

# ePCT webinar series

## Doing *92bis* changes

Webinar 15  
Thursday, June 15, 2023, 10AM Mountain Time

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<https://blog.oppedahl.com>

1

## Disclaimer

Watching this webinar, or reading these slides, does not make you my firm's client and does not make me your attorney. This webinar is intended to be educational.

At times I will wear either of two hats. At times I will be presenting purely factual information, the same way that a WIPO person might present. At other times I will be sharing opinions and preferences. Please join me in appreciating these two distinct hats.

2

# Upcoming ePCT webinar

Webinar 16. Thursday, June 22, 2023, 10AM Mountain Time.

Publication front page preview, generating reports of outstanding Forms ISA/202, generating reports of applications with outstanding priority documents.

3

# Upcoming ePCT webinars

How to register? Go to

[https://blog.oppedahl.com/?page\\_id=8978](https://blog.oppedahl.com/?page_id=8978).

How to learn of future webinars? Subscribe to my blog ( <https://blog.oppedahl.com/> ), or subscribe to the PCT listserv ( [https://oppedahl-lists.com/mailman/listinfo/pct\\_oppedahl-lists.com](https://oppedahl-lists.com/mailman/listinfo/pct_oppedahl-lists.com) ).

4

# Recordings

- Webinar 1. Thursday, March 2, 2023. Intro to ePCT, why ePCT is important, getting a user ID and password, setting up 2FA. Download the presentation materials. View the recording (1:13).
- Webinar 2. Thursday, March 9, 2023. Why attorneys need to learn about ePCT, why you cannot simply delegate stuff to support staff. Download the presentation materials. View the recording (1:05).
- Webinar 3. Thursday, March 16, 2023. Making sure your US priority documents are available to DAS, best practices for filing US priority documents, Certificates of Availability, setting up alerts. Download the presentation materials. View the recording (1:21).
- Webinar 4. Thursday, March 23, 2023. Handshakes, eOwners, eEditors, eViewers, access rights groups, employee first day of work, employee last day of work. Download the presentation materials. View the recording (1:20).
- Webinar 5. Thursday, March 30, 2023. Shared address books, collaborative workflow, sharing with clients, sharing with outside counsel. Download the presentation materials. View the recording (1:10).
- Webinar 6. Tuesday, April 4, 2023. Getting to know your ePCT workbench, portfolios, office profiles, cloning, ePCT actions. Download the presentation materials. View the recording (1:15).
- Webinar 7. Thursday, April 13, 2023. Getting pending PCT applications into your workbench, going back to January 1, 2009, archiving old applications. Download the presentation materials. View the recording (0:39).
- Webinar 8. Thursday, April 20, 2023. Filing a new PCT application in RO/US using ePCT. Download the presentation materials. View the recording (1:13).
- Webinar 9. Thursday, April 27, 2023. Filing a new PCT application in RO/IB using ePCT. Download the presentation materials. View the recording (1:05).
- Webinar 10. Tuesday, May 2, 2023. ePCT actions and communications with the IB. Download the presentation materials. View the recording (1:18).
- Webinar 11. Thursday, May 11, 2023. External signatures and PCT declarations. Download the presentation materials. View the recording (1:18).
- Webinar 12. Thursday, May 18, 2023, 10AM Mountain Time. Sequence listings and ePCT. Note that this is not about how to create a sequence listing. This webinar assumes you already know how to create a sequence listing. This webinar talks about things that you need to know in ePCT that relate to sequence listings. Download the presentation materials. View the recording (1:21).
- Webinar 13. Thursday, June 1, 2023, 10AM Mountain Time. Docketing of PCT applications and making use of ePCT notifications. Suggested companion purchase. Download the presentation materials. View the recording (1:05).

## Today's scheduled topic

### Doing *92bis* changes in ePCT

## Today's bonus topic

- Doing *26bis* changes in ePCT

7

## Kinds of changes

- Changes to names – *92bis*
- Changes to priority claims – *26bis*

8

## Where we send *92bis* requests

A change of address should be notified by way of a request for recording of a change under PCT Rule *92bis* (hereinafter: *92bis* request). Although there is nothing to prevent you from sending your *92bis* request to the Receiving Office (or to an ISA, or to an IPEA), this is not the best practice, as the Receiving Office (or other Office) will then only forward it to the IB for recording. Not only does this add an extra step to the process, but also it may take days, or even weeks, before the Receiving Office (or other Office) transmits the *92bis* request to the IB, noting that the IB must receive it before the expiration of 30 months from the priority date (PCT Rule *92bis.1(b)*). It is therefore always recommended that you submit the request directly to the IB.

