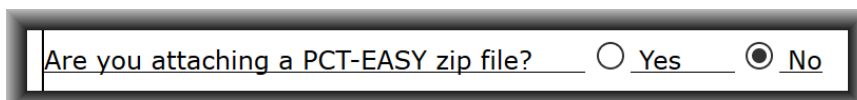
118

E-filing in RO/US

- Launch EFS-Web
- In EFS-Web, pick “International Application (PCT) for filing in the US Receiving Office”
- In EFS-Web, enter the Title and docket number and Applicant Name and Correspondence Address (yes you already entered them in the Request in PCT-SAFE or ePCT)
- Pick a customer number for purposes of Private PAIR access
- Click “continue”

119

E-filing in RO/US



Are you attaching a PCT-EASY zip file? Yes No

- Click “yes” you are attaching a PCT-EASY zip file
- Upload the ZIP file
- Upload the other application parts (specification, claims, abstract, drawings)

120

E-filing in RO/US

- Do the fee calculation
 - Pick entity size (large, small, micro)
 - Transmittal fee
 - International filing fee “with zip file”
 - Possible extra-pages fee
 - Search fee
- Optionally, see if the fee total here matches the fee total previously determined in PCT-SAFE or ePCT

121

E-filing in RO/US

- When everything is done, click “submit”
- If you are quite sure everything is perfect, then optionally, pay the government fees
- Check the filing carefully in Private PAIR
- If everything looks perfect in Private PAIR, and if you have not yet paid the government fees, then pay the fees

122

E-filing in RO/IB

- Log in to Private ePCT
- Click on “ePCT filing”
- Enter file reference (docket number)
- Select “IB” as Receiving Office

123

E-filing in RO/IB



- You will now click through these thirteen tabs
- You can go back and forth as you wish
- You can save your work
- You can validate your inputs at any point during the process

124

E-filing in RO/IB

- In the “Priority claims” tab, click “add” and copy and paste your priority application information
- If the priority application is from the USPTO, check the box “International Bureau to obtain from a digital library”
- This means DAS

125

E-filing in RO/IB

- Note that this means that when you filed your US priority application, you should have authorized USPTO to release the application to the DAS system
 - You would do this by a check box on the ADS
 - Or you do this with Form PTO/SB/39
- If you did not authorize it before, do it now, right away

126

E-filing in RO/IB

- If the priority application is from some Office other than USPTO, hopefully you can check the box “International Bureau to obtain from a digital library”
- This means DAS
- Otherwise you will need to provide a physical certified copy to the IB

127

E-filing in RO/IB

- As discussed above, you will probably skip over the “Designations” tab
- If you have any Declarations to attach, you will use the “Declarations” tab
- If you have an indication regarding a deposit of a microorganism, you will use the “Biology” tab
- You will use the “International Search” tab to indicate the ISA that the client selected

128

E-filing in RO/IB

- In the “Names” tab, you will enter the Applicant, the Inventors, and the Agent
- If you already have one or more of these names in your ePCT Address Book then you can simply drag and drop the name into the Request
- Note that ePCT permits you to share your Address Book with other users and they can share their Address Book with you
- This can be very convenient

129

E-filing in RO/IB

- In the “IA Contents” tab, you will upload PDF files containing the description and claims and abstract and drawings
- Indicate the Title
- Indicate a suggested figure for publication

130

E-filing in RO/IB

- In the “Fees” tab you will enter information for the “fee calculation” page
- You will indicate the transmittal fee, the search fee, and the international filing fee

131

E-filing in RO/IB

- In the “Summary and File IA” tab you have an opportunity to review the Request and the rest of the application
- When everything is correct, click the button “File International Application to RO/IB”

132

Communicating with the client about the filed PCT application

- Client must be clearly told about the “30-month date”
- Client should also be told that the PCT application will be published at P+18

133

Communicating with the client about the filed PCT application

- When the PCT application becomes visible to you in ePCT ...
- You may wish to download the publication preview page and send it to the client for review
- This gives the client a chance to let you know if there has been any mistake or misunderstanding about inventors, priority, applicant name etc.

134

Communicating with the client about the filed PCT application

- You may want to tell the client once about the “three-country” docket
- For TZ, UG, LX if you want to do a direct national phase filing at 30 months, you will have to file a Demand by P+19
- Even if you do not file a Demand by P+19, you can still reach any of these countries by means of a regional phase entry

135

Docketing PCT

When you file a PCT application, docket to check for these forms:

- Form PCT/RO/105, which memorializes the filing date and application number
- Form PCT/RO/102, which memorializes that proper fees were paid
- Form PCT/IB/301, which memorializes that the International Bureau has received the Record Copy from the RO
- Form PCT/IB/304, which memorializes that the International Bureau has received the certified copy of the priority document
- Form PCT/ISA/202, which memorializes that the International Searching Authority has received the Search Copy.

