

The Contemplated WIPO "Centralized System for Performing Most of the Tasks Related to National Phase Entry"

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WIPO contemplates a system for performing most tasks related to national phase entry. Information on their initiative is posted at: http://www.wipo.int/efiling_standard/en/pre-pfc/. Copied in below are my comments to WIPO in response to their solicitation for comments. My comments refer to the WIPO document posted at:

http://www.wipo.int/export/sites/www/efiling_standard/en/pre-pfc/npe-samples/ePCT-NPE-detail-2013-04.doc titled "ePCT NATIONAL PHASE ENTRY" and dated April 25, 2013.

In response to Michael Richardson email below (on the Oppedahl PCT email list service) soliciting comments on the proposed "centralized system for performing most of the tasks related to national phase entry", I have additional comments. I am a U.S. registered practitioner, and a member of the Virginia bar. I run a small IP law firm near the USPTO's main campus. I have 23 years of experience in the IP field. I was the Vice Chair of the AIPLA PCT Issues committee. As you probably know, I have communicated with the ePCT staff on a variety of issues. My comments follow. I refer to your "ePCT-NPE-detail-2013-04.doc" linked at: http://www.wipo.int/efiling_standard/en/pre-pfc/.

1. I would hope that you WIPO would promulgate a Power of Attorney/Agent form in which the international agent could uniquely and unambiguously specify national phase agents, one agent (or organization) in each country/region in which national stage entry is to be effected. And specify in that WIPO form which national/regional Offices accept that form for recognizing national agents. (In other words, promulgate a form, and get the USPTO, the EPO, and other Offices to review and tell you at WIPO whether they would accept that form for recognizing representation by a national agent, and then specify that information in the form.) One benefit would be a form that lists all national agents in which national stage entry is effected, in one document.

2. I am particularly concerned about the possibility of a clerical law firm employee entering the wrong application in response to a client's instructions and not catching that the wrong PCT application is specified, or that the wrong countries and regions for national stage entry are specified. In this regard, "wrong" means other than as instructed by the IP owner or their representative.

Unnumbered page 6 of your contains a comment relevant to this issue. There, Hiroshi Takenaka (JIPA) comments and you reply:

(vi) The ePCT system user may want to make sure that their input data is correct before sending a request of national phase entry. For that purpose, a function of displaying confirmation screen or outputting checklist should be provided to the ePCT system.

IB Response: A option to preview the relevant form for each Office

before submission is foreseen.

REQUEST: I would like an intervening step an option in the sequence of GUI's before the GUI containing the button to click to request national stage entries, that allows for IP owner confirmation. That is, a GUI allowing the clerk to email "their input data" to a client email associated with the PCT application (aka to the company/owner or inventor/owner of the application) requesting confirmation that the input data corresponds to a PCT application for which the client instructed national stage entry, and that the countries for national stage entry are countries the client instructed national stage entry. Whether the email is an automated process based upon an "address book" or email stored in association with the PCT, or merely an email containing the input data, allowing the clerk to enter a suitable email address, is not as important. What is important is that the IP owner be afforded an opportunity to review and effectively, "push the button" effective national stage entries, either by confirming to the clerk to push the button, or having the "button" embedded in the email to the client.

While it is rare that the wrong PCT application enters a national stage, or fails to enter a national stage, that I understand that error has occurred in the past, and I understand that the results have been disastrous.

On unnumbered page 7, Hiroshi Takenaka (JIPA) comment suggesting a function for temporarily saving input data, is relevant. Your response seems to have misunderstood his comment that the "input data" refers to national stage entry input data input into the proposed system, so that for example a supervisor once a week can review proposed national stage entry submissions before finally agreeing and hitting the "send" button. Saving the data for review is what his comment implies. Such a saved submission feature exists in EFS, for your reference.

3. Unnumbered page 7 of ePCT-NPE-detail-2013-04.doc contains a GUI with check boxes for 96 two letter identifiers. The tab name is "National". Other tabs are named "AP"; "EA"; "EP" and "OA" which presumably list two digit codes for regional filing authorities.

3.1 Not everyone knows all of the national two digit codes. The live page should include rollovers that specify the country name associated with the two digit codes to reduce user entry errors.

3.2 Under the tab "National" is the word "Designations". However, only 96 country codes appear. Replace "Designations" with "Designations of countries not members of [AP, EA, EP, OA, spelling out these regional authorities by full name].

3.3 Change "Name*" to "Inventor Name* (of if not inventor name, specify the relevant name to enter). Same text, add "(English language name)

3.4 Change "Name (In Filing Language)" to "Inventor "Name (In Filing Language)" Add the text in the filing language for "Inventor "Name (In Filing Language)"

3.5 Change "Address" to "Address in English"

3.6 Supplement "Address (In Filing Language)" with the same text in the filing language

4. On unnumbered page 7, Hiroshi Takenaka (JIPA) comments suggest an immediate filing receipt, and you reply that "most Offices' implementation of PCT EDI, retrieving documents is a batch process which only occurs at specific times, rather than being instantaneous." The ePCT system should therefore include in the ePCT confirmation of receipt, a specification of the anticipated date of official filing receipt by national/regional offices based upon their batch process intervals or dates (so that the filer knows when to set reminder and action deadlines in their internal docketing systems, in case things do not occur by the anticipated time). Similarly, I presume the ePCT system would (1) receive filing receipt from the national offices, (2) send the receipts or notifications to the filer, and, just as importantly, send an email or provide a notification once all national stage entry designated Offices confirm receipt of the ePCT filed national stage entry.

5. On unnumbered page 7, Hiroshi Takenaka (JIPA) comments "The ePCT system user should be able to pay national fees to ... the WIPO..." Your comment indicates that this would be difficult "while minimizing transaction costs and risks relating to fluctuating exchange rates." I think you underestimate the value a single payer source provides to users! Keep in mind that currently every agent in the world has to pay each of their national stage agents invoices for government fees and national stage entry, and most payments must be made in local currency. And then, to add insult to injury, those fees (and any service charges) need to be billed back to the IP owner. Moreover, the invoices from national agents for PCT national stage filings come back to the PCT international agent over times spanning from, prior to national stage entry, to up to a year after national stage entry. That causes internal cost accounting problems and client accountability problems that you appear to not have taken into account in your reply. In short, any solution you provide for centralized payment, will certainly reduce the costs to users, and therefore be more cost efficient than the way business is currently handled. The value of a single invoice, and a single debit in real time which can be billed in real time to the IP owner, is of great value.

6. On unnumbered page 4, you respond to comments by Sam Helfgott on behalf of IPO, responding to "how the international phase applicant would be able to share the work effectively with translators". I presume what Sam had in mind was rights for translators to upload translations, and do nothing else in ePCT for an application. However, I have a different concern, which is ensuring that the translation corresponds to the intended PCT specification. Keep in mind that the person uploading a translation to a PCT application may not be able to ascertain that the translation, because it is in a language they do not understand, corresponds to the PCT application. It may be for some other application. I would ask that you consider validating documents identified as translations against the original language PCT specification. Provide, at a minimum, a validation check comparing the number of claims, number of figures, and other readily identifiable indicia that are language independent. (You could even provide a correlation of a machine translation against the translator's translation, as a validation tool).

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