

2022 Virtual PCT Training Seminar

# Session 1

What is PCT?, Why We Care?, Paris Path Versus PCT

**Tuesday, February 8, 2022**



## Before We Get Started...



### Recording

A recording of this session will be posted to the Attendee Hub after the live session ends.



### Questions

Please enter questions in the Q&A feature in the Zoom menu.



### Social

Follow us on LinkedIn or go to SLW Institute on slwip.com to see upcoming and on demand webinars.

About the Speaker

## Carl Oppedahl

Your presenter is Carl Oppedahl, the author of the Ant-Like Persistence blog. Carl is a partner in Oppedahl Patent Law Firm LLC. He has served as an adjunct professor at University of Denver law school, teaching Patent Prosecution. Carl has been a Fellow of the American Intellectual Property Law Association. He has spent more than twenty-five years serving intellectual property clients.

Carl has taught Schwegman's Advanced PCT Training in-person class in 2017 in San Jose and in 2018 in Minneapolis.

Carl often serves as a lecturer on the Patent Cooperation Treaty as a consultant for the World Intellectual Property Organization.



## Disclaimer

This is not legal advice. Reading these slides or attending this webinar or viewing a recording 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.

# 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

# How We Will Proceed

Please please please complete the evaluation questionnaire.

-----

Please note that if you have not already downloaded your presentation materials, you can download them now from a link in the *SLW Institute* web site (at the Attendee Hub).

-----

The presentation system has “chat” and “questions”.

I suggest posting your questions to the “questions” system, not the “chat” system.

We have over a thousand attendees and I am sorry to say we might not be able to get to all of the questions during the scheduled time for the webinar.

There is a way that we can capture and save the questions from the “questions” system. We might be able to edit them with answers and post the some of the answers later. This is why we suggest using the “questions” system rather than the “chat” system.

# Polling Question

## Today's Goals

- Introduce myself
- Describe our fifteen sessions and how they will work
- Review some useful PCT resources
- Present today's material

# 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

# Introducing Myself

- Worked as an associate at a patent firm in Manhattan for several years.
- Launched my own patent firm in 1993
- Moved my firm to the mountains of Colorado in 1996
- In 2006 when the USPTO launched a system for e-filing PCT applications, our firm filed the very first PCT application in that e-filing system
- In 2007 our firm filed our 200<sup>th</sup> PCT application
- In 2008, I served for the first time as part of the faculty of a PCT seminar
- In 2013, when WIPO launched its ePCT system for e-filing PCT applications, our firm filed the very first PCT application in that e-filing system
- In 2018, our firm obtained its 2000<sup>th</sup> granted US patent that is a national-phase entry from a PCT application
- By now I have served, by myself and with others, in teaching roles in over fifty PCT seminars
- By now I have presented over fifty webinars about PCT
- I have taught many one-day and two-day private custom-designed PCT programs for corporations, for patent firms, and for patent departments of general-practice firms
- I have had the honor to teach full-day in-person live PCT Training Seminars for the Schwegman firm in 2017, 2018, and 2019

# Our Fifteen Sessions and How They Will Work

- First session (today) is 1½ hours
- Each of the remaining 14 sessions will be 1 hour
- The sessions are every other day for six weeks



# Can I Skip Some Sessions?

I guess I can't stop you from skipping

But this stuff is cumulative

Many sessions are prerequisites for later sessions

If you skip a session, then there may be a later session where some points won't make sense

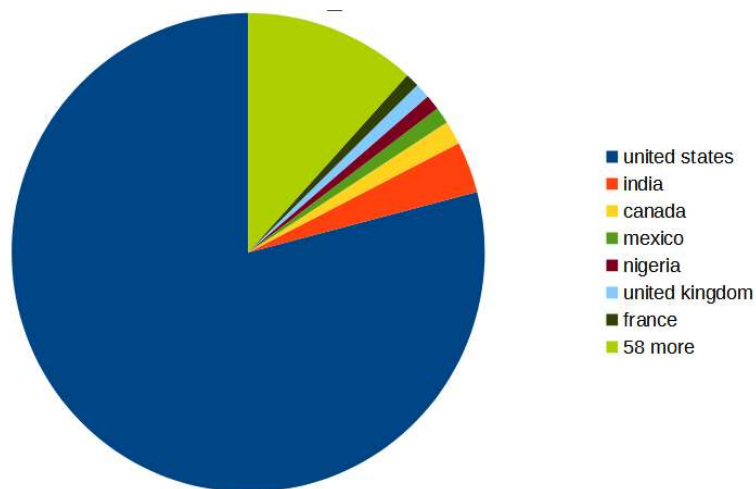
# What If I Miss a Session?

