

2022 Virtual PCT Training Seminar

# Session 8

What to Do When the International Search Report and Written Opinion Arrives, Do You File a Demand?

**Monday, February 28, 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

- What to do when the ISR/WO arrives
- Decisions to make
- We will talk about the docketing that you do after the ISR/WO arrives

## How We Got Here

- The RO transmitted the Search Copy to the ISA
- The RO transmitted the Search Fee to the ISA
- The ISA mailed the Form PCT/ISA/202 to you
- You already had a docket set to check for arrival of the ISR/WO

## The PCT Application Was Already in Your ePCT Workbench

If you are in a law firm, of course you had already extended ePCT access to:

- Your client contact people
- The inventors
- Many people within your firm
- Everybody in your docket department

## Now the ISR/WO Arrives

Is it fully favorable? Do all claims have a “yes” for all three questions?

- Maybe your client has given standing instructions to enter national phase and get onto the Patent Prosecution Highway before the sun sets
- If so, then carry out those steps

## Form Numbers

- The ISR is Form PCT/ISA/210 (*PCT Forms* book page 149)
- The WO is Form PCT/ISA/237 (*PCT Forms* book page 168)

## Now the ISR/WO Arrives

Then we get to clear the docket to check for arrival of the ISR/WO

What? We had not previously set a docket to check for arrival of the ISR/WO?

Then time to ***Call a Meeting.***

## Calling a Meeting

- (PCT Forms book, page 15)
- This is where several people sit around a conference table and look at each other
- How did this get missed?
- How many other files are missing this docket?

## When Was the ISR/RO Mailed?

- The docket dates flow from the *date of mailing* of the ISR/WO
- Things don't get mailed anymore
- How do you know what is the date of mailing?
- This is communicated in Form PCT/ISA/220 (*PCT Forms* book page 155)

## The ISR/WO Arrived

- This may mean that the due date for filing a Demand has changed
- Previously it was P+22
- Maybe now it is ISR+3

## The ISR/WO Arrived

- This may mean that the due date for filing an Article 19 Amendment has changed
- Previously it was P+16
- Maybe now it is ISR+2

## The ISR/WO Arrived

- Time to capture copies of the cited references
- If it is ISA/KR, download them from the ephemeral web page



## The ISR

- It might have X references or Y references or A or others
- People assume that X means “lack of novelty” like “Section 102” and that Y means “obvious” like “Section 103”
- That’s not right. X means “the reference by itself renders a claim unpatentable” and Y means “the reference when combined with something else renders a claim unpatentable”

## The ISR/WO Arrived

- Our standard practice is to file an ADS to begin US national-phase entry, and then prepare and file an IDS disclosing the references from the ISR/WO
- Also disclosing the ISR and the WO
- We try to do this before the sun sets
- This saves us having to docket to check for remembering to file the IDS

## The ISR/WO Arrived

- Client needs to be told that the ISR/WO arrived
- Presumably the client already knows because the client already had eViewer access in ePCT
- Thus the client received a Notification from ePCT

## The ISR/WO Arrived

Strategic decisions for client

- File Article 19 amendment?
- File a Demand?
- File Informal Comments to the IB?
- Enter national phase and get on the Patent Prosecution Highway?
- Withdraw application to prevent publication?

## File Article 19 Amendment?

- This does not incur any fee
- (Client already paid for this in the international filing fee.)
- Enormous advantage is that it covers all designations free of charge
- Local counsel in national-phase cases will not have an opportunity to gouge you with professional fees to enter this amendment
- But you should only use this approach if you are quite confident that the changes, whatever they are, make sense in every Designated Office
- Many practitioners use this approach only for simple unequivocal changes where there is no question the change needs to be made
- Some piece of prior art got uncovered in the ISR and it is absolutely clear that some very straightforward amendment is exactly the right way to overcome the prior art no matter what country you are in
- Some word got misspelled and it is quite clear that we need to correct the spelling no matter what country we are talking about
- The IB does not check for new matter
- But you may be quite sure that in any national-phase entry, the examiner will check for new matter.

## File Informal Comments to the IB?

- This might be for the inventor who is absolutely sure the ISA got something completely wrong, and the inventor wants to put in his or her side of the story, but the inventor does not want to pay the money that would be required to prepare and file a Demand
- This probably also means the inventor does not want to pay the practitioner to carefully analyse the situation in detail to see if the practitioner agrees with the inventor
- The inventor might be mistaken
- How can you be so sure that there is some single argument that is exactly the right thing to say, that will make sense in every Designated Office?
- How can you be so sure that this argument will not come back to haunt you later?
- It is pretty rare that applicants file Informal Comments to the IB

## Withdraw Application to Prevent Publication?

- Sometimes the client decides to withdraw the PCT application so as to prevent publication
- If you decide to do such a withdrawal, the smart thing is to use language saying that your request for withdrawal is contingent upon the request turning out to be timely enough to make it possible to prevent publication
- What you would not want is the worst of both worlds:
  - Ending up with an irrevocably withdrawn PCT application, and
  - Despite this, having the PCT application get published anyway
- There is an ePCT “action” that contains such protective language

