

2022 Virtual PCT Training Seminar

# Session 10

Filing a Demand, Steps Before and After Filing a Demand

Friday, March 4, 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.

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## 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.



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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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## How Can You Ask Questions?

- 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)

## Today's Topics

- Steps before filing a Demand
- Mechanics of filing a Demand
- Steps after filing a Demand

## Wouldn't It Be Nice?

Wouldn't it be nice if some system were to provide a warning notification that you had, say, only two weeks left before the last possible date for filing a Demand?

## Yes, But...

Yes, but this automatic notification happens for a particular PCT application only if...

- You have a WIPO user ID and password ...
- You have two-factor authentication set up for your WIPO user ID, and ...
- That particular PCT application is already in your ePCT workbench

## Action Items

- Make sure you have a WIPO user ID and password
- Make sure you have set up two-factor authentication for your WIPO user ID
- Make sure that every one of your pending PCT applications is in your ePCT workbench

## Filing a Demand and Article 34 Amendment

- You can think of the ISR/WO from the ISA like an Office Action
- You can think of the Demand and Article 34 Amendment like a Response to the Office Action
- Ask yourself why you would ever pass up a chance to respond to an Office Action?
- And yet 90% of the time, that is what PCT applicants do these days
- They fail to file a Demand
- I think that is unwise in many cases

## Steps Before Filing a Demand

- Recall that before making use of the PCT in a particular to-be-filed application, the applicant had to establish that the applicant was entitled to use the PCT at all
- The same requirement presents itself for Chapter II of the PCT
- The applicant needs to establish that the applicant is entitled to use the Demand process
- Suppose the applicant changed citizenship and domicile since the date that the PCT application was filed
- Maybe the applicant is not entitled to make use of the Demand process
- Wouldn't it be nice if some computerized process were to carry out validations that would warn you if you have a problem in this area?
- If you prepare your Demand as a PDF file with fillable fields, no such validation will take place
- To avoid malpractice, prepare your Demand in ePCT, where the software will carry out validations on your inputs to protect you from embarrassment or worse

## File a Demand?

- Nobody files Demands nowadays
- Well, only about 10% of the time
- I think some applicants would be smart to file a Demand in some cases
- If it looks like you might have a fairly good shot at getting more claims favorably treated, maybe go for it
- Keep in mind if you get a good result from your IPEA, this will allow you to put your national-phase cases on the Patent Prosecution Highway

## File a Demand?

- Is the ISA ISA/EP? Keep in mind that if you manage to get good results from IPEA/EP, then the EPO will “drink its own champagne”
- This might lead to a quick EP patent, quicker than trying to do it through old-fashioned domestic EP prosecution
- Consider getting assistance from experienced EP counsel in carrying out the Demand and Article 34 activity

**Polling Question**

## Maybe You Have More Than One IPEA to Choose From?

- If you have more than one IPEA to choose from, then what you would not want to do is fail to mention this to the client
- You had better communicate this in writing
- Some IPEAs are universal acceptors (they do not turn you down based upon which ISA you picked):
  - IPEA/AT, IPEA/AU, IPEA/BR, IPEA/EG, IPEA/ES, IPEA/FI, IPEA/IL, IPEA/IN, IPEA/KR, IPEA/PH, IPEA/RU, IPEA/SE, IPEA/TR, IPEA/UA, IPEA/XN, IPEA/XV
- ePCT will calculate the list of available IPEAs for you

## Sometimes Your Reason for Filing a Demand Is Quite Unrelated to the ISR/WO

- Sometimes it is that the practitioner got turned down by the ISA when the practitioner tried to hand in formal drawings after filing day
- This might be a way to get the formal drawings into the case
- The practitioner should have handed in the formal drawings on filing day!
- Sometimes it is that the practitioner is trying to get some big mistake rectified that the practitioner was not able to get rectified by arguing with the RO or the ISA



## Sometimes Your Reason for Filing a Demand Is Quite Unrelated to the ISR/WO

- Sometimes it is that the applicant wants to get 30 months in LU or TZ
- If so, then the Demand must be filed by P+16

## Picking an IPEA

- Recall our discussions about picking an ISA
- Same factors inform the process of picking an IPEA
  - Quality
  - Cost
  - Full faith and credit around the world
  - PPH applicability
  - Drinking their own champagne

## Picking How to Amend

- You can amend using Article 19
- You can amend using Article 34
- How should you choose which of these two ways to amend?