- For each completed session, our organizers plan to post a raw video recording of the session
- This will be posted on the Attendee Hub web page
- Later we plan to edit each raw video into a better quality recording
- When we post the finished recording, we will take down the raw recording
- If you miss a session, we invite you to download the slides for the session, and watch the raw video, during the two days before the succeeding session

# How Can You Ask Questions?

- This is going to be a challenge given that we have more than 1600 registrants
- Maybe after a few sessions I will get a rhythm going and might be able to answer more questions during the sessions
- At first I think I might not get everybody's questions answered during the scheduled time
- Ask your questions in the "questions" box, not the chat box
- I might try to post some answers in the Attendee Hub later
- Consider posting some questions in the PCT Listserv (email discussion group sponsored by my firm)
- I might post some answers in my blog (Ant-Like Persistence blog)

## Where Are Our Attendees Located?





## Session 3 Near Substitute

- Picking a PCT Receiving Office
- <https://blog.oppedahl.com/?p=7201>

## Session 4 Near Substitute

- Picking an International Searching Authority
- <https://blog.oppedahl.com/?p=7244>

## Session 13 Near Substitute

- National phase or Bypass?
- <https://blog.oppedahl.com/?p=7209>

## Helpful PCT Resources

- WIPO's PCT Distance Learning Course
- WIPO video series (Matthias Reischle)
- WIPO's PCT Applicant's Guide
- The PCT listserv (email discussion group)
- PCT section of the Ant-Like Persistence blog

# Polling Question

## Helpful PCT Resources

- WIPO's PCT Help Desk  
+41 22 338 83 38
- USPTO's PCT Help Desk  
+1 571 272 4300
- Make sure you are subscribed to WIPO's *PCT Newsletter*

# Helpful PCT Resources

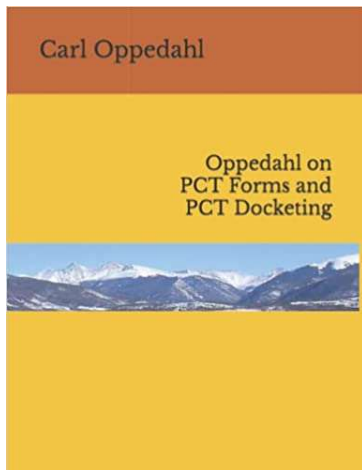
- Upcoming webinar:
- February 10, 2022, at 3 p.m. (Central European Time)
- **Best practices for recording of changes (Rule 92bis)**
- The speakers will be:
- Matthias Reischle-Park, Deputy Director, PCT Legal and User Relations Division
- Mineko Mohri, Legal Officer, PCT Legal and User Support Section, PCT Legal and User Relations Division
- To register, see WIPO web site or my blog.

## Upcoming ePCT Webinars That I Will Be Presenting

- Intro to ePCT, why ePCT is important, getting a user ID and password, setting up 2FA
- Making sure your US priority documents are available to DAS, best practices for filing US priority documents, Certificates of Availability, setting up alerts
- Handshakes, eOwners, eEditors, eViewers, access rights groups, employee first day of work, employee last day of work
- Shared address books, collaborative workflow, sharing with clients, sharing with outside counsel
- Getting to know your ePCT workbench, portfolios, office profiles, cloning, ePCT actions
- Getting pending PCT applications into your workbench, going back to January 1, 2009, archiving old applications
- filing a new US PCT application in RO/US using ePCT
- filing a new US PCT application in RO/IB using ePCT
- ePCT actions and communications with the IB
- External signatures and PCT declarations
- sequence listings and ePCT
- using ePCT to e-file in ISAs and IPEAs, filing Demands
- doing 92bis changes
- docketing of PCT applications and making use of ePCT notifications
- Publication front page preview, generating reports of outstanding Forms ISA/202, generating reports of applications with outstanding priority documents

