Best Practice for Patent Cooperation Treaty Filings, Part 2

Presented by
Michael Neas
Carl Oppedahl, Esq.

LI12
3:00 PM
Why we use PCT-SAFE and ePCT

Intellectual Property Conference
for Legal Management Professionals
September 27, 2018

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WIPO consultant
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Why we use PCT-SAFE and ePCT

ePCT offers functions like EFS-Web
ePCT offers functions like Private PAIR
Many ways to commit malpractice

- And many ways to be embarrassed in front of the client
- Argentina problem
- Picking an ISA that makes no sense
- Picking an RO that makes no sense
- Getting a priority claim wrong

Legacy practice – fillable PDF

- This is not a Best Practice
PCT-SAFE

- PCT-SAFE validates lots of things

Consequences of defective or missing priority claim

- Complete loss of priority claim
- Often this means loss of all patent rights
- Must be corrected within 4-and-16 time limit
- PCT-SAFE validates lots of things, but …
- PCT-SAFE does not validate everything that might be wrong in a priority claim
ePCT validates priority claims

- ePCT looks up priority claims in DAS
- This works only if the priority application is already in DAS
- This means you should make sure that every application that is a potential priority application should be in DAS
- You should obtain a Certificate of Availability for each such potential priority application

E-filing with ZIP files

This is a Best Practice
Attach zip file
The rest of the workflow is familiar EFS-Web workflow
- attach all of the usual files – specification, claims, abstract, drawings
- pay fees through EFS-Web as usual...

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This is the application data associated with your filing. If any information is missing, please provide it.

<table>
<thead>
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<th>Title of Invention</th>
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<td>Applicant Name</td>
<td>The Chocolate Factory</td>
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<tr>
<td>Customer Number</td>
<td>57380</td>
</tr>
<tr>
<td>Correspondence Address</td>
<td>Oppenhal Patent Law Firm LLC 12000 Pecos Street #252 Westminster CO 80234 US +1 303 252 8800</td>
</tr>
<tr>
<td>Filed By</td>
<td>Carl Oppedahl</td>
</tr>
<tr>
<td>Attorney Docket Number</td>
<td>WONKA-P-001</td>
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</table>
| Application Type   | International Application (PCT) for filing in the US receiving...

Are you attaching a PCT-EASY zip file?  ● Yes  ○ No

Files to be Submitted

Browse... No file selected.

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When attaching a PCT-EASY Zip file, you must also attach your application parts (Specification, Claims, Abstract, Drawings).

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E-filing in RO/US

- Click “yes” you are attaching a PCT-EASY zip file
- Upload the ZIP file
- Upload the other application parts (specification, claims, abstract, drawings)
How cases get into Private PAIR?

What exactly is it that we do so that a newly filed US case will be visible in Private PAIR?
Are you trendy, modern, and up-to-date?

If you don’t yet have access to “private” ePCT, you will have to skip the next step.

Now go to “private” ePCT and get an eOwnership code

Click “eOwnership” and “request code” ...

Copy/Paste your Customer ID and eOwnership Code to the fields on the e-filing software signature screen.

NOTE This eOwnership Code can only be used at the time of filing, for one application and is not required when using ePCT-Filing.

Customer ID: user_US_OPPEDAHL_CARL_2526
eOwnership Code: TF4H9GCYQZMWX0
Copy and paste the ePCT codes into the signature window

Apply alphanumeric signature containing both name and registration number

Click “Apply Signature”

Using ePCT like we use Private PAIR

This permits us to check file status and contents
Generating useful reports from ePCT

- Applications with priority documents outstanding
- Applications with Form PCT/ISA/202 outstanding

Applications with Form PCT/ISA/202 outstanding

- Open ePCT and go to the Workbench
- Click “show filter” and expand “status”
- Pick “receipt of search copy at ISA confirmed to the IB” as “no” and click “apply filter”
- This will identify your PCT applications that are missing the Form PCT/ISA/202
- Depending on client needs and priorities, you may wish to follow up on such applications
Applications with priority documents outstanding

- Open ePCT and go to the Workbench
- Click “show filter” and expand “documents”
- Pick “with outstanding priority documents” and click “apply filter”
- This will identify your PCT applications that have outstanding priority documents
- It is important to follow up on such applications

Applications with priority documents outstanding

- Note that ePCT will (by default) send you an email reminder if an international application has a priority document outstanding
Fixing Mistakes and Best Practices: International and U.S. National Phase Applications

Michael A. Neas
Deputy Director
International Patent Legal Administration
**No Request form**

- An international application was filed with the RO/US via EFS-Web without a Request form
- Can this mistake be fixed?
  - Where there is no indication as to the nationality or residency of the applicants
    - The USPTO will treat the submission as an international application, but will transmit it to RO/IB under Rule 19.4(a)(i)
  - The EFS-Web software now provides a reminder to attach a Request form when filing a new international application
    - WARNING: New PCT applications filed in the US Receiving office should include an RO/101 request form. If the submission is meant to be a filing for entry into the US National Stage under 35 USC 371, you have incorrectly selected the type of application you are intending to file. Please go back and select the radio button corresponding to US National Stage under 35 USC 371 under the heading Utility

**Multiple Request forms**

- If filing PCT Safe or ePCT .zip file in EFS-Web
  - Do NOT upload a .pdf Request form
  - .pdf version will be automatically extracted from the .zip file
- Signature missing on the Request in the .zip file
  - Upload the page containing a signature in Box X of the Request as substitute sheet of the Request
    - Post initial submission use document description - Substitute Sheets of Request (Form PCT/RO/101)
- Multiple Requests that are not identical
  - RO/US will generally treat as cumulative
  - Changes will require correction under relevant regulations, Rules 26bis, 92bis, etc.
Missing parts/elements tips (1)

