

# Preparing for the December 12, 2023 webinar

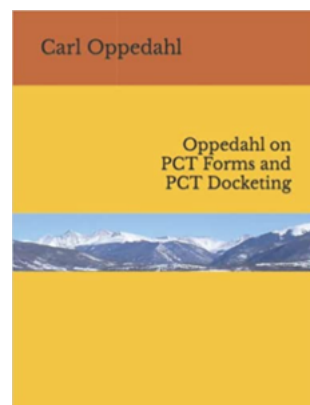
**What will I need to have in hand when I attend the webinars?** To make best use of the webinar, you will need to have on hand a *copy of each PCT form being discussed*. I can imagine three ways that you might do this.

**Print copies of the PCT forms.** You can go to the WIPO web site at <https://www.wipo.int/pct/en/forms/ipea/index.html> and you can click on and print out each of the approximately eight PCT/IPEA 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/ipea/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.



# International Preliminary Examining Authority forms

Tuesday, December 12, 2023  
10AM to 11:30 AM MT

Carl Oppedahl  
Blog.oppedahl.com

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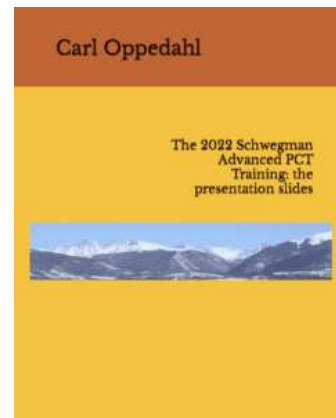
## Today's webinar

- Feel free to post questions as they come to mind
- 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

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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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## Helpful resources

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

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## PCT Distance Learning Course: Introduction to the Patent Cooperation Treaty

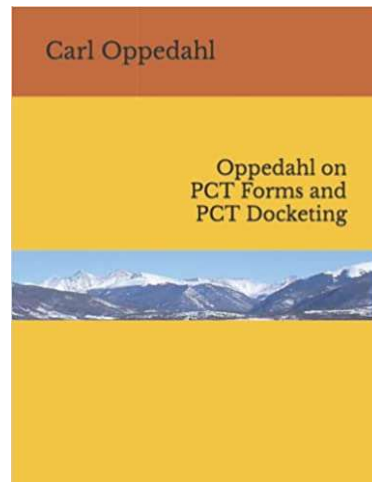
Course number PCT\_101E – DL101

- Unfortunately not available until January 15
- 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](https://welc.wipo.int/acc/index.jsf?page=courseCatalog.xhtml&lang=en&cc=PCT_101E)

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## Oppedahl on PCT Forms and PCT Docketing

- 218 pages
- 8.5 x 1/2 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](https://oppedahl-lists.com/mailman/listinfo/pct_oppedahl-lists.com)
- More than 900 members

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## Form PCT/IPEA/402 – Notification of Demand by Competent International Preliminary Examining Authority

**What's going on here:** This is the form by which the Preliminary Examining Authority tells you that it has received your Demand.

Hopefully it arrived from the IPEA that you wanted. The usual blunder is for the US filer to attempt to file a Demand to some IPEA other than IPEA/US, but to file it directly at the USPTO (for example through Patentcenter). In such a case, you will end up with the IPEA/US as your IPEA.

**Inbound docketing significance:** The chief significance of this notification is that hopefully you will get to clear your docket. Back when you filed the demand, you set a docket to check for receipt of Form PCT/IPEA/402. Now you received this form and you get to clear the docket. If no docket had been set, then you get to Call a Meeting (page 15).

**Reporting:** Hopefully, the preliminary examining authority will state that you did file your demand timely. If so, that's good news. If, however, the preliminary examining authority says you did not file the demand timely, then that is bad news.

**Next steps:** You may wish to make use of your One Telephone Call. 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).

**Outbound docketing significance:** If the IPEA is not the same office as the ISA, then you might receive a form PCT/IPEA/408 and you may wish to docket for it.

The typical next step is to check for receipt of form PCT/IPEA/409. You might docket P+28 for this.

