

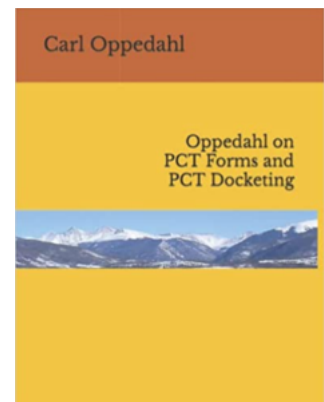
Preparing for the November 28, 2023 webinar

What will I need to have in hand when I attend the webinars? To make best use of the webinar, you will need to have on hand a *copy of each PCT form being discussed*. I can imagine three ways that you might do this.

Print copies of the PCT forms. You can go to the WIPO web site at <https://www.wipo.int/pct/en/forms/ro/index.html> and you can click on and print out each of the approximately sixteen PCT/RO forms that will be discussed. This approach has the advantage that you can write notes on the forms and can jot questions on the forms. You can then preserve your annotated forms along with the presentation materials.

Viewing the PCT forms on a computer screen. Some attendees might choose simply to view the forms on a computer screen. To make this work well you would likely want to use two computer monitors during the webinar, devoting one monitor to the forms as viewed at <https://www.wipo.int/pct/en/forms/ro/index.html> and devoting the other monitor to the live webinar activity.

The PCT Forms book. Some attendees will already have a copy of the book *Oppedahl on PCT Forms and PCT Docketing*. If so, then the attendee will find it very helpful to keep the book at hand during the webinar, turning the pages of the book to follow along as we discuss the various PCT/RO forms one by one. This permits writing notes on the forms and jotting questions on the forms.



Printing out the presentation materials. Most attendees will likely find it very helpful to print out the presentation materials in advance of the webinar. This permits taking notes and jotting questions on the presentation materials.

Receiving Office forms

Tuesday, November 28, 2023
10AM to 11:30 AM MT

Carl Oppedahl
Blog.oppedahl.com

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Today's webinar

- Feel free to post questions as they come to mind
- We will adjourn at 90 minutes and this means some slides might get deferred to the next webinar on Tuesday, December 5, 2023
- You will want to refer to the forms themselves:
 - You may have already printed them out from <https://www.wipo.int/pct/en/forms/>
 - You may have set it up to view them on a computer screen from <https://www.wipo.int/pct/en/forms/>
 - You may be making use of a copy of *Oppedahl on PCT Forms and PCT Docketing* which provides the forms

2

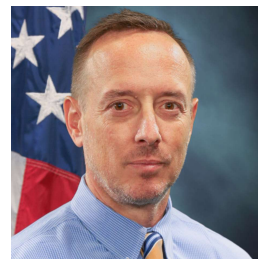
The next three webinars

- **International Bureau forms** webinar, Tuesday, December 5, 2023, 10AM to 11:30 AM MT. Note that depending on timing, some of the International Bureau forms will likely be covered in the December 8 webinar. If you sign up for the December 5 webinar, you will probably also want to sign up for the December 8 webinar.
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Who thought of this

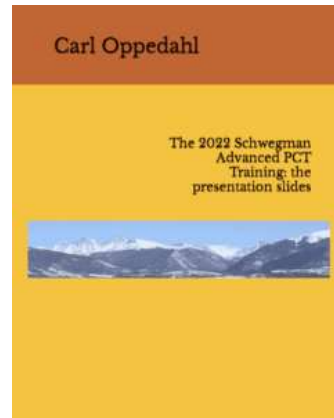
The person who thought of this webinar concept is Mike Neas, former Deputy Director of International Patent Legal Administration at USPTO



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Helpful resources

- Binge-watching 14 hours about the PCT
- Free of charge
- <https://blog.oppedahl.com/the-2022-schwegman-advanced-pct-training/>



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Polling question

6

Helpful resources

- Binge-watching 19 hours about ePCT
- Free of charge
- <https://blog.oppedahl.com/please-sign-up-for-fifteen-webinars-about-epct/>