## Getting the *92bis* change in before technical preparations day

In order to ensure that the new name or address appears in the published international application, it must be received by the IB, at the latest, by midnight on the day before completion of technical preparations for publication (which takes place 15 days before the publication date). It is always better to submit it well in advance of this deadline, however, in case there is a problem with the request.

## How you know you succeeded?

The IB will confirm to you (using Form PCT/IB/306) that the change has been made, sending a copy of this information to the Receiving Office, the International Searching Authority, any Authorities specified for supplementary search, the International Preliminary Examining Authority and the designated (or elected) Offices concerned

11

## After tech-prep day but before 30-month date

Note that even if the completion of technical preparations for publication deadline is missed, the *92bis* request would still be processed by the IB (provided that it is received by the IB before the expiration of the 30-month time limit). The application would not be republished, but the applicant's address would be updated accordingly in PATENTSCOPE under the "Biblio. Data" tab of the international application concerned, and would thus be available to third parties.

(Saves you having to pay local counsel to do the changes.)

12

## After 30-month date

Any *92bis* request that is received by the IB after the 30-month time limit would not be recorded by the IB, and it would be up to the applicant to notify each designated or (elected) Office separately of the change.

## Why “actions” are best

ePCT actions under ePCT private services will be processed more quickly, accurately and efficiently than other methods of submitting *92bis* changes. Besides the obvious time-saving involved in sending this *92bis* request online direct to the IB, one advantage of using the relevant action in ePCT is that by using the web form provided, you are specifying the changes directly, which eliminates any risk of the IB misinterpreting or mistyping the change. Furthermore, as the action is done directly in the file of a particular international application, there is no risk of the information being applied to the wrong application file.

## Less good than “actions”

If an international application has not yet been published, and if you are not in a position to use the relevant action in ePCT private services, for example, if you do not have access to the application, and need to submit a *92bis* request urgently, the next best practice is to submit a letter via ePCT public services. For this, you need to create a WIPO account (a quick and simple procedure), but do not need to authenticate it with a digital certificate in order to access ePCT public services. The letter containing the *92bis* request would need to be converted to PDF format, and then uploaded to the international application concerned.

15

## If it gets suspended

When access to the contents of the international application via ePCT has been suspended, the “IA Status” column of the Workbench shows “access suspended”. If you try to view the contents of an international application in the “IA Number” tab while access is suspended, the international application will appear showing only the international filing date and the IA Status “Access suspended”. No other confidential data or documents will be available. Also, the only documents that will be visible in the File View are those which were previously uploaded by you.

16



# Why actions are best

ePCT pre-fills the bibliographic data relating to your international application, and the only thing you need to do is type in the new name or address of the applicant and sign it – there is no need to formulate a letter explaining the changes;

a number of online validations help you avoid embarrassment, for example, you are warned if the time limit under PCT Rule 92*bis* has expired or if the change will not be reflected in the international publication because technical preparations have already been completed.

17

# Supporting document

When using the ePCT Action, there is an option to attach a supporting document, which you can use in this case to attach a list of the other international application numbers for which the same change is requested (select “General correspondence” as the document type to be added). You can also type an optional informal message for the attention of the IB before submitting the change request; for example, you could mention that a list of international applications is attached for which the same change is requested.

You could attach a Power of Attorney.

18

# Nice video training

[https://multimedia.wipo.int/wipo/en/epct/epct\\_actions\\_r92bis.mp4](https://multimedia.wipo.int/wipo/en/epct/epct_actions_r92bis.mp4)



19

## Update access rights first

When recording changes under PCT Rule 92bis in respect of international applications to which applicants or agents have online access rights via ePCT, the recommended procedure is for one of the persons with “eOwner” access rights to the international application to modify, prior to the submission of the PCT Rule 92bis request, the ePCT access rights in the ePCT system in accordance with the transmittal of the request for change. For instance, in the case of a change of agent, the outgoing agent who has eOwner access rights in ePCT can already assign access rights to the new agent in the ePCT system, provided that the new agent has created an ePCT account, authenticated it with a digital certificate and concluded an eHandshake with the original agent.

20

## Who might require evidence?

For information on which Offices would require a copy of an assignment or any other evidence, please see the Summary of each National Chapter of the PCT Applicant's Guide, which lists the special requirements, if any, which must be complied with in connection with entry into the national phase.

21

## Getting extra signatures

Even though the requirement to submit a separate power of attorney may have been waived by the International Bureau, agents or common representatives should carefully consider whether they should in any case obtain the signatures of all applicants, either by way of signing a power of attorney or by way of signing the request. By obtaining those signatures, any withdrawal, which requires the signatures of all of the applicants or a power of attorney signed by all of the applicants, could be dealt with immediately, and delays caused by the need to obtain missing signatures would be avoided. Even if those signatures are not actually submitted by the agent/common representative to the International Bureau, but are merely kept in the file of the agent/common representative, at least they would be available if they were needed later.

