

2025 PCT Training Seminar

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Planning for PCT and Paris, Article 4 of Paris,
Making Use of WIPO DAS, the DOCX problem

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Disclaimer

This is not legal advice. Reading these slides or attending this seminar 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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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?

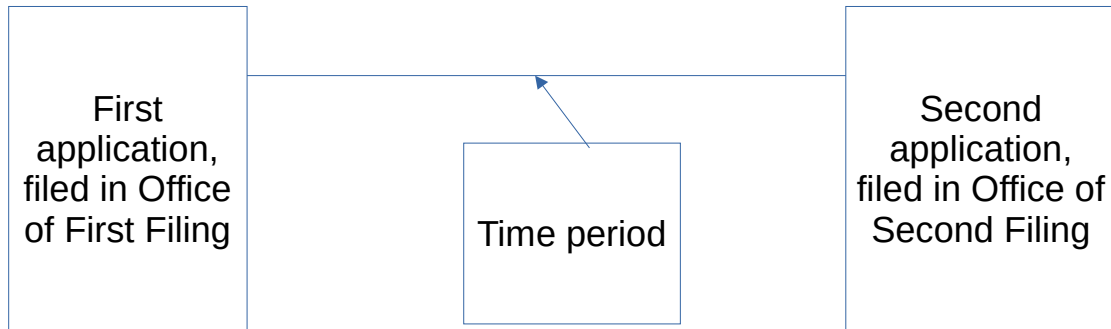
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Bodenhausen's book

- Before WIPO, there was BIRPI
- Bodenhausen 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

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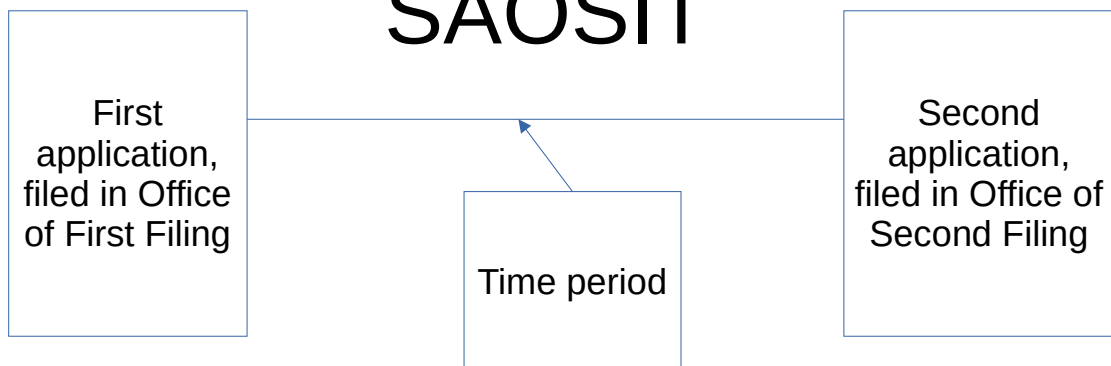
Priority applications



- 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***”

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SAOSIT



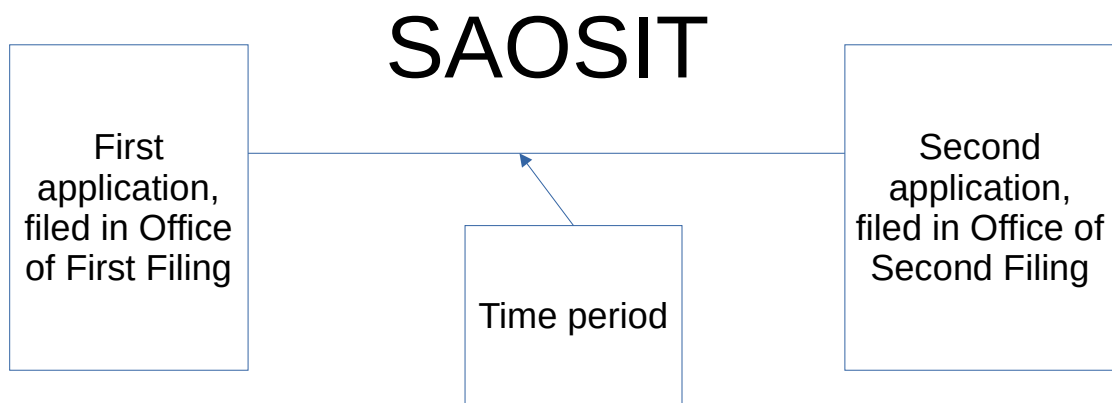
Any ***person who has duly filed an application*** for a patent, or for the registration of a utility model, or of an industrial design, or of a trademark, in one of the countries of the Union, ***or his successor in title***, shall enjoy, for the purpose of filing in the other countries, a right of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

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Is SAOSIT an acronym?

- No. It is a mere initialism.