7

Polling question

8

PCT Distance Learning Course:
Introduction to the Patent Cooperation Treaty

Course number PCT_101E – DL101

- Free of charge
- Self-paced
- You can earn a certificate
- https://welc.wipo.int/acc/index.jsf?page=courseCatalog.xhtml&lang=en&cc=PCT_101E

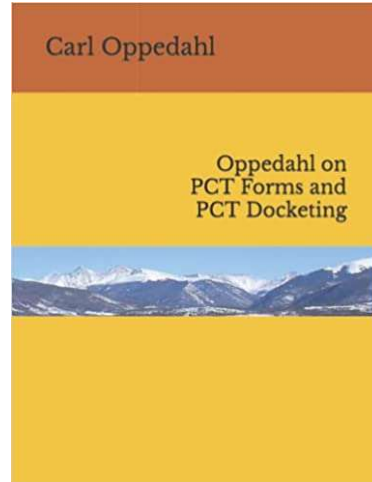
9

Polling question

10

Oppedahl on PCT Forms and PCT Docketing

- 218 pages
- 8.5 x ½ x 11 inches
- Language: English
- ISBN-13: 979-8766914655
- Item Weight: 1.41 pounds



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PCT listserv

- https://oppedahl-lists.com/mailman/listinfo/pct_oppedahl-lists.com
- More than 900 members

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Polling question

13

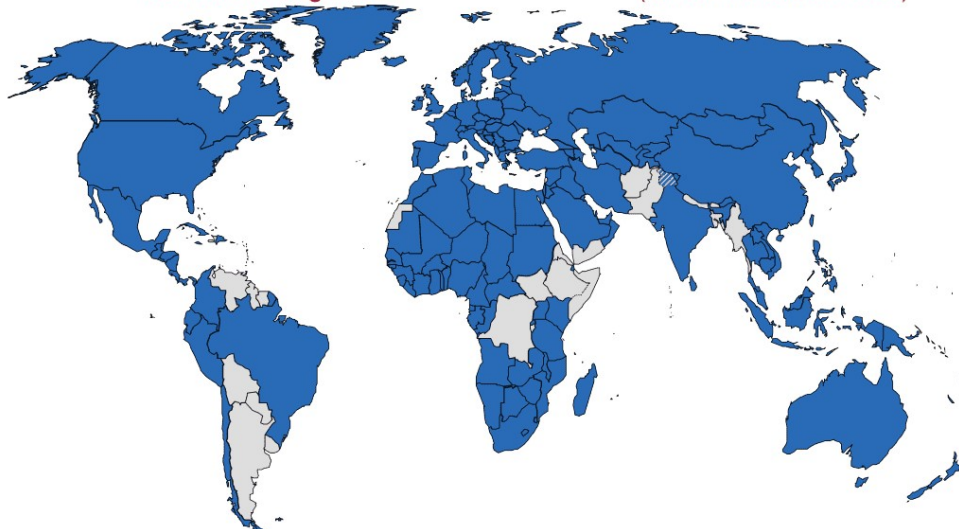
Why we use PCT?

- Assume you already have a patent application prepared that is ready to file
- What does it cost to file that patent application in EPO?
- What does it cost to file that patent application in KIPO?
- What does it cost to file that patent application in JPO?
- What does it cost to file that patent application in CNIPA?
- When would you like to spend this money? Before you know whether or not the invention is patentable?

