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2022 Virtual PCT Training Seminar

Session 2

Planning for PCT and Paris, Article 4 of Paris, SAOSIT, Making Use of WIPO DAS

Thursday, February 10, 2022

Schwegman Lundberg & Woessner | slwip.com



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.

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 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.



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Today's Goals

Long before foreign filings are carried out under the Paris Convention, long before a PCT patent application is filed, the applicant should be planning ahead to avoid a number of traps for the unwary. Among these is the requirement that in an Office of Second Filing, the applicant needs to be the same applicant (or successor in title) as the applicant in the priority application (the application that was filed in the Office of First Filing. The filer of any application that has the prospect of later serving as a priority application should also pay attention to the importance of making that application available to the WIPO DAS system. The US filing system offers a particularly rich variety of ways to get these things wrong, and we will discuss Best Practices for such priority filings.



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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)

Paris Convention, Article 4

We will spend much of today’s 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?

Bodenhause's Book

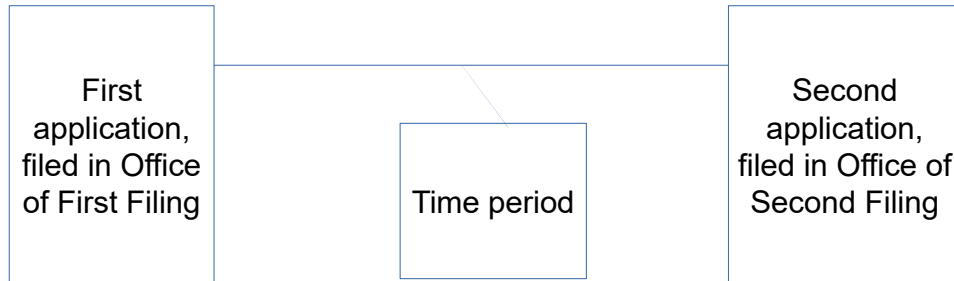
- Before WIPO, there was BIRPI
- Bodenhause was the head of BIRPI
- He wrote an excellent book about the Paris Convention
- It is an exegesis of the Paris Convention
- WIPO published the book in 1969
- The book went out of print
- You can get a PDF of the book for free from WIPO and you can print it 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

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”***

SAOSIT

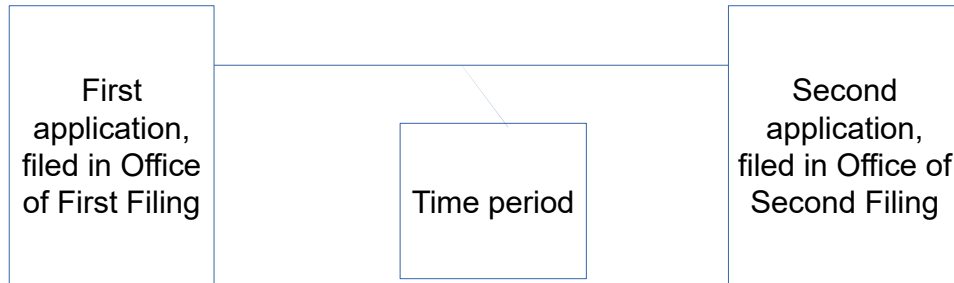


Any ***person who has duly filed an application*** for a patent, or for the registration of a utility model, or of an industrial design, or of a trademark, in one of the countries of the Union, ***or his successor in title***, shall enjoy, for the purpose of filing in the other countries, a right of priority during the periods hereinafter fixed.

Is SAOSIT An Acronym?

- No. It is a mere initialism.

