

2025 PCT Training Seminar

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Selecting an International Searching Authority,
Applicant of Convenience

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There are 25 ISAs

· AT AU BR CA CL CN EA EG EP ES
FI IL IN JP KR PH RU SA SE SG
TR UA US XN XV

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How you know which ISAs you have to choose from?

- The list of ISAs that you have to choose from is determined by your choice of RO
- Your range of choices of RO is in turn defined by your applicant list
- This might prompt adding an Applicant of Convenience to your applicant list

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Each RO “specifies” one or more ISAs

- By far the majority of ROs have specified only a single ISA
- This means there are many PCT filers who do not routinely consider any choice of ISA

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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
- Maybe add an Applicant of Convenience for one designation (my favorite is Malawi) who is from the US
- Now you can also pick ISA/AU, ISA/IL, ISA/JP, ISA/KR, ISA/SG, ISA/RU, ISA/US
- Some applicants in this situation pick ISA/KR

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The highest number of ISAs that any RO has specified is ten

RO/SA has specified CA, CN, EG, EP, JP, KR, RU, SA, SG and US

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Special case: RO/IB

- How do you know which ISAs you have to choose from if you are in RO/IB?
- Figure out all the ROs that you could have used based on your applicant list
- List all of the ISAs that you could have chosen given all of those ROs
- That is your list of available ISAs

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ePCT will help you with this

- ePCT will work out for you which ISAs you have to choose from
- This can be very helpful particularly when you are in RO/IB
- It is good to learn how to use all functions of ePCT

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Some filers are in a rut

- They assume that some particular ISA is always the right choice
- “we’ve always done it that way”
- It is likely that one client may have factors making one ISA a best choice, while a different client may have factors making some other ISA a best choice
- It is very unlikely that “one size fits all”

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Selecting an International Searching Authority

Many factors may influence the client's selection of ISA

- Quality
- Cost for first invention
- (a former factor: cost for 2nd through nth inventions)
- Timeliness
- Suitability for later use for PPH purposes
- Possible benefits and interactions with particular national- or regional-phase filing paths
- Paper or electronic communication
- Availability of cited references

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Picking an International Searching Authority

- You are getting ready to file a PCT application
- You (actually, the client) must pick an International Searching Authority (ISA)
- If your habit is always to pick the same ISA, because “we've always done it that way,” then this is an opportunity to provide better service to your client

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A brief mention of Patent Center

- You need to start contributing to the beta testing and trouble reporting for Patent Center.
- Join the Patent Center listserv. (This is not Ideascap!)

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PPH Benefit

- AU, IL, JP, KR, RU, SG, and US are all part of the Global PPH. Positive results from any of those ISAs may form the basis for PPH status in:
 - AT, AU, CA, DE, DK, EE, ES, FI, GB, HU, IL, IS, JP, KR, NO, PT, RU, SE, SG, US
- EP, JP, KR, and US are part of the IP5 PPH. Positive results from any of those ISAs may form the basis for PPH status in:
 - CN, EP, JP, KR, US
- So if you know now in which Offices you might enter national/regional phase, and if you might want PPH benefit in those Offices, this may influence your choice of ISA

EPO and PPH

- Note that EPO has the PACE program, which offers the opportunity to accelerate search or examination without having to qualify for PPH
- This explains why it almost never happens that an applicant in EPO uses PPH
- Note that in recent years, nearly all EPO cases receive a first Office Action within PACE time anyway, even if the case is not in PACE
- This also explains why EPO applicants usually do not worry about PPH
- But EPO results (including ISA/EP results) are frequently employed to make use of PPH in other Offices

Search Fees

- US non-small entity: \$2400
- EP: \$2094
- SG: \$1849
- AU: \$1383
- IL: \$1220
- JP: \$1179
- US small entity: \$960
- KR: \$888
- PH: \$600
- US micro entity: \$480

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Additional Search Fees in the Event of Lack of Unity of Invention

- Where there is lack of unity, the ISA will only search one invention
- Typically it will turn directly to the first invention
- To have the additional inventions searched, applicant has to pay an additional search fee for each invention
- The fee is paid in the ISA's local currency
- Consider the comparative cost of search if there is a likelihood of lack of unity

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Effect on Later National/Regional Stage