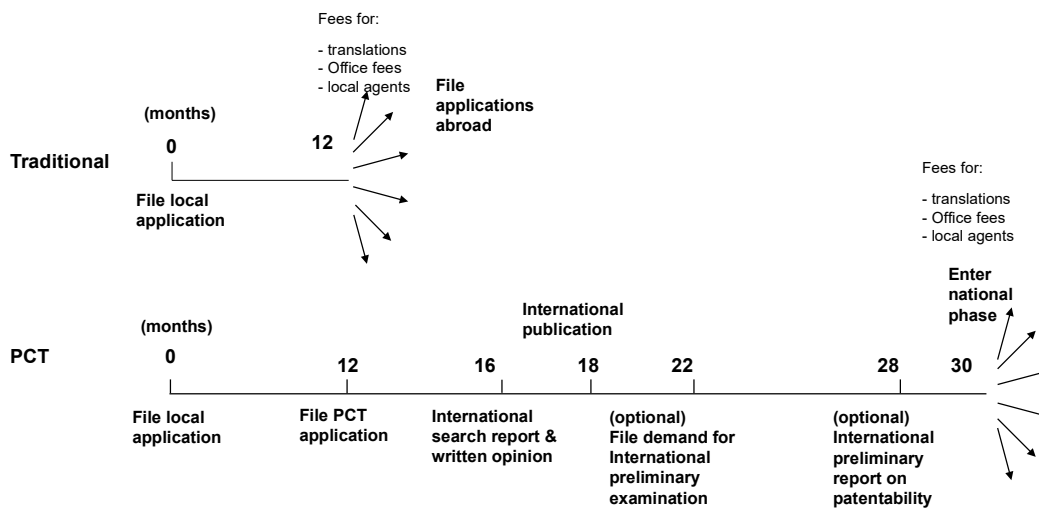
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PCT Contracting States

(157 on 1 November 2023)



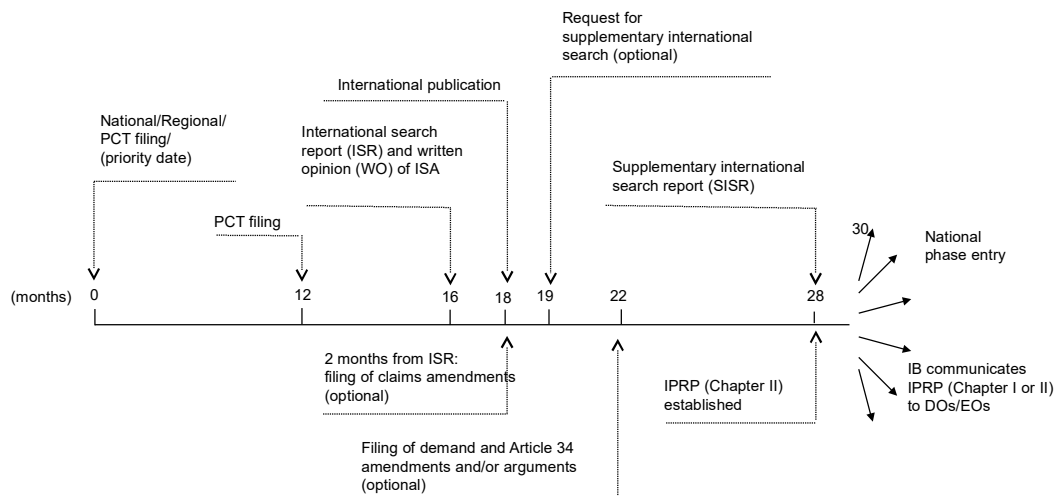
Traditional patent system vs. PCT system



Typical sequence of events

- Light bulb blinks on over the inventor's head
- Provisional patent application gets filed
- Some months pass
- PCT application gets prepared and filed
- ISR/WO arrive
- Maybe a Demand gets filed
- Entry into national phase in one or more of 120 Designated and Elected Offices

17



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Our docket clerks

Thank you to our docket clerks!

19

Calling a meeting

From time to time I will describe some event and I
will say “it is time to call a meeting”

What this means

20

Form PCT/RO/102 Notification Concerning Payment of Prescribed Fees

What's going on here: This is the form by which the receiving office tells you how much money they think you need to pay, how much money you have actually paid and the balance, namely how much money you still need to pay.

Inbound docketing significance: When this form arrives, you get to clear the docket to check for receipt of Form PCT/RO/102. If no docket had been set, then you get to Call a Meeting.

Reporting: You will probably want to report this to the client.

Next steps: Once the form does arrive, you're going to want to proofread carefully and make sure that you agree with what it says about the money that you paid. If there's any balance left to pay, you need to pay it within one month.

Outbound docketing significance: If it says you need to pay money and if you agree that you need to pay money, you need to set a docket to make sure that you actually pay the money.