## Article 19 and Article 34

- Article 19 – you can only amend claims
- Article 34 – you can amend spec, claims, and drawings
- Article 19 – you don't have to pay money
- Article 34 – you have to pay lots of money
- Article 19 – the IB does not check to see if you added new matter
- Article 34 – the IPEA checks to see if you are adding new matter
- Article 19 – must file by P+16 (or tech prep day or ISA+2)
- Article 34 – may file as late as P+22 (or ISA+3 if later)
- Article 19 – gets published by the IB (pregrant damages!)
- Article 34 – does not get published by the IB (but is eventually visible to the public)

# Polling Question

## Pregrant Damages!

- Yes there are many countries where the owner of a granted patent can go back and collect damages for infringement that happened before the patent was granted
- But only if the claims that were infringed in the granted patent can be found in the published patent application
- And if other conditions are satisfied
- The Article 19 claims can be the claims that are asserted for purposes of pregrant damages
- This can work under US law and it can work in Europe
- This is a reason to use Article 19

## Mechanics of Filing a Demand

- Maybe you will use a domestic e-filing system to file your Demand
- For example, if a US filer wants to use IPEA/US, then the US filer will naturally pick EFS-Web or Patentcenter as the way to file the Demand
- Of course as between the two, you should be using Patentcenter

## Mechanics of Filing a Demand

Trap for the unwary for US filers:

- Suppose the US filer has picked an IPEA that is not IPEA/US
- The trap for the unwary is to pick EFS-Web or Patentcenter as the way to file the Demand
- The unwary filer will find that the IPEA/US will grab the work and it will be impossible to wrest the work away from IPEA/US and get it into the hands of the IPEA that the filer really wanted

## Mechanics of Filing a Demand

A very convenient way to file a Demand is to make use of an ePCT “action”

- You will get credit for what time it is in Switzerland or what time it is at the IPEA, whichever is more favorable
- You will still have to figure out how to pay the preliminary examination fee to the IPEA (ePCT will not do this for you)

## Mechanics of Filing a Demand

Avoiding embarrassment by filing late

- Suppose the last possible date has already passed but you somehow failed to notice this
- Suppose you try to file the Demand anyway
- This would make you look stupid in front of the client
- Practice tip: use ePCT as your way of filing Demands
- ePCT carries out a validation of your inputs
- If the last possible date has already passed, ePCT will catch this in the validations
- This will save you from looking stupid in front of the client

## Mechanics of Filing a Demand

Avoiding embarrassment that would follow from picking an IPEA that is not actually available in your case

- Suppose you try to file the Demand anyway before that IPEA
- This would make you look stupid in front of the client
- Practice tip: Use ePCT as your way of filing Demands
- ePCT carries out a validation of your inputs
- If the IPEA that you are trying to use is not in fact available in your case, ePCT will catch this in the validations
- This will save you from looking stupid in front of the client

## Mechanics of Filing a Demand

Avoiding embarrassment that would follow from picking an IPEA that will not be satisfied with the language in which the PCT application was published

- Suppose you try to file the Demand anyway before that IPEA
- This would make you look stupid in front of the client
- Practice tip: Use ePCT as your way of filing Demands
- ePCT carries out a validation of your inputs
- If the IPEA that you are trying to use is not in fact available in your case, ePCT will catch this in the validations
- This will save you from looking stupid in front of the client

## Mechanics of Filing a Demand

You may, if you wish, check a box indicating that you would like the IPEA to consider the claims as amended under Article 19 to be the claims for purposes of preliminary examination (as if they were also the Article 34 claims)

## Mechanics of Filing a Demand

It is possible to file a Demand and not amend claims

- You might do this if the only thing you wish to do is argue
- Some IPEAs seem to tend to toss such Demands into the trash

## Trap for the Unwary

- In the old days, the IPEA would put it all on ice until P+22 or ISR+3, whichever was later (unless the filer expressly requested the IPEA to commence the preliminary examination sooner)
- That's not how it works now (since a 2019 rules change)
- Now the IPEA commences its work as soon as it is in possession of:
  - The Demand
  - The money, and
  - The ISR/WO (or declaration of non-establishment).
- This means that if you foot-drag getting your claim amendment (for example Article 34) into the case, you risk that the preliminary exam will start and finish very fast, failing to take into account the claim amendment that you failed to file.
- Practice tip – get everything about your Demand filed up front!