• Avoid omission of documents
  – Review documents prior to submission
    • Recent increase in applications filed with missing elements/parts
      – Use the “Review Documents” and “Save for Later Submission” functions in EFS-Web

Missing parts/elements tips (2)
Missing parts/elements tips (3)

- Check for completeness/accuracy promptly after filing
  - Via Electronic Acknowledgement Receipt and Private PAIR
  - Application can be supplemented on the day of filing without adjustment to the IFD
- Only have two months from filing to confirm an incorporation by reference of a missing part/element where the RO does not issue an invitation
  - PCT Rule 20.6
- Respond to Form PCT/RO/107 by confirmation of incorporation by reference
  - Simply providing missing part will change the IFD

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ALA IP Conference

Missing parts/elements tips (4)

Check files and page count
Also check PAIR to verify the correct document was submitted
Missing parts/elements tips (5)

- Confirmation of incorporation by reference
  - Don’t supply sheets embodying parts not contained in the earlier application
    - Replacement of informal drawings with formal drawings may be a problem
      - Not a “new matter” standard

Filed wrong parts of the IA

- Wrong description and/or claims was attached to an international application filed with the RO/US via EFS-Web
- Can this mistake be fixed?
  - Use of the current version of the PCT Request form
    - Allows confirmation of the incorporation by reference of the missing parts, provided those parts are contained in an application to which priority is claimed
      - Not all designated Offices will recognize incorporation of a description and claims where an erroneous set was originally filed
    - However, there is no simple means for removing the incorrect description and/or claims
Appendices

• There is no provision for appendices in international applications
  – A computer program listing or table must be submitted and paid for as part of the description
  – Unlike the provisions of 37 CFR 1.52(e) for U.S. national applications
  – RO will request clarification from applicant if unclear whether appendix is to be treated as part of the description
    • If part of the description, it will need to be renumbered
    • If not part of the description, will not form part of the IA

Formal drawings

• Providing drawings compliant with Rule 11 on filing avoids hassles later
  – Invitation from RO to correct (Form PCT/RO/106)
    • Correction may require approval from ISA under Rule 91
    • No amendment to drawings in Chapter I
    • May need to wait for Chapter II or national phase in order to amend
  – Prevents national/regional Offices from requiring new drawings based on form
    • PCT Art. 27 – No national law shall require compliance with requirements relating to the form or contents of the international application different or in addition to those which are provided for in this Treaty and the Regulations.
**Unintended duplicate filing of an international application in EFS-Web**

- Withdrawal of the international application must be signed by all applicants
  - Where withdrawal is signed by an agent, POA is required from every applicant
    - Which includes those designated as “applicant and inventor”

**Use of customer numbers in international applications**

- Customer number cannot be used in an international application to
  - appoint/withdraw agents
  - establish/change correspondence address
- Customer number associated with an international application
  - is only for access in Private PAIR
  - can be changed with Form PTO-2248
Do NOT Use This Form in International Applications

Do Not Use EFS-Web as a Testing Ground

- Use the “sandbox”
- Please do not file test cases
  - Someone has to review these
  - Someone on this panel has done it!
Request MUST Indicate a Sequence Listing (SL) 
Forms Part of an International Application (IA)

- Failure to identify the SL as part of the IA in the Request
  - May result in a fatally-defective National Stage application
  - Where sequences are not otherwise sufficiently disclosed in the IA
  - Even if the SL was provided on the international filing date (IFD)
- Incorporation by reference (as in a regular U.S. application) is NOT sufficient
  - If present, some national/regional Offices may require removal
- Request – Box IX
  - Check List indicates items that form part of the IA
  - Accompanying Items do NOT form part of the IA

Request – Box IX – PCT SAFE

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Parts of the IA

Accompanying items NOT part of the IA
Instructions for Completion of the Request To Indicate That SL Forms Part of IA

- Available on the International Patent Legal Administration home page at:
  www.uspto.gov/go/pct
National Stage Application Contents

- A U.S. national stage application ("371") continues the prosecution of the IA
  - Contents of the IA determines contents of the 371
- Simply filing a SL on the date of first submission of the 371 DOES NOT make it part of the application
  - Unless the SL was already part of the IA
    - If filed, should be accompanied by a letter explaining its status, e.g., “The sequence listing submitted herewith is identical to the sequence listing forming part of the international application.”
  - A SL that was not part of the IA MUST be accompanied by a preliminary amendment to enter it into the 371
    - E.g., SL in text format submitted to the ISA/US in response to PCT/ISA/225
    - See next slide

Preliminary Amendment to Enter a Text Format SL into a 371 Application

- SL in text format only, filed via EFS-Web upon 371 entry
  - Can serve both as part of the application and as the CRF
    - Is excluded when determining the application size fee
- If not part of the IA, MUST file a preliminary amendment, including
  - A statement that SL in text format does not introduce new matter to the IA as of its IFD
  - An indication of support for the amendment in the 371 application
  - An incorporation by reference
    - A separate paragraph added the SPEC that identifies the
      - Name of the file
      - Date of creation
      - Size of the file in bytes
    - As specified in MPEP 502.05 and the Legal Framework for EFS-Web

National stage entry error

• A typographical error in the international application number was made on the national stage entry papers or EFS-Web screen
• Can this mistake be corrected?
  – If the correct number appears somewhere in the original submission, applicant may correct this error by filing a petition under 37 CFR 1.182
  – If the correct number does not appear anywhere, applicant may have to file a petition to revive the international application

Questions?

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Michael.Neas@uspto.gov
PCT Help Desk
(571) 272-4300
Monday – Friday 8:30am – 5:00pm ET
Your opinion matters!
Please take a moment now to complete the evaluation.

Thank You!