136

Docketing PCT

Also docket P+22 (priority date plus 22 months) for filing of a Demand and Article 34 amendment, and docket P+30 for entry into the national phase

- After Form PCT/IB/301 arrives, check to make sure that you have access to the PCT application in the ePCT system
- After Form PCT/ISA/202 arrives, docket three months to check for receipt of the International Search Report and the Written Opinion (ISR/WO)

137

Receiving an Invitation to Pay Additional Fees

- Sometimes the first communication from the ISA is an invitation to pay additional fees
- This is the equivalent of a Restriction Requirement in US domestic practice
- The typical consequence of an RR in US domestic practice is the need to file one or more divisional applications
- Such applications are expensive

138

Receiving an Invitation to Pay Additional Fees

- Paying the invited additional fees is much less expensive than filing and prosecuting US divisional applications
- It may be a good business decision for the client to pay the invited additional fees

139

Receiving and reporting the International Search Report and Written Opinion

- It is good to receive the ISR/WO as soon as possible
- Best Practice is to check the box in the Request authorizing email communications
- Some ISAs send the ISR/WO by email
- ePCT will notify you when the IB receives the ISR/WO

140

Receiving and reporting the International Search Report and Written Opinion

- Previously you had docketed P+22 for the Demand and Article 34 amendment
- Now you get to calculate ISR+3 (mailing date of ISR plus 3 months) to see if this changes the due date
- You might need to redocket this due date
- The time line in ePCT will calculate this for you as well

141

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				
1. 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

142

Client communications after receiving the ISR/WO

- Ideally you already gave ePCT access (perhaps eReader access) to the client for this application
- If so, the client may learn of the ISR/WO at about the same time that you do

143

Client communications after receiving the ISR/WO

- When the ISR/WO arrives, the client needs to be reminded of the need to decide whether to file an Article 19 amendment
- Likewise the client needs to be reminded of the need to decide whether to file a Demand and Article 34 amendment
- Client must be reminded of the due dates for each
- ePCT will provide both due dates

144

Client communications after receiving the ISR/WO

- The client may already have the ISR/WO from ePCT, but if not, you should provide copies
- Probably also provide copies of the cited references to the client

145

Client communications after receiving the ISR/WO

- Depending on the particular ISA that was previously selected, the client may have a choice of two or more IPEAs
- In such a case, then you need not only to make sure the client knows to decide whether or not to file a Demand ...
- You need to make sure the client knows to pick among the available IPEAs
- ePCT will determine which IPEA or IPEAs are available (see below discussion of Demand)

146

Filing an IDS

- When the ISR/WO is established, consider filing an IDS in the US national-phase case
- File an ADS to start the US national-phase process (if one has not already been filed) and file the IDS disclosing the references from the ISR/WO
- This avoids the risk of embarrassment or risk from forgetting to file the IDS later
- This permits clearing the docket for this task
- In a case with a favorable WO, this gets you a step closer to getting on the Highway

147

If the WO is favorable

- If the WO is favorable, consider entering the US national phase immediately and putting the application on the Highway
- Remember to file an Express Request for immediate national-phase processing
- Also consider entering the national phase outside of the US immediately and putting the application on the Highway

148

Filing an Article 19 amendment

- The client might make a choice to file an Article 19 amendment
- If this is going to be filed, it must be filed by the later of three dates:
 - Two months after the ISR was mailed
 - Prior to the IB's completion of technical preparations for publication
 - Sixteen months after the priority date
- ePCT will calculate this date for you
- Make sure it has been docketed

149

Filing an Article 19 amendment

- In an Article 19 amendment, you can only amend the claims
- You may not amend anything else (for example specification or drawings)
- Unlike US practice, adding claims by means of an Article 19 amendment does not incur claims fees
- Indeed there are no fees at all associated with filing of an Article 19 amendment (you paid for this service when you paid the international filing fee)

150

Filing an Article 19 amendment

- To file the Article 19 amendment you need:
 - A complete new set of claims (no markup is needed and no status identifiers)
 - An Article 19 letter
 - Must indicate the differences between the claims as filed and those as amended
 - Must indicate the basis for the amendments (pointing out support in the application as filed)
 - Should state whether each claim is unchanged, cancelled, new, replaces an originally-filed claim, and so on
 - Optionally, an Article 19 statement (not the same thing as the Article 19 letter)

151

Filing an Article 19 amendment

- The Article 19 statement is not the same as the Article 19 letter. The Article 19 statement is optional. If provided, it may explain the various claim amendments in connection with the various references cited and discussed in the ISR/WO

152

Filing an Article 19 amendment

- The Article 19 amendment should **not** be sent to the Receiving Office and should **not** be sent to the International Searching Authority
- The Article 19 amendment **should** be sent directly to the International Bureau
- Keep track of when it will be midnight at the International Bureau (ePCT will tell you what time it is at the IB)
- Keep track of daylight saving time differences between Europe and the US

153

Filing an Article 19 amendment

- The Best Practice is to e-file the Article 19 amendment using ePCT
- Within ePCT, it is a Best Practice to use an “action” rather than an “upload”
- You pick the application from your ePCT workbench, click on “action”, click on “article 19 amendment”
- You upload the files and submit them
- Then go to ePCT to view the documents that you submitted to make sure they are okay

154

Filing an Article 19 amendment

- In case of emergency it *is* possible to fax the Article 19 amendment to the IB
- This is not a Best Practice

155

Docketing after your Article 19 amendment

- When an Article 19 amendment has been filed, docket to check for receipt of Form PCT/IB/346
- This is the IB's way of letting you know it received the Article 19 amendment
- When the Form arrives, check to see that it says the Article 19 amendment was filed “within the time limit”

156

What happens to the Article 19 amendment?

- The RO pays no attention to the Article 19 amendment
- The IB examines the Article 19 amendment only as to matters of form
- Assuming there are no formal defects, the IB publishes the Article 19 amendment
- The ISA does not examine the Article 19 amendment, because the ISA's work was completed with the establishment of the ISR/WO

157

What happens to the Article 19 amendment?

