

# Preparing for the December 8, 2023 webinar

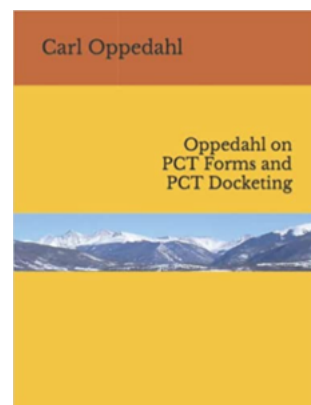
**What will I need to have in hand when I attend the webinars?** To make best use of the webinar, you will need to have on hand a *copy of each PCT form being discussed*. I can imagine three ways that you might do this.

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

Friday, December 8, 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 12, 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

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# The last webinar

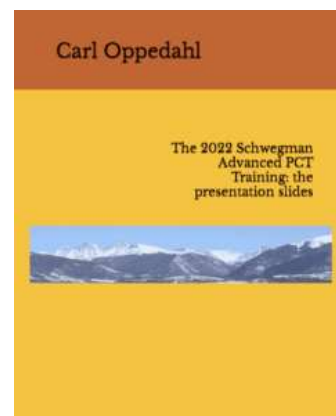
## ***International Preliminary Examining Authority forms***

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

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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/](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

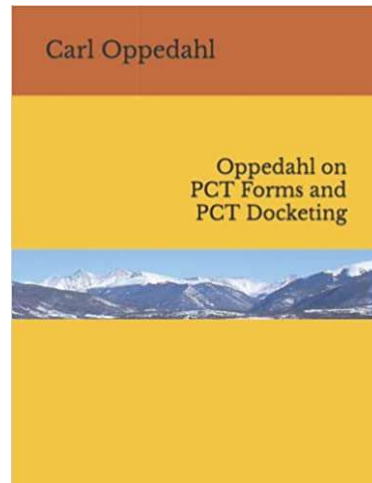
Course number PCT\_101E – DL101

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

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## Form PCT/ISA/202 – Notification of Receipt of Search Copy

What's going on here: The idea here is that the Search Copy got transmitted to the International Searching Authority. This form is the ISA's way of letting you know that it did indeed receive the Search Copy (and, although it goes unmentioned, the Search Fee).

Inbound docketing significance: Arrival of this form permits you to clear the docket to check for arrival of this form. If you had not already had a docket set for this, it is time to Call a Meeting (page 15).

Reporting: The reporting of this form depends on the particular client. Some clients do not care very much about the international phase other than keeping track of the 30-month date. Such a client will not be very interested in the arrival of this form. Other clients are very interested in Best Practices including optimal use of PPH or the Demand process. Such a client will want very much to know that the Search Copy has reached the ISA.

Next steps: You will want to calculate the date upon which the ISR/WO is expected. This is P+9 or SC+3, whichever is later. (Priority date plus nine months, or Search Copy receipt date plus three months, whichever is later.) Having calculated this yourself, you can then cross-check with the Time Line in ePCT where this date will also have been calculated.

Some ISAs, for example ISA/KR and ISA/US, have been observed to carry out their work by the SC+3 date even if that is earlier than P+9.

Outbound docketing significance: Depending on the interest level of the client, you may wish to docket the expected establishment date for the ISR/WO.

ePCT will, if you like, generate a report of all cases in your workbench in which form PCT/ISA/202 is missing. This can be helpful.

## Form PCT/ISA/203 – Declaration of Non-Establishment of International Search Report

What's going on here: Most PCT applicants do not receive this form. If you received this form, it is rather out of the ordinary. This form is sent in the relatively infrequent circumstance that you filed your PCT application with claims for which your searching authority was not able to establish an international search report. This might happen because the subject matter of your claims is subject matter for which your searching authority declares itself not to be competent to carrying out searching. If you do receive this declaration, it means, among other things, that you cannot file an Article 19 amendment and you cannot file a demand. This does not mean your PCT application is withdrawn. You may still enter the national phase, and you can still pursue patent protection anywhere that the PCT process permits you to pursue patent protection.

