

Avoiding Malpractice When Filing PCT Applications

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National Association of Patent Practitioners

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10:10 AM – 10:40 AM

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Goals for the next 30 minutes

- Best practices for filing of PCT applications
- Avoiding embarrassment in front of clients
- Avoiding malpractice

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Helpful PCT resources

- WIPO's PCT Distance Learning Course
- WIPO video series (Matthias Reischle)
- WIPO's PCT Applicant's Guide
- The PCT listserv (email discussion group)
- PCT section of the *Ant-Like Persistence* blog

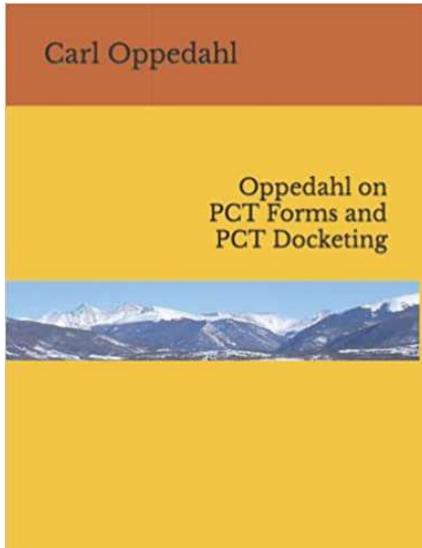
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Helpful PCT resources

- WIPO's PCT Help Desk
+41 22 338 83 38
- USPTO's PCT Help Desk
+1 571 272 4300
- Make sure you are subscribed to WIPO's *PCT Newsletter*

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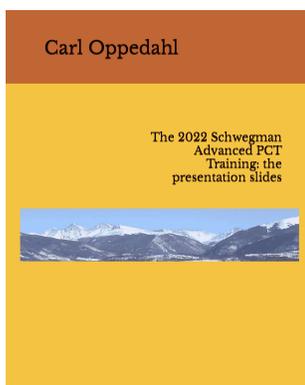
Helpful PCT resources



- The fifty PCT forms that you are most likely to encounter
- Which dockets to set or clear when these forms arrive
- What dates and check boxes to check on the forms
- Warning signs that you can detect from the forms
- Order through your local bookstore
- Also available at shop.oppedahl.com
- Also available on Amazon
- ISBN-13 : 979-8766914655
- Paperback : 218 pages
- A bargain at USD 89

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Helpful PCT resources



- https://blog.oppedahl.com/?page_id=7703
- Fourteen hours of free PCT training
- Video is available for free
- Slides are available for free
- You can binge-watch this
- Slide book costs \$9.95
- This is cheaper than printing the slides

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Make sure your priority applications are in DAS

- Your PCT application will probably claim priority from some previous application
- Make sure it is available to the DAS system
- This means file it with an ADS
- The ADS contains magic words about making the application available to the DAS system
- This means do not use a mere provisional cover sheet

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What? You don't know about DAS?

- If you don't know about DAS, you need to learn about it
- Google "WIPO DAS" and study the DAS page on the WIPO web site
- Go to the *Ant-like Persistence Blog* and search "DAS Quiz"
 - or key in <https://blog.oppedahl.com/?p=3337>

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For each of your priority applications

- Docket a couple of weeks after filing the priority application ...
 - Set up “tracking” in the DAS system
 - Obtain a *Certificate of Availability* in the DAS system

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SAOSIT

- Same applicant or successor in title
- We could spend a whole session on this
- Google SAOSIT
- Read my blog article about it
 - Search box in my blog
 - or key in <https://blog.oppedahl.com/?p=3958>

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SAOSIT

- Same applicant or successor in title
- When you file your PCT application, the PCT applicant needs to be the same applicant as the applicant in your provisional application
- Yet another reason to use an ADS, not a mere provisional cover sheet
- Best practices for filing provisional patent applications
 - See my blog article – use the search box
 - or key in <https://blog.oppedahl.com/?p=3508>

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That was maybe ten months ago

- Okay the priority application got filed maybe ten months ago. You are getting ready to prepare and file your PCT application. How to avoid embarrassment in front of your client? How to avoid malpractice?
- You already reduced those risks by getting your priority application into DAS
- You already reduced those risks by making sure your provisional application named the correct corporate entity as the applicant so as to avoid screwing up SAOSIT
- Now you are getting ready to prepare and file your PCT application

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No informal drawings

- In domestic US practice you get to be a lazy bum with drawings
- Hand in informal drawings on filing day
- When you feel good and ready, at some later time, hand in your formal drawings
- Right?
- Not for PCT!
- You must have the self-control to get your PCT formal drawings ready in time to file them on filing day
- Search “PCT drawings” in my blog
 - or key in <https://blog.oppedahl.com/?p=4437>

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No incorporation by reference

- Many US filers rely on IBR when preparing a patent application
- This is no good for PCT applications
- In almost every country that is not the US, IBR is not permitted
- It sounds really old-fashioned, but if you need something for enablement, *you need to put it into the patent application*
- There is a kind of IBR that works in PCT but it is not the kind of IBR that you think it is so don't think you can use IBR in PCT patent applications

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What screwups are fixable?

- Most screwups are fixable
 - Maybe you pay money
 - Maybe you file a petition
 - Maybe you say you had a good excuse
 - Maybe you say you are very sorry

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What are examples of screwups that are not fixable?