- If you timely file a Demand, then if you ask the IPEA to examine the Article 19 amendment, it will do so
- If you do not file a Demand, then there will not be any IPEA connected with your PCT application and thus there will be no examination of the Article 19 amendment by an IPEA

158

What happens to the Article 19 amendment?

- If no Demand is filed, then the first time any patent office will examine the Article 19 amendment is after entry into the national phase
- One potential advantage of filing an Article 19 amendment is that it applies across all national phase entries
- You may thus avoid having to pay local counsel in each national-phase country to carry out the amendment

159

Filing a Demand

- Back when the PCT application was filed, the eligibility of the applicant to make use of the PCT was tested
- At the time of filing a Demand, the eligibility of the applicant to make use of the PCT is **again** tested
- Usually this is not a problem – an applicant that was a citizen or domiciliary of a PCT member state at PCT filing time will likely still be a citizen or domiciliary of a PCT member state at Demand filing time

160

Filing a Demand at 19 months

- As mentioned earlier, one conceivable reason for filing a Demand is to get ten extra months in Uganda, Tanzania and and Luxembourg. Such a Demand would have to be filed by 19 months after the priority date.
- It is extremely rare that an applicant would file a Demand for this reason.
- Generally the reason for filing a Demand is to purchase the services of the IPEA

161

Purchasing the services of an IPEA

- A typical reason for purchasing the services of an IPEA (that is, filing a Demand) is that the applicant is not completely happy with the ISR/WO and hopes to do better by arguing or amending claims or both
- Another possible reason is that the applicant has identified some problem in the description or drawings and hopes to correct the problem in the international phase (which may only be done with the assistance of the IPEA)

162

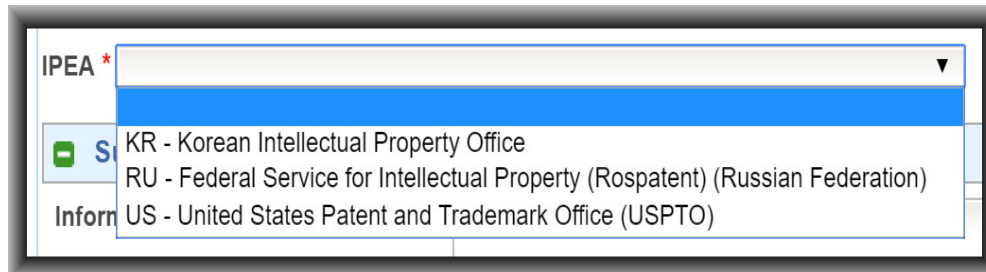
Picking an IPEA

- Depending on the previous choice of ISA, the client may have two or more options for a choice of IPEA
- ePCT will figure out which IPEA or IPEAs are available
- Select your application from the Workbench
- Click on “actions” and “Submit Chapter II Demand”
- Look at the drop-down list for “IPEA”

163

Picking an IPEA

- Look at the drop-down list for “IPEA”
- In this example, the ISA was ISA/KR
- As a consequence the client can select from among three possible IPEAs



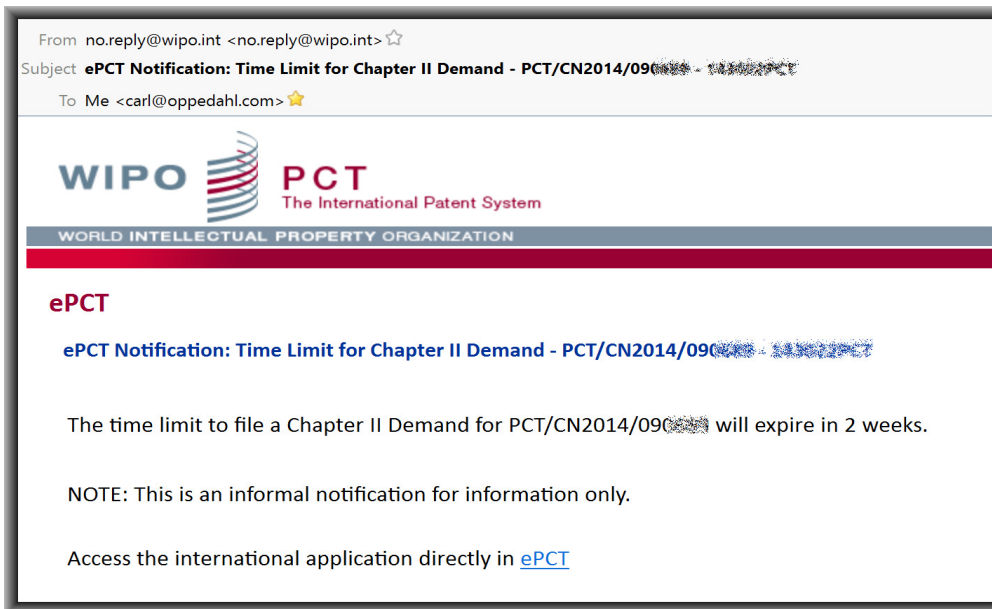
164

Filing a Demand and Article 34 amendment (“D&34”)

- The client might make a choice to file a D&34
- If this is going to be filed, it must be filed by the later of two dates:
 - Three months after the ISR was mailed
 - 22 months after the priority date
- ePCT will calculate this date for you
- Make sure it has been docketed

165

Note that ePCT will warn you that the time limit for the Demand is imminent



The screenshot shows an email notification from WIPO. The header includes the sender 'no.reply@wipo.int', the subject 'ePCT Notification: Time Limit for Chapter II Demand - PCT/CN2014/090688 - 13/06/2014', and the recipient 'Me <carl@oppedahl.com>'. The main body of the email features the WIPO and PCT logos, followed by the text 'ePCT' and 'ePCT Notification: Time Limit for Chapter II Demand - PCT/CN2014/090688 - 13/06/2014'. The notification states that the time limit to file a Chapter II Demand for PCT/CN2014/090688 will expire in 2 weeks. A note clarifies that this is an informal notification for information only. At the bottom, there is a link to 'ePCT' for direct access to the international application.

