

# What's New for Applicants in ePCT


11 & 13 January 2022

## Q&A Report

No.	Questions	Answers
1	We usually file our PCT applications through the EPO (RO/EP). What advantage do we have if we file through IB directly (RO/IB)?	<p>Filing directly with RO/IB using ePCT, the benefits are:</p> <p>From a technical point of view:</p> <ul style="list-style-type: none"> <li>- Automatic eOwnership/ direct access rights to your applications</li> <li>- No need to wait for the Record copy to be transmitted from RO/EP to the IB</li> <li>- Online Action to pay the fees to the IB</li> <li>- Direct support from RO/IB and PCT Operations Customer Support Section</li> </ul> <p>There are also other factors to be considered when selecting a RO in general. For example, international applications may be filed with RO/IB in any language. The transmittal fee may be less (e.g. currently 100 CHF with RO/IB compare to 133 CHF with RO/EP). Filing with RO/IB may offer you a broad selection of ISA and IPEA, and choice of agent if the applicants are from different countries. For more details, please refer to <a href="#">PCT Newsletter 03/2019: Practical Advice</a>: Filing strategies: factors to consider when deciding whether to file an international application with a national (or, where applicable, regional) Office or the International Bureau as receiving Office – an example of a US resident who is a national of Canada.</p>
2	Can a U.S. inventor, who is not a registered agent, file himself at RO/IB?	The inventor himself can file, but in this case, he should also be an applicant. Therefore, the person's status is "applicant and inventor" and the application is filed without an agent.
3	Our Team drafts many applications in advance and save as drafts. Sometimes we have to change the RO from the IB to the US. Is there any way you would be able to update the system so in the drafts you could easily change the RO from	<p>If you originally selected RO/IB, it is not possible to change this selection to any other RO.</p> <p>If the selected RO is not RO/IB, you have a one-time opportunity to change the selected RO to RO/IB. Once you change the RO to RO/IB, it cannot be reversed and it is not possible to change the RO to any other RO. However, if the selected RO is RO/IL or</p>