- If you pick ISA/EP and later enter the EP regional phase, you don't have to pay a search fee to the DO/EO/EP
 - EPO "drinks its own Champagne"
- If you pick ISA/US and get a favorable WO, or pick IPEA/US and get a favorable IPRP (Chapter II), and you later enter the US national phase, you get out-of-order examination and reduced (zero) search and examination fees (37 CFR § 1.496)
- If you pick IPEA/AU, you get a reduced examination fee in EO/AU

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Language Competency

- An ISA/AU or ISA/US searcher might read only English
- ISA/EP searchers read at least English, German, and French, and some also read additional languages
- ISA/IL searchers read Hebrew and English and most also read Russian
- ISA/JP searchers read Japanese and English
- ISA/KR searchers read at least Korean and English and most also read Japanese
- ISA/PH searchers read at least English and some also read additional languages
- ISA/SG searchers read English and Chinese and some also read additional languages

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Excluded Subject Matter and Subject Matter Not Required to be Searched

- An International Authority may exclude certain subject matter from its agreement with WIPO to act as an ISA and IPEA
 - If all the claims are directed to such subject matter, ISA will issue an Article 17(2)(a) declaration of non-establishment of the ISR
 - Subject matter not required to be searched includes (Rule 39.1)
 - Scientific and mathematical theories
 - Plant or animal varieties or essentially biological processes for the production of plants or animals (except microbiological)
 - Schemes, rules or methods of doing business
 - Methods for the treatment or diagnosis of the human or animal body
 - Mere presentations of information
 - Computer programs

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Subject Matter Not Searched

- For example:
 - AU
 - Methods of treatment
 - Plant and animal varieties
 - KR
 - Methods of treatment of the human body by therapy

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ISA Competency Considerations

- ISA/AU
 - Not competent to act as ISA for international applications filed by US applicants in RO/US or RO/IB if more than 250 IAs have been received in the relevant fiscal quarter
- ISA/EP
 - will not search claims directed to mere business methods
- ISA/IL
 - Numerical limitation of no more than 100 IAs per fiscal quarter for US-based filers

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EP: Limitation on Number of Independent Claims in a Category

- Where there are two or more independent claims in the same category of invention (i.e., product or method) that are in unity of invention:
 - ISA/EP may issue an informal communication telling the applicant that the description, claims or drawings fail to comply with the PCT requirements to such an extent that a meaningful search cannot be carried out because the plurality of independent product claims lack conciseness as required by PCT Article 6
 - The applicant may need to choose which independent claim should be searched
 - Unlike a unity of invention requirement, the applicant cannot pay for the search of the other independent claims in that category
 - It is best to ensure that most important independent claim is listed first

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Outsourcing

- ISA/US searches are outsourced
 - Continued user concern that USPTO examiners in US national phase may not give full faith and credit to outsourced ISA/US searches and written opinions
 - USPTO focus on ensuring the quality of work from ISA/US contractors

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Provision of Cited References

- Upon payment or free of charge
 - ISA/AU: upon payment of AUD 50 (about \$36) per document
 - ISA/EP: provides copies of cited references
 - ISA/IL: upon payment of ILS 44 (about \$14) per document
 - ISA/JP: upon payment of JPY 1400 (about \$12) per document
 - ISA/KR: provides an ephemeral link to a web page containing electronic copies of cited references
 - ISA/PH: upon payment of \$20 per document (but free if ISA is provided electronically)
 - ISA/SG: upon payment of SGD 30 (about \$ 22) per document
 - ISA/US: provides copies of cited non-US patent documents and non-patent literature

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EPO – mailbox system

- ISA/EP has a mailbox system
- You should use it
- If you fail to use the EPO mailbox system, then you will have to wait weeks for documents to show up by postal mail
- This leads to risk of delays
- Yes you can get extra time for delays but it is a lot of trouble

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The ISA might cite references in its own tongue

- Some practitioners report receiving lots of Chinese-language references from ISA/CN
- Those practitioners tell me they don't like having to pay to get the references translated into English
- “Doctor, it hurts when I move my arm like this!” “So, don't move your arm like that!”

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Later choice of International Preliminary Examining Authority

Your choice of ISA affects your later choice of an IPEA

- AU/EP/IL/JP/SG will be available as IPEA to the US filer in a particular PCT application only if that IPEA was also the ISA
 - Bear this in mind when selecting an ISA

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Deciding what to do if you receive an *Invitation to Pay Additional Fees*

This is Form PCT/ISA/206 – discussed at page 140 of the *PCT Forms Book*

Clients sometimes complain when they receive an *Invitation to Pay Additional Fees*

My view is that such an Invitation is actually very good news, not bad news at all

No matter how high the invited fee may be, it is cheaper than filing a bunch of divisional patent applications

I suggest, pay the additional fees!

