

2024 Live In-person Seminar on PCT Docketing

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Disclaimer

This is not legal advice. Reading these slides or attending this seminar does not make you my client and does not make me your lawyer. This is an educational program. If you want legal advice, consult competent counsel who can learn your detailed situation and can give you advice about your situation.

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A word about your presenter

Yes I am often a consultant for WIPO, teaching this and many other PCT programs, live and recorded ...

in person and via webinar ...

I am also an opinionated private practitioner

Please join me in recognizing that I wear two hats from time to time during the webinar

When you hear me expressing opinions, then I am not speaking on behalf of WIPO, and instead I am merely speaking as a private practitioner

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Introducing myself

- I majored in math and physics
- Degree from Grinnell College
- Went to Harvard Law School
- Amateur Extra Class ham radio license
- Avid computer programmer

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Docketing generally

- Receiving docketing events and loading them into the docket
- Clearing docket entries
- Generating reports and nagging people to get stuff done

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Clearing docket entries

- In general we do not simply “clear a docket entry”
- Almost always, the correct thing is to clear a given particular docket entry, linking this with setting up a new docket for whatever the next step is in a particular process
- Any time we are clearing docket entries, we need to look to make sure there is at least one future docket entry still in the case
- It would be extremely rare that when we get done clearing a docket entry, there is no future docket entry still in the case

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Nagging people to get stuff done

- This is one of the most important parts of doing docket work
- This can include walking down the hall and taking a seat in the attorney's office and making it clear that you will not go away until some task has been completed
 - You may need to bring a bag lunch with you
- This can include calling up some attorney at home at 7PM to see if they have still not done some drop-dead last-possible-day task

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Calling a meeting

- This is where a partner and an associate get summoned to a meeting because you said they have to show up
- Everybody squirms and looks at each other because it means somebody screwed up
- This may lead to reviewing all files in a particular category to see how many other active files have also gotten screwed up in the same way
- Hopefully the attorneys will be grown-ups about all of this instead of punishing the messenger
- My heart goes out to every docket clerk who ends up having to call a meeting

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A shout-out

A shout-out to the docket clerks who are among our attendees. You are the unsung heroes of your law firms and corporations. You regularly save your firm or corporation from disasters, yet many people seemingly do not know that you exist.

Thank you for being there. I mean that.

Now to the rest of you

Turning to the rest of you ...

Later after we are done with this seminar, go down the hall (or the work-from-home equivalent) and say “thank you” to your docket clerks. I mean that.

A would-be priority application got filed

- docket to make sure that the application somehow became available in the DAS system
- Docket to make sure somebody has set up “tracking” for the application in DAS
- Docket to make sure somebody has downloaded a certificate of availability the DAS system
- Probably add your own “tracking” so that you will receive any subsequent tracking reports from DAS

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A would-be priority application got filed

- Maybe docket to make sure the attorney warned the client that they now have only 12 months to do the foreign filing
 - Six months for designs
 - Six months for trademarks
- Maybe docket 10 or 11 months to check to see if the attorney is paying attention to the imminent end of the 12-month period
- But if the would-be priority application was a provisional application of limited quality ...

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If the would-be priority application was a provisional application of limited quality

- Then we probably do not merely docket 12 months to prepare and file a non-provisional application
- We docket more aggressively, maybe only 1 or 2 months for preparation and filing of a non-provisional application

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A would-be priority application got filed

- Docket to check for assignments getting signed by the inventors
- Then docket to check for somebody e-filing the signed assignments in Assignment Center
- Then docket for reel and frame number arriving from the Assignment Branch

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Docket event is that against all odds, the attorney has actually commenced preparation of the non-provisional application

- Make sure the attorney gives ePCT access for the draft PCT application to plenty of other people including you
- Note that ePCT will try to count down the days to the end of the 12-month priority period
- Cross-check that count-down with your own docket entries

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The docket for getting the PCT application filed

- Try to pin down the attorney as to whether the PCT application will get filed in RO/IB (often a better choice) or in RO/US (often a worse choice)
- If RO/IB, keep in mind when it will be midnight in Geneva
- If RO/US, what will matter is when it will be midnight in Alexandria, Virginia

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The PCT application got filed

- Maybe you now must docket to check for the attorney telling the client that the PCT application got filed
- And that the attorney warned the client about the 30-month date
- And that the attorney did not tell the client an incorrectly calculated 30-month date

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General procedure going forward

- Any time a PCT form arrives, look it up in the PCT forms book
- Maybe the book says you can ignore this form
- Maybe the book says the form cannot be ignored
- Maybe this is a form for which you are told to clear a docket
 - If so, and if a docket had not already been set, then you must ***Call a meeting***

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Any time a PCT form arrives ...

- For some PCT forms, you need to scrutinize the form
- Correct filing date?
- Correct priority claims?
- Does it say your filing was timely?
- Does it say your filing was untimely?
- Does it contain the dreaded “NR”?