## How to Screw This Up?

- A typical way that a practitioner screws up a withdrawal request is by filing it in some Office that is not the IB
- For example they file it at their very familiar local Receiving Office
- Then the RO takes its own sweet time forwarding the withdrawal request to the Office where it should have been filed in the first place (the IB)
- Maybe by the time the withdrawal request eventually reaches the IB, it is too late to prevent publication

## 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 ISR/WO, there is much to be said for entering national phase immediately and getting onto the Patent Prosecution Highway

## Was the Favorable ISR/WO from ISA/EP?

- If the favorable ISR/WO was from ISA/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 ISR/WO from ISA/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

## 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

## 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

## Maybe That First Communication from the ISA Was Not an ISR/WO At All!

- Maybe that first communication was an Invitation to Pay Additional Fees
- Maybe that first communication was an Invitation to Furnish Sequence Listing
- Maybe that first communication was a Declaration of Non-Establishment
- Maybe it was an Invitation to Request Rectification

## Invitation to Pay Additional Fees

- Form PCT/ISA/206 (*PCT Forms* book page 140)
- 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 ISA
- How to pay? For ISA/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



## Should You Protest?

- Is it worthwhile protesting the finding of a lack of unity of invention?
- Most practitioners consider it a waste of time
- You have to pay the additional search fees anyway if you protest
- You get them back if you win the protest
- Every now and then I encounter a practitioner who says they protested and they think it turned out to be a smart thing to do

## What If You Decline the Invitation?

- Then the ISA will search only one invention
- Some ISAs will let you choose
- Most will not let you choose, and instead they will examine only the invention that includes claim 1
- You can still pursue the other inventions in the national phase, but you won't find out whether they are patentable until much later after you have spent enormous sums of money filing divisional applications

## Declaration of Non-Establishment

Form PCT/ISA/203 (*PCT Forms* book page 134)

- This might be because you claimed subject matter in some area that your ISA refuses to search and examine
- Or the ISA says your claims are incomprehensible
- Or you failed to provide a proper sequence listing
- Or you did not pay all of the search fees that you were invited to pay
- This does not mean the PCT application is deemed withdrawn
- You can still pursue the subject matter in the national phase

## Invitation to Furnish Sequence Listing

Form PCT/ISA/225 (*PCT Forms* book page 157)

- This might be a very serious matter
- It might be impossible to respond without adding new matter
- Maybe if you are very lucky, the only problem is some minor defect in a sequence listing originally provided
- You may need to pay a Late Furnishing Fee

## Late Furnishing Fee

- ISA/US – USD 320
- ISA/EP – EUR 240 (about \$271)
- ISA/XV – EUR 230 (about \$260)
- ISA/PH – USD 250
- ISA/FI – EUR 200 (about \$226)
- ISA/IL – ILS 467 (about \$148)
- ISA/KR – KRW 112500 (about \$94)
- ISA/IN – INR 4000 (about \$53)
- ISA/RU – RUB 4000 (about \$49)
- ISA/BR – BRL 180 (about \$35)
- ISA/CN – CNY 200 (about \$31)
- ISA/TR – TRY 200 (about \$14)
- ISA/EG – EGP 200 (about \$12)
- ISA/CL – zero
- ISA/UA – zero

## Invitation to Request Rectification

Form PCT/ISA/216 (PCT Forms book page 151)

- This means that the ISA thinks maybe you really made some kind of big mistake
- If you receive this, it is time to ***Call a Meeting***
- This is a ***Very Serious Matter***
- The ISA will give a hint as to who they think might be the correct Office to grant your Request for Rectification (RO, ISA, IB)

## Other Things That the ISA Does

- Sometimes the ISA will decide that your title is no good
- If so, they will rewrite your title
- If this happens, tough

## Request Supplementary International Search?

- Due date is P+22
- There is an ePCT “action” for this
- You can only get this for claims that were searched by the ISA
- Many SISAs let you pick and choose what you want them to search, for example:
  - Turkish Patent and Trademark Office – one option is a search only of documents in Turkish held in the search collection of the Authority
  - Nordic Patent Institute – one option is a search only of documentation in Danish, Icelandic, Norwegian and Swedish
  - Visegrad Patent Institute – one option is a search only of documentation in Czech, Hungarian, Polish and Slovak
- SISs are only rarely requested

## The SISAs

- AT
- EP
- FI
- RU
- SE
- SG
- TR
- UA
- XN
- XV

## Communicating with ISAs

- The following ISAs permit document uploads through ePCT:
  - ISA/AT, ISA/AU, ISA/BR, ISA/CL, ISA/EG, ISA/EP, ISA/FI, ISA/IN, ISA/KR, ISA/PH, ISA/RU, ISA/SE, ISA/SG, ISA/TR, ISA/UA, ISA/XN, ISA/XV

# Polling Question

## Communicating with ISAs

- The following ISAs permit you to send electronic messages to them through ePCT:
  - ISA/AT, ISA/BR, ISA/CL, ISA/EG, ISA/IN, ISA/PH, ISA/TR, ISA/UA, ISA/XN, ISA/XV

# Polling Question

## What Lies Ahead?

- 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!