21

Form PCT/RO/103 Invitation to Correct the Purported International Application

What's going on here: This is a form by which the receiving office tells you that there is something wrong with your international application. If you receive this form, it's a very serious matter. The problem is that if you do not manage to straighten out whatever it is that the receiving office doesn't like, you're going to end up with the unhappy news that you did not actually file a PCT application at all. If you receive this form, you need to Call a Meeting.

Inbound docketing significance: you will not have been expecting this form.

Reporting: Yes it must be reported to the client.

Next steps: dealing with whatever issues are raised in this form.

Outbound docketing significance: See above.

22

Form PCT/RO/104

Notification that the Purported International Application is not and Will not Be Treated as an International Application

What's going on here: This is an extremely serious document. If you receive this, you need to Call a Meeting. It means that you are being told that you did not actually file a PCT application.

Inbound docketing significance: you will not have been expecting this form.

Reporting: Yes it must be reported to the client.

Next steps: dealing with whatever issues are raised in this form.

Outbound docketing significance: See above.

23

Form PCT/RO/105 – Notification of the International Application Number and of the International Filing Date

What's going on here: This is usually a "good news" form.

Inbound docketing significance: From the docketing point of view, a chief significance of this form is that you will have already set a docket to check to make sure that you received Form PCT/RO/105. If so, then you get to clear the docket. If not, then you get to Call a Meeting.

Reporting: This form is the equivalent of a filing receipt from a national patent office. This is the form by which a receiving office delivers the good news that they think you really did file a PCT patent application. You can look at this form and you can see the filing date by which the receiving office says you filed your PCT application. You will of course want to proofread this form carefully to make sure that it matches the date that you think you filed your PCT application. Yes you will want to report this to the client.

Outbound docketing significance: When this form arrives, you'll want to set a new docket to check for receipt of Form PCT/IB/301 from the International Bureau.

24

Form PCT/RO/106 – Invitation to Correct Defects in the International Application

What's going on here: This is the form by which the receiving office tells you that they think there is some defect in your international application.

Inbound docketing significance: You would normally not have docketed to expect this form.

Reporting: You will typically want to report this to the client.

Next steps: A typical defect would be communicated on Annex C1, namely that RO thinks that the drawings do not permit "reasonably uniform international publication". This is quite scary since the form explains that:

Failure to correct the defects will result in the international application being considered withdrawn by this Office.

USPTO people explain that RO/US does not really carry through on this threat. The filer that wishes to get the last word could file a response stating that the applicant respectfully disagrees with the RO/US and feels that the drawings do permit reasonably uniform international publication.

It is much better to have filed formal drawings from the outset.

Outbound docketing significance: You will want to docket two months to check for correcting the defects. In the case of an application filed in RO/US where the defect is a supposed failure regarding reasonably uniform international publication, one might wish to file the above-mentioned push-back response within those two months.

25

Form PCT/RO/107 – Invitation Relating to Certain Parts of the International Application that Are, or Appear to Be, Missing

What's going on here: This is an invitation relating to certain parts of the international application that are or appear to be missing. This is an extremely serious matter and it will be necessary to Call a Meeting.

Inbound docketing significance: You would normally not have docketed to expect this form.

Reporting: You will typically want to report this to the client.

Next steps: If you're extremely lucky, you might be able to use the incorporation by reference rules of the PCT to bring in subject matter from your priority application to somehow satisfy the problem of things that appear to be missing, or you may decide to tough it out and say that whatever is missing is not actually needed. Another possibility is that you may decide to just refile your PCT application, maybe filing a request for the restoration of priority.

Outbound docketing significance: You will want to docket two months to check for correcting the defects.

26

Form PCT/RO/108 – Invitation to Request Rectification

What's going on here: This is a form by which the Receiving Office tells you that it has identified what it feels is an obvious mistake. You will want to Call a Meeting.

This is a counterpart to Form PCT/IPEA/411 and Form PCT/IB/314 and Form PCT/ISA/216.