166

Filing a D&34

- Strictly speaking you could file a Demand without an Article 34 amendment
- For example you could simply present arguments as to patentability without amending anything
- If you have timely filed an Article 19 amendment, you could skip filing an Article 34 amendment and simply ask the IPEA to consider the Article 19 amendment to be the claims for purposes of the Demand

167

Filing a D&34

- In an Article 34 amendment, you can amend not only the claims but also the specification and drawings
- You may not, however, add new matter and the IPEA will check to see that no new matter is being added

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The filing process for a D&34

- If the IPEA that the applicant selected is IPEA/US, then the Best Practice is to e-file in EFS-Web
- If the IPEA that the applicant selected is an IPEA *other than IPEA/US*, then the Best Practice is to e-file in ePCT
- If you e-file in ePCT, then the Best Practice is to do this by means of an “action”, not an “upload”

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Paying fees for a Demand

- The applicant must pay these fees:
 - Handling Fee
 - Preliminary Examination Fee
- If you file the Demand in EFS-Web, then you may pay these fees in the same EFS-Web session
- If you file the Demand in ePCT, then you will need to somehow get the money to the IPEA
 - The usual way to do this is a bank wire transfer that mentions the PCT application number

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Required documents for a Demand

- One required document for a Demand is Form PCT/IPEA/401 (“Demand for Preliminary Examination”)
- Best Practice is to prepare the Demand using ePCT
- ePCT will pre-populate many of the fields using bibliographic data from the PCT Request
- ePCT will carry out dozens of validations which will reduce the risk of embarrassment or malpractice

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If you are filing via EFS-Web

- If you are filing your Demand via EFS-Web, it is nonetheless a Best Practice to prepare the Demand in ePCT
- Proceed to the point of previewing the Demand
- This will permit you to get the benefit of the dozens of validations
- ePCT will determine for you which IPEAs are available to you given your previous choice of ISA

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Other document for a Demand

- As mentioned above you might be filing a Demand solely because of UG, TZ, or LU.
- But usually you will be filing because you are not completely satisfied with the ISR/WO
- In this case, then you would almost certainly wish to prepare and file a *Response to the Written Opinion of the ISA*

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Other documents for a Demand

- Probably you will want to amend claims as part of the Demand process
- You may have filed an Article 19 amendment in which case you could ask that those claims be used for the Demand
- You may also wish to file an Article 34 amendment

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Article 34 amendment

- If you choose to file an Article 34 amendment, then this will normally be one of the documents to upload with the Demand
- This is done by replacement sheets
- If you file an Article 34 amendment, then you must also provide an accompanying letter which explains the difference between the replaced sheet and the replacement sheet and which preferably explains the reasons for the amendment
- This is very similar to the explanatory letter that would accompany an Article 19 amendment

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Timing of the Demand-related documents

- Strictly speaking you would not have to file all of the Demand-related documents on the same day
- It is a Best Practice to file all of these documents on the same day

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When the IPEA will start its work

- If you don't say anything about it, the IPEA may put the Demand and Article 34 amendment “on ice” until near the end of the 30-month period.
- If you want the preliminary examination to commence sooner, then check the box that says:
 - “The IPEA is requested to start international preliminary examination before the expiration of the time limit under Rule 54bis.1(a)”

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Best Practice for timing and filing the Demand

- The more time available for the international preliminary examination, the better will be the result and quality which can be expected.
- Therefore, the Demand and Article 34 amendment should be filed as soon as possible after the applicant's evaluation of the ISR/WO has shown that it is worthwhile to pursue the international application further
- And the box requesting immediate preliminary examination should be checked

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If you e-filed the Demand in ePCT

- Look in ePCT to see what the IB received
 - Check it for correctness
- , docket to check for receipt of Form PCT/IB/368
 - By this form the IB acknowledges receipt of the Demand on a particular date
 - Check that this receipt date is correct

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If you e-filed the Demand in EFS-Web

- Look in Private PAIR to see what the IPEA/US received
 - Check it for correctness

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Further docketing relating to the Demand

- Docket to check for receipt of Form PCT/IPEA/402
- By this Form the IPEA acknowledges that it received the Demand
 - Check that the receipt date is correct

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Upon receipt of Form PCT/IPEA/402

- Docket 28 months or sooner for receipt of the *International Preliminary Report on Patentability under Chapter II of the Treaty*
- Depending upon the historical timeliness of the IPEA, be prepared to pester the IPEA to do its job timely

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Upon receipt of Form PCT/IPEA/402

- The PCT expressly provides that the applicant has a right to communicate orally, by telephone or personally, or in writing with the International Preliminary Examining Authority (PCT Article 34(2)(a); see also PCT Rule 66.6)

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What you would like to see

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY		International application No.
		PCT/US2015/013014
Box No. V Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement		
1. Statement		
Novelty (N)	Claims <u>1-27</u>	YES
	Claims <u>NONE</u>	NO
Inventive step (IS)	Claims <u>1-27</u>	YES
	Claims <u>NONE</u>	NO
Industrial applicability (IA)	Claims <u>1-27</u>	YES
	Claims <u>NONE</u>	NO