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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 (page 60 of *PCT Forms*)
- Form PCT/RO/102, which memorializes that proper fees were paid (page 53 of *PCT Forms*)
- Form PCT/IB/301, which memorializes that the International Bureau has received the Record Copy from the RO (page 97 of *PCT Forms*)
- Form PCT/IB/304, which memorializes that the International Bureau has received the certified copy of the priority document (page 99 of *PCT Forms*)
- Form PCT/ISA/202, which memorializes that the International Searching Authority has received the Search Copy (page 132 of *PCT Forms*)

Docketing PCT

- Docket P+22 (priority date plus 22 months) for filing of a Demand and Article 34 amendment (note that this may change later)
- Docket P+30 for entry into the national phase
- Docket P+19 or tech-prep day for Article 19 amendment (note that this may change later)
- Docket tech-prep day for (among other things) withdrawal to prevent publication

Docketing PCT

- After Form PCT/IB/301 arrives, check to make sure that you have access to the PCT application in the ePCT system (page 97 of *PCT Forms*)
- After Form PCT/ISA/202 arrives, docket three months to check for receipt of the International Search Report and the Written Opinion (ISR/WO) (or P+9 if later, depending upon which ISA the applicant selected) (page 132 of *PCT Forms*)

A PCT application got filed ...

It is very poor practice to postpone assignments and inventor declarations

Soon after the PCT application has been filed, docket to check for receipt of signed inventor assignments

then docket for getting them recorded in Assignment Center

Soon after the PCT application has been filed, docket to check for receipt of signed inventor declarations

- this can be PCT Declaration Number 4 in which case file it in ePCT
- This can be USPTO Form AIA/01 in which case commence the US national phase and file it in Patent Center

Form PCT/RO/105, which memorializes the filing date and application number
(page 60 of *PCT Forms*)

One of the jobs of the docket clerk is to scrutinize Form PCT/RO/105 to see if the filing date they gave to us is the same as the date that we think we filed the PCT application

Form PCT/RO/102, which memorializes that proper fees were paid (page 53 of *PCT Forms*)

Or maybe it says fees are outstanding

In that case, docket aggressively to check for fees getting paid

Form PCT/IB/304, which memorializes that the International Bureau has received the certified copy of the priority document (page 99 of *PCT Forms*)

Except that maybe Form PCT/IB/304 says the dreaded “NR”

In that case, call a meeting to reach clarity as to why you received the dreaded “NR”

Docketing relating to the ISA

Docket to check for Form PCT/ISA/202

If you don't receive it, figure out why

If you do receive it, pay attention to the expected date for the ISR/WO

Probably docket for receipt of the ISR/WO

Keep an eye out for the ISR/WO

This is discussed in the *PCT Forms* book at pages 10 and 132

Docketing relating to the ISA

Keep an eye out for the ISR/WO

What you do not want is the client asking "where is the ISR/WO?" and it is way late and you did not notice it was way late

You may need to badger the ISA

Docketing relating to the ISA

Maybe you receive the *Invitation to Pay Additional Fees* (Form PCT/ISA/206 (*PCT Forms* book page 140))

If so, docket to make sure you pay the fees

You may wish to docket to make sure somebody asks the client for instructions

When the fees get paid, you can clear that docket

There is no reason to foot-drag on paying these fees

The sooner you pay the fees, the sooner you will receive the ISR/WO

Docketing relating to the ISA

When the ISR/WO arrives ...

Keep in mind the arrival date of the ISR/WO might make a difference in the due date for filing a Demand

(ISR/WO+3 might be later than P+22)

ePCT will help with this

Docketing relating to the ISA

When the ISR/WO arrives ...

Keep in mind the arrival date of the ISR/WO might make a difference in the due date for making an Article 19 amendment

(ISR/WO+2 might be later than P+16 and tech-preparations date)

ePCT will help with this

Docketing relating to the ISA

When the ISR/WO arrives ...

Maybe docket to check to make sure the ISR/WO gets reported to the client

Ideally the client has been set up as an eViewer in ePCT for the pending PCT application

In that case, the client will automatically be told of the arrival of the ISR/WO

If you picked ISA/EP

- Maybe you (or the client) picked ISA/EP
- Then long ago you surely had already set up an EPO mailbox
- Long ago you had set it up so that the communications from ISA/EP would get sent to your EPO mailbox
- Your smart advance planning means you received the ISR/WO a week or more ahead of time
- Maybe ISA/EP felt the need to ask for a Sequence Listing
 - If so, then your smart advance planning means you received the Sequence Listing request instantly rather than receiving it too late to do anything about it
- What? You had not already set up an EPO mailbox? Inconceivable! But if this is really the case, then you need to set up an EPO mailbox.

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Surely you attended this EPO training webinar?

Special PCT seminars

Recorded online seminar: PCT for US paralegals and agents

On 9 May 2023 the European Patent Office (EPO) offered an online seminar for US paralegals and agents dedicated to the Patent Cooperation Treaty (PCT). This video summarises the services provided by the EPO and the latest developments in the PCT system as well as getting practical information on the related EPO's online services like payment and reimbursement, the new secure online access, the online filing possibilities and the electronic Mailbox.