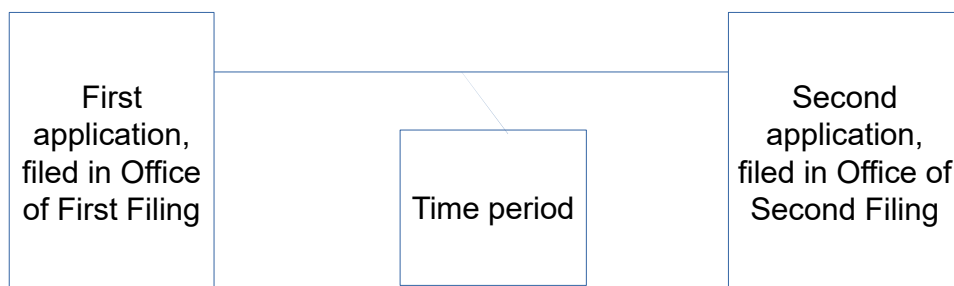
SAOSIT



The Office of Second Filing may say that the applicant in the second application is required to be the same applicant as the applicant in the first application.

(Or “his successor in title”.) (The Treaty says “his”.)

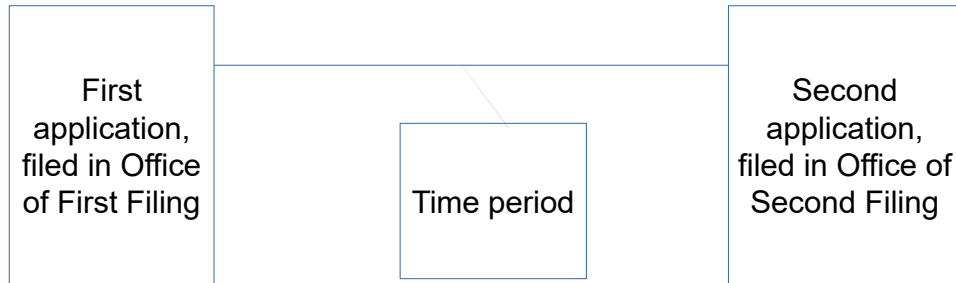
Cleaning Up a Mess



Suppose the applicants don't match? How much time do you have to do the paperwork to clean up the mess? Can you clean up the mess **chronologically after** the filing of the second application?

It depends on who your Office of Second Filing happens to be.

Cleaning Up a Mess




How much time do you have to do the paperwork to clean up the mess? Can you clean up the mess **chronologically after** the filing of the second application? How about a **nunc pro tunc** assignment?

Nunc Pro Tunc

The best way to understand *nunc pro tunc* is like this:



Nunc Pro Tunc

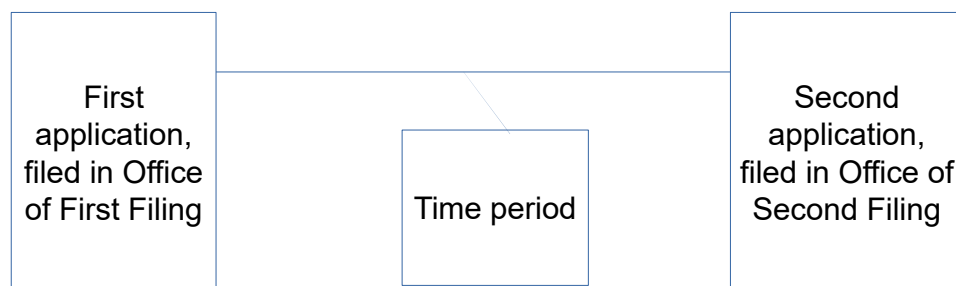
 United States Patent and Trademark Office	
Home Site Index Search Guides Contacts eBusiness eBiz alerts News Help	
Electronic Patent Assignment System	
Patent Assignment Recordation Form Navigation: Guidelines - Conveyance Type	EPAS v.1.11 PTO-1595 (Rev. 06/18) OMB No. 0651-0027 (Exp. 06/30/2021)

Conveyance Type

Select nature of conveyance

<input type="radio"/> Assignment	
<input checked="" type="radio"/> Nunc Pro Tunc Assignment	Effective date: <input type="text"/> Format: MM/DD/YYYY
<input type="radio"/> Merger	Effective date is required for 'Nunc Pro Tunc', 'Merger' and 'Merger and Change of Name' types
<input type="radio"/> Merger and Change of Name	

Some OSFs are More Generous



Some Offices of Second Filing are much more generous as compared with the requirements of Paris Convention Article 4. Look for example at 35 USC § 119(a-d) where there is no requirement that the applicants be the same (or successor in title).

