

Docketing PCT for US filers

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Presented with support from the
World Intellectual Property Organization

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About this presentation

I wear two hats today:

- Consultant for WIPO
- Private practitioner

My goal as a consultant for WIPO is to provide accurate factual information about PCT and ePCT.

When I express opinions from a practitioner point of view, I am speaking for myself and not for WIPO.

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Disclaimer

This webinar is not legal advice. These slides are not legal advice.

Attending this webinar, or viewing a recording of this webinar, or reading these slides, does not make you a client of me or my firm, and does not make me your attorney. This webinar is intended to be an educational program.

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Format of today's presentation

This is a webinar. We have set aside 90 minutes for the webinar. We might not use all of the time. Feel free to ask questions as they arise. There is no need to save questions for the end.

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First 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.

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Now to the rest of you

Turning to the rest of you ...

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

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General docketing goals

Not letting things go abandoned

Not missing due dates

Providing reminders to attorneys

Providing reminders to clients

(For a corporation, “client” might mean “head of business unit”)

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Docket events

Examples of docket events

- Inventor invented something
- A disclosure or product sale is imminent
- A patent application got filed that might serve as a priority document
- Something showed up from a patent office

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Nightmare docket events

“Oh by the way” phone call from a client

“I can’t imagine this is important from the patent point of view but tomorrow we are planning to do X” phone call from a client

“later today we are planning to do X” phone call from a client

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Escalating the nature of the reminders

You start with an email to the attorney or to the client

You escalate to a second email maybe with all caps in the subject line

You escalate to a phone call

And so on

You have my sympathy

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Calculating dates

Often we have to calculate dates

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

We will talk about a way that you can cross-check your calculation with a trusted external source for these dates

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Systems that run in parallel

We will talk about a system that can generate warnings of upcoming due dates that can run in parallel with your own warnings from your own docket system

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ePCT

ePCT has a function that is somewhat like Private PAIR

It lets you see the content and status of your pending PCT applications, just as

Private PAIR lets you see the content and status of your pending US applications

But does Private PAIR send you warnings of upcoming due dates? No!

ePCT sends you warnings of upcoming due dates!

Does Private PAIR maintain a time line for each application, listing upcoming due dates? No!

ePCT maintains a time line for each application, listing upcoming due dates.

It would be daft not to make full use of the automatic warnings that ePCT sends you for your upcoming due dates on your PCT applications.

Right?

ePCT

Clearly you are going to want to make sure that all of your pending PCT applications are visible to you in ePCT, just as all of your pending US applications are visible to you in Private PAIR

It would be daft not to make it so. Right?

ePCT

This means that you need to do what it takes to make it so that each new PCT application that you file automatically gets loaded into the part of ePCT that is like Private PAIR

This means that you need to do what it takes to get all of your old pending PCT applications loaded into the part of ePCT that is like Private PAIR

Polling question

Communicating with the client about foreign filings

- Whenever you file any patent application that has a chance of serving as a priority document for later foreign filings ...
- It is important to write to the client about the need to keep track of the 12-month priority period
- It is important to docket the 12-month priority period

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Communicating with the client about non-provisional filings

- Probably that first filing was a US provisional application, in which case you will also need to docket 12 months for filing a US non-provisional application

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Communicating with the client about foreign filings

- The communication to the client about the 12-month period, which you carefully saved in your client communications file, serves two goals
- One goal is so that the client is aware of the 12-month period
- A second goal is so that later, if the client claim not to have been warned, you can point to the communication to show that the client was warned
- Each of these goals is very important

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Communicating with the client about foreign filings

- Just hypothetically let's imagine that the priority filing was a US provisional patent application that was filed under extreme time pressure
- Maybe it was a stack of power-point slides
- Maybe it was a preprint of a professional or academic article that was about to be published the next day
- Maybe it was an inventor's disclosure that had been sketched on a napkin
- Maybe for purposes of supporting a set of patent claims, the content of the provisional patent application was of limited quality

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Provisional patent application of limited quality?