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Comparing Article 19 amendments and Article 34 amendments

Chapter I (Article 19)

have effect in all DOs
claims only
filed upon receipt of the ISR and
written opinion of ISA
filed directly with IB (not ISA)
formality examination by IB
published as part of the international
application by IB
serve as basis for examination by
IPEA unless reversed

Chapter II (Article 34)

have effect in all EOs
description, claims, drawings
filed best together with the demand, or during
examination by IPEA
filed directly with IPEA
formality and substantive examination by IPEA
are confidential between IPEA and the
applicant, are not published during the
international phase
serve as basis for examination by IPEA unless
superseded

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Filing a *92bis* request

- The point of the *92bis* request is to correct or update bibliographic data
- You could enter the national phase and then pay foreign counsel to update such things
- This would cost money
- This cost would be incurred in each office in which the national phase has been entered

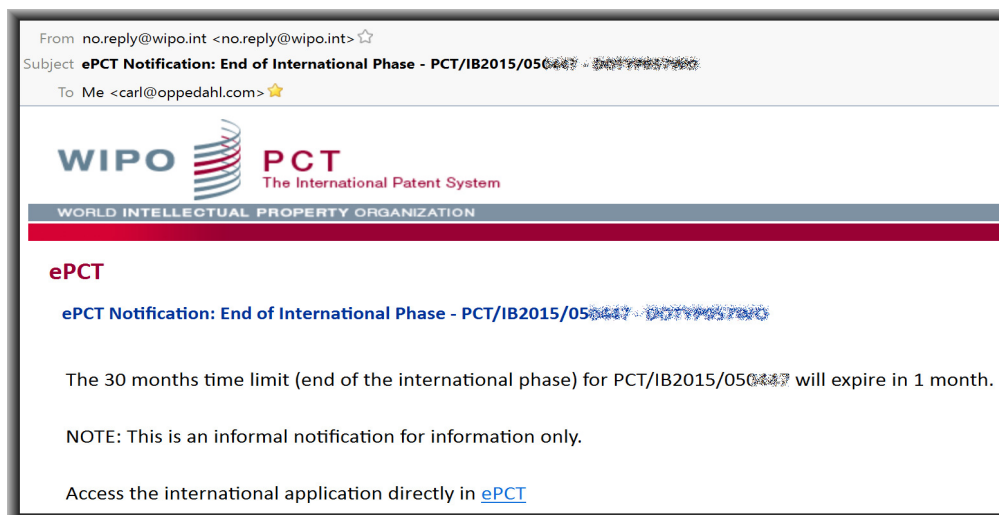
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The end of the international phase

- The international phase ends when you enter the national phase
- You could enter the national phase a day after filing a PCT application
- You could wait until almost the end of 30 or 31 months to enter the national phase
- It is important to keep close track of the 30-month period
- It is important to remind the client about the 30-month period


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Note that ePCT will warn you that the end of the 30 months is imminent



The screenshot shows an email notification from WIPO. The header includes the sender 'no.reply@wipo.int', the subject 'ePCT Notification: End of International Phase - PCT/IB2015/050447', and the recipient 'Me <carl@oppedahl.com>'. The main body of the email features the WIPO and PCT logos, followed by the text 'ePCT' and the subject line. The notification states that the 30-month time limit for the application PCT/IB2015/050447 will expire in 1 month. A note clarifies that this is an informal notification for information only. At the bottom, there is a link to access the international application directly in ePCT.

From no.reply@wipo.int <no.reply@wipo.int> ☆
Subject ePCT Notification: End of International Phase - PCT/IB2015/050447 - 0017763786
To Me <carl@oppedahl.com> ☆

WIPO  **PCT**
The International Patent System
WORLD INTELLECTUAL PROPERTY ORGANIZATION

ePCT
ePCT Notification: End of International Phase - PCT/IB2015/050447 - 0017763786

The 30 months time limit (end of the international phase) for PCT/IB2015/050447 will expire in 1 month.

NOTE: This is an informal notification for information only.

Access the international application directly in [ePCT](#)

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IPRP-I and IPRP-II

- Every PCT application gets an International Preliminary Report on Patentability (except in the rare case where no ISR was established)
- If no Demand was filed, the application receives an IPRP under Chapter I of the Treaty (IPRP-I)
- If a Demand was filed, the application receives an IPRP under Chapter II of the Treaty (IPRP-II)

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IPRP-I

If no Demand was filed, the application receives an IPRP under Chapter I of the Treaty (IPRP-I)

- This comes from the International Bureau
- The IB simply places a cover sheet over the Written Opinion of the ISA
- This happens shortly after the 30th month

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IPRP-II

- If a Demand was filed, the application receives an IPRP under Chapter II of the Treaty (IPRP-II)
- This is mailed by the International Preliminary Examining Authority
- This often happens around the 28th month

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WO/ISA and WO/IPEA

- Every application receives a Written Opinion of the International Searching Authority (except in the infrequent case where no ISR was established)
- If a Demand is filed, then usually the IPEA adopts the WO/ISA as its Written Opinion
- An IPEA could, however, establish its own WO
- This sometimes happens if the IPEA is not the same as the ISA
- If the IPEA establishes its own WO, this is termed the WO/IPEA

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Entry into national phase and regional phase outside of the US