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How to pay the additional fees to ISA/KR?

- At our firm we use Wise Business (the company formerly known as Transferwise)
- see *Ant-Like Persistence* blog
- Recipient Bank Name: NongHyup Bank
(농협은행) [011]
- Account number: 67601011484

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Communicating with ISAs through ePCT

- This works for ISA/AU, ISA/EP, ISA/KR, ISA/RU, ISA/SG
- Of course your PCT application is already in your ePCT workbench (right?)
- You click on “upload documents” and pick “to ISA”
- You will get credit for what time it is at the ISA
- You do not need to figure out how to e-file directly at the ISA
- Very handy for sequence listings and responses to invitation to pay additional fees

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Requests for rectification

- Some filers try to get an ISA to grant a request for rectification
- Recall the standard for grant of such a request
- That no other correction could possibly be correct other than the correction you are asking for
- Many requests are likely to fail this ³¹

Informal drawings at time of filing of PCT application

- Some filers think they can get away with handing in formal drawings after filing day
- They hand in informal drawings when filing the PCT application
- It is the ISA that will receive any request to enter the formal drawings
- (The RO is unable to make decisions about entering formal drawings)
- ISAs don't like these requests very much
- Often the requests get turned down
- Yes you can get the request and the turn-down published if you do not mind paying a fee
- It is much better to simply hand in formal drawings on filing day ³²

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!

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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***

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Okay or not okay to use AOC?

- My view ...
 - Using AOC so that an applicant that would otherwise be unable to use the PCT ... may use the PCT? Okay!
 - Using AOC so that an applicant that would otherwise be unable to use applicant's choice of ISA may use that ISA? Okay!
 - Using AOC so that a would-be agent may avoid being demoted to mere "address for correspondence"? Not okay!

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Example: Argentina

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

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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/US

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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.

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Applicant 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.

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The screenshot shows the 'NAMES' section of the ePCT interface. At the top right, there is a red box indicating '2 issues'. Below this, there are two error messages: a red one stating 'Prevents filing: At least one applicant must have nationality or residence of a PCT contracting State.' and a yellow one stating '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, there is a list of applicants with one entry: 'Name CANDY WRAP UNLIMITED' and '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".

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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.

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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 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.	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 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.	exclusively in electronic form (no paper notifications will be sent)

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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.

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WIPO (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)
PLINJE, Walter [US/AR]; 123 Main Street Buenos Aires, 12345 (AR) (MW only)

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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	✎

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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 plinge/
 Signatory: PLINGE, Walter (Applicant)
 Date: 17 February 2022 22:05:59 CET
 User Name: carl OPPEDAHN
 Authentication: Sign-in with strong authentication

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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

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Avoiding mere “address for correspondence” status?

- Client (applicant) is from Canada
- Practitioner is in the US
- Normally the RO that would make sense for the applicant is RO/CA
- US practitioner is probably not admitted to practice in Canada
- US practitioner can thus not file in RO/CA and serve as “agent” in RO/CA
- US practitioner does not want to share revenue and work with a Canadian agent
- May US practitioner use AOC to enable use of RO/US and to enable the practitioner to be “agent” before RO/US?
- While this AOC path is not forbidden by PCT rules, I feel this is not a proper use of AOC

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Avoiding mere “address for correspondence” status?

- Client (applicant) is from Canada
- Let’s assume the invention was not made in the US
- Practitioner is in the US
- US practitioner is probably not admitted to practice in Canada
- US practitioner can file in RO/IB and serve as “address for correspondence”
- No need to use AOC for this filing path

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Avoiding mere “address for correspondence” status?

- Client (applicant) is from Canada
- Let’s assume that we cannot say for sure that the invention was not made in the US
- Practitioner is in the US
- US practitioner is probably not admitted to practice in Canada
- US practitioner can file in RO/US and serve as “address for correspondence”
- The application will need to be filed with a PDF Request
- But prepare the entire Request in ePCT to get the benefit of validations, then proceed with the PDF Request
- Let the client know that the RO/US will transmit the application to RO/IB
- No need to use AOC for this filing path

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Upcoming webinars

- 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 92*bis* 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!

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