- In such a case, I suggest not merely docketing 12 months
- I suggest trying to docket for the preparation and filing of a full non-provisional patent application ***as soon as possible*** after the filing of the provisional application of limited quality

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One of my favorite things about ePCT

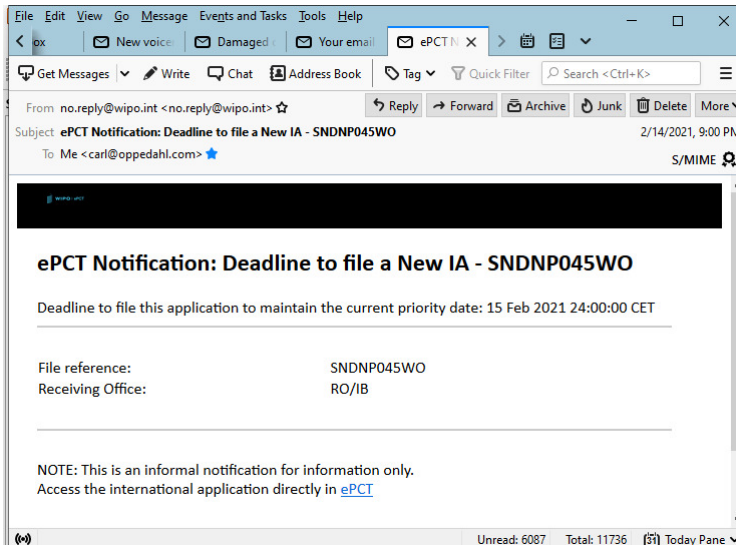
You start preparing a PCT Request and you enter a priority claim for an application that was filed 364 days ago

In other words, the one-year period runs out one day from now

Wouldn't it be nice if some system somewhere would remind you that you have only one day left to get the PCT application filed?

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One of my favorite things about ePCT



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Polling question

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Returning to docketing when a priority application gets filed

Docket to check that the application has been made available to the DAS system

Docket to check that “tracking” has been set up in the DAS system

Docket to check that we have a Certificate of Availability from the DAS system

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The DAS system

This requires that an ADS (not a provisional cover sheet) was used when the provisional application was filed

This requires that somebody follow through to set up the “tracking” in DAS

This requires that somebody follow through to obtain the Certificate of Availability from the DAS system

Yes this means that somebody has to learn how to use the DAS system

Go to my blog, go to the search box, plug in “DAS quiz”

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Three polling questions

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SAOSIT?

This might or might not be the responsibility of your docket people,
but you need to worry about “same applicant or successor in title”

Paris Convention Article 4

The US provisional application probably needs to have been filed
with a named applicant that matches the applicant that will later
be used for the non-US filings

Note that a mere provisional cover sheet is no good for this

Make sure your crystal ball predicts the later applicant name
accurately

Yeah, right

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Did I mention that you probably should not use a mere provisional cover sheet?

A mere provisional cover sheet fails to establish a non-inventor applicant, meaning you will flunk SAOSIT

A mere provisional cover sheet fails to get the application into the DAS system

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What if the 12-month period got missed?

Horrors! What if the 12-month Paris Convention priority period for foreign filing got missed?

Then docket P+14 for filing a Request for the Restoration of the Right of Priority

WIPO has a very helpful web page detailing the various patent offices and the extent to which they are willing to consider restoring a priority claim

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ROROP

Maybe you can establish that the 12-month date was missed despite the exercise of due care

Or maybe the best you can do is to say that the lapse occurred unintentionally

Study the ROROP resource on the WIPO PCT web site

Consider filing in RO/IB rather than RO/US

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Communicating with the client about the filed PCT application

- Client must be clearly told about the “30-month date”
- Client should also be told that the PCT application will be published at P+18

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Communicating with the client about the filed PCT application

- When the PCT application becomes visible to you in ePCT ...
- You may wish to download the publication preview page and send it to the client for review
- This gives the client a chance to let you know if there has been any mistake or misunderstanding about inventors, priority, applicant name etc.

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Communicating with the client about the filed PCT application

- You may want to tell the client once about the “three-country” docket
- For TZ, LX if you want to do a direct national phase filing at 30 months, you will have to file a Demand by P+19
- Even if you do not file a Demand by P+19, you can still reach any of these countries by means of a regional phase entry

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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
- Form PCT/RO/102, which memorializes that proper fees were paid
- Form PCT/IB/301, which memorializes that the International Bureau has received the Record Copy from the RO
- Form PCT/IB/304, which memorializes that the International Bureau has received the certified copy of the priority document
- Form PCT/ISA/202, which memorializes that the International Searching Authority has received the Search Copy.