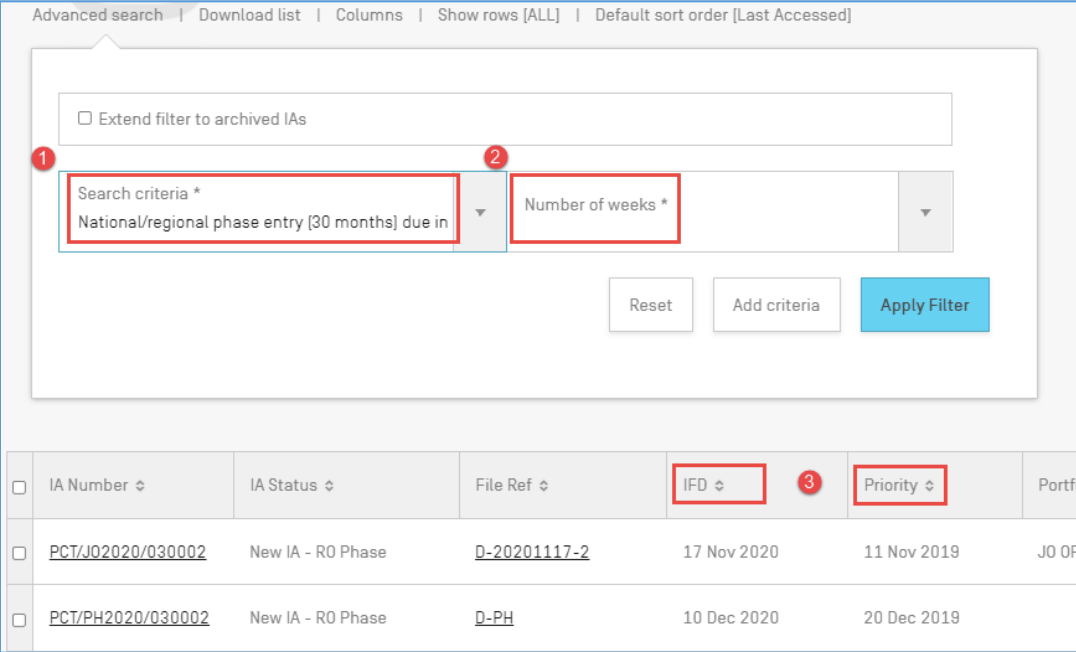
	the IB to the US. We have to redo the entire draft because you cannot just change the RO.	RO/US, this option to change the RO to RO/IB is not available due to the very limited validation functionality with these two Offices as only the request form is prepared in ePCT. In such cases if you do not want to proceed with a draft for which you had selected RO/IB, RO/IL or RO/US, you will need to delete it in order to remove it from your Workbench, i.e., tick the checkbox next to it on your Workbench and choose "Delete draft" in the dropdown list of actions. In order to do this, you must have eOwner access rights to the draft.
4	If the agent only has the right to practice before one office and there are multiple applicants from different countries, how should I choose the option?	Based on the nationality/ residence of the multiple applicants, ePCT displays a list of all available ROs before which the applicants can file the application.  If the person is only qualified as agent before one of the ROs, you need to select that RO to indicate the person's qualification as agent before that RO so to confirm that the person is qualified to represent the applicants before RO/IB; if the person is qualified as agent before more than one RO indicated on the list of available ROs, you can select any of the ROs before which the person is qualified as agent.
5	Which RO should we indicate in case the agent is entitled to practice before multiple receiving offices (i.e. EP and IT)?	You can select either Office (national (IT) or regional RO (EP)) as long as you are competent to act as agent before that office according to Annex C of the <a href="#">PCT Applicant's Guide</a> .
6	If an agent has the right to practice before multiple offices (e.g. CH and EP in case of a Swiss applicant), only one of the two options can apparently be selected upon filing (CH or EP). Is it contemplated to possibly allow the agent to select both available options?	Only one RO can be selected. As long as the agent is competent before one RO (national or regional IP office) to represent the applicant(s), the agent is qualified to represent the applicant before RO/IB. Therefore, indicating one RO before which the agent is qualified to represent the applicant(s) is sufficient.
7	If you can represent applicants from Europe but not from Asia where is domicile a national from let say Japan, can we represent this applicant from Asia before the IB as receiving office? In that case, it can be designated the EPO as searching authority?	If the applicant has the JP nationality and/or residence, the application can be filed with RO/JP or RO/IB. According to <a href="#">Annex C of the PCT Applicant's Guide (JP)</a> , the agent should be any patent attorney or attorney-at-law resident in Japan, or any firm registered to practice before the Office. This requirement applies for filing with RO/JP and also for filing with RO/IB if the applicant has the JP nationality and/or residence.  The ISA can be ISA/EP, ISA/IN, ISA/SG or ISA/JP.
8	Please confirm that an attorney registered at the USPTO can sign as Agent when filing a PCT application directly with	According to <a href="#">Annex C of the PCT Applicant's Guide (IB)</a> , for acting as agent before RO/IB, the person must have the right to practice before the national (or regional) Office of, or acting for, a Contracting State of which the applicant or, if there are two or more applicants,

