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2022 Virtual PCT Training Seminar

Session 5

Applicants of Convenience

Preparing a PCT Request – Making Use of ePCT and Getting Benefit of Validations, Avoiding Malpractice on Priority Claim Mistakes

Friday, February 18, 2022

Schwegman Lundberg & Woessner | slwip.com



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.



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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



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How We Will Proceed

Please please please complete the evaluation questionnaire.

Please note that if you have not already downloaded your presentation materials, you can download them now from a link in the *SLW Institute* web site (at the Attendee Hub).

The presentation system has “chat” and “questions”.

I suggest posting your questions to the “questions” system, not the “chat” system.

We have over a thousand attendees and I am sorry to say we might not be able to get to all of the questions during the scheduled time for the webinar.

There is a way that we can capture and save the questions from the “questions” system. We might be able to edit them with answers and post the some of the answers later. This is why we suggest using the “questions” system rather than the “chat” system.



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Today's Goals

Detailed discussion of Applicant-of-Convenience filing process

Live demo of the process of preparing a PCT Request



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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)

PCT Applicant's Guide

What? You have not yet subscribed to the *PCT Applicant's Guide*?

Without further delay, go to the WIPO web site and subscribe to the PCT Applicant's guide!

The last you heard from me (two days ago) the price for ISA/JP was \$1405. Now we learn that it is going to increase on April 1, 2022 to \$1475.

PCT Applicant's Guide – International Phase – Annex D

| D | International Searching Authorities | | | | D |
|--|--|----------------------|----------------------------|----------------------|--------------------------|
| JP | JAPAN PATENT OFFICE (JPO)¹ | | | | JP |
| Search fee (PCT Rule 16): ² | Japanese yen (JPY) | 70,000 ³ | (143,000) ³⁻⁴ | 156,000 ⁵ | (169,000) ⁴⁻⁵ |
| | Euro (EUR) | 542 ³ | (1,108) ³⁻⁴ | 1,208 ⁵ | (1,310) ⁴⁻⁵ |
| | Singapore dollar (SGD) | | | 1,906 ⁵ | (1,991) ⁴⁻⁵ |
| | Swiss franc (CHF) | 583 ³ | (1,149) ³⁻⁴ | 1,300 ⁵ | (1,358) ⁴⁻⁵ |
| | US dollar (USD) | 631 ³ | (1,248) ³⁻⁴ | 1,405 ⁵ | (1,475) ⁴⁻⁵ |
| | Won (KRW) | 748,000 ³ | (1,493,000) ³⁻⁴ | | |

Applicant of Convenience

- It is the applicant list that determines whether or not the PCT is available at all
- It is the applicant list that determines which ROs you can choose from
- It is the RO that determines which kinds of ROROP requests you can file
- It is the RO that determines what transmittal fee you have to pay
- It is the RO that determines what e-filing system you get to use
- It is the RO that determines what time zone controls for your filing
- It is the RO that determines what language or languages may appear in your PCT application
- It is the RO that determines which ISA or ISAs you have to choose from
- It is the ISA that you choose that determines what IPEAs you have to choose from
- And, most importantly, ***you get to control your applicant list***

Example: Argentina

- Applicant is resident and citizen of Argentina
- The PCT is not available
- If you add to the applicant list, you can make the PCT available to the Argentine applicant
- Maybe add an applicant who is a citizen or resident of the US
- Now the PCT is available to the Argentine applicant

Example: Maybe You Are Accustomed to Only Being Able to Pick ISA/EP

Example: applicant is from AL, AT, BA, BW, CH, CY, DE, EE, FR, GB, GR, HR, IE, IT, LU, ME, MK, MT, MW, NL, PT, SC, SI, TN

This would normally mean the only choice for ISA is ISA/EP

Suppose your claims are very close to being pure business methods or are very close to being pure software implementations

ISA/EP might not be your best choice for an ISA

Add an applicant who is a US resident or citizen

This makes RO/IB available

Now the applicant's ISA choices include ISA/AU, ISA/IL, ISA/JP, ISA/KR, ISA/SG, ISA/RU, ISA/US

Recall What a PCT Application Is

A PCT application is a bundle of 127 patent applications. Arguably what you do in one of those patent applications has little or no effect on the other 126 patent applications. You could assign rights as to one of those applications separately from any of the other 126 applications.

Application for Purposes of Malawi

What some practitioners do is set up an assignment of rights from the applicant over to a suitable US resident A. The assignment recites that A is the assignee of rights with respect to the Malawi designation of the to-be-filed PCT application, the perfection of the transfer of rights contingent upon the event of entry into the national phase in Malawi.

