TWENTY-ONE PATENT PRACTITIONERS

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February 7, 2020

To the United States Patent and Trademark Office:

This comment letter responds to a Notice of Proposed Rulemaking entitled *Facilitating the Use of WIPO's ePCT System To Prepare International Applications for Filing With the United States Receiving Office*, 85 FR 5362, January 30, 2020.

The twenty-one signers of this comment letter are patent practitioners belonging to the Patent Cooperation Treaty Listserv (see https://oppedahl-lists.com/mailman/listinfo/pct_oppedahl-lists.com), an online community of users of the Patent Cooperation Treaty. The signers of this comment letter have between them filed more than 1500 international patent applications (PCT patent applications) in the past ten years, and have between them entered the US national phase from a PCT patent application more than 2000 times in the past ten years, and have between them paid more than $15 million in fees to the United States Patent and Trademark Office in the past ten years.

In brief, this comment letter supports the proposed rule change. More detailed comments follow.

By way of background, it is of course a shared goal for applicants and patent offices that bibliographic data (for example inventor information, applicant information, priority information, and application title) be accurately entered into Office systems. This goal is best served if the applicant is able to provide the bibliographic data to the Office in a computer-readable format and if the bibliographic data can then auto-load into the Office systems. This goal is also well served if updates and revisions from the applicant can likewise be auto-loaded into the Office systems. Offices differ from one to the next in the extent to which they provide user-friendly ways to accomplish such bibliographic data submissions and updates and revisions.

To give a particular example, the system for carrying out updates of bibliographic data for PCT applications (called the 92*bis* "action" in the ePCT system) is very user-friendly. By comparison the USPTO system for updates of bibliographic data (submission of PDF application data sheets) is not as user-friendly, and the signers of this comment letter urge the USPTO to follow WIPO's example by developing a system more nearly like the 92*bis* "action" in the ePCT system.

It is a further shared goal for applicants and patent offices that bibliographic data be given the benefit of validations carried out prior to the submission of the bibliographic data to an Office. Such validations have the prospect of saving work for Office personnel who might otherwise have to carry out corrective steps that do not generate fees for the Office. Such validations have the prospect of

reducing how often an applicant loses substantive rights, in some cases irretrievably, due to errors or omissions in the submission process. And such validations have the prospect of reducing how often a patent practitioner makes an error that is embarrassing or even leads to professional liability.

One category of error that arises regrettably often in the filing of PCT patent applications is inaccuracy in the presentation of a priority claim. The inaccuracy, if not detected and corrected by the "4-and-16 date" (four months from the date of filing of the PCT application, or sixteen months from the would-be priority date, whichever is later), can in many Designated Offices lead to irretrievable loss of the priority claim. It would of course be very desirable if there were some way in which the validation of bibliographic data (including priority claims) could include the detection of an inaccurately recited priority claim. Such validation is, however, typically taking place prior to the one-year anniversary of the priority filing date, and this is at a time when the priority application itself is probably not a matter of public record. It is thus not an easy matter to devise software that would carry out a detection of an inaccurately recited priority claim in a way that draws upon original source data at the one or more Offices where a priority application might have been filed. One can of course attempt to detect errors by means of intermediate data stores such as docket software or personal notes, but any such intermediate data store is only as accurate as the human data-entry steps that gave rise to the data store. It would be very desirable if such a validation could draw upon original Office source data.

WIPO made such validation possible by developing and making available two linked systems — DAS (Digital Access Service) and ePCT. The filer who files a patent application that has the chance of later being a priority application can make that application available to the DAS system. This can be done within days of the filing of the would-be priority application, and in particular can be accomplished well in advance of the one-year anniversary thereof. The filer can add the patent application to the filer's "workbench" in the DAS system, and can set up an "alert" so that the filer will learn of any Office retrieving an electronic certified copy of the application. The filer can obtain a so-called Certificate of Availability from the DAS system which certifies that the application is available to Offices (including the International Bureau of WIPO) through that system.