- WIPO provides a table which summarizes the time limits for national- and regional-phase entry
- Click on “PCT” and “time limits”
- Examples:
 - CN 30 months
 - EP 31 months
 - JP 30 months
 - KR 31 months

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Entry into national phase and regional phase outside of the US

- The client will need to decide where (if at all) the client wishes to enter the national and/or regional phase
- Many factors might affect these important decisions as for a particular country or region
 - Size of the economy in that country or region
 - Prosecution cost in that country or region
 - Business needs of the client in that country or region

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Entry into national phase and regional phase outside of the US

- You will need to send instructions to foreign counsel
- Best Practice is that foreign counsel already uses ePCT, in which case you need merely click to give ePCT access to foreign counsel
- Another option is to send the permalink from Patentscope (if the application has been published)
- You will need to let foreign counsel know your file number

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Entry into national phase and regional phase outside of the US

- When sending instructions to foreign counsel, allow enough time for translations and other tasks
- Coordinate with foreign counsel about local needs. For example in EPO you will probably want to limit the application to fifteen claims
- Docket to check for prompt confirmation of instructions from foreign counsel

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Pursuing US patent protection from a PCT application

- There are two ways to pursue US patent protection from a PCT application:
 - US national phase
 - Bypass continuation
- Be alert to the possibility of making use of the Patent Prosecution Highway

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Comparing national phase with bypass continuation

Examiner's ability to impose restriction requirement

- With national phase, the restriction standard is “unity of invention”
- With bypass, the restriction standard is the regular domestic “distinct invention” standard
- Many applicants prefer the “unity of invention” standard

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Comparing national phase with bypass continuation

Certified copies of priority applications

- With national phase, nearly always the certified copies are taken care of automatically as part of the PCT process
- With bypass, it is the applicant's responsibility to attend to the certified copies
 - You may have the good luck that PDX or DAS will obtain the certified copies electronically
 - Otherwise you will have to provide physical certified copies

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Comparing national phase with bypass continuation

Getting help from the USPTO

- With national phase, you get to use the PCT Help Desk (+1 571 272 4300)
- With bypass, your source of help is the Application Assistance Unit (+1 571 272 4000)

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Comparing national phase with bypass continuation

Occasionally an applicant will have a PCT application in which a would-be priority claim was not timely presented

- In a US national phase case from the PCT, the priority claim problem **cannot** be corrected
- In a bypass continuation from the PCT, the priority claim problem **can** be corrected

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Comparing national phase with bypass continuation

- With a bypass continuation, if things are not filed all at once, extra government fees are incurred
- With a US national phase entry, you can file piecemeal up to the 30-month date without incurring extra government fees

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Comparing national phase with bypass continuation

Suppose the 30-month date has arrived and client has not given clear instructions whether to proceed

- With a bypass continuation, the filing fee could be handed in late so long as you do not mind paying a late fee
- With a US national phase entry, you must pay the base national phase filing fee within the 30 months

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US national phase

- Entry into the US national phase should be done with EFS-Web
- The initial submission package should include the Application Data Sheet
- Filings can be done piecemeal
 - ADS filed on Monday
 - Inventor declaration filed on Tuesday
 - Government fees paid on Wednesday

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US national phase

If you have some references (such as references from the PCT International Search Report) that need to be disclosed in the national phase case, do it immediately

- For example suppose you are not planning to enter the US national phase until the 29th month
- Maybe the ISR arrives at the 16th month
- Best Practice is to file an ADS to start the national phase application process and then file the IDS
- This way the IDS is done and you do not need to worry about forgetting to file the IDS
- This provides an offsite backup for the IDS references

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US national phase

Best Practice is to secure the inventor's signature on an Assignment and US inventor declaration as soon as possible

- Suppose you have obtained these signatures a few days after filing the PCT application (the documents bearing the PCT application number)
- And suppose you are not planning to enter the US national phase until the 29th month
- Best Practice is to file an ADS to start the national phase application process and then e-file the inventor declaration
- Best Practice is to file the Assignment in EPAS
- This provides an offsite backup for the declaration and Assignment

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US national phase

Consider that the PCT application may have been filed with a US inventor declaration

- Check ePCT or Patentscope to see if a US inventor declaration is already in the application file
- If so, then download it from ePCT or Patentscope and upload it to EFS-Web
- This will save having to prepare an inventor declaration and getting it signed

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US national phase – the “short list”

- What must be filed at USPTO to avoid abandonment at 30 months from priority?
 - Identify the PCT application
 - Pay the base national phase fee
 - If the PCT application has not been published (very unlikely), provide a copy of the PCT application
- Best Practice is to do this via EFS-Web

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US national phase – the “long list”

- What must be filed in addition to the “short list” to avoid not only abandonment but also a notice of missing requirements?
 - Pay the rest of the needed fees besides the base national phase fee (search fee, exam fee, excess pages fee, multiple dependent claim fee, excess claims fee)
 - English translation of the PCT application (if not in English)
 - Inventor's declaration
 - Translation of the annexes to the IPRP-II (if there is one, and if the annexes are not in English)

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Other papers to file

- Power of Attorney
- Information Disclosure Statement
- Assignment

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US national phase – express request

- Suppose the “long list” is satisfied prior to the end of the 30 months, what will DO/EO/US do?
- Nothing
- If the applicant wants USPTO to commence the national phase process before the end of the 30 months, the applicant must make an “express request” for immediate national stage processing
- This can be done by means of Form PTO-1390
- It is a Best Practice to do so
 - Case will get examined sooner
 - Applicant might get more Patent Term Adjustment

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US national phase – trap for the unwary

- Some filers include a blanket authorization to charge any and all fees due to the filer's USPTO deposit account
- PCT application might have excess claims
- Filer might be assuming that the excess claims can be canceled later by preliminary amendment
- DO/EO/US will charge the deposit account for all of the excess claims
- In the past this has sometimes amounted to tens of thousands of dollars
- ***Filer should avoid such a blanket authorization***

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US national phase – docketing

Docket the 30-month date

- The 30-month date should be cleared **only** when the “long list” has been fulfilled
- When the “long list” is fulfilled, docket to check for receiving the Filing Receipt and Form PCT/DO/EO/903 Notice of Acceptance into the National Phase

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What is the Filing Date?