	<p>the RO/IB where the applicant and all inventors are located outside of the US.</p>	<p>any of the applicants is a resident or national, or, where the IB acts as RO pursuant to PCT Rule 19.1(b), any natural or legal person.</p> <p>It means that, except when PCT Rule 19.1(b) is applicable, if none of the applicant(s) or the applicant(s)/inventor(s) has a US nationality or residence, and the person is only a registered agent before RO/US and not before any other office of a PCT Contracting State of which the applicant or any of the applicants is a resident or national, the person is not qualified to act as agent for the applicant(s) before RO/IB. Therefore, the person cannot sign the Request as agent at the time of filing the application and can only be recorded as the Address for Correspondence.</p>
<p>9</p>	<p>Is my understanding correct: a US agent may file (i.e. is competent) the PCT application with a German entity as Applicant with inventors from US and DE. And, we no longer have to file in RO/US with German Applicant and designating one US inventor as Applicant/Inventor (followed by 92bis change to Inventor only)?</p>	<p>The available RO(s) depend(s) on the nationality and/or residence of the applicant. When filing with RO/IB, according to <a href="#">Annex C of the PCT Applicant's Guide (IB)</a>, to act as agent before RO/IB, the person must have the right to practice before the national (or regional) Office of, or acting for, a Contracting State of which the applicant or, if there are two or more applicants, any of the applicants is a resident or national, or, where the IB acts as RO pursuant to PCT Rule 19.1(b), any natural or legal person. That is - even if you file with RO/IB, the same requirement for the agent is checked as if the application was filed with another competent RO based on the nationality and/or residence of the applicant.</p> <p>In your case, we understand that the US agent is not a registered agent before either RO/DE or RO/EP, which are competent ROs according to the DE nationality and residence of the applicant.</p> <p>If the US agent wants to represent the applicant before the RO/IB, there still needs to have at least one US applicant or applicant/inventor. In this way, the agent is qualified as agent before RO/IB for the application as if the agent was qualified before RO/US when the application was filed with RO/US.</p> <p><b>Please be advised that the new functionality relating to the confirmation of the agent's rights to practice before RO/IB introduced at the webinar does not have an impact on the existing rules under the PCT for the determination of the agent's rights/qualification to represent the applicant(s) before RO/IB. It is only that the agent now needs to explicitly indicate in ePCT, at the time of filing, the RO before which the agent is qualified to represent the applicant(s) based on the applicant(s)' nationality and/or residence, so to confirm the agent's rights to represent the applicant(s) before RO/IB.</b></p>

10	Can you please add a few words regarding filing with priority up to two month after priority deadline? Is the restoration automatic and if not how do use decide whether to restore or not?	<p><a href="#">PCT Rule 26bis.3</a> refers to the restoration of right of priority by the RO. Requests for restoration should be submitted by the applicant to the RO, provided that the <a href="#">RO accepts restoration of right of priority</a>. You may also refer to <a href="#">PCT Newsletter 09/2015: Practical Advice</a>: How to make a request for restoration of the right of priority, and the furnishing of declarations and evidence relating to such requests.</p> <p>Applicants are always strongly advised to file international applications within a reasonable period of time before the end of the 12-month priority period. This helps to avoid situations where the priority period is missed due to unforeseen problems.</p>
11	Will the improvements in PCT Declarations also be available in EPO online filing 2.0 when filing a PCT application to RO/EP?	eOLF 2.0 with ePCT-Filing embedded is aligned with ePCT and declaration rendering is the same with no unnecessary extra pages being rendered for declarations.
12	How to use the multi-select feature for entering inventor names in the 4.17(i) Declaration?	<p>After selecting the Declaration type – (i) identity of the inventor, please click on the small triangle to show the drop-down list of all inventors, then hold down the Ctrl key and click on the inventors’ names one by one. All inventors selected will appear in the filed “Select inventor[s]” above.</p> 