Inbound docketing significance: You would normally not have docketed to expect this form.

Reporting: You will typically want to report this to the client.

Next steps: The RO will usually give a hint as to which Office it feels is the correct Office to entertain the request for rectification.

Outbound docketing significance: You will want to docket this aggressively. If you made your request for rectification to the RO, then you will docket to check for receipt of form PCT/RO/109. If you made your request for rectification to the ISA, then you will docket to check for receipt of form PCT/ISA/217. If you made your request for rectification to the IB, then you will docket to check for receipt of form PCT/IB/315.

27

Form PCT/RO/109 – Notification of Decision Concerning Request for Rectification

What's going on here: This is the Receiving Office telling you its decision about whether it will carry out a rectification that you have requested. The point of this form is that you have submitted a request for rectification to the Receiving Office, and this is the RO's way of telling you what decision they have made about it.

Likely as not, the RO will be turning you down. The reason for this is that the RO has no one who is technically trained to independently evaluate from a technical point of view whether your proposed change is the only way that could possibly correct whatever was wrong. If so, the RO would then bounce the question to the International Searching Authority.

This is the counterpart to Form PCT/ISA/217 and Form PCT/IB/315 and Form PCT/IPEA/412.

Inbound docketing significance: If you had already set a docket, then you get to clear it. If you had not set a docket, then it is time to Call a Meeting.

Reporting: You may wish to report this to the client.

Next steps: Assuming the RO bounced the request to the ISA, then you will now wait to hear from the ISA as to whether or not it is willing to grant the rectification.

If the RO granted the request, and if for example your reason for the request was to try to get formal drawings entered into the case to replace originally filed informal drawings, then you will want to check to see if the front-page publication preview now shows the formal drawing.

You can request that the request for rectification and the decision be published, along with further brief comments. One must balance the possible benefit of such publication against the possible embarrassment of having the public reading about the situation.

Outbound docketing significance: You may end up setting a docket to check for Form PCT/ISA/217.

28

Form PCT/RO/110 – Invitation to Correct Priority Claim and/or Notification of Possibility to Request Restoration of the Right of Priority

What's going on here: This is the receiving office's way of telling you that they think there is something terribly wrong with your priority claim. You will need to Call a Meeting.

You probably should not have even gotten to this point. If you used ePCT to prepare your PCT request, then any serious problem with your priority claim would have been identified much earlier on in the process. The only way you could have even received this form is if you did not use ePCT to prepare your request. Nonetheless, if you are in receipt of form PCT/RO/110, this is an extremely serious matter, and you should try to figure out how you're going to deal with the problem. One possibility is that you would file a request for restoration of the right of priority, and you would need to urgently attend to this well before the end of P+14 (14 months from the priority date).

Inbound docketing significance: You would normally not be expecting this form.

Reporting: This needs to be reported to the client.

Next steps: You will want to take whatever steps are needed to correct the problem.

Outbound docketing significance: You will want to docket this aggressively.

29

Form PCT/RO/111 – Notification Relating to Priority Claim

What's going on here: This is the form by which the Receiving Office will tell you how they feel about, for example, attempts that you have made under Rule 26*bis* to make priority claim changes. Hopefully, the notification is telling you that the receiving office is accepting your priority claim change.

Inbound docketing significance: Presumably you already set a docket because you filed a change under rule 26*bis*. Now you get to clear the docket. If no docket had already been set, then you get to Call a Meeting.

Reporting: Hopefully the Notification is good news – the RO accepts your proposed change. Either way, you will probably want to report this to the client.

Next steps: If things are not as you wish them to be regarding priority claims, and if you have not yet used up your 4-and-16 time (four months from IFD, sixteen months from the priority date) then you need to keep trying.

Outbound docketing significance: See the above.

30

Form PCT/RO/113 – Request for the Recording of a Change (PCT Rule 92*bis*.1)

What's going on here: Nearly always, when a 92*bis* change gets requested, it gets requested by the applicant. The PCT rules provide, however, that a 92*bis* request can come from the Receiving Office. If so, the RO can do this by means of this form. More likely, the RO will be trendy, modern and up-to-date and will do this by means of ePCT, the result of which is a electronically generated form that is identical in substantive content to this form. Either way, you will want to pay close attention to the situation.