**Don't want to miss them? Subscribe to the PCT listserv or subscribe to my blog (or both)**

# Helpful PCT Resources



- The fifty PCT forms that you are most likely to encounter
- Which dockets to set or clear when these forms arrive
- What dates and check boxes to check on the forms
- Warning signs that you can detect from the forms
- Order through your local bookstore
- Also available at [shop.oppedahl.com](http://shop.oppedahl.com)
- Also available on Amazon
- ISBN-13 : 979-8766914655
- Paperback : 218 pages
- A bargain at USD 89

## Today's Material

### What is PCT? Why We Care?

#### Paris Path Versus PCT

- We provide some background about what it costs to file patent applications in various patent offices around the world. We remind ourselves that if we file a large number of patent applications in various patent offices around the world, and if later we learn for the first time that the invention is not patentable, then we might regret having spent the money to file those patent applications. We review the time line that the Paris Convention offers for filing of patent applications in Offices of Second Filing around the world. We see how the Patent Cooperation Treaty offers an opportunity to get a preliminary indication as to the patentability of our invention before the expensive and difficult decisions need to be made as to whether to proceed with patent filings around the world.

## What We Mean by “Client” ...

- If you work in a law firm, it is usually pretty clear what we mean by “client”.
- In a corporate setting, “client” might mean “head of a business unit” or “internal decisionmaker”.

## Our General Goals

- Maybe each of us can think of a time or two when we realize we served a client well.
- It can be very satisfying.
- I would be delighted if something that we talk about during these webinars some day leads to a situation in which you can look back and say to yourself that it helped you to serve a client well.

# Has This Ever Happened to You?

- You ask the client: “I assume you are not just going to want to get patent protection in your own country. Where else are you going to want to get patent protection?”
- Client looks at you blankly, like maybe you just asked a really dumb question, and answers: “Well, everywhere, right?”

## Groupings of Offices

We can talk about the TM5 – the five trademark offices that account for the most trademark filings (CNIPA, EUIPO, JPO, KIPO, USPTO)

We can talk about the ID5 – the five design protection offices that account for the most design filings (CNIPA, EUIPO, JPO, KIPO, USPTO)

We can talk about the IP5 – the five patent offices that account for the most utility patent filings (CNIPA, EPO, JPO, KIPO, USPTO)

# What Do Patent Applications Cost to File?

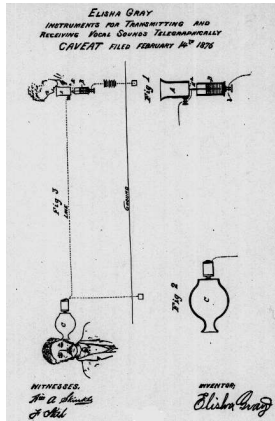
- Suppose a patent application has already been written in English. Now you are going to file it, let's say, in the IP5. What does that cost? (Very roughly!)
  - China – maybe \$9K
  - EPO – maybe \$9K
  - Japan – maybe \$11K
  - Korea – maybe \$11K
  - US – maybe \$4K
- ... fees to local agents, translation costs, government fees

# What it was like before 1883?

- Light bulb blinks on over the inventor's head
- Scramble around to file patent applications everywhere in the world in a big hurry!
- Many thousands of dollars spent in a big hurry



## Why the Hurry? Elisha Gray, That's Why. Who Is Elisha Gray? I'm Glad You Asked.



Elisha Gray is the one who got to the patent office after Alexander Graham Bell.

It turns out to be a big problem if somebody else got to the patent office before you did.

## Paris Convention

for the Protection of Industrial Property of **March 20, 1883**,  
as revised at Brussels on December 14, 1900,  
at Washington on June 2, 1911,  
at The Hague on November 6, 1925,  
at London on June 2, 1934,  
at Lisbon on October 31, 1958,  
and at Stockholm on July 14, 1967,  
and as amended on September 28, 1979.

