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2022 Virtual PCT Training Seminar

Session 7

E-Filing of the PCT Application and Docketing of PCT Thereafter

Thursday, February 24, 2022

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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.

2/24/2022

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 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)

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Today's Topics

- We will talk about e-filing of the PCT application
- We will talk about the docketing that you do after you file a PCT application

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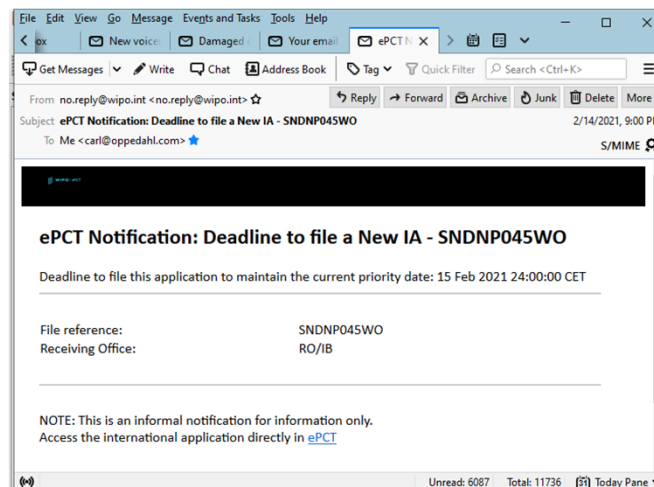*Building Extraordinary IP Assets*

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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The e-Filing Process

- In the old days we would prepare a paper Express Mail package and we would take it to the Post Office

- Two people licked their fingers and flipped through the pages one at a time

- Every page got looked at

- Mistakes got caught

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The e-Filing Process

- These days the e-filing might be carried out by one person, clicking away in isolation

- One hour before midnight in Geneva

- Or one hour before midnight in Alexandria, Virginia

- The last of the client instructions came in only earlier the same day

- Extreme time pressure

- Maybe there is a second pair of eyes, maybe not

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How I Do It

- If I am filing the PCT application in EFS-Web or Patentcenter, *I do not pay the fees!*

- I wait until I have had an opportunity to look closely to see if I screwed up and uploaded the wrong verson of the application from yesterday, or the wrong drawings from another case

- Then if I see that I did not screw it up, I actually pay the fees

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Same-Day Corrections

- If you file in RO/IB using ePCT, there is a "same-day corrections" countdown timer that lets you know how much time is left before midnight in Geneva

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Drawings

- Do not file informal drawings
- Do not use color
- Do not use gray scale

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Previewing in ePCT

- If you are e-filing in RO/IB using ePCT, it will detect color or gray scale and it will let you preview to see how the color or gray scale will get converted
- This is a very nice feature
- Neither EFS-Web nor Patentcenter offers such a feature

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If You Are Filing in RO/US

- A reminder that you need to be uploading a ZIP file Request
- Not a PDF Request
- It is malpractice not to upload a ZIP file

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If You Are Filing in RO/US

- A reminder that your ZIP file needs to come from ePCT
- Not from PCT-SAFE
- It is malpractice not to use ePCT to generate your ZIP file

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If You Are Filing in an RO
That Is Not RO/IB

- A reminder that when you indicate how your priority documents should get from the RO to the IB, do not pick "RO to transmit to IB"

- Pick "IB to retrieve from DAS"

- Only if you make this selection will ePCT cross-check your priority claims with DAS

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Now You Have Filed Your PCT Application

- *Whew!*

- What next?

- Docketing! That is what is next!

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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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Calculating Dates

Often we have to calculate dates

- Priority date plus 30 months (P+30)
- Priority date plus 22 months (P+22)
- Mailing date of International Search Report plus 3 months (ISR+3)
- 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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Technical Preparations for Publication Day at WIPO

Figure out publication day

This is P+18 except that you have to keep counting until you hit a Thursday (or every now and then a Friday)

Then count back 15 days (usually reaching a Wednesday) which is technical preparations day

Then count back one more day (usually reaching a Tuesday)

Now you know the last day to request withdrawal to prevent publication

ePCT will calculate this for you

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Why We Care about Technical Preparations Day?

- Last day to hand in the PCT Declarations
- Last day to request withdrawal to avoid publication
- Last day to make an Article 19 amendment (unless ISR+2 gives you more time)
- Last day to hand in certified copies

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Polling Question

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 and Patentcenter

It lets you see the content and status of your pending PCT applications, just as Private PAIR and Patentcenter let you see the content and status of your pending US applications

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

Does Patentcenter send you warnings of upcoming due dates? No!

ePCT sends you warnings of upcoming due dates!

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

Does Patentcenter maintain a timeline for each application, listing upcoming due dates? No!

ePCT maintains a timeline 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?

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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 and Patentcenter.

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

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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 and Patentcenter.

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 and Patentcenter.

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Polling Question

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

- 10% of the reason for doing this is so that the client will hear these things

- 90% of the reason for doing this is to protect your situation

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 "two-country" docket

- For TZ and LU if you want to postpone a direct national phase filing until 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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Polling Question

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 (page 60 of *PCT Forms*)
- Form PCT/RO/102, which memorializes that proper fees were paid (page 53 of *PCT Forms*)
- Form PCT/IB/301, which memorializes that the International Bureau has received the Record Copy from the RO (page 97 of *PCT Forms*)
- Form PCT/IB/304, which memorializes that the International Bureau has received the certified copy of the priority document (page 99 of *PCT Forms*)
- Form PCT/ISA/202, which memorializes that the International Searching Authority has received the Search Copy (page 132 of *PCT Forms*)

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Docketing PCT

- Docket P+22 (priority date plus 22 months) for filing of a Demand and Article 34 amendment (note that this may change later)
- Docket P+30 for entry into the national phase
- Docket P+19 or tech-prep day for Article 19 amendment (note that this may change later)
- Docket tech-prep day for withdrawal to prevent publication

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Docketing PCT

- After Form PCT/IB/301 arrives, check to make sure that you have access to the PCT application in the ePCT system (page 97 of *PCT Forms*)
- After Form PCT/ISA/202 arrives, docket three months to check for receipt of the International Search Report and the Written Opinion (ISR/WO) (or P+9 if later, depending upon which ISA the applicant selected) (page 132 of *PCT Forms*)

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Note That ePCT Will Also Calculate All These Same Dates

Look in the ePCT "timeline"

You can cross-check the dates from the ePCT timeline 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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What Lies Ahead?

· 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

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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

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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

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Now maybe a few questions?

Thank you!

See you at the next session!

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