

2022 Virtual PCT Training Seminar

Session 9

Using ePCT for "Actions", 92bis Requests,
Communicating with ISAs

Wednesday, March 2, 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.

 **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.



3



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



4



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

- We will talk about ePCT “actions”
- One example is 92*bis* change requests
- The general category is sometimes called SFDs (subsequently filed documents) or follow-on submissions

Examples of Things You Can Do with Your Pending PCT Application in ePCT

- Action - Upload documents
- Action - Amendments under Article 19 (text format only)
- Action – Create power of attorney
- Action - Declarations under Rule 4.17
- Action - Licensing availability request
- Action - Make international application available to DAS
- Action - Observations on close prior art
- Action - Obtain priority document from DAS
- Action – Online Payment at RO/IB (post-filing)
- Action – Prepare and submit indications relating to biological material (RO/134)
- Action - Request for early publication
- Action - Rule 92*bis* change request
- Action - Submit Chapter II Demand
- Action – Withdraw Chapter II Demand
- Action – Withdraw designations
- Action – Withdraw election(s)
- Action – Withdraw International Application
- Action – Withdraw priority claim(s)
- Action - IA in RO phase

Licensing Availability Request

- Yes you can indicate that the invention is available for licensing
- This indication, if made, is searchable in Patentscope
- I am not aware of anyone who has obtained licensing revenue as a result of having made such an indication
- Consider how this may eviscerate any later attempt to get injunctive relief

Make International Application Available to DAS

- This action makes sense only if the RO for this application happens to have been RO/IB
- This works because RO/IB is a Depositing Office in the DAS system
- If the RO was not RO/IB, then this request needs to be made to that RO
- You do this because there is some chance you might want to claim priority from this PCT application
- Maybe in some country that is not a PCT member country
- Or maybe in some country where the applicant is not planning to use national-phase entry
- Or maybe in some country in which national-phase entry is not possible

Obtain Priority Document from DAS

- Sometimes this comes up because you added a priority claim after filing day (but before the 4-and-16 date)
- Now you want to retrieve the electronic certified copy from DAS
- This offers the validation benefit that protects you from malpractice regarding a mistyped digit in the priority claim

Obtain Priority Document from DAS

- Sometimes this comes up because a priority application was not available in DAS on filing day
- But since then it has become available in DAS
- Now you want to retrieve the electronic certified copy from DAS
- This offers the validation benefit that protects you from malpractice regarding a mistyped digit in the priority claim

Request for Early Publication

- Sometimes the client wants this because there is a chance that the earlier publication might make more trouble for competitors' newly filed patent applications
- It may require paying a fee (CHF 200)

Rule 92*bis* Change Request

- Much less expensive than paying local counsel around the world to do the same things
- Must be submitted before the end of the 30 months

How to Screw This Up

- The usual way to screw this up is to file it with a Receiving Office
- The Receiving Office then might take its own sweet time forwarding the 92*bis* request to the IB
- By then the 30 months may have expired and then it is too late

When Filing a 92*bis*, Plan Ahead

- Filing a 92*bis* request often results in everybody losing access to the PCT application in ePCT
- This can be very disruptive
- Plan ahead and if you have several other things to do for this application in ePCT, do them first and do this last

Submit Chapter II Demand

- You get credit for what time it is at WIPO even if that is later than the time at your IPEA
- It pre-populates your Demand form based upon bibliographic data from your PCT Request
- It carries out validations and catches some malpractice mistakes in the Demand process

Withdraw International Application

- If you are going to file such a Request to Withdraw, this “action” is the Best Practice
- Better than a PDF “letter” request
- The “action” contains the “magic words” making it contingent upon successfully preventing publication

Withdraw Priority Claim(s)

- Who would ever do such a thing?
- Yes sometimes people actually do this!
- If you do this, the IB will recalculate the remaining dates in your PCT timeline that have not yet passed
- Some people do this to stretch out their 30 months
- I have to imagine that this is almost never a good idea

Upload Documents

Some things do not fit into an “action”

For this the “upload documents” may be your best way to proceed

An example is some Article 19 amendments (for example with math equations or chemistry structures)

Upload Documents

Uploading to an ISA

Responding to an invitation to furnish a sequence listing

Responding to an invitation to request rectification of an obvious error

Sending an ePCT Message

- In any pending PCT application you can always send an ePCT message to the IB
- Depending on which ISA is your ISA, you may be able to send an ePCT message to your ISA
- Depending on which IPEA is your IPEA, you may be able to send an ePCT message to your IPEA

Reviewing Fees That You Have Paid

- In ePCT, you can review the fees that you have paid to the IB

Obtaining Your IASR, Front-Page Review

- With ePCT you can obtain a current version of your International Application Status Report
- If the case has not yet been published, you can get your front-page preview

Modify Access Rights

- Add access rights
- Delete access rights
- Modify access rights
- View access rights
- See history of access rights

Timeline

- View time line for this pending application
- Visual timeline
- Character-based narrative timeline (suitable for copying and pasting)

Application History

- See all kinds of internal history and audit trail information
- Who did what

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?

Now Some Live Demo?

Thank you!

See you at the next session!