The screenshot shows the 'NAMES' section of an ePCT application. At the top right, a red box indicates '2 issues'. Below this, two error messages are displayed in a list:

- Prevents filing: At least one applicant must have nationality or residence of a PCT contracting State.
- Will require correction but does not prevent filing: At least one inventor or applicant-inventor must exist.

Below the error messages are three buttons: 'Add Applicant(s)/Inventor(s)', 'Agent/Common representative/Address for correspondence', and 'Power of Attorney'. At the bottom, a table lists the applicant information:

| | | |
|---------------------------|-----------------|--|
| Name CANDY WRAP UNLIMITED | Party Applicant | |
|---------------------------|-----------------|--|

Example: Candy Wrap has a mailing address in the US and is an Argentine resident and Argentine citizen. Note that ePCT puts this red error message on the screen.

But we control the applicant list. So we click “add applicant”.

| | |
|--|--|
| Party * <input checked="" type="radio"/> Applicant <input type="radio"/> Applicant and inventor <input type="radio"/> Inventor only | First Name * Walter |
| Type * <input type="radio"/> Legal entity <input checked="" type="radio"/> Natural person | Last Name * PLINGE |
| Applicable designations * Specific designations | Street address * 123 Main Street <input type="checkbox"/> No street address applicable |
| | City * Buenos Aires |
| | Country or territory * AR - Argentina |
| | Postal Code 12345 |
| | State of Nationality US - United States of America |
| | State of Residence AR - Argentina |

| | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | |
|--------------------------|--------------------------|--------------------------|--------------------------|--------------------------|--------------------------|--------------------------|--------------------------|--------------------------|--------------------------|--------------------------|--------------------------|--------------------------|--------------------------|--------------------------|-------------------------------------|--------------------------|--------------------------|--------------------------|--------------------------|--------------------------|--------------------------|--------------------------|--------------------------|--------------------------|--------------------------|--------------------------|--------------------------|--------------------------|--------------------------|--------------------------|--|--|
| Designations | | | | | | | | | | | | | | | | | | | | | | | | | | Deselect all | Select all | | | | | |
| Specific | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | |
| National Designations | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | |
| AE | AG | AL | AM | AO | AT | AU | AZ | BA | BB | BG | BH | BN | BR | BW | BY | BZ | CA | CH | CL | CN | CO | CR | CU | CZ | DE | DJ | DK | DM | DO | | | |
| <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | | |
| DZ | EC | EE | EG | ES | FI | GB | GD | GE | GH | GM | GT | HN | HR | HU | ID | IL | IN | IR | IS | IT | JM | JO | JP | KE | KG | KH | KN | KP | KR | | | |
| <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | | |
| KW | KZ | LA | LC | LK | LR | LS | LU | LY | MA | MD | ME | MG | MK | MN | MW | MX | MY | MZ | NA | NG | NI | NO | NZ | OM | PA | PE | PG | PH | PL | | | |
| <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input checked="" type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | | |
| PT | QA | RO | RS | RU | RW | SA | SC | SD | SE | SG | SK | SL | ST | SV | SY | TH | TJ | TM | TN | TR | TT | TZ | UA | UG | US | UZ | VC | VN | WS | | | |
| <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | | |
| XY | ZA | ZM | ZW | | | | | | | | | | | | | | | | | | | | | | | | | | | | | |
| <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> | | | | | | | | | | | | | | | | | | | | | | | | | | | | | |

Arguably nothing that happens in this designation has legal effects on the other 126 designations.

NAMES 1 issue

Will require correction but does not prevent filing: At least one inventor or applicant-inventor must exist.

| | | |
|-----------------------------|-----------------|--|
| ▶ Name CANDY WRAP UNLIMITED | Party Applicant | |
| ▶ Name PLINGE, Walter | Party Applicant | |

The red error message has gone away.

Now We Can Preview Form PCT/RO/101 (The Request)

| | |
|---|--|
| II Applicant | |
| II-1 This person is | Applicant only |
| II-2 Applicant for | All designated States |
| II-4 Name | CANDY WRAP UNLIMITED |
| II-5 Address | 300 Colorado Street Baltimore, Maryland 21201-4307 United States of America |
| II-6 State of nationality | AR |
| II-7 State of residence | AR |
| II-8 Telephone No. | 1-310-876-5432 |
| II-10 e-mail | candy@wrap.com |
| II-10(a) E-mail authorization <small>The receiving Office, the International Searching Authority, the International Bureau and the International Preliminary Examining Authority are authorized to use this e-mail address, if the Office or Authority so wishes, to send notifications issued in respect of this international application:</small> | exclusively in electronic form (no paper notifications will be sent) |