## Trap for the Unwary: Small Entity Being Asserted for the First Time

- Suppose this is a PCT application in which no previous assertion of US small entity status had been made
- Now suppose IPEA/US has been selected
- Some US practitioners will wrongly assume that the mere payment of a “small entity” preliminary examination fee to the IPEA/US will count as an assertion of US small entity status
- Such a US practitioner will be mistaken and will look stupid in front of the client



## Communicating with IPEAs

The following IPEAs permit document uploads through ePCT:

- AT
- AU
- BR
- CL
- EG
- EP
- FI
- IN
- KR
- PH
- RU
- SE
- SG
- TR
- UA
- XN
- XV

## Communicating with IPEAs

The following IPEAs permit you to send electronic messages to them through ePCT:

- IPEA/AT
- IPEA/BR
- IPEA/CL
- IPEA/EG
- IPEA/IN
- IPEA/PH
- IPEA/TR
- IPEA/UA
- IPEA/XN
- IPEA/XV

## 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)

## 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

## 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

## Another Docket to Set

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

## Invitation to Pay Additional Fees

- Form PCT/IPEA/405 (*PCT Forms* book page 177)
- This is the equivalent of a Restriction Requirement
- I recommend always paying the additional fees
- No matter how much the client gripes, convince them to pay the additional fees
- You have to pay in the local currency of the IPEA
- How to pay? For IPEA/KR, I use Wise Business
- Dockets to set:
  - Docket to make sure the Invitation gets reported to the client
  - Docket the due date for handing in the money
  - Docket to check for instructions from the client

## Maybe a Second WO

- You already have a WO from the ISA
- You might also receive a WO from the IPEA
- This sometimes happens if the IPEA is not the same Office as the Office that was the ISA

## You Always Get At Least One Phone Call

- The IPEA is not allowed to say “no” if you want to talk with the Examiner
- PCT Rule 66.6 “Informal Communications with the Applicant”
  - The International Preliminary Examining Authority may, at any time, communicate informally, over the telephone, in writing, or through personal interviews, with the applicant. The said Authority shall, at its discretion, decide whether it wishes to grant more than one personal interview requested by the applicant, or whether it wishes to reply to any informal written communication from the applicant.

## IPRP Chapter I? IPRP Chapter II?

- If you don't file a Demand, you will receive an IPRP Chapter I. This is your WO from the ISA, with a cover sheet stating that it is the IPRP Chapter I.
- If you do file a Demand, then what you will receive is an IPRP Chapter II.

## What You Would Like

- Of course what you would like is a “yes” answer to all three questions for all of your claims
- And you would like “annexes” stating that all of your proposed amendments are being entered (among other things, that you are not adding any new matter)

## Enter National Phase and Get on the Patent Prosecution Highway?

- There is no requirement for an applicant to postpone national-phase entry until 30 months
- If a client has a favorable IPRP from the IPEA, there is much to be said for entering national phase immediately and getting onto the Patent Prosecution Highway

## Was the Favorable IPRP from IPEA/EP?

- If the favorable IPRP was from IPEA/EP, then there is no reason to foot-drag
- Enter the EP regional phase without delay
- You will not have to pay a search fee or an examination fee
- The Notice of Allowance will be automatic (they “drink their own champagne”)
- Pay the Issue Fee promptly
- Get your granted European patent promptly
- Bob’s your uncle
- The favorable IPRP from IPEA/EP will be given full faith and credit in an official way in many Offices
- It will be given substantial faith and credit *sotto voce* in many more Offices

## What Lies Ahead?

- 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

**Now maybe a few questions?**



# Thank you!

See you at the next session!