The need for this form would be expected to arise only rarely. Usually if an RO finds the need to change something of this nature, it will do so by means of an *ex officio* change to the Request prior to sending the Request along with the rest of the Record Copy to the IB. So what we are probably talking about here is a case where an RO already sent the Record Copy to the IB and then discovered the need for such a change.

Form PCT/RO/113 – Request for the Recording of a Change (PCT Rule 92*bis*.1)

Inbound docketing significance: If you receive Form PCT/RO/113 (or its ePCT equivalent), this means that your Receiving Office has for some reason decided that something needs changing. This might be a completely innocent and harmless thing – correcting *ex officio* a city name that the got misspelled by some participant in the PCT process – by the applicant, by the Receiving Office, even conceivably by the International Bureau. But it will be very important that you figure out what prompted the RO to do this. And it will be very important to figure out whether the proposed change somehow makes a big difference to your client. Unless you are absolutely certain that the explanation is indeed innocent and harmless, then you will need to Call a Meeting.

Reporting: Barring some surprise, this form will lead to a change in what will appear in the publication of the PCT application. It is the sort of thing that many clients would notice. For this reason alone you would want to report this to the client. You will probably want to capture a publication preview showing the situation before this change takes effect.

Next steps: You will want to set the docket mentioned below. When the IB acts upon the 92*bis* change you will want to capture another publication preview showing the situation post-change and you will probably want to report this to the client.

Outbound docketing significance: You will want to docket to check for the later arrival of the form from the IB that indicates what it has decided to do in response to this form. The IB communicates this by means of an ePCT form that is the equivalent of Form PCT/IB/306.

Form PCT/RO/114 – Notification on Decision of Confirmation of Incorporation by Reference of Element or Part

What's going on here: This is the Receiving Office telling you whether it will or will not allow you to make use of IBR (incorporation by reference) under the PCT rules.

Inbound docketing significance: The main significance of this form is that when you filed a paper in which you attempted to incorporate by reference, that is to say you “confirmed incorporation by reference”, you will have set a docket to check for receipt of Form PCT/RO/114, and when you received this form, you may clear that docket. If no docket had been set, then you need to Call a Meeting.

Reporting: This needs to be reported to the client.

Outbound docketing significance: Depending on the decision, you may wish to try again in an Article 34 Amendment or in the national phase.

33

Form PCT/RO/115 – Notification of Intention to Make Declaration that International Application Considered Withdrawn

What's going on here: This is the form in which the RO lets you know that they are planning to declare your PCT application withdrawn. It is time to Call a Meeting.

Inbound docketing significance: Maybe you intentionally did not pay your fees, because after filing the client decided to drop the application. In that case you were expecting this form. Otherwise this form will be a surprise.

Reporting: Your reporting and next steps are different depending on whether you were or were not expecting this form. If you were expecting it, then your reporting letter begins “this is no surprise because ...”

Next steps: See above.

Outbound docketing significance: What will come next, unless you somehow avert the plans of the RO, is that you will receive Form PCT/RO/117. If you are expecting it, then you may wish to docket to check for this form arriving.

34

Form PCT/RO/117 – Notification that International Application Considered to be Withdrawn

What's going on here: This is the form by which the receiving office tells you that they do officially consider the application to be deemed withdrawn. It will normally have been preceded by Form PCT/RO/115. This might count as good news if your goal was that you wanted to be deemed withdrawn. The other possibility of course is that you did not at all want it to be deemed withdrawn, in which case this form is extremely bad news.

Inbound docketing significance: Probably you had already set a docket for this form, prompted by previous receipt of Form PCT/RO/115. If not, then it is time to Call a Meeting.

Reporting: This should almost certainly be reported to the client. One possibility is that the form is expected in which case the reporting letter begins "this is no surprise because ...". The other possibility is that the form was not expected. Either way it should be reported.