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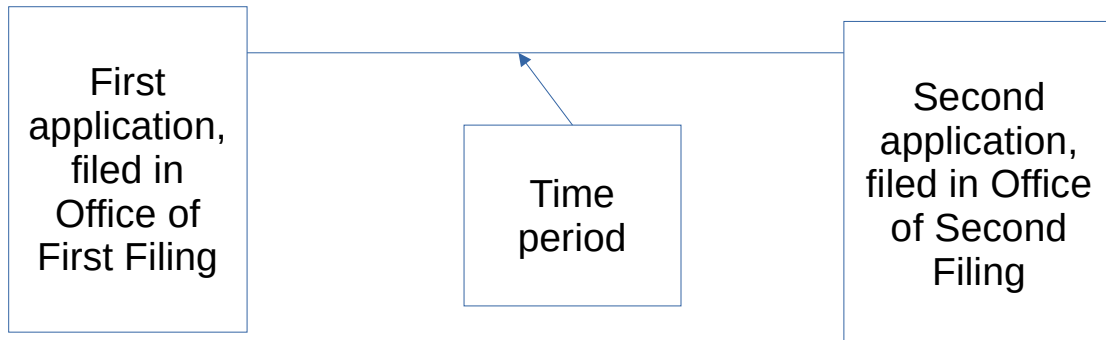


The Office of Second Filing may say that the applicant in the second application is required to be the same applicant as the applicant in the first application.

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

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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).

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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.
- UK and Japan are among the Offices that are quite strict about SAOSIT.

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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.

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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!

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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.

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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.

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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 cleanup paperwork is needed to make them match, get it done ***before filing the PCT application***.

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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.

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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.

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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.***

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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.

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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.

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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

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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?

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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.

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The DOCX problem

- DOCX is risky. PDF is safe.
- USPTO wants to penalize you \$430 (or \$172 or \$86) if you want to preserve the safety of PDF filing for US patent applications.

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What a USPTO person admits

- A recent email from an SPE:
 - The interview date and time of X-XX-2024 X:XX PM ET is accepted. If there are additional topics or details for discussion other than those provided in the AIR request please send an agenda with a brief summary of topics/arguments intended to be discussed and/or proposed claim amendments (if any) by replying to this email at least 24 hours prior to the interview so that I may prepare. ***If the agenda is an attachment, please attach the agenda in PDF format (differences in software versions of Word, Word Perfect, Apache Writer, doc, docx, etc. can cause formatting such as underline and strikethrough to be removed from the text).***
- (Emphasis added.)

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Does “auxiliary PDF” really make the malpractice risks go away?

- No it does not. On February 7, 2024 Mark Polutta called to say he would soon be answering a January 24, 2024 letter about the supposed “safeguard” of aux-PDF. (See download)
- Mr. Polutta has not answered that letter

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You can file a PCT application in PDF and this will not incur the \$430 penalty

- That's right. You can file a PCT application in RO/US (through Patent Center) and you will not get dinged with the \$430 non-DOCX penalty.
- And you can file a PCT application in RO/IB (through ePCT) and you will not get dinged with the \$430 non-DOCX penalty.

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You can enter the US national phase from a PCT and this will not incur the \$430 penalty

- Note that you need not even provide specification, claims, abstract or drawings at all when entering the US national phase
- This means you need not provide them in DOCX
- The specification, claims, abstract and drawings reach the DO/EO/US in an automatic way from the IB

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You can enter the US national phase from a PCT and this will not incur the \$430 penalty

- If you do feel you cannot hold back from provide specification, claims, abstract or drawings when entering the US national phase, you can hand them in as PDF and this will not incur the \$430 penalty
- It is not a Best Practice to provide specification, claims, abstract or drawings at all when entering the US national phase, but if you do it anyway, it will at least not incur the \$430 penalty

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You can enter the US national phase from a PCT and this will not incur the \$400 penalty

- Yes if the PCT was not published in English, you will need to provide a translation into English. This is not the same thing as “filing a patent application” and it will not incur the \$430 penalty
- Yes you may find it necessary to file a Preliminary Amendment (for example to amend the claims), but this is not the same thing as “filing a patent application” and it will not incur the \$430 penalty

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Yet another factor in a decision whether to use national-phase or bypass continuation

- If you pick national-phase, you avoid the \$430 non-DOCX penalty
- And you have the complete safety of filing in PDF
- If you pick bypass continuation, to be safe you need to file in PDF
- This incurs the \$430 non-DOCX penalty

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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.

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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.

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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.

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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.

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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.

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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.

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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.

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Upcoming webinars

- 3 - Monday, December 1, 2025
Selecting a Receiving Office, RO/US versus RO/IB
- 4 - Tuesday, December 2, 2025
Selecting an International Searching Authority
- 5 - Wednesday, December 3, 2025
Preparing a PCT Request – Making use of ePCT and getting benefit of validations, avoiding malpractice on priority claim mistakes
- 6 - Wednesday, December 10, 2025
Using workplace collaboration features of ePCT as you lead up to the PCT Filing, shared address book, external signatures, document reviews

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Upcoming webinars

- 7 - Thursday, December 11, 2025
E-Filing of the PCT Application and docketing of PCT thereafter
- 8 - Friday, December 12, 2025
What to do when the International Search Report and Written Opinion arrive, do you file a Demand?
- 9 - Monday, December 15, 2025
Using ePCT for “actions” such as 92bis requests, communicating with ISAs
- 10 - Tuesday, December 16, 2025
Mechanics of filing a Demand, steps before and after filing the Demand
- 11 - Wednesday, December 17, 2025
Understanding and using the five kinds of PCT declarations

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Upcoming webinars

- 12 - Thursday, December 18, 2025
National-phase entry generally – tips for some Offices
- 13 - Friday, December 19, 2025
Choosing between US national-phase entry and bypass continuation
- 14 - Monday, December 22, 2025
Best practices and procedure for US national-phase entry
- 15 - Tuesday, December 23, 2025
Making use of PCT-PPH, and comparison with Track I

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Thank you!