# 1883

- First electric lighting system with overhead wires
- Oxygen liquified for the first time
- Brooklyn Bridge opened to traffic
- First operation of the train *The Orient Express*
- Cholera bacillus discovered
- Work begins on the even now not-yet-completed *Sagrada Família* Cathedral in Barcelona

## Paris Convention, Article 2

Nationals of any country of the Union shall, as regards the protection of industrial property, enjoy in all the other countries of the Union the advantages that their respective laws now grant, or may hereafter grant, to nationals ... . Consequently, they shall have the same protection as the latter, and the same legal remedy against any infringement of their rights ... .

This was 139 years ago ...

# Paris Convention, Article 4

We will spend much of today's session, and much of the next session, discussing Article 4 of the Paris Convention

It is 1200 words in length.

It requires multiple readings to get a fair chance of making sense of it.

It is really important to understand Article 4 of the Paris Convention thoroughly.

But how?

# Bodenhausen's Book

• Before WIPO, there was BIRPI

• Bodenhausen was the head of BIRPI

• He wrote an excellent book about the Paris Convention

• It is an exegesis of the Paris Convention

• WIPO published the book in 1969

• The book went out of print

• You can get a PDF of the book for free from WIPO and you can print it yourself

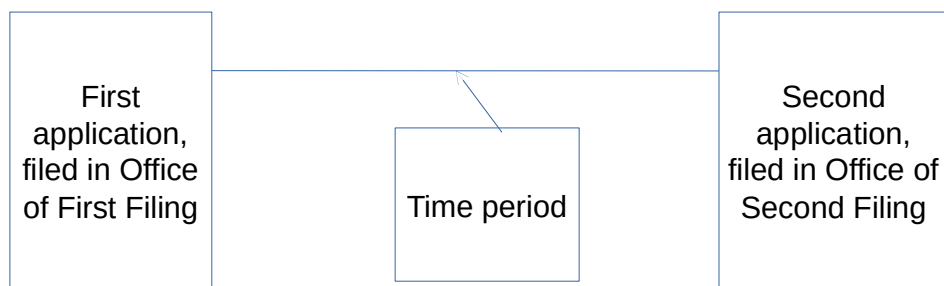
• For less than the cost of the printer toner, you can buy a nicely readable copy of the book

• ***You absolutely must read this book***

• It is a bit dry in places but that cannot be helped

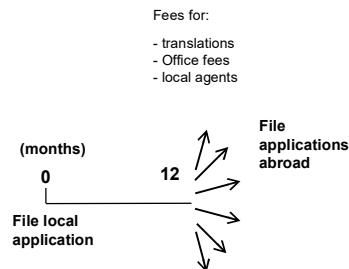
# Polling Question

## Priority Applications



- First application cannot be an application for a license plate for an automobile
- “***whatever may be the subsequent fate*** of the application”
- “shall be recognized as giving rise to ***the right of priority***”

# Paris Convention



This is a traditional path that has been available since 1883. The expensive and difficult decisions about foreign filing may be postponed until almost 12 months.

But at 12 months you may not yet know whether the invention is patentable.

## 12 Months?

- Twelve months for patents (and utility models)
- Six months for industrial designs
- Six months for trademarks

# Back to Utility Patents

- 12 months from your first priority filing
- You can start the 12 months over again
- EALNRO
- If the would-be priority application has been expressly abandoned leaving no rights outstanding, before the filing of the next would-be priority application, then you get to restart the clock

# Is EALNRO An Acronym?

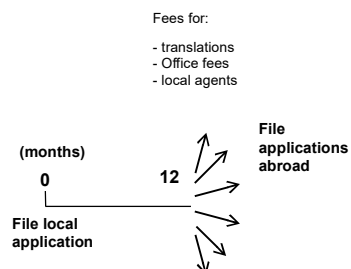
- No. You can only call something an acronym if it is capable of being pronounced as a word.
- NATO. NASA. WIPO. These are acronyms.
- EALNRO is merely an *initialism*.