Inbound docketing significance: Because this form is usually unexpected, there would usually be no docket to clear other than clearing the docket for receipt of form PCT/ISA/220 which will now never arrive.

Reporting: Yes this must be reported to the client. It is almost always bad news.

Next steps: None other than entry into the national phase.

Outbound docketing significance: None.

This form normally goes hand in hand with a Transmittal (Form PCT/ISA/220).

## Form PCT/ISA/206 – Invitation to Pay Additional Fees and, Where Applicable, Protest Fee

What's going on here: The International Searching Authority is telling you that they think your PCT application claims more than one invention.

Inbound docketing significance: There is no reason that you would have docketed to check for arrival of this form. So there will 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).

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 international searching authority is a less expensive way to find out whether the inventions 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.

## Form PCT/ISA/206 – Invitation to Pay Additional Fees and, Where Applicable, Protest Fee

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 ISA.

In our office we use Wise Business for sending money to ISAs. 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 ISA 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/ISA/210 – International Search Report

What's going on here: This is the form by which the International Searching Authority reports to you the result of its search of the prior art based upon the claims in your PCT application.

Inbound docketing significance: The arrival of this form permits you to clear your docket to check for arrival of this form. If you had not set any docket for this, it is time to Call a Meeting (page 15).

Reporting: This form should be reported to the client much as you would report a first Office Action.

This form normally goes hand in hand with the Written Opinion (Form PCT/ISA/237) and the Transmittal (Form PCT/ISA/220).

Note that there is a way to be smart about receiving documents from ISA/EP.

## Form PCT/ISA/210 – International Search Report

Next steps: One step is to docket ISR+2 (mailing date of the ISR plus two months) as a possible last date for filing an Article 19 amendment. The point of this docket is that it might be later than the docket that you had already set for the filing of the Article 19 amendment. If you had not already set any docket for the filing of the Article 19 amendment, then it is time to Call a Meeting.

Another step is to docket ISR+3 (mailing date of the ISR plus three months) as a possible last date for filing a Demand and an Article 34 amendment. The point of this docket is that it might be later than the docket that you had already set for the filing of the Demand and Article 34 amendment. If you had not already set any docket for the filing of the Demand and Article 34 amendment, then it is time to Call a Meeting.

Of course you can cross-check these calculations against the Time Line in your workbench.



## Form PCT/ISA/210 – International Search Report

For a small high-tech startup, a favorable ISR (no X or Y references, only A references) might be a good thing to provide to a potential investor.

Comments: This form lists the references that were found in the searching activities. The references are listed with category letters like X and Y and A. X meaning that the reference taken alone puts into question the **novelty or inventive step** of at least one claim. Y means that the reference **taken together with some other reference** puts into question the inventive step of at least one claim. A means that the reference is of only the general state of the art and the other letters have significance as is shown on this form.

The search report gets translated into English by International Bureau, and this English translation of the search report can be very helpful for many purposes, including for use in an information disclosure statement before the USPTO.

You will want to get your hands on copies of all of the cited references. You will need them for use in an IDS at the USPTO. And you will need them for purposes of reporting the ISR to the client. Some ISAs provide copies of some or all of the cited references at no charge. Some of the ISAs will provide copies but only if you pay a fee. In the case of ISA/KR you can download them from a password-protected web site but only within a limited number of months from the date of establishment of the ISR.

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## Form PCT/ISA/216 – 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/IPEA/411.

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 ISA 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 ISA, then you will docket to check for receipt of form PCT/ISA/217.

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## Form PCT/ISA/217 – Notification of Decision Concerning Request for Rectification

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

If you are lucky, the ISA might grant the request. The challenge here is that the standard is that it should be granted only if your proposed change is the only way that could possibly correct whatever was wrong.

This is the counterpart to Form PCT/RO/109.

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: See above. 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 shows the formal drawing.

And you can see a preview of the entire publication!

## Form PCT/ISA/220 – Notification of Transmittal of the International Search Report and the Written Opinion of the International Searching Authority, or the Declaration

What's going on here: This is a cover letter for the ISR (Form PCT/ISA/210) and the WO (Form PCT/ISA/237). It lets you know **the date of mailing** for those two forms.