In the case of a PCT application, the name that is given to the document that provides the bibliographic data to the patent office is "Request". The filer of a PCT application assembles the bibliographic data including the applicant name and applicant information and (importantly for this comment letter) the priority information, so that it may be entered into the Request. In legacy practice a filer would enter the bibliographic data into a PDF form for submission to a PCT Receiving Office, but for over a decade it has been possible to enter the bibliographic data into a WIPO-provided software system. The WIPO-provided software system carries out validations and then the Request is provided in a computer-readable way to the Receiving Office. Some twenty years ago the WIPO-provided system was called PCT-Easy and the computer-readable format was a floppy disk, physically delivered to the Receiving Office. By ten years ago the system was called PCT-SAFE and for a filing in the Receiving Office of the USPTO the PCT-SAFE software would generate a ZIP file which the filer would then upload into EFS-Web. The ZIP file would communicate the bibliographic data in a computer-readable way to the Office.

PCT-SAFE carried out a number of validations of the bibliographic data provided by the filer. But because PCT-SAFE was software running on the user's Windows computer, it had no ability to validate priority-claim information with reference to original source data at the one or more Offices where a priority application might have been filed.

About five years ago, WIPO released a successor to PCT-SAFE called ePCT. ePCT is web-based rather than being based upon software that runs on a user's own computer. ePCT offers functions for assembly of bibliographic data into a Request and validation of that bibliographic data. ePCT also offers functions for online file inspection and status inquiry, and for the filing of follow-on documents, for pending PCT applications. US practitioners would thus find in ePCT many functions that are much like Private PAIR. Importantly, ePCT is able to carry out a particular category of data validation that PCT-SAFE is not, namely a cross-check of a proposed priority claim against the DAS database. If the filer enters a proposed priority claim (application number, Office of filing, filing date, and DAS access code) into ePCT, then the ePCT system is able to interrogate the DAS system to see if a matching application can be found in DAS. The cross-check takes place in real time and the result is annunciated instantly to the filer. If a matching application is found, then this tells the filer that he or she has successfully avoided making typographical errors in the entry of the priority claim into ePCT. If on the other hand no matching application is found, then the filer knows right away to investigate further to see whether some mistake has been made in the PCT filing workflow.

It will be appreciated that these functions, provided by WIPO starting about five years ago, permit a filer to detect and correct many priority-claim mistakes and errors well before the 4-and-16 date and indeed prior to the filing of the PCT application itself. These functions save work for Offices that would otherwise have to spend time communicating such mistakes to filers and, in many cases, having to communicate that a particular priority claim has been irretrievably lost. These functions save applicants from loss of substantive rights. And these functions reduce professional liability risks for patent practitioners.

Prior to June 1, 2016 if a filer in the RO/US wished to upload a ZIP file to EFS-Web as part of a PCT filing, the only way to generate that ZIP file was by means of PCT-SAFE. As is mentioned in the Notice, on June 1, 2016 WIPO made it possible for the filer to use ePCT to generate the ZIP file. Thus, as of June 1, 2016, filers had for the first time the opportunity to carry out this validation of the priority-claim information against the DAS system, a validation that was not available in the earlier PCT-SAFE system.

On May 16, 2016, the USPTO published a *Federal Register* notice entitled *Use of WIPO's ePCT System for Preparing the PCT Request for Filing as Part of an International Application With the USPTO as Receiving Office*, 81 FR 27417. The Notice warned filers against the use of ePCT for this purpose. The Notice stated that prior to using ePCT in this way, the filer:

> should consider contacting the Bureau of Industry and Security (BIS) at the Department of Commerce, the Directorate of Defense Trade Controls (DDTC) at the Department of State, or the National Nuclear Security Administration (NNSA) at the Department of Energy for the appropriate clearances where the international application may include technology subject to export controls.

It is thus understandable that many practitioners, upon learning of this 2016 Notice, chose to refrain from use of ePCT. Regrettably this led to some practitioners forgoing even the Private-PAIR-like functions of ePCT, even though those functions of ePCT were not the target of the warnings in the 2016 Notice.