# Communicating with the Client about Foreign Filings

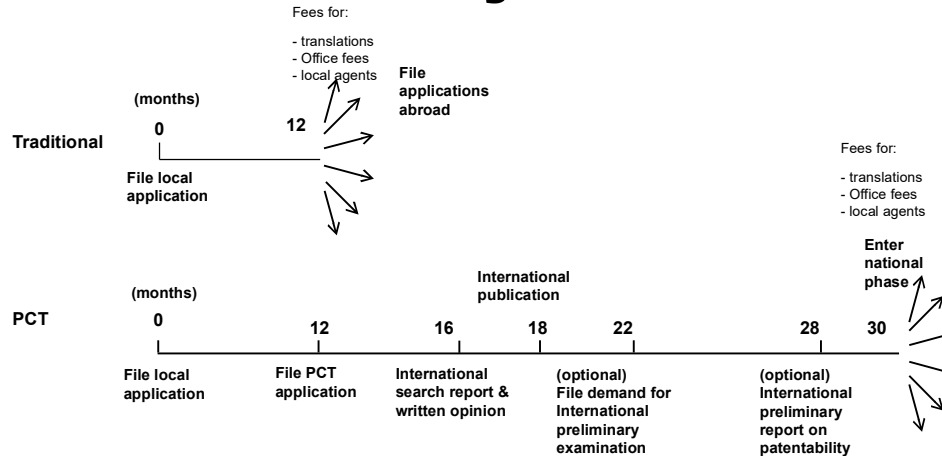
- Whenever you file any patent application that has a chance of serving as a priority document for later foreign filings ...
- It is important to write to the client about the need to keep track of the 12-month priority period
- It is important to docket the 12-month priority period

## Purchasing \$44k Worth of Lottery Tickets

Wouldn't it be nice to know whether or not the lottery tickets are going to be winners, ***before*** you spend the money to purchase the lottery tickets?



# Traditional Patent System vs. PCT System



## Benefits of and Reasons to Use PCT

- The PCT offers a prompt and early preliminary indication as to patentability
- The PCT permits postponing expensive and difficult foreign-filing decisions for an extra eighteen months
- The PCT permits a single filing in a single format to be used in multiple offices around the world





Not every country  
belongs!

## **To Join PCT, You Must Already Belong to the Paris Convention**

### **Here Are Countries That Belong to the Paris Convention but Do Not Yet Belong to the PCT**

Afghanistan	Iraq (will become bound by the PCT on 30 April 2022)
Andorra	Jamaica (will become bound by the PCT on 10 February 2022)
Argentina	Kiribati
Bahamas	Lebanon
Bangladesh	Mauritius
Bhutan	Nepal
Bolivia	Pakistan
Burundi	Paraguay
Congo	Suriname
Guyana	Tonga
Haiti	Uruguay
Holy See	Venezuela

# Purchasing \$44k Worth of Lottery Tickets

With PCT, you have at least a little bit of an idea whether or not the lottery tickets are going to be winners, ***before*** you spend the money to purchase the lottery tickets!

You have an International Search Report and a Written Opinion from the International Searching Authority

# What You Would Like to See

WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY				International application No. <b>PCT/US2016/027448</b>
<b>Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement</b>				
<b>I. Statement</b>				
Novelty (N)	Claims	1-17	YES	
	Claims	NONE	NO	
Inventive step (IS)	Claims	1-17	YES	
	Claims	NONE	NO	
Industrial applicability (IA)	Claims	1-17	YES	
	Claims	NONE	NO	

# What Is the Significance of a Favorable Written Opinion?

A Written Opinion from an International Searching Authority is a document from somebody who “does not have a dog in this fight”.

It is a document from a neutral party.

Even if somebody is skeptical of many things, they will have no particular reason to be skeptical about a Written Opinion from an ISA

# When Do You Receive Your Written Opinion?

- The typical arrival date of an WO is:  
P+9 or SC+3, whichever is later.
- Priority date plus nine months, or three months after the date the ISA receives the search copy, whichever is later.
- (If you filed your PCT on the last possible date, then the WO might arrive around 4 months after that.)