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## Form PCT/IPEA/403 – Notification concerning Payment of the Preliminary Examination and Handling Fees

What's going on here: This is the form by which the preliminary examining authority tells you how much money they think you needed to pay and how much money you actually paid and whether they think you still need to pay some money. If so, you need to pay it within a month if you want your demand to be perfected. Not all preliminary examining authorities mail out this form. Some preliminary examining authorities, if you have in fact paid all the necessary money, will not actually mail out this form.

Inbound docketing significance: As I say, some IPEAs do not mail out this form unless they see some discrepancy in your fee payment.

Reporting: You might want to report this to the client.

Outbound docketing significance: The main significance would be to pay any missing money if the IPEA says you failed to pay all of the money, and then docket to check for receipt of another form PCT/IPEA/403 acknowledging that you finally got around to handing in all of the money.

## Form PCT/IPEA/405 – Invitation to Restrict or Pay Additional Fees, and, Where Applicable, Protest Fee

What's going on here: The Preliminary Examining Authority is telling you that they think your PCT application claims more than one invention. This form is the natural successor to Form PCT/ISA/206. By this I mean that if the International Searching Authority felt that you had claimed more than one invention, then it would be no surprise at all for the International Preliminary Examining Authority to reach the same view. In fact any other outcome would be astonishing. I guess if in your Article 19 amendment or Article 34 amendment you had canceled a lot of claims, you might possibly end up with a situation in which the IPEA would think you are claiming fewer inventions than the ISA thought you were claiming.

Inbound docketing significance: You would not necessarily have set any docket to check for arrival of this form. So there will probably be no docket to clear.

Reporting: As mentioned below, this needs to be reported to the client for a decision about paying the additional fees (or conceivably, protesting).

## Form PCT/IPEA/405 – Invitation to Restrict or Pay Additional Fees, and, Where Applicable, Protest Fee

Next steps: My suggestion is that unless there is some strong reason to proceed otherwise, the usual Best Practice is for the applicant to go ahead and pay the additional fees. Getting all of these inventions examined by the preliminary examining authority is a less expensive way to find out whether the inventions (as amended) are patentable than any other way that you could possibly get the answer to that question. The other way that you might try to get the answer to this question is the filing of divisional applications before one or more patent offices around the world, which is a lot more expensive.

I would try to avoid waiting until the last possible day to pay the money. The sooner you pay the money, the sooner you will get your response from the IPEA.

In our office we use Wise Business for sending money to IPEAs. You may find it convenient to use whatever payment method you use for paying your foreign patent agents.

A very convenient way to e-file papers at the IPEA is by means of ePCT. ePCT will tell you the effective filing date to which such an e-filing will be entitled.

Outbound docketing significance: You will of course want to set a one-month docket to check for payment of the additional fees and perhaps a warning of that date. In addition you will want to set a docket to check for someone reporting this form to the client and a docket to check for receipt of instructions from the client.

## Form PCT/IPEA/408 – Written Opinion of the International Preliminary Examining Authority

What's going on here: This form reminds us that in today's PCT practice, you might receive as many as two different written opinions. You will nearly always receive a written opinion of the international searching authority, but in addition, under certain somewhat rare circumstances, you might also receive a Written Opinion (WO) of the international preliminary examining authority. When will this happen? Well, it will almost never happen if the IPEA that you choose is the same as your ISA. It will also not happen if you do not file a demand. If however you do file a demand and if the IPEA that you select is different from your international searching authority, then what might happen is that the international preliminary examining authority may establish its own written opinion above and beyond whatever written opinion was established by the international searching authority. If so, then it will be communicated to you with this Form PCT/IPEA/408.

Inbound docketing significance: if you docketed for this form, then you get to clear the docket.

Reporting: You will almost certainly want to report this to the client.

Next steps: Note that you are always entitled to at least one phone call with the preliminary examining authority. 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).

Outbound docketing significance: If you received this form, you're going to want to set a docket. The docket is going to be to make sure that you reply to the written opinion. You want to reply within the time limit that is set in the form.