- No matter how sorry you are
- No matter how good your excuse is
- No matter how willing you are to pay some money
- No matter how willing you are to file a petition

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Missing the 4-and-16 date

- If you miss the 4-and-16 date, in most countries around the world, it is too bad, so sad
- Oh by the way what is the 4-and-16 date?
- 4 months from when the application was filed in the Office of Second Filing under Article 4 of the Paris Convention
- 16 months from when the priority application was filed

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How do we screw up the 4-and-16 date?

- There are lots of ways to screw up the 4-and-16 date
- One way is to get a digit wrong in the priority application number
- Another way is to transpose a couple of digits in the priority application number
- Another way is to get the day-month-year wrong for the filing date of the priority application
- May sixth? June fifth?

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How do we communicate bibliographic data to the patent office when we file a patent application?

- If it is a US domestic patent application, we communicate it by means of ... the application data sheet
- If it is a PCT patent application, we communicate it by means of ... the Request (form PCT/RO/101)

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How do you communicate your **PCT Request** to the PCT Receiving Office?

- Do you communicate your PCT Request to the PCT Receiving Office as a PDF?
- Guess what? You are in good company! Half of US filers do it this way
- And you are committing malpractice!

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What is the non-malpractice way to communicate your **PCT Request** to the Receiving Office?

- The non-malpractice way to communicate your **PCT Request** to the Receiving Office is ...
 - If you are filing at RO/US, you upload a ZIP file to Patentcenter or to EFS-Web
 - If you are filing at RO/IB, you use ePCT

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If you are filing in RO/US

- Then you might be using EFS-Web and it asks you this:

| | |
|--|---|
| Application Type | International Application (PCT) for filing in the US receiving office |
| Are you attaching a PCT-EASY zip file? <input type="radio"/> Yes <input checked="" type="radio"/> No | |

The “no” answer means “I wish to commit malpractice”

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Where do you get the ZIP file?

- You get the ZIP file by using ePCT
- You load in the bibliographic data
- Who is the applicant?
- Who are the inventors?
- Which searching authority did the client choose?
- What are you claiming priority from?
 - What is the priority application number?
 - What is the priority application filing date?
 - What is the country code for the patent office where the priority application was filed?

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When you get to the place in ePCT where you say you are claiming priority from something ...

The malpractice-avoiding way to do it is to say this:

| | | |
|-------------|---|--------------------------------------|
| VI-1 | Priority claim of earlier national application | |
| VI-1-1 | Filing date | 13 February 2020 (13.02.2020) |
| VI-1-2 | Number | 62/976,260 |
| VI-1-3 | Country or Member of WTO | US |
| VI-2 | Priority document request | |
| | The International Bureau is requested to obtain from a digital library a certified copy of the earlier application(s) identified above as item(s), using, where applicable, the access code(s) indicated: | VI-1 Access code: 6511 |

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ePCT cross-checks with DAS

ePCT will then cross-check your priority claim with the DAS system

This catches it if you got a digit wrong with your application number

or entered May sixth when you should have entered June fifth

You have just been saved from malpractice

But only because you loaded your priority application into the DAS system

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Other ePCT benefits

- There is a function in ePCT that is like Private PAIR
- It lets you see the status and content of your pending PCT application even if it has not yet been published
- You need to be using this function of ePCT
- To do this you have to already have a WIPO user ID and password
- To do this you have to already have set up two-factor authentication for your WIPO user ID

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Other ePCT benefits

- Does PAIR give you reminders of upcoming due dates? No
- ePCT gives you reminders of upcoming due dates
 - The due date for filing your PCT application
 - The due date for filing a Demand
 - The end of the 30-month period
- But you get these benefits only if you have a WIPO user ID and password, and only if you have set up two-factor authentication, and only if you get your PCT applications loaded into your ePCT workbench
- You need to be using ePCT to generate that ZIP file
- You need to be using ePCT for its function that is sort of like Private PAIR

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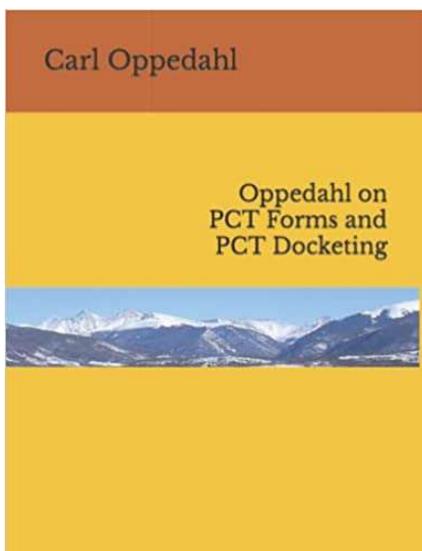
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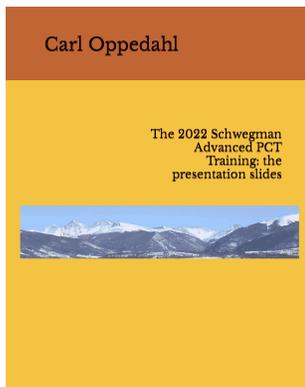
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Evaluation form

- Be sure to fill out the evaluation form

Thank you!

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