Next steps: If you are trying to somehow avert or undo the withdrawal, then you will likely have many next steps. Depending on what went wrong, you might want to see whether you can make use of a Request for the Restoration of the Right of Priority with a new PCT filing.

Outbound docketing significance: If the withdrawn status was expected, then there may be no further steps to carry out beyond reporting to the client.

35

Form PCT/RO/126 – Notification Concerning Later Submitted Sheets Not For Incorporation By References

What's going on here: you sent in "later submitted sheets". This may well have been a big mistake.

The applicant is hereby notified that later submitted sheets embodying a missing part or a correct element or part of the (purported) international application furnished by the applicant to complete or correct the international application were received by this receiving Office on <blah date> that is, on a date later than the date on which one or more elements referred to in Article 11(1)(iii) were first received by this receiving Office.

WARNING: Where item c. or d. is checked, the applicant may, in a notice submitted to the receiving Office within one month from the date of mailing of this notification, request that the later submitted sheets be disregarded, in which case the later submitted sheets shall be considered not to have been furnished and the correction of the international filing date shall be considered not to have been made and, where applicable, the erroneously filed element or part shall be considered not to have been removed from the application (Rule 20.5(e) or 20.5bis(e)).

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Form PCT/RO/126 – Notification Concerning Later Submitted Sheets Not For Incorporation By References

Inbound docketing significance: Maybe you had already set a docket for this form, prompted by your having sent in “later submitted sheets”. More likely this form will be a complete surprise. Either way, it is time to Call a Meeting.

Reporting: This should almost certainly be reported to the client. One possibility is that the form is expected in which case the reporting letter begins “this is no surprise because ...”. The other possibility is that the form was not expected. Either way it should be reported.

Next steps: Decide whether you are willing to lose your original filing date.
Almost certainly the answer is “no”!

Outbound docketing significance: Aggressively docket the one-month response period.

37

Form PCT/RO/132 – Communication in Cases for which no other form is Applicable

This is the RO counterpart to form PCT/IB/345.

What’s going on here: Usually this form is unexpected.

The chief situation where this form is expected is the situation where you asked the Receiving Office to make the IA available to the DAS system. When the RO does this, the RO needs to somehow let you know the DAS access code. This form is used to communicate the DAS access code. (See next slide.)

If this form was unexpected ...

Inbound docketing significance: You get to Call a Meeting.

Reporting: The form is probably letting you know you did something wrong. Probably the client needs to be told.

Next steps: You will have to choose next steps based upon whatever is being communicated by the form.

38

Form PCT/RO/132 – Communication in Cases for which no other form is Applicable

The chief situation where this form is expected is the situation where you asked the Receiving Office to make the IA available to the DAS system. When the RO does this, the RO needs to somehow let you know the DAS access code. This form is used to communicate the DAS access code.

Inbound docketing significance: Given that you asked the Receiving Office to make the IA available to the DAS system, then it will have been a Best Practice to set a docket to check for receipt of this form and then you get to clear the docket.

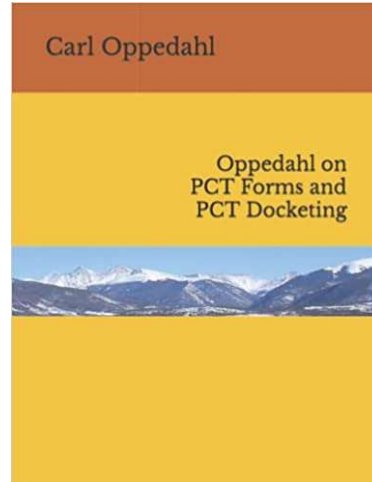
Next steps: If the point of this form was to learn the DAS access code, then your next step will be to add this IA to your DAS workbench and to set up an alert and to obtain a Certificate of Availability. Probably it will not be possible to do these things on the very day that the form arrives. More likely you will have to wait one or two business days to get these things to work.

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PCT listserv

- https://oppedahl-lists.com/mailman/listinfo/pct_oppedahl-lists.com
- More than 900 members

42

- Be sure to complete the evaluation questionnaire
- Thank you!