

2022 Virtual PCT Training Seminar

Session 12

National Phase Entry Generally – Tips for Some Offices

Thursday, March 10, 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



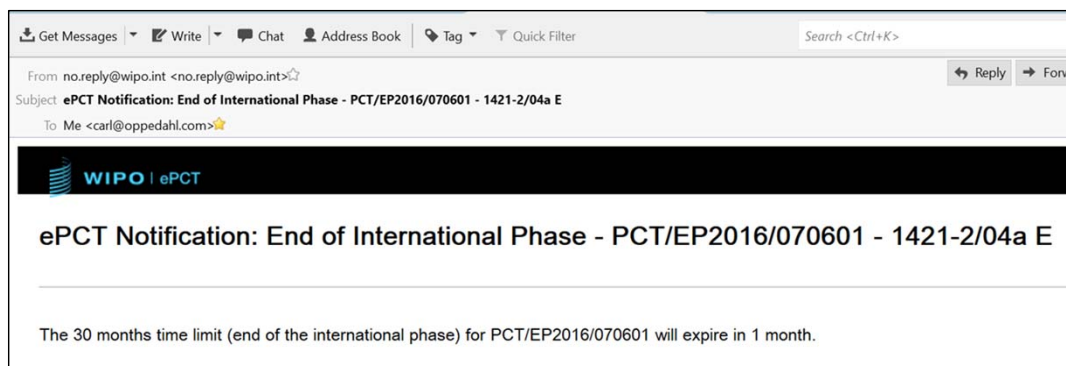
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How Can You Ask Questions?

- 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)

Isn't It Nice?



IPRP-I and IPRP-II

- Every PCT application gets an International Preliminary Report on Patentability (except in the rare case where no ISR was established).
- If no Demand was filed, the application receives an IPRP under Chapter I of the Treaty (IPRP-I).
- If a Demand was filed, the application receives an IPRP under Chapter II of the Treaty (IPRP-II).

IPRP-I

If no Demand was filed, the application receives an IPRP under Chapter I of the Treaty (IPRP-I).

- This comes from the International Bureau.
- The IB simply places a cover sheet over the Written Opinion of the ISA.
- This happens shortly after the 30th month.

IPRP-II

If a Demand was filed, the application receives an IPRP under Chapter II of the Treaty (IPRP-II).

- This is mailed by the International Preliminary Examining Authority.
- This often happens around the 28th month.

WO/ISA and WO/IPEA

- Every application receives a Written Opinion of the International Searching Authority (except in the infrequent case where no ISR was established).
- If a Demand is filed, then usually the IPEA adopts the WO/ISA as its Written Opinion.
- An IPEA could, however, establish its own WO.
- This sometimes happens if the IPEA is not the same as the ISA.
- If the IPEA establishes its own WO, this is termed the WO/IPEA.

Entry into National Phase and Regional Phase Outside of the U.S.

- 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: 30 months

Entry into National Phase and Regional Phase Outside of the U.S.

- The client will need to decide where (if at all) the client wishes to enter the national and/or regional phase.
- Many factors might affect these important decisions as for a particular country or region:
 - Size of the economy in that country or region
 - Prosecution cost in that country or region
 - Business needs of the client in that country or region

Entry into National Phase and Regional Phase Outside of the U.S.

- You will need to send instructions to foreign counsel.
- Best Practice is that foreign counsel already uses ePCT, in which case you need merely click to give ePCT access to foreign counsel.
- Another option is to send the permalink from Patentscope (if the application has been published).
- You will need to let foreign counsel know your file number.

Entry into National Phase and Regional Phase Outside of the U.S.

- When sending instructions to foreign counsel, allow enough time for translations and other tasks.
- Coordinate with foreign counsel about local needs. For example, in EPO you will probably want to limit the application to fifteen claims.
- Docket to check for prompt confirmation of instructions from foreign counsel.

The IP5

- CNIPA
- EPO
- JPO
- KIPO
- USPTO

These five Offices between them account for 85% to 90% of all patent filing activity worldwide. Some corporate filers automatically do not think of other Offices.

Cost

Some Offices cost a lot less money than you might think.

- Australia
- Canada
- New Zealand

Especially if you have favorable results elsewhere.

Effectiveness of Courts and Enforcement Systems

Great variation from one country to the next, especially historically.

Cost

Some filings cost really a lot of money.

- Translation costs
- Government fees

But in the case of EPO, do not forget you are getting 23 countries through one filing, plus possible extension states.

And EPO could end up costing a lot less than you expected if you previously picked EPO as your ISA.

Pharma

You will see an occasional pharma filing path in which filings are done in essentially every Office in which it is possible to file.

Where are the Customer Markets?

Some corporations will file based upon where the customer markets are located.
Or based upon guesses of where the customer markets might be located in the next twenty years.

Where are the Factories?

Some corporations will file based upon where the factories are located.

If you can get enforceable rights in the places where competitors might build factories, maybe this is all that you need.

Maybe no need to worry about where the customers are located.

Consider Lifecycle Cost

It is very easy for a client to consider merely the cost to enter national phase in various offices, failing to take into account ongoing costs.

Annuities can really add up.

Clients that have not been through this process before need to be warned about the annuity costs in various Offices.

Selecting Foreign Counsel

Worst way to pick:

- They spammed you, and you give them business

Second worst way to pick:

- They send you work, and so you send work back to them

Selecting Foreign Counsel

Best ways to pick:

- Referrals from trusted colleagues
- Referrals from colleagues on the PCT listserv
- Do they use ePCT for all functions?
- Do they use PCT declarations 2, 3 and 4?

Should You Use a One-Stop Shopping Service Provider?

For a cheap fixed fee per Office they will do your national-phase entries in lots of countries.

They handle the translations.

They pick the local firms.

They really keep the costs down.

Is it a good idea?

Maybe okay for some bronze cases. Surely a bad idea for any gold cases.

How do you know if the translations are any good?

How to Get Translations Done?

There are some very expensive translation service providers.

There are some translation service providers that offer amazingly inexpensive prices.

How can you possibly know whether the work is good quality?

Should you simply entrust the translation work to your foreign patent counsel?

How to Pay Foreign Counsel?

We find Wise Business to work well for us.

If the foreign firm uses Wise Business too, then transfers each direction will be free of bank fees and will be instant.

What Lies Ahead?

- 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!