The reason given in the 2016 Notice for the warning against use of ePCT was the USPTO's interpretation of 37 CFR § 5.11 *et seq.*   37 CFR § 5.11 *et seq.* ("the FFL Rules") spell out what a Foreign Filing License ("FFL") does and does not do for a patent filer. According to the FFL Rules, if

the filer has an FFL, the filer can file a patent application outside of the US without having to worry about export control clearances from BIS and DDTC and NNSA. And according to the FFL Rules, if the filer has an FFL, the filer can file a PCT application (for example at the RO/IB) outside of the US without having to worry about export control clearances from BIS and DDTC and NNSA. But, according to USPTO's interpretation of the FFL Rules, the possession by the filer of an FFL did not make it so that the filer using ePCT to prepare a ZIP file for uploading into EFS-Web did not need to worry about export control clearances from BIS and DDTC and NNSA.

One important statistic in PCT filings at the USPTO is the fraction of PCT filings carried out in a way that benefits from validation of bibliographic data. This works out to the same thing as the fraction of PCT filings carried out with a ZIP file having been uploaded to EFS-Web by the filer. Remarkably this percentage, which was about 55% a few years ago, has actually dropped in recent years to only about 50%. One suspects that the cloud raised by the 2016 Notice around the use of ePCT in the generation of such a ZIP file is a contributing factor to the reduction of this percentage.

The concern raised in the 2016 Notice was that the filer entering information into ePCT would be transmitting that information outside of the US (to a web server in Switzerland). The Abstract might communicate technology subject to export controls. Even the Title might communicate technology subject to export controls.

Given that USPTO had taken the positions set forth in the 2016 Notice, what needed to happen next was for USPTO to revise 37 CFR § 5.11 *et seq.* to explicitly set forth that if the filer has an FFL, the filer can enter bibliographic information into ePCT for purposes of generating a Request to generate a ZIP file for uploading into EFS-Web, without having to worry about export control clearances from BIS and DDTC and NNSA.

The intellectual property community immediately asked USPTO to do exactly this. See for example **USPTO needs to update its Foreign Filing License rule**, *Ant-Like Persistence* blog, October 29, 2016. See for example **AIPLA resolution 702-20,** adopted February 1, 2019. Some of the undersigned communicated this need to the USPTO multiple times over the past several years in postings to the *Patent Cooperation Treaty listserv* and in direct communications with USPTO personnel.

Now comes the present *Notice of Proposed Rulemaking*. The proposed rules, if promulgated, will largely remove the cloud that was created by the 2016 *Federal Register* notice. Practitioners who had forgone use of ePCT completely, including forgoing the Private-PAIR-like functions of ePCT, because of this cloud will now be prompted to make full use of ePCT. This will permit validating a would-be priority claim against original Office source data.

It is urged that if and when the Final Rules get published in the *Federal Register*, the Notice communicating these Final Rules expressly cite the 2016 *Federal Register* notice and expressly state to the reader that the warnings set forth in that 2016 Notice no longer apply. Such a communication directed to the 2016 Notice will likely be of great help in training and outreach efforts to assist filers in overcoming previous reluctance to make use of ePCT. This is likely to improve the statistic as to the percentage of PCT filers in the RO/US who upload ZIP files, that is, it is likely to increase the fraction of PCT filings in the USPTO that enjoy the benefit of bibliographic data validations. In particular it is likely to increase the fraction of PCT filings in the USPTO that get the benefit of cross-checking of priority claims against original Office source data. Such changes in filer practices will save work for Offices, will reduce instances of irretrievable losses of substantive rights by applicants, and will reduce professional liability risks for patent practitioners.

In summary, the twenty-one signers favor the proposed rules, and urge that the Notice promulgating such Final Rules expressly state to the reader that the warnings set forth in the 2016 Notice no longer apply. The signers also favor the USPTO developing a mechanism for updating of bibliographic data that is more user-friendly than the present mechanism therefor, taking as an example the 92*bis* "action" mechanism of ePCT.

Respectfully submitted,

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