- What is the Filing Date for an entry into the US national phase?
- It is the PCT filing date (see 35 USC § 363)
- The Filing Receipt will not list this date as the “filing date”
- PAIR will not list this date as the “filing date”

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When the Filing Receipt arrives

- Closely review the Filing Receipt
- Make sure it states that the application is a 371 of the PCT application
- Make sure the foreign priority is listed and is accurate
- Applicant name listed correctly (e.g. non-inventor applicant)
- Correspondence address correct
- If a Power of Attorney was filed, check that the power of attorney is listed correctly

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When the Form PCT/DO/EO/903 arrives

- Closely review the Form
- Check accuracy of dates that filing tasks were carried out
- USPTO might have overlooked the Express Request
- Check the 371 date (which is a function of when the “long list” was satisfied and when an Express Request was filed)

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Handing in the inventor declaration

- The rules permit postponing the inventor declaration until the Notice of Allowance, but this is not a Best Practice
- The inventor declaration should be handed in as early as possible
- To avoid a late fee, the inventor declaration should be handed in before the 30-month date

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US national phase – if the 30-month date was missed

- If the 30-month date was missed, but the failure to file timely was unintentional, then a Petition to Revive may be filed along with the “short list”
- Late fees will still have to be paid for the items that are on the “long list” but are not on the “short list”

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Signatures for the Petition to Revive

- A Petition to Revive requires two distinct signatures
- A signature from someone with personal knowledge of the facts to state that “the entire period of delay was unintentional”
- A signature from an authorized person on the Petition itself
- These are not the same thing and you will probably be unable to use Form PTO/SB/64PCT as is

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Signatures for the Petition to Revive

- Who is “an authorized person” for the signature on the Petition itself?
- If a non-inventor applicant has been identified on an ADS, then the authorized practitioner may sign the Petition
- This person may not have personal knowledge of the facts as to the delay being unintentional

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If a Restriction Requirement arrives

- If you receive a Restriction Requirement in a US national phase application ...
- Check to see whether it is a “unity of invention” RR or a “distinct invention” RR under 35 USC § 121
- If it is a “distinct invention” RR then the applicant may wish to request that it be withdrawn

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Minimal filing for bypass continuation

- A minimal filing for a bypass continuation is just an ADS, checking the box to do a “file by reference”
- The FBR section will list the PCT application and filing date
- No fees need to be paid for such a minimal filing
- Best Practice is to do this via EFS-Web
- The minimal filing is to be considered if time is very short or client instructions are not definite

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Bypass continuation

The normal filing requirements for a bypass continuation are the same as for a “111a” application (ordinary domestic filing)

- Specification
- Claims
- Abstract
- Drawings
- Fees
- Inventor Declaration
- Application Data Sheet

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Bypass continuation

You will need to provide certified copies of your priority documents

- You may get lucky and PDX or DAS may accomplish this electronically
- Otherwise you will need to obtain physical certified copies and send them to the USPTO
 - Docket to make sure the USPTO receives the certified copies and that they are visible in IFW

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Other papers to file

- Power of Attorney
- Information Disclosure Statement
- Assignment

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Patent Prosecution Highway

- Client should be counseled that if a case is placed on the Highway, this does not assure that the USPTO will give deference to the Written Opinion or IPRP-II that enabled the case to get on the Highway
- USPTO's only commitment is to make the case "special" which means it should get examined sooner than a non-Highway case
- The allowance rate for Highway cases is nonetheless much higher than for non-Highway cases

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Patent Prosecution Highway

- Some studies have found that as between a Highway case and a non-Highway case, the Highway case will on average have one less Office Action
- This saves prosecution costs for the applicant

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Patent Prosecution Highway

- PCT-PPH is equally available for bypass continuations as for US national-phase cases
- You must file an IDS disclosing all of the references developed in the international phase
- The IDS must also disclose the work product (ISR, WO, IPRP-II)

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Getting older PCT applications loaded into ePCT

- We have already discussed how to get a to-be-filed PCT application into ePCT
- It is also a Best Practice to get all of your older PCT applications loaded into ePCT
- All applications filed on and after January 1, 2009 may be loaded into ePCT
- Procedure is different depending upon whether the application has or has not been published

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Getting older PCT applications loaded into ePCT

- If the application has not been published
- Find Form PCT/IB/301 which has a secret code number in the lower right corner
- Go to ePCT and click on eOwnership
- Enter the application number and filing date and secret code number
- Follow any additional instructions in ePCT

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Getting older PCT applications loaded into ePCT

- If the application has been published
- Go to ePCT and click on eOwnership
- Enter the application number and filing date
- “secret code number” field may be left blank
- The IB will mail out Form PCT/IB/345 which contains a secret code number
- Return to ePCT and click on eOwnership
- Enter the application number and filing date and secret code number

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Generating useful reports from ePCT