Offices of Second Filing Differ

- Patent offices differ from one to the next as to how and when SAOSIT needs to be satisfied.
- As for each Office that your client may wish to get a patent in, you should consult competent counsel in that location to find out what the requirements are.
- EPO and UK and Japan are among the Offices that are quite strict about SAOSIT.

EPO's View

- EPO's view is that to the extent that a filer in EPO has flunked the "Same Applicant" test, the "OSIT" cleanup paperwork needs to have been completed **before the filing in the EPO**
- In the case of an EP regional-phase entry from a PCT application, this means the cleanup paperwork needs to have been completed **before the filing of the PCT application**

EPO's View

- EPO's view is that people who try to use *nunc pro tunc* assignments are not going to be permitted to get away with it.
- Simply **saying** that your document that is signed after December 12, 2013 supposedly makes it so that the document had legal effect prior to December 12, 2013 does not, in the view of the EPO, make it so.
- Simply **saying** that "this is not a pipe" does not keep the pipe from being a pipe, EPO would say.

Simply Saying that "This is Not a Pipe" Does Not Keep the Pipe From Being a Pipe, EPO Would Say

"The famous pipe. How people reproached me for it! And yet, could you stuff my pipe? No, it's just a representation, is it not? So if I had written on my picture 'This is a pipe', I'd have been lying!"

– René Magritte



There Are Very Famous SAOSIT Cases Involving CRISPR

- Cases where practitioners did not get SAOSIT right
- Cases where a patent became an ex-patent
- “it’s an ex-parrot.” “No, just resting.” “No, it’s an ex-parrot”
- Cases where very likely eventually billions of dollars will turn on the outcome
- Imagine if you were that practitioner

Yes, CRISPR Is An Acronym!

- Because it can be pronounced as a word.
- Finally we get an acronym in this discussion.

Best Practice

- When getting ready to file a US provisional application, minimize professional liability risk by finding out who the applicant or applicants will be in the OSF.
- Memorialize the answer.
- When filing the US provisional application, use an ADS instead of or in addition to a Provisional Cover Sheet, and establish that the OSF applicant or applicants are the applicant or applicants in the US provisional application.
- TYFNIL you will have eliminated the SAOSIT line of attack.

Making Mistakes

- We all make mistakes.
- It is part of life.
- In the world of patents, most mistakes are fixable if you don't mind paying a bunch of money or you don't mind filing a petition or if you have a really good excuse or you are very sorry.
- When we get somebody new in our office we try to teach them about the particular kinds of mistakes that are not fixable even if you were willing to pay a bunch of money, even if you did not mind filing a petition, even if you had a really good excuse, and even if you were very sorry.
- One of the worst mistakes in this category is messing up a priority claim and failing to catch the mistake until after the passage of the dreaded "4-and-16 date".
- Four months after the Application of Second Filing was filed, and sixteen months after the priority date, whichever is later.
- We tell the new person, please if you are going to screw something up, please pick anything else. Not this. Please pick something else, anything else. Please please please.
- Nonetheless, people screw up things like this all the time. They miss the dreaded 4-and-16 date and only later discover that they made some mistake in a priority claim.
- Wouldn't it be nice if there were something in the PCT system that would protect us from committing malpractice in this area?
- See if you can guess where I am going with this!

Further Reasons to Use That ADS

Failing to use an ADS in that US provisional application means that it will not be available to the DAS system.

If it is not available to the DAS system, then you will fail to receive the validation benefit of the priority claim when entering the priority claim in ePCT.

This means that if you had inadvertently gotten a digit wrong in the priority claim in your PCT application, you risk not discovering your mistake until after the dreaded “4 and 16 date”.