13	Will ePCT ever make possible to update/change the International Search Authority via ePCT after the application has been filed with the RO (if the Search Copy has not yet been transmitted)?	It is not possible to edit the data as held by the IB using ePCT after filing in your WIPO account. All possible changes to the application should be made through submitting requests according to PCT rules.  When the Search Copy has not yet been transmitted to the selected ISA, you may submit a request to the RO to change the ISA. If the RO accepts documents via ePCT after filing, you can use the Upload Documents function to submit such a request.
14	How can we see that the fees are safely paid if the fees are paid to the RO (Pay Letter)?	The RO should issue Form PCT/RO/102 to confirm the payment of fees. The RO/102 indicates what has been paid and what is still due. If the RO is RO/IB, in addition to the RO/102, you can use the "Online Payment" action in ePCT to see the status of the fees due for filing to RO/IB.
15	My understanding is that when filing at the IB, the submission fees has to be paid on the same day? We do not have 30 days to pay anymore?	The time limit for the payment of the transmittal fee, international filing fee and search fee under PCT Rules 14.1(c), 15.3 and 16.1(f), respectively, is one month from the date of receipt of the international application. For more information about the payment time limit, and consequences of late payment or no payment, you may refer to <a href="#">PCT Newsletter 05/2015: Practical Advice</a> : Late payment fees when the PCT fees are paid more than one month after the date of receipt of the international application by the receiving Office. In addition, RO/IB continues to waive the payment of any applicable late payment fees due to the COVID-19 situation until further notice. Further information can be found <a href="#">here</a> .
16	Will the "Online Payment" option be replacing the "no payment for the time being" for RO/US as well?	The update on the online payment indication in this new release on 6 December 2021 only concerns filings with RO/IB. For RO/US, the payment methods have not been changed and "No payment for the time being" is still available.
17	If you file RO/IB but use the EP as the ISA, and if you want to pay for additional searches (Lack of Unity), can you pay the additional search fees through this link? Or will you get a separate link for payment to the ISA?	It is NOT possible to pay the additional fees for ISA using ePCT, The additional fees should be paid directly to ISA/EP. The online payment function in ePCT can only be used to pay the filing related fees, including the international filing fee, international search fee and transmittal fee, for filings with RO/IB.
18	Is a link for payment automatically generated then by the ISA? And if so, is that link sent by e-mail or is there a notice posted to Workbench on ePCT?	The acceptable payment methods depend on each ISA. The payment to other PCT authorities other than the payment of the filing related fees to RO/IB cannot be made

		through ePCT. Therefore, no ePCT e-mail notification or notice is sent for this. Please check with the ISA concerned as to how you can make the payment.
19	What is the payment method for Chapter II Demand?	Payment is to be made directly to the selected IPEA, so it depends on which payment methods the chosen IPEA accepts. The fees for Chapter II are NOT to be paid to the IB, and ePCT cannot be used to pay the fees to the IPEA.
20	When taking over a PCT application from a previous agent, why is the new agent not automatically provided with the ePCT access code (Form 301) after having submitted the Power of Attorney? Right now, it involves several communications to receive ePCT access. This should be simplified for the users.	<p>If the previous agent has access rights to the application, the best practice is for the previous agent to assign access rights to the new agent before removing his/her access rights.</p> <p>When the new agent needs to request access rights himself/ herself (for example, no one has access rights to the application), the confirmation code on IB/301 is required when filling in the online form in ePCT to submit the request for access rights for unpublished applications.</p> <p>IB/301 is issued by the IB at the receipt of the Record copy from the RO. Any copy sent afterwards is per request. If the new agent does not have the IB301 (e.g. not provided by the applicant or not transferred from the previous agent) but it is required for the request of access rights because the application has not been published yet, the request for a copy of IB/301 can be submitted together with the request under R92bis for changing the agent, or by simply sending an ePCT message to the IB.</p>
21	When we file a transfer of rights during international phase, then we do not need to file the assignment again in national phase, do we?	<p>Even though an assignment or other documentation by means of which the change of applicant was effected may not be required by the IB, designated (or elected) Offices are entitled under PCT Rule 51bis to require, upon entry into the national phase, or within a time limit fixed by the designated Office concerned after national phase entry, additional evidence or documents in the national phase regarding any change requested during the international phase, such as proof of ownership and transfer of ownership of the application. It may therefore be in the interest of the applicant to submit a copy of an assignment to the IB along with the PCT Rule 92bis request anyway.</p> <p>If you submit the assignment during the international phase, the IB makes it available on PATENTSCOPE and national Offices can access it.</p>

