PCT for US paralegals and patent agents
Presenter

Richard Garvey

- Key Account Manager
  EPO Munich

- At the EPO since 1998

- Formalities experience, Outward facing IT Projects, Key Account Manager

- Managing relationships between the EPO and customers
Elke von Brevern

- Expert in PCT Affairs Department
  EPO Munich
- At the EPO since 2008
- Paralegal at various Patent Attorney firms (Germany) (2000-2008)
- Formalities Officer (2008-2010), Online Filing Application Manager (2010-2015) at the EPO
- In the context of the PCT Affairs Department coordination of PCT-related projects implementation at the EPO
Presenter

Heli Manner

- Finance Expert in Revenue Controls
  EPO Munich
- At the EPO since 2011
- Extensive experience on project work involving development of EPO fee payment tools
Presenter

Michael Lindblom

- Key Account Manager
- EPO Berlin

- At the EPO since 1987. Has been working for DG1, DG2 and DG3, and with the e-products since 2002.

- Workflow implementation for the nordic countries and the UK
Agenda

- Introductions
- PCT procedure before the EPO as International Authority
- Overview of Electronic Interactions
- Filing, Receiving Communications, Fees, Monitoring Files,
- Paying Fees
- PCT Legal Updates
What does the PCT bring …
… to your patent filing strategy?

- **Keep control of your timing:**
  - use the multiplying effect in up to 153 States
  - All-designation system

- **Time gain** – from 12 m of the Paris Convention up to 30 / 31 months of the PCT

- **Cost and administrative efficiency:** **ONE** procedure in **ONE** language with **ONE** agent
How can the EPO support you …
… in your journey?

- You must be interested in … Europe
  - Where do you seek for patent protection?

- Quality is in our DNA!
  - same standard for both EP & PCT procedures

- Flowers in the Garden
  - More