If you only discover your mistake after the dreaded “4 and 16 date” then in most Offices around the world it is too late to fix the priority claim and it is irrevocably lost.

Do You Want to be the Last Practitioner who Touched the PCT File Prior to Irrevocably Losing a Priority Claim?

No I thought not. So let's go through that one again. Let's review the Best Practices:

When you are filing any US patent application that might later serve as a priority application, always use an ADS, so that the application will be available to DAS.

This includes every US provisional patent application that you file.

Make sure that you have established the correct non-inventor applicant or applicants.

Always docket to check later that the application does actually become available to DAS.

Always set up “tracking” in DAS for each such application.

Always obtain a Certificate of Availability from the DAS system for each such application.

Polling Question 1

Polling Question 2

Do You Want to be the Last Practitioner who Touched the PCT File Prior to Irrevocably Losing a Priority Claim?

Continuing our review of the Best Practices:

When you are getting ready to file your PCT application, find out what application or applications you will be claiming priority from.

Look to see who is listed as the applicant or applicants in that priority application or applications. Compare this with who you are planning to list as the applicant or applicants in your to-be-filed PCT application. If clean-up paperwork is needed to make them match, get it done ***before filing the PCT application.***

Do You Want to be the Last Practitioner who Touched the PCT File Prior to Irrevocably Losing a Priority Claim?

Continuing our review of the Best Practices:

When you are getting ready to file your PCT application, you will be preparing a PCT Request.

Do not do this by filling in a fillable PDF form.

Do not do this by using PCT-SAFE.

The only correct way to do this is by using ePCT.

Do You Want to be the Last Practitioner who Touched the PCT File Prior to Irrevocably Losing a Priority Claim?

Continuing our review of the Best Practices...

For each of the applications for which you plan to make a priority claim, check to make sure that you have a Certificate of Availability in the DAS system.

As you enter each priority claim into ePCT, you will be entering the application number, the filing date, and the identity of the OFF into ePCT.

ePCT will ask how you plan to provide a certified copy of the priority application to the IB.

Do You Want to be the Last Practitioner who Touched the PCT File Prior to Irrevocably Losing a Priority Claim?

Continuing our review of the Best Practices:

ePCT will ask how you plan to provide a certified copy of the priority application to the IB.

Here is the important part. You should tell ePCT that you want to retrieve an electronic certified copy from a digital library.

This is geek talk and it means “retrieve it from the DAS system”.

This means that ePCT will cross-check the application number that you entered, and the filing date that you entered, and the identity of the OFF that you entered, against the DAS system, ***in real time and before your very eyes.***

Do You Want to be the Last Practitioner who Touched the PCT File Prior to Irrevocably Losing a Priority Claim?

Continuing our review of the Best Practices...

This means that ePCT will cross-check the application number that you entered, and the filing date that you entered, and the identity of the OFF that you entered, against the DAS system, ***in real time and before your very eyes.***

- Let’s suppose you got a digit wrong in the application number.
- Let’s suppose you entered April 6 when you meant June 4 (you know, a metric month instead of an American month).

ePCT will catch your mistake! You have just been saved from a malpractice lawsuit or worse.

You Have Just Been Saved from a Malpractice Lawsuit or Worse.

By the way what does that even mean “or worse”?

For this cross-checking to save you from the risk of irrevocably losing a priority claim, what Best Practices did you need to follow?

- Making sure your priority application found its way into DAS.
- Using ePCT to create your Request.

Making Sure Your Priority Application Found Its Way into DAS

- Which in turn required using an ADS, not just a Provisional Cover Sheet, if the application you were filing was a US provisional
- Which calls for you to check to make sure the patent office really did make the application available to DAS
- That is, making sure that you can get a Certificate of Availability
- While you are there, you might as well set up “tracking” in DAS

Using ePCT to Create Your Request

- Which means having the self-control not to use a fillable PDF to create your PCT Request
- And which means having the self-control not to use PCT-SAFE to create your PCT Request
- And which means you need to check the box that says you want to retrieve your priority document from a digital library
- Only if you check that box will ePCT cross-check your data entry with the DAS system
- Only if you check that box will ePCT catch it if you entered a digit wrong
- Only if you check that box will ePCT have the opportunity to save you from that category of malpractice lawsuit
- Did I mention that it is a good idea to use ePCT?