| | |
|--|---|
| III-1 Applicant and/or inventor | |
| III-1-1 This person is | Applicant only |
| III-1-2 Applicant for | MW |
| III-1-4 Name (LAST, First) | PLINGE, Walter |
| III-1-5 Address | 123 Main Street 12345 Buenos Aires Argentina |
| III-1-6 State of nationality | US |
| III-1-7 State of residence | AR |
| III-1-10 e-mail | a@b.com |
| III-1-10(a) E-mail authorization <small>The receiving Office, the International Searching Authority, the International Bureau and the International Preliminary Examining Authority are authorized to use this e-mail address, if the Office or Authority so wishes, to send notifications issued in respect of this international application:</small> | exclusively in electronic form (no paper notifications will be sent) |

I e-Filed the PCT Application!

You have successfully filed the following international application:

| | |
|-----------------------|-----------------------------------|
| IA Number | PCT/IB2022/040065 |
| Receiving Office | IB - International Bureau of WIPO |
| Date of receipt at RO | 17 Feb 2022 21:55 CET |

You will be notified by e-mail as soon as the full contents of the international application are available.

REMO (12) International Application Status Report

Received at International Bureau: 20220217
Report generated on: 17 February 2022 (17.02.2022)

| | | |
|---------------------------------|-------------------------------|-----------------------------------|
| (10) Publication number: | (43) Publication date: | (26) Publication language: |
| | | English (EN) |
| (21) Application Number: | (22) Filing Date: | (25) Filing language: |
| PCT/IB2022/040065 | 20220217 | English (EN) |

(51) International Patent Classification:

(71) Applicant(s):

CANDY WRAP UNLIMITED [AR/AR]; 300 Colorado Street Baltimore, Maryland 21201-4307 (US) (for all designated states)
PLINGE, Walter [US/AR]; 123 Main Street Buenos Aires, 12345 (AR) (MW only)

Now We Do a 92bis Change Request

RULE 92BIS CHANGE REQUEST

Check that any required powers of attorney are already on file or attach them below.

Current date and time at recipient Office: Thursday, 17 February 2022, 22:02 CET
 Deadline to submit draft action: Monday, 19 August 2024 24:00:00 CET

Date 17 Feb 2022

EDIT PARTIES

Add a new Party

| | | | |
|---|---|--|--|
| ▶ CANDY WRAP UNLIMITED | Applicant | Legal entity | |
| ▼ Name PLINGE, Walter Address 123 Main Street Buenos Aires, 12345 (AR) (Address for service) Registration No. | Role Applicant Type Natural person Succession Nat US Res AR | Applicable Designations Specific designations Telephone Fax Email Address a@b.com | |



ePCT Action: Rule 92bis change request

IA Number: PCT/IB2022/040065
 International Filing Date: 17 February 2022
 File reference: abcdp001
 Request Date: 17 February 2022

Data requested to be deleted:

the applicant the inventor the agent the common representative the applicant-inventor the correspondence address

Type: Natural person

Applicable designations:
 Regional: AP (MW)
 National: MW

Name and Address:
 PLINGE, Walter
 123 Main Street
 Buenos Aires, 12345
 Argentina

Registration No

| | |
|--------------------------|---------------------------------|
| State of Nationality: US | State of Residence: AR |
| Telephone | Fax |
| Email a@b.com | Notification method E-mail only |

The following documents were submitted as attachments: None

Signature: /walter plinger
 Signatory: PLINGE, Walter (Applicant)
 Date: 17 February 2022 22:05:59 CET
 User Name: carl.OPPEDAHL
 Authentication: Sign-in with strong authentication

Important information

Due to confidentiality reasons, submitting a Rule 92bis request will temporarily suspend online access to the IA via ePCT pending processing by the IB.

Do you want to add another change or continue to submit this Rule 92bis request?

Add another change

Submit 92bis Change Request

Now Some Live Demo

What Lies Ahead?

- Session 6 | Tuesday, February 22 – Using Workplace Collaboration Features of ePCT as You Lead up to the PCT Filing, Shared Address Book, External Signatures, Document Reviews
- Session 7 | Thursday, February 24 – E-Filing of the PCT Application and Docketing of PCT Thereafter
- Session 8 | Monday, February 28 – What to Do When the International Search Report and Written Opinion Arrive, Do You File a Demand?
- Session 9 | Wednesday, March 2 – Using ePCT for “Actions” Such as 92bis Requests, Communicating with ISAs

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?

Thank you!

See you at the next session!