Speakers: Richard Garvey, Marina Micheli, Benjamin Dankers, Michael Lindblom, Adriana Mazurkiewicz, EPO - Carl Oppedahl, partner in Oppedahl Patent Law Firm LLC



<https://e-courses.epo.org/course/view.php?id=178>

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Calculating dates

Often we have to calculate dates

- Priority date plus 30 months (P+30)
- Priority date plus 22 months (P+22)
- Mailing date of International Search Report plus 3 months (ISR+3)
- Date of technical preparations for publication by the International Bureau

There is a way that you can cross-check your calculation with a trusted external source for these dates

Technical preparations for publication day at WIPO

Figure out publication day

This is P+18 except that you have to keep counting until you hit a Thursday (or every now and then a Friday)

Then count back 15 days (usually reaching a Wednesday) which is technical preparations day

Then count back one more day (usually reaching a Tuesday)
If the Wednesday is a national holiday in Switzerland

Now you know the last day to request withdrawal to prevent publication

Why we care about technical preparations day?

- Last day to hand in the PCT Declarations
- Last day to request withdrawal to avoid publication
- Last day to make an Article 19 amendment (unless ISR+2 gives you more time)
- Important day to hand in certified copies

Note that ePCT will also calculate all these same dates

Look in the ePCT “time line”

You can cross-check the dates from the ePCT time line with your own dates

Steps after filing a Demand

- Did you file your Demand through ePCT? Then docket to check for receipt of Form PCT/IB/368 (*PCT Forms* book page 124)
- Docket to check for receipt of Form PCT/IPEA/402 (*PCT Forms* book page 172)

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When Form PCT/IB/368 arrives

- Now you get to clear the docket to check for arrival of Form PCT/IB/368
- Check that it says the Demand was not untimely

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When Form PCT/IPEA/402 arrives

- Now you get to clear the docket to check for arrival of Form PCT/IPEA/402
- What? No such docket had been set? Time to **Call a Meeting**
- Check that it says the Demand was not untimely

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Another docket to set

- Presumably you had also set a docket for P+28 to check for receipt of the IPRP/chapter II

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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

Cross-checking with the ePCT “time line”

- ePCT offers a “time line”
- From time to time, you ought to cross-check the ePCT time line for a file against the existing docket entries for that same file
- If they match, great
- If something fails to match, we can all be thankful for a learning opportunity

Automatic email notifications from ePCT

- Warning that there is only a day remaining to get our PCT application filed
- Warning that technical preparations day is only one or two weeks away
- Warning that we are getting close to the end of our 30-month time period

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Cross-checking against automatic email notifications from ePCT

- Let's say we receive one of the automatic email notifications from ePCT
- It's probably smart to cross-check this against our existing corresponding docket entry
- If we did not already have an existing corresponding docket entry, then we need to figure out whether there is cause for alarm

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What if a priority claim gets canceled?

- The IB will then recalculate all subsequent dates in the time line for the PCT application
- You need to recalculate all of your subsequent docket entries accordingly
- Best practice will be to cross-check the ePCT time line (after recalculation by the IB) with your recalculated docket entries

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What about a failed request for restoration of priority?

- Suppose the attorney requests restoration of the right of priority ... and gets turned down by the RO
- This does not permit you to count time line dates from the later actual priority date
 - Which might be simply the PCT filing date
- You must still count your time line dates from the failed (attempted) priority date
- The reason of course is that down the line, conceivably the attorney might plead his or her request again, this time to a DO/EO ... and might succeed on the second try
- The best way to avoid making this mistake is to do a cross-check of the ePCT time line against your own time line
- Related to this is to do a cross-check of the ePCT warnings against your own docket entries
 - For example the ePCT warning that you are nearing the end of your 30-month period

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What about a failed request for restoration of priority?

- This does not permit you to count time line dates from the later actual priority date
 - Which might be simply the PCT filing date
- You must still count your time line dates from the failed (attempted) priority date
- This is not idle. At least one very well-known US patent firm got this wrong at least once. Don't make the same mistake that they did.

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Docket event – instructions arrive from foreign instructing counsel

- In the old days, the docket event was the arrival of a fax from foreign counsel
 - Or a courier package from foreign counsel
- Nowadays the docket event is arrival of an email from foreign counsel entrusting to us the task of entering the US national phase from a PCT application
- Tasks include:
 - Assign a file number to this new case
 - Arrange to get ePCT access to this new case
 - Figure out the Patentscope permalink for this new case
 - Independently calculate the due date (the end of the 30 months)
 - Probably foreign counsel got the 30-month date right
 - But what if they got it wrong? You need to independently calculate it.

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Protective no-fee filing for client that cannot seem to make up its mind about the 30 months

- There is no such thing as a protective no-fee entry into the US national phase
- The only choice would be a no-fee bypass continuation

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National-phase case got filed

- Docket aggressively for getting signed inventor declarations
 - Except not if the PCT Declaration Number 4 is present in the PCT case
- Docket for getting signed inventor declarations filed
 - You do not want to become a “walking corpse” because an RCE got filed
- Docket for getting inventor assignments signed (if this has not been done already in the PCT case)

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Thank you