## What Can You Do With a Favorable Written Opinion?

- Suppose you are a small startup company
  - A favorable WO might make a good impression with a potential investor
- ... or a potential partner

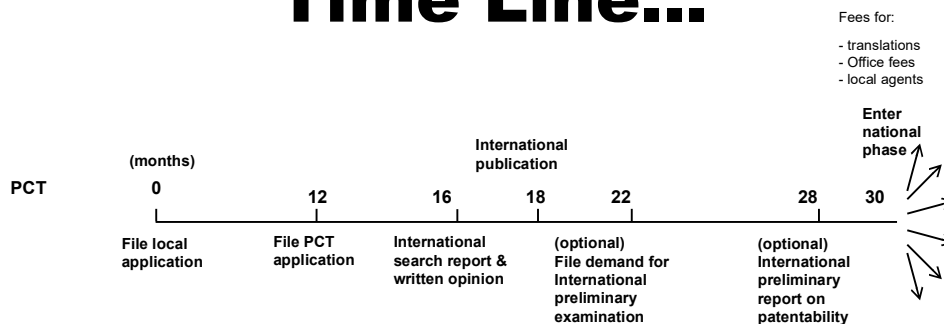
## What Can You Do With a Favorable Written Opinion?

- A favorable WO can be a big help as you face difficult and expensive decisions like spending \$44K on foreign filings
- A favorable WO can get you onto the Patent Prosecution Highway

# What Can You Do With an *Unfavorable* Written Opinion?

- An unfavorable WO can be a big help because maybe you can decide to stop throwing good money after bad
- Because maybe you might agree with the view that the invention has turned out to be unpatentable
- In that case you have saved \$44K that can now be kept in the bank or can be spent on new patent filings on other inventions

## Back to Our 30-Month Time Line...



# Where Is the International Searching Authority?

- There are twenty-three ISAs
- US filers will most often encounter:
  - ISA/AU (Australian Patent Office)
  - ISA/EP (European Patent Office)
  - ISA/IL (Israeli Patent Office)
  - ISA/JP (Japanese Patent Office)
  - ISA/KR (Korean Patent Office)
  - ISA/SG (Singapore Patent Office)
  - ISA/RU (Russian Patent Office)
  - ISA/US (USPTO)

# Where Is the International Preliminary Examining Authority?

- There are twenty-three IPEAs, one for each ISA
  - IPEA/KR
  - IPEA/SG
  - IPEA/RU
  - IPEA/US
- US filers will most often encounter:
  - IPEA/AU
  - IPEA/EP
  - IPEA/IL
  - IPEA/JP

# What Does the IPEA Do?

- In 90% of cases, there is no IPEA connected with the application, because the applicant does not choose to file a Demand
- If the applicant files a Demand then the IPEA considers arguments and/or amendments made by the applicant
- Maybe the result for the applicant will be a more favorable result than the WO of the ISA

# Function of DO/EO

- The DO/EO office in a particular patent office handles national-phase entry at that patent office
- US filers will most often encounter:
  - DO/US
  - DO/EP
  - DO/JP
  - DO/KR
  - DO/CN
- These five Offices are sometimes called “the IP5”

# A Typical Sequence of Events for a PCT Application

- Priority patent application filed (“P” filing date)
- PCT application filed at P+12 (priority date plus twelve months)
- RO sends the Search Copy to the International Searching Authority (“ISA”)
- RO sends the Record Copy to the International Bureau

# A First Typical Sequence of Events for a PCT Application

- The ISA establishes the International Search Report and Written Opinion at about P+16
- The IB publishes the PCT application at about P+18
- Just before P+30, the applicant enters the national phase in the US, China (“CN”), and Japan (“JP”)
- Just before P+31, the applicant enters the national phase in EPO (“EP”) and South Korea (“KR”)
- Each of these Offices (US, CH, JP, EP, and KR) is termed a “Designated office”



## **Even If We Ignore the Written Opinion, Let's Talk Specifically about the 30-Month Time Line ...**

Suppose that at 27 or 28 months you learn that for some newly appreciated business reason, the invention is not nearly as important as it originally seemed to be ...

So now you stop throwing money at this invention ...

You have just saved \$44K that can now be kept in the bank or can be spent on new patent filings on other inventions

This savings of \$44K would not have been available under a legacy Paris path!