SAOSIT

- Is SAOSIT only a thing to get wrong if you are filing a PCT application?
- No.
- You can also get this just as wrong if the application of second filing is an ordinary domestic patent application filed in a second patent office.
- Remembering the CRISPR cases, if The Broad and MIT and Harvard had filed an ordinary EP patent application on December 12, 2013 instead of a PCT application designating EP, they would have faced exactly the same problems and risks as we have discussed here.

Important Next Steps

- Get a copy of Bodenhausen if you do not have a copy already.
- Read it if you have not read it already.
- Go back through all of your previously filed applications that might serve as priority applications, and make sure they are all available to DAS.
- If necessary, do whatever is needed in your patent office to get them made available to DAS. (In the USPTO, this is Form PTO/SB/39.)
- Set up “tracking” in DAS for all of your previously filed applications that might serve as priority applications.
- Obtain a Certificate of Availability for each of your previously filed applications that might serve as a priority application.
- If necessary, take the “DAS Quiz” at *The Ant-Like Persistence* blog.

Important Next Steps

Find out if anybody in your office is using anything other than ePCT to generate PCT Requests.

For example are they using fillable PDF forms? PCT-SAFE?

If so, make them stop. We are talking about malpractice avoidance.

When a priority claim is being entered into ePCT, always check the box that says “retrieve from a digital library” to force ePCT to cross-check the priority claim against DAS. We are talking about malpractice avoidance.

Important Next Steps

Find out if anybody in your office is filing US provisionals and not using an ADS on filing day.

If so, make them stop. We are talking about malpractice avoidance.

Important Next Steps

Find out if anybody in your office is filing a US patent application that might later serve as a priority application, and is not asking around to find out who the applicant would be or who the applicants would be in a later non-US application of second filing. (Maybe it is a PCT or maybe not.)

If so, make them start asking around. We are talking about malpractice avoidance.

The US patent application needs to be filed in a way that establishes a non-inventor applicant or non-inventor applicants to match what will be done later in the non-US application of second filing. A mere provisional cover sheet is not good enough for this.

Important Next Steps: Use ePCT

We have mentioned a couple of reasons to be using ePCT.

It will not surprise you to hear that there are dozens of other good reasons to be using ePCT.

We will be presenting future webinars in which this is discussed in great detail.

Important Next Steps: Subscribe to My Blog and Read All of the Back Articles about PCT

Anybody who is a regular reader of *The Ant-Like Persistence* blog is likely already aware that every point made in today's webinar was previously covered, in many cases twice over, in past articles in my blog.

A chief practice tip is thus to subscribe to my blog.

A related practice tip is thus to read all of the back articles about PCT.

This can also be helpful as a cure for insomnia.

Side Topic: Will PCT Declarations 2 or 3 Somehow Make SAOSIT Problems Go Away?

- Answer: No. PCT Declarations 2 and 3 are important, but nothing about either of these declarations has any chance of making an SAOSIT problem go away if there is one.
- PCT Declaration Number 2 – Entitlement to apply for and be granted a patent. This is the Declaration that you will want to file in any case where the PCT applicant is not the same as the inventors.
- PCT Declaration Number 3 – Entitlement to claim priority. This is the Declaration that you will want to file in any case where the Applicant in the OSF (Office of Section Filing, that is, the PCT) is not the same as the Applicant in the OFF (Office of First Filing, that is, the office where the priority application was filed).
- We will discuss PCT Declarations in great detail in session 11.

What Lies Ahead?

- 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

Now maybe a few questions?

Thank you!

See you at the next session!