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Docketing PCT

Also docket P+22 (priority date plus 22 months) for filing of a Demand and Article 34 amendment, and docket P+30 for entry into the national phase

- After Form PCT/IB/301 arrives, check to make sure that you have access to the PCT application in the ePCT system
- After Form PCT/ISA/202 arrives, docket three months to check for receipt of the International Search Report and the Written Opinion (ISR/WO)

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**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

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**What about your cases that you
filed a year ago?**

Cases that you filed a year ago that are not yet in
ePCT?

You need to get them loaded into ePCT

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ePCT

Did I mention that it is good to be using ePCT?

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The 4-and-16 date

If you are going to make a priority claim in your PCT application, you need to make it by the 4-and-16 date

Within four months of when the PCT application was filed, or

within sixteen months of when the priority application was filed,

whichever is later.

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The 4-and-16 date

What are the consequences of missing the 4-and-16 date?

In most Offices around the world, missing the date means the priority claim is irrevocably lost.

What are the consequences of presenting a priority claim prior to that date but getting a digit wrong?

It still means the priority claim is lost.

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The 4-and-16 date

Hmmm. Who knows where I am going with this?

Maybe it would be really good if there were a way to avoid getting a digit wrong in the priority claim, right?

Wouldn't it be nice if there were a way to know absolutely for sure that we had not gotten a digit wrong in the priority claim?

Who knows where I am going with this?

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Avoiding getting a digit wrong

Yeah. ePCT. When you enter the priority application number into ePCT, it cross-checks with what the USPTO entered into DAS eleven months earlier. If they match, great. If they don't match, you can try to figure out what went wrong.

But PCT-SAFE doesn't do this cross check.

If you use a PDF-type PCT Request, it doesn't do this cross-check.

Did I mention it is good to use ePCT?

Maybe this reduces the need to docket the 4-and-16 date.

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Docketing the last date for withdrawing the application to avoid publication

When is the last possible date to file a successful request to withdraw the application to avoid publication?

Technical preparations for publication day, of course, everybody knows that!

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Technical preparations for publication day

How do you calculate TPRP day?

You work out publication day. That's easy. You take the priority date, and add eighteen months. If it's a Thursday, fine. Otherwise, keep counting until you hit a Thursday.

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Technical preparations for publication day

Now you know publication day, which is of course a Thursday. So now you back off fifteen days. That is of course a Wednesday. That will be TPDF day. Except not if that Wednesday is a holiday in Switzerland. Which it might be, in which case you back off another day, and that is TPDF day.

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Technical preparations for publication day

Once you have calculated when you think TFP day is, then check the “time line” in ePCT for your particular PCT application to see the TFP day that is cited there.

This will be the last day for requesting withdrawal of the application to avoid publication.

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Receiving and reporting the International Search Report and Written Opinion

- It is good to receive the ISR/WO as soon as possible
- Best Practice is to check the box in the Request authorizing email communications
- Some ISAs send the ISR/WO by email
- ePCT will notify you when the IB receives the ISR/WO

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Receiving and reporting the International Search Report and Written Opinion

- Previously you had docketed P+22 for the Demand and Article 34 amendment
- Now you get to calculate ISR+3 (mailing date of ISR plus 3 months) to see if this changes the due date
- You might need to redocket this due date
- The time line in ePCT will calculate this for you as well

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Client communications after receiving the ISR/WO

- Ideally you already gave ePCT access (perhaps eReader access) to the client for this application
- If so, the client may learn of the ISR/WO at about the same time that you do

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Client communications after receiving the ISR/WO

- When the ISR/WO arrives, the client needs to be reminded of the need to decide whether to file an Article 19 amendment
- Likewise the client needs to be reminded of the need to decide whether to file a Demand and Article 34 amendment
- Client must be reminded of the due dates for each
- ePCT will provide both due dates

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Filing an IDS

- When the ISR/WO is established, consider filing an IDS in the US national-phase case
- File an ADS to start the US national-phase process (if one has not already been filed) and file the IDS disclosing the references from the ISR/WO
- This avoids the risk of embarrassment or risk from forgetting to file the IDS later
- This permits clearing the docket for this task
- In a case with a favorable WO, this gets you a step closer to getting on the Highway

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Filing an Article 19 amendment

- The client might make a choice to file an Article 19 amendment
- If this is going to be filed, it must be filed by the later of three dates:
 - Two months after the ISR was mailed
 - Prior to the IB's completion of technical preparations for publication
 - Sixteen months after the priority date
- ePCT will calculate this date for you
- Make sure it has been docketed