Inbound docketing significance: You will already have set a docket to check for arrival of the ISR (Form PCT/ISA/210) and that docket will cover this form as well.

Reporting: The mailing date of the ISR is what determines due dates for the Article 19 amendment and for filing of a Demand.

Next steps: See above.

Outbound docketing significance: See above.

## Form PCT/ISA/225 – Invitation to Furnish Nucleotide and/or Amino Acid Sequence Listing and to Pay, Where Applicable, Late Furnishing Fee

What's going on here: If you received this form, this is a serious matter. If you receive this form, it is basically a slap in the face from the international searching authority. It is the ISA's way of telling you that when you filed your PCT application in the first place, you failed to provide your sequence listing in an appropriate computer readable form.

You might have screwed this up in either of two or three different ways. One way to screw it up would be to provide the sequence listing only in human readable form; in which case, this form PCT/ISA/225 is inviting you for the first time to provide your sequence listing in computer readable form. Another possibility is that you did provide it in computer readable form, but the searching authority thinks you didn't provide it in proper computer readable form. Typical examples being that the optional fields like the field indicating what kind of animal you got your genetic sequence from was not completed correctly. You didn't say what kind of mouse you got your sequences from. In any event, this form is inviting you to provide the computer readable sequence listing form in inappropriate format, and most searching authorities now will require that you provide a late fee for handing it in late.

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## Form PCT/ISA/225 – Invitation to Furnish Nucleotide and/or Amino Acid Sequence Listing and to Pay, Where Applicable, Late Furnishing Fee

My suggestion if you run into this situation is not simply to try to do this yourself the hard way and find out if it's good enough. Contact the searching authority and see if you can learn what exactly it is they don't like about your sequence listing file. Perhaps retain a professional to prepare your sequence listing file for you. Make sure that you run it through the WIPO Sequence software before you send it in, but the problem is that the WIPO Sequence software does not check all the fields in your sequence listing file. For example, it does not check the fields that talk about what kind of animal you got your sequence listing from.

What are the consequences of failure? If you were to fail to furnish a compliant sequence listing within the relevant time period, does your application go abandoned? The answer is no. The application will not go abandoned. You would still be able to enter the national phase within your 30-month time period, but it's possible that you would end up with no search report and no written opinion. You might end up with a declaration of non-establishment.

Inbound docketing significance: You would normally not be expecting this form and so no docket would have been set.

Reporting: This will need to be reported to the client.

Next steps: e-filing of a proper computer-readable sequence listing.

Outbound docketing significance: docket the specified time period and at least one warning.

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## Form PCT/ISA/237 – Written Opinion of the International Searching Authority

What's going on here: In any PCT application in which an ISR was established (which is almost all PCT applications), the ISA will establish a Written Opinion. The WO is communicated by this form.

Inbound docketing significance: You will already have docketed to check for arrival of the ISR, and that docket will cover checking for arrival of this WO.

Reporting: This will need to be reported to the client, much as you would report a first Office Action.

Next steps: The most important part of this form is box five where the searching 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 WO might be provided to potential investors as an objective indication of patentability.

Outbound docketing significance: You will of course want to docket to check for reporting of this form to the client. As mentioned above, favorable findings might prompt docketing to check for client instructions and later action based upon the client's instructions.

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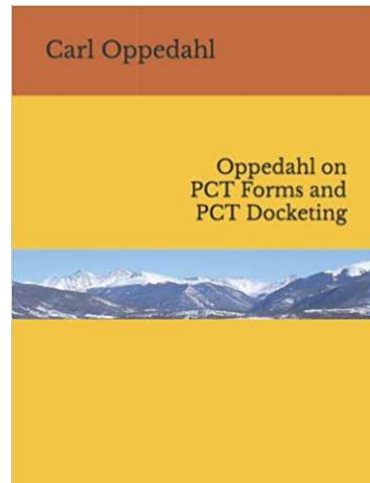
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## PCT listserv

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