22

## Further drawback of “upload” instead of “action”

Please note that if a Rule 92*bis* change is submitted via the Upload Documents Action, regardless of the type of change requested, online access will be automatically suspended pending processing at the IB. It is therefore preferable to use the Actions tab to submit a Rule 92*bis* change request.

23

## Suspension of access?

- Will suspend access:
  - Applicant or Agent: change of name, person and/or address will suspend access;
  - Inventor only (not also applicant): change of name and/or person will suspend access;
  - Deletion of Applicant, Inventor or Agent will suspend access.
- Will NOT suspend access:
  - Inventor only (not also applicant): change of address will NOT suspend access;
  - adding a new Party (regardless of the type) or submitting a request for change concerning only the nationality, residence, country of address, telephone or facsimile number, e-mail address, notification method, applicable designations, or the IA file reference will not result in online access being suspended.

24

# Starting the “action”

**ACTIONS**

Select Action

Action \*

25

# Selecting the “action”

**ACTIONS**

Select Action

- Amendments Under Article 19 [text format only]
- Create Power of Attorney
- Declarations under Rule 4.17
- Licensing Availability Request
- Make international application available to DAS
- Observations on close prior art
- Obtain priority document from DAS
- Online Payment
- Request for Early Publication
- Rule 92bis change request**
- Submit Chapter II Demand

26

# Saving you from embarrassment

## RULE 92BIS CHANGE REQUEST

**WARNING** Technical preparations for international publication are now complete. Changes recorded under Rule 92bis will not be taken into account for international publication.  
Check that any required powers of attorney are already on file or attach them below.

27

# Subject matter for *92bis*

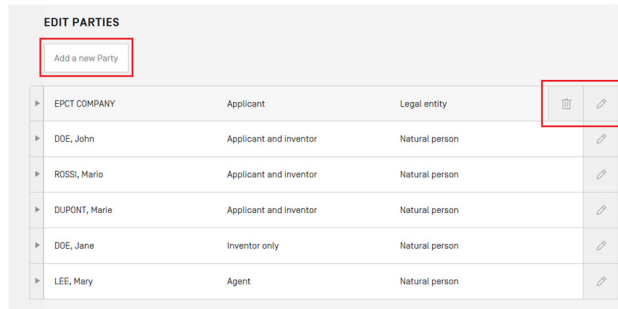
'Party' can be:

- an applicant
- an applicant/inventor
- an inventor only
- a common representative
- an agent
- an address for correspondence.

It is possible to request that a new party be added, or to edit or delete an existing Party.

28

# Adding a party, deleting, editing



The screenshot shows a web interface titled "EDIT PARTIES". At the top left, there is a button labeled "Add a new Party". Below this is a table with the following data:

▶	EPCT COMPANY	Applicant	Legal entity	🗑️ ✎️
▶	DOE, John	Applicant and inventor	Natural person	✎️
▶	ROSSI, Mario	Applicant and inventor	Natural person	✎️
▶	DUPONT, Marie	Applicant and inventor	Natural person	✎️
▶	DOE, Jane	Inventor only	Natural person	✎️
▶	LEE, Mary	Agent	Natural person	✎️

29

# Validations and warnings

- A validation checks that, taking into account the changes requested in the Action, an e-mail address will always be available for sending PCT forms to the addressee entitled to receive correspondence for the international application. As the IB no longer sends forms in paper format, it is mandatory to provide such an e-mail address.
- At the time you select to submit the Rule 92bis change request, you are warned if access will be suspended and can choose to 'Add another change' before continuing with the submission, which will then suspend access.

30

# The warning

**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. Please proceed with any further action before submitting this Rule 92bis request.





Cancel OK

31

# Editing/Replacing an existing Party

**EDIT PARTIES**

Add a new Party

▶ EPCT COMPANY	Applicant	Legal entity	
▶ DOE, John	Applicant and inventor	Natural person	 
▶ ROSSI, Mario	Applicant and inventor	Natural person	 Edit / Replace existing party

32



# Changing a name

Change in person

Party \*

- Applicant
- Applicant and inventor
- Inventor only
- Common Representative
- Agent
- Address for Correspondence

First Name \*

John

Data currently on file : John

Last Name \*

DOE

Data currently on file : DOE

33

# Indicating “deceased”

Change in person

Party \*

- Applicant
- Applicant and inventor
- Inventor only
- Common Representative
- Agent
- Address for Correspondence