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Docketing after your Article 19 amendment

- When an Article 19 amendment has been filed, docket to check for receipt of Form PCT/IB/346
- This is the IB's way of letting you know it received the Article 19 amendment
- When the Form arrives, check to see that it says the Article 19 amendment was filed “within the time limit”

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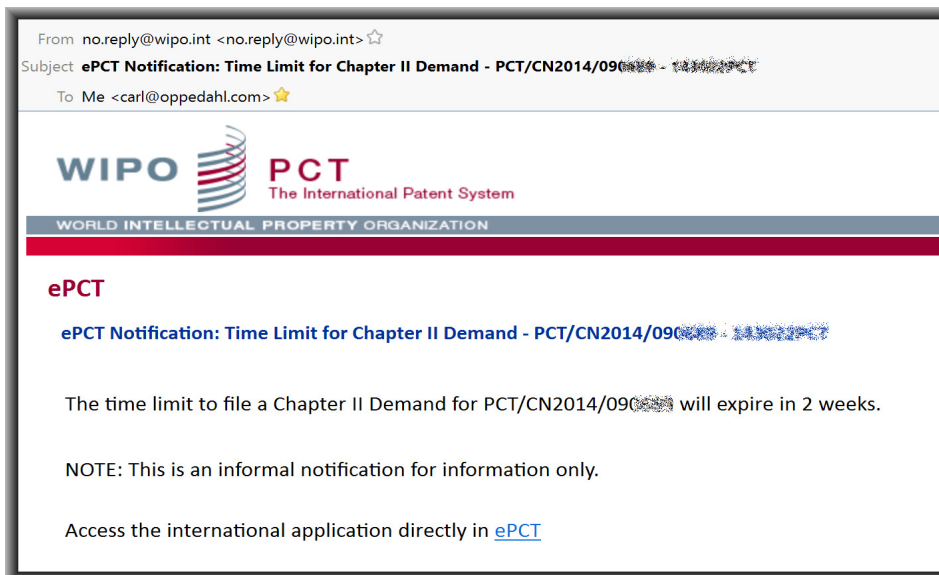
Filing a Demand and Article 34 amendment (“D&34”)

- The client might make a choice to file a D&34
- If this is going to be filed, it must be filed by the later of two dates:
 - Three months after the ISR was mailed
 - 22 months after the priority date
- ePCT will calculate this date for you
- Make sure it has been docketed

wibn

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Note that ePCT will warn you that the time limit for the Demand is imminent



From: no.reply@wipo.int <no.reply@wipo.int> ☆

Subject: **ePCT Notification: Time Limit for Chapter II Demand - PCT/CN2014/090000 - 1.1.2014**

To: Me <carl@oppedahl.com> ☆

WIPO  **PCT**
The International Patent System

WORLD INTELLECTUAL PROPERTY ORGANIZATION

ePCT

ePCT Notification: Time Limit for Chapter II Demand - PCT/CN2014/090000 - 1.1.2014

The time limit to file a Chapter II Demand for PCT/CN2014/090000 will expire in 2 weeks.

NOTE: This is an informal notification for information only.

Access the international application directly in [ePCT](#)

If you e-filed the Demand in ePCT

- Look in ePCT to see what the IB received
 - Check it for correctness
- , docket to check for receipt of Form PCT/IB/368
 - By this form the IB acknowledges receipt of the Demand on a particular date
 - Check that this receipt date is correct

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Further docketing relating to the Demand

- Docket to check for receipt of Form PCT/IPEA/402
- By this Form the IPEA acknowledges that it received the Demand
 - Check that the receipt date is correct

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Upon receipt of Form PCT/IPEA/402

- Docket 28 months or sooner for receipt of the *International Preliminary Report on Patentability under Chapter II of the Treaty*
- Depending upon the historical timeliness of the IPEA, be prepared to pester the IPEA to do its job timely