## Form PCT/IPEA/409 – International Preliminary Report on Patentability (Chapter II of the Patent Cooperation Treaty)

What's going on here: This form is the mirror image for Form PCT/IB/373 – International Preliminary Report on Patentability (Chapter I of the Patent Cooperation Treaty). In any PCT application in which an ISR was established (which is almost all PCT applications), there will be either an IPRP Chapter I or an IPRP Chapter II. What determines which one you receive is whether or not you filed a Demand. If you did not file a Demand, you will receive an IPRP Chapter I and its cover letter will be Form PCT/IB/373. If you did file a Demand, you will receive an IPRP Chapter II and it will be this Form PCT/IPEA/409.

Inbound docketing significance: The arrival of this form means you can clear your docket to check for arrival of this form. If you did not already have a docket set for this form, it is time to Call a Meeting (page 15).

Reporting: This will need to be reported to the client, much as you would report a second Office Action. The whole reason that this form arrived is that a Demand was filed, and the whole reason that the Demand was filed is that the client was not happy about the ISR/WO. The hope was that the filing of the Demand would result in some progress toward patentability as compared with the situation that was communicated to the applicant in the ISR/WO.

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## Form PCT/IPEA/409 – International Preliminary Report on Patentability (Chapter II of the Patent Cooperation Treaty)

Next steps: The most important part of this form is box five where the preliminary examining authority tells you what they think about the three important questions of novelty, inventive step and industrial applicability. Your hope of course is that you might get a yes answer to all three questions perhaps for all of the claims. If the applicant does get yes answers for one or more claims for all three questions, the applicant may wish to consider whether to, for example, enter the national phase in more than one offices right away and perhaps try to get on the patent prosecution highway in one or more offices.

For an applicant that is a small high-tech startup, a favorable IPRP-II might be provided to potential investors as an objective indication of patentability.

Outbound docketing significance: You will want to make sure that a docket was already set for the end of the international phase (the end of the 30 months). If no such docket had already been set, then it is time to Call a Meeting (page 15). You will also want to set a docket to make sure that this IPRP-II gets reported to the client. Once it gets reported, you may want to set a docket to check for instructions from the client. Or the existing 30-month docket may suffice. Once the instructions are received (for example to enter national phase and put the case on the Patent Prosecution Highway) then you will want to set a docket for making sure that these steps are carried out.

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## Form PCT/IPEA/411 – Invitation to Request Rectification

What's going on here: This is a form by which the IPEA tells you that it has identified what it feels is an obvious mistake. You will want to Call a Meeting (page 15).

This is a counterpart to Form PCT/RO/108 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 IPEA will 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 to the RO, then you will docket to check for receipt of form PCT/RO/109. If you made your request to the IB, then you will docket to check for receipt of form PCT/IB/315. If you made your request to the IPEA, then you will docket to check for receipt of form PCT/IPEA/412.

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## Form PCT/IPEA/412 – Notification of Decision Concerning Request for Rectification

What's going on here: This is the IPEA 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 IPEA, and this is the IPEA's way of telling you what decision they have made about it.

This is the counterpart to Form PCT/ISA/217 and Form PCT/RO/109 and Form PCT/IB/315.

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 (page 15).

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

Next steps: Your next steps may be to try to get things fixed in the national phase.

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: See above.

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## Form PCT/IPEA/416 – Notification of Transmittal of International Preliminary Report on Patentability

What's going on here: This form is sort of a cover letter by which the preliminary examining authority communicates the IPRP chapter II (form PCT/IPEA/409) to the applicant.

Inbound docketing significance: You will already have set a docket for form PCT/IPEA/409 and that docket covers this form.

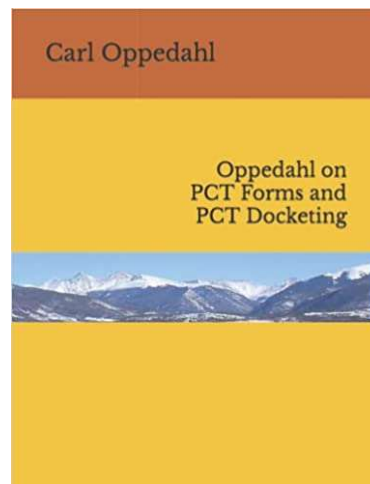
Reporting: This form and the PCT/IPEA/409 will need to be reported to the client.

Next steps: The main significance of this form is that it reminds the applicant of the important dates by which things need to be done.

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- More than 900 members

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

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