22	<p>At times when I try to establish access rights for a PCT case, I receive error “You have not been assigned access rights to this IA by the eOwner.” How can I establish eOwnership rights in this situation? Other times I can click “Find IA outside of my workbench” and it moves me forward and allows an opportunity to provide the claims number of the application as filed along with my name and contact information – with an IB345 to come.</p>	<p>This means someone already has access rights of that application. You need to establish an eHandshake with that person and request the person to share the access rights of that application with you.</p> <p>If it relates to a change of the agent, you need to file the request of change under PCT Rule 92bis. When the IB processes the request, the previous agent’s access rights to the application will be removed. Then you will be able to request the access rights as usual.</p>																					
23	<p>Is there a way to sort applications based on upcoming date of national phase entry deadline or end of PCT 30 month period?</p>	<p>On ePCT Workbench, it is possible to use the search criteria “National/regional phase entry [30 months]” due in a defined time (from 1 week up to 52 weeks) to filter out the applications, and then use the arrows next to “Priority” (or “IFD” for applications with no priority claimed) to sort the applications concerned.</p>  <p>Advanced search   Download list   Columns   Show rows [ALL]   Default sort order [Last Accessed]</p> <p><input type="checkbox"/> Extend filter to archived IAs</p> <p>Search criteria * National/regional phase entry [30 months] due in</p> <p>Number of weeks *</p> <p>Reset Add criteria Apply Filter</p> <table border="1"> <thead> <tr> <th><input type="checkbox"/></th> <th>IA Number ↕</th> <th>IA Status ↕</th> <th>File Ref ↕</th> <th>IFD ↕</th> <th>Priority ↕</th> <th>Portf</th> </tr> </thead> <tbody> <tr> <td><input type="checkbox"/></td> <td><a href="#">PCT/J02020/030002</a></td> <td>New IA - R0 Phase</td> <td><a href="#">D-20201117-2</a></td> <td>17 Nov 2020</td> <td>11 Nov 2019</td> <td>J0 OF</td> </tr> <tr> <td><input type="checkbox"/></td> <td><a href="#">PCT/PH2020/030002</a></td> <td>New IA - R0 Phase</td> <td><a href="#">D-PH</a></td> <td>10 Dec 2020</td> <td>20 Dec 2019</td> <td></td> </tr> </tbody> </table>	<input type="checkbox"/>	IA Number ↕	IA Status ↕	File Ref ↕	IFD ↕	Priority ↕	Portf	<input type="checkbox"/>	<a href="#">PCT/J02020/030002</a>	New IA - R0 Phase	<a href="#">D-20201117-2</a>	17 Nov 2020	11 Nov 2019	J0 OF	<input type="checkbox"/>	<a href="#">PCT/PH2020/030002</a>	New IA - R0 Phase	<a href="#">D-PH</a>	10 Dec 2020	20 Dec 2019	
<input type="checkbox"/>	IA Number ↕	IA Status ↕	File Ref ↕	IFD ↕	Priority ↕	Portf																	
<input type="checkbox"/>	<a href="#">PCT/J02020/030002</a>	New IA - R0 Phase	<a href="#">D-20201117-2</a>	17 Nov 2020	11 Nov 2019	J0 OF																	
<input type="checkbox"/>	<a href="#">PCT/PH2020/030002</a>	New IA - R0 Phase	<a href="#">D-PH</a>	10 Dec 2020	20 Dec 2019																		

24	Is the removal of the “Paper” and “Paper & E-mail” options permanent or only temporary due to the COVID situation?	The IB does not plan to revert to “Paper” and “Paper & E-mail” options. “E-mail only” will continue to be the unique channel for sending official PCT forms issued by the IB.
25	Is it planned to get letters via e-PCT (maybe having an inbox) instead of e-mail?	<p>For ePCT notifications, it is possible to set in the “Notification Preferences” to receive them in the Notifications list in ePCT instead of in your e-mail. However, please note that these ePCT-generated notifications are completely separate and independent from official PCT forms, such as PCT/IB/301 or PCT/IB/304. Such official PCT forms are still sent by the IB via e-mail.</p> <p>ePCT notifications do not contain attachments (e.g. official PCT forms) but indicate, for example, that a new document has been processed or a new form has been issued with a direct link to that application in ePCT in order for users with access rights to download/view the documents.</p>