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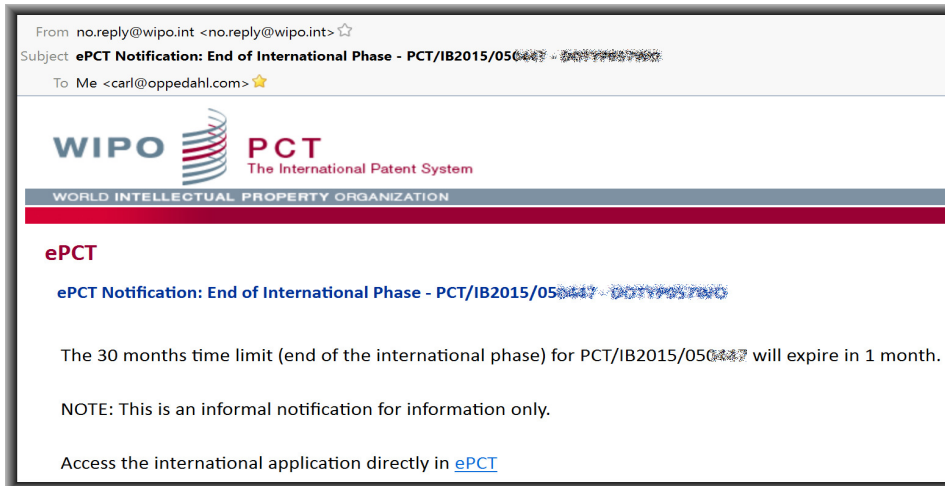
The end of the international phase

- The international phase ends when you enter the national phase
- You could enter the national phase a day after filing a PCT application
- You could wait until almost the end of 30 or 31 months to enter the national phase
- It is important to keep close track of the 30-month period
- It is important to remind the client about the 30-month period

wibn

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Note that ePCT will warn you that the end of the 30 months is imminent



Entry into national phase and regional phase outside of the US

- WIPO provides a table which summarizes the time limits for national- and regional-phase entry
- Click on “PCT” and “time limits”
- Examples:
 - CN 30 months
 - EP 31 months
 - JP 30 months
 - KR 31 months

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

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How a corporate patent department can keep tabs on outside counsel

Outside counsel should do e-handshakes with people in the corporate patent department

Outside counsel should extend access in ePCT to people in the corporate patent department

I suggest eOwner access (not mere eViewer) so that people in the corporate patent department can easily and promptly extend access to new hires in the corporate patent department

And to inventors and heads of business units (as eViewers)

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How the docket department can make use of ePCT

Clearly you are going to want everybody in the docket department to have access to every pending case in ePCT

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Learning about rogue filings by attorneys and agents

Sometimes an attorney or agent will file a provisional application and will “forget” to tell the docket desk

In my firm we call these “rogue filings”

In my firm, yours truly is the most frequent offender :(

In EFS-Web you can catch this by checking “Last 40 ack receipts” every day or so

In Financial Manager you can catch this by looking for payments of provisional filing fees that don’t match with any known file

Make sure to start using Patentcenter if you have not already done so

Note that Patentcenter does not yet have anything quite like “Last 40 ack receipts”

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Transferred-in cases and self-filed provisionals

A whole separate category of pain is the transferred-in families of cases where there were multiple provisionals and you have no confidence that you have been told about all of the provisionals

Related to this is the independent inventors who filed their own provisional applications never did anything about PAIR access

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Transferred-in families of cases and self-filed provisionals

There is really no choice but to keep pushing and pushing until you have access to every single case in Private PAIR

Only then can you be sure what is listed on that most recent Filing Receipt (for example applicant name for SAOSIT)

This may require filing Forms PTO/SB/122

You will need to get the cases into DAS

This will likely require filing Forms PTO/SB/39

You will need to get Certificates of Availability from DAS

You have my sympathy

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Docket event: execution of assignment

If an assignment gets signed, docket three months
for its recordation

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Resources

Many very helpful resources at <http://www.wipo.int>

USPTO's PCT Help Desk at 571-272-4300

Join the PCT-L listserv at

<http://www.oppedahl.com/listserves.html>

WIPO's PCT Distance Learning Course

Schwegman's Youtube recorded lectures

Subscribe to the Ant-Like Persistence blog (particularly the PCT
section)

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Upcoming books

Books in progress

- Incoming PCT Forms
- Oppedahl on PCT

To hear about them, subscribe to my blog or
subscribe to the PCT listserv

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Upcoming free-of-charge WIPO-sponsored webinar

Worry-free use of ePCT with EFS-Web and e-filing
PCT applications at the USPTO

April 7, 2021 – 10 AM Mountain Time

See <https://blog.oppedahl.com/?p=6719>

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Thank you!

Be sure to complete the evaluation questionnaire

Thank you!