First Name \*

Joseph

Data currently on file : Joseph

Last Name \*

BLACK

Data currently on file : BLACK

Data currently on file : Applicant

Address \*

1 Rue du Rhône  
1234 Lausanne

Deceased

Applicable Designations \*

- All
- Specific designations

Data currently on file : 1 Rue du Rhône  
1234 Lausanne

Data currently on file : All

Country \*

CH - Switzerland

Data currently on file : CH - Switzerland

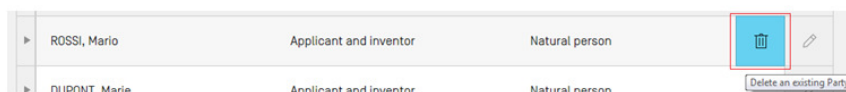
Cancel Confirm

34



Note that clicking on 'Confirm' does NOT submit the request to the IB - you must proceed to indicate a signature and use the 'Submit 92bis Change Request' button in order to complete the submission of the request under Rule 92bis.

35

## Requesting the deletion of a Party from the record






The screenshot shows a table with two rows of party information. The first row is for 'ROSSI, Mario', with roles 'Applicant and inventor' and 'Natural person'. The second row is for 'DUPONT, Marie', with roles 'Applicant and inventor' and 'Natural person'. On the right side of the table, there are two icons: a trash can icon and an edit icon. The trash can icon is highlighted with a red square, and a tooltip 'Delete an existing Party' is visible below it.

▶ ROSSI, Mario	Applicant and inventor	Natural person		
▶ DUPONT, Marie	Applicant and inventor	Natural person	Delete an existing Party	

36

## More about deleting a party

SAVED CHANGES [3]		
Party Applicant and inventor MICHEAL, John	Type Added	
Party Applicant and inventor DOE, John	Type Edited	
Party Applicant and inventor ROSSI, MARIO	Type Deleted	<a href="#">Click to preview 92bis request</a> 

[Click to preview 92bis request](#)

37

## Attaching a file and submitting the Rule 92bis request

Once you have entered all the changes required, you can optionally attach a document (in PDF format) to support your request, e.g., a power of attorney.

**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 92bis request?

[Add another change](#) [Submit 92bis Change Request](#)

38

# Preview of the request

ePCT Action: Rule 92bis change request	
IA Number:	PCT/B2017/080116
International Filing Date:	20 March 2017
File Reference:	MyRef-10987
Request Date:	
<b>Data requested to be added:</b>	
<input type="checkbox"/> the applicant <input type="checkbox"/> the inventor <input type="checkbox"/> the agent <input type="checkbox"/> the common representative <input checked="" type="checkbox"/> the applicant-inventor <input type="checkbox"/> the correspondence address	
<b>Type: Natural person</b>	
<input checked="" type="checkbox"/> Change in person	
<b>Applicable designations: All</b>	
Name and Address:	
ROSSI, Maria	
34, ch. des Colombettes	
1201 Geneva	
Switzerland	
Registration No	
State of Nationality: IT	State of Residence: CH
Telephone	Fax
Email maria.rossi@company.com	Notification method Paper and advance e-mail

39

## How to screw up a 26bis request

Hand it in too late ...

- Must be within 16 months of the existing oldest priority
- Must also be within 16 months of the proposed new priority
- Can also be within 4 months of the IA filing date

40

# Where to send a 26bis request

Maybe to the RO

Generally to the IB

41

# How we start a 26bis change

The screenshot shows a web interface for starting a 26bis change. It features a header 'ACTIONS' and a sub-section 'UPLOAD DOCUMENTS'. The form includes a 'Recipient \*' dropdown menu with 'IB' selected, a status bar showing 'Electronic routing method: ePCT Immediate access to IB' and 'Current date and time at recipient Office: Thursday, 15 June 2023, 00:23 CEST', a 'Document Type \*' dropdown menu with 'Correction or addition of priority claim [Rule 26bis.1]' selected, and an 'Attach document \*' field with an 'Add document [.pdf]' button.

42

# What happens next

The International Bureau shall promptly notify the applicant, the Receiving Office and the International Searching Authority of any correction or addition of a priority claim under Rule 26*bis* and of the date on which it received such correction or addition

43

# Four upcoming webinars

- Eighteen most frequently encountered forms from the Receiving Office
- Fourteen most frequently encountered forms from the International Bureau
- Nine most frequently encountered forms from the International Searching Authority
- Eight most frequently encountered forms from the International Preliminary Examining Authority

44

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45

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46

# Please complete the evaluation questionnaire

- Yes please complete it
- Pay it forward

47

# Thank you

48