- Applications with priority documents outstanding
- Applications with Form PCT/ISA/202 outstanding

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Applications with Form PCT/ISA/202 outstanding

- Open ePCT and go to the Workbench
- Click “show filter” and expand “status”
- Pick “receipt of search copy at ISA confirmed to the IB” as “no” and click “apply filter”
- This will identify your PCT applications that are missing the Form PCT/ISA/202
- Depending on client needs and priorities, you may wish to follow up on such applications

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Applications with priority documents outstanding

- Open ePCT and go to the Workbench
- Click “show filter” and expand “documents”
- Pick “with outstanding priority documents” and click “apply filter”
- This will identify your PCT applications that have outstanding priority documents
- It is important to follow up on such applications

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Informal comments to the ISR/WO

- One option if an applicant has received a less than fully favorable ISR/WO is to file informal comments at the IB
- It is quite rare that an applicant has chosen to do this
- It would nonetheless given an applicant an opportunity to “put in its side of the story” without the expense of filing a Demand
- This can be done as an “upload” in ePCT
- See the *PCT Applicant's Guide* for details

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Third-party submissions of prior art

- A third party could submit prior art with respect to your pending PCT application
- You could file a response to such a submission
- Both have only rarely been carried out
- Nonetheless if someone were to make such a submission, it would be very important to file such prior art at the USPTO as an Information Disclosure Statement
- Best Practice is to make sure your PCT application is in your ePCT workbench so that you learn of such a submission as promptly as possible
- You would then want to file the IDS as promptly as possible thereafter

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Applicant disclosures of prior art

- There is a way in ePCT to disclose known prior art in your pending PCT application
- Such a disclosure will be communicated to the ISA if it happens early enough in the international phase
- Such a disclosure will be available to the IPEA if it happens early enough in the international phase
- Such a disclosure will be available to Designated/Elected Offices
- Such disclosures have only rarely been made to date

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Supplementary International Search

- An applicant can request a second search that would follow the search by the ISA
- One reason for doing this might be to use a Supplementary International Searching Authority with a different language strength than that of the ISA
- This has only rarely been carried out
- See the *PCT Applicant's Guide* for details

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Restoration of the Right of Priority

- If the applicant misses the 12-month priority period set forth in Article 4 of the Paris Convention ... but discovers the lapse before 14 months have passed ...
- Then ROP might possibly help
- File the PCT application before the end of 14 months from priority and request ROP

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Restoration of the Right of Priority

- To use ROP the applicant would need to be able at a minimum to say (truthfully) that the lapse was *unintentional*
- Perhaps the applicant will also be able to establish that the lapse occurred *despite the exercise of due care*
- There are some Designated Offices, among them EPO, that will recognize ROP only if the granted ROP request is a “due care” request

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Restoration of the Right of Priority

- WIPO's web site has a very helpful table detailing the ROP situation in various patent offices around the world
- From the main web page, click on PCT and “Restoration of the Right of Priority”

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Restoration of the Right of Priority

- In the first instance an applicant seeking ROP will present the request to the Receiving Office
- If the RO declines to grant ROP, the applicant can request ROP from the DO/EO
- RO/US will only entertain an “unintentional” request and will not entertain a “due care” request
- If the applicant seeks restoration with respect to an Office that only recognizes “due care” ROP, then this means RO/US is not a good choice

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Restoration of the Right of Priority

- The government fee charged by RO/US is \$1700 (half for small entities)
- RO/US will only entertain an “unintentional” request and will not entertain a “due care” request
- If the applicant wants to seeks restoration with respect to an Office that only recognizes “due care” ROP, then this means RO/US is not a good choice

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Restoration of the Right of Priority

- RO/IB will entertain an “unintentional” request or a “due care” request
- The fee charged by RO/IB is zero
- If the applicant wants to seeks restoration with respect to an Office that only recognizes “due care” ROP, then this means RO/IB is a good choice
- But if the invention was made in the US, it will be necessary to obtain a Foreign Filing License first

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Restoration of the Right of Priority

- The applicant may already have a Foreign Filing License in the priority application
- It is also possible to obtain an FFL from the USPTO by fax
- See the *PCT Applicant's Guide* for details

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Incorporation by reference

- The term “incorporation by reference” means different things depending on the context
- In the context of PCT, IBR has a very specific meaning
- If, when filing a PCT application, the applicant omitted a part of the application (“part” explained later) ...
- And if the Request contained a priority claim and contained certain “magic words” about IBR ...
- Then the applicant can bring in the omitted part from the priority application

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Incorporation by reference

- PCT IBR works only if what was omitted was one (or more) of the following:
 - a part of, but not all of, the description
 - a part of, but not all of, the claims
 - a part of, or all of, the drawings
- PCT IBR will not work if the lapse is so severe that the application lacks “a part which on the face of it appears to be a claim”
- PCT IBR will not work if the lapse is so severe that the application lacks “a part which on the face of it appears to be a description”

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Incorporation by reference

- PCT IBR will not work if what was filed was *the wrong description*
- PCT IBR will not work if what was filed was *the wrong claims*
- PCT IBR will not work if what was filed was *the wrong drawings*

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IBR and ROP

- It will be appreciated that IBR and ROP are somewhat related. In a situation where IBR will not help, perhaps ROP will help, or *vice versa*
- Suppose for example that a PCT filing was defective in a way that could not be fixed by IBR, and suppose this lapse is detected before the 14th month has passed ...
- Then the applicant might consider filing a new PCT application and asking for ROP