## **Even If We Ignore the Written Opinion, Let's Talk Specifically about the 30-Month Time Line...**

Suppose that at 27 or 28 months you find a new way to solve the problem, that is better/cheaper/faster compared to the way of the invention ...

So now you stop throwing money at this invention ...

You have just saved \$44K that can now be kept in the bank or can be spent on new patent filings on other inventions

This savings of \$44K would not have been available under a legacy Paris path!

## **Even If We Ignore the Written Opinion, Let's Talk Specifically about the 30-Month Time Line...**

Suppose that at 27 or 28 months you learn to your disappointment that absolutely no consumer is interested in purchasing your inventive product, and they never will be ...

So now you stop throwing money at this invention ...

You have just saved \$44K that can now be kept in the bank or can be spent on new patent filings on other inventions

This savings of \$44K would not have been available under a legacy Paris path!

## **As Mentioned Earlier, the PCT System Permits You to Carry Out a Single Filing**

The PCT permits a single filing in a single format to be used in multiple offices around the world

One way to think of a PCT application is that it is a bundle of individual national applications (more than a hundred) that happen to be filed all at once by means of a single filing process in one place

# What PCT Is

- PCT is not a “patent granting system”
- PCT is only a “patent filing system”
- Each designated Office makes its own decision whether to grant a patent
- There is no such thing as a “PCT Patent”
- While we are on the topic of things that do not exist, there is no such thing as a “provisional patent”

# International Filing Systems

We can talk about the Madrid Protocol – the international filing system for trademarks

We can talk about the Hague system – the international filing system for industrial designs

We can talk about the Patent Cooperation Treaty – the international filing system for patents

# Is the ISR/WO Binding on Later Patent Offices in the National Phase?

No not at all!

Each patent office is very proud and they cannot imagine that any other patent office could be as good as they are at figuring out what is patentable and what is not

But see EPO which “drinks its own champagne”

Many patent offices at least *sotto voce* give substantial faith and credit to the findings of the ISA/EP

## What Lies Ahead?

- Session 2 | Thursday, February 10 – Planning for PCT and Paris, Article 4 of Paris, SAOSIT, Making Use of WIPO DAS
- Session 3 | Monday, February 14 – Selecting a Receiving Office, RO/US Versus RO/IB
- Session 4 | Wednesday, February 16 – Selecting an International Searching Authority
- Session 5 | Friday, February 18 – Preparing a PCT Request – Making Use of ePCT and Getting Benefit of Validations, Avoiding Malpractice on Priority Claim Mistakes.

# What Lies Ahead?

- Session 6 | Tuesday, February 22 – Using Workplace Collaboration Features of ePCT as You Lead up to the PCT Filing, Shared Address Book, External Signatures, Document Reviews
- Session 7 | Thursday, February 24 – E-Filing of the PCT Application and Docketing of PCT Thereafter
- Session 8 | Monday, February 28 – What to Do When the International Search Report and Written Opinion Arrive, Do You File a Demand?
- Session 9 | Wednesday, March 2 – Using ePCT for “Actions” Such as 92bis Requests, Communicating with ISAs

# What Lies Ahead?

- Session 10 | Friday, March 4 – Mechanics of Filing a Demand, Steps Before and After Filing the Demand
- Session 11 | Tuesday, March 8 – Understanding and Using the Five Kinds of PCT Declarations
- Session 12 | Thursday, March 10 – National Phase Entry Generally – Tips for Some Offices
- Session 13 | Monday, March 14 – Choosing between US National-Phase Entry and Bypass Continuation

# What Lies Ahead?

- Session 14 | Wednesday, March 16 – Best Practices and Procedure for US National-Phase Entry
- Session 15 | Friday, March 18 – Making Use of PCT-PPH, and Comparison with Track I and AE

# A Reminder ...

## **Upcoming webinar:**

February 10, 2022, at 3 p.m. (Central European Time)

## **Best practices for recording of changes (Rule 92bis)**

The speakers will be:

Matthias Reischle-Park, Deputy Director, PCT Legal and User Relations Division

Mineko Mohri, Legal Officer, PCT Legal and User Support Section, PCT Legal and User Relations Division

To register, see WIPO web site or my blog.

**Now maybe a few questions?**

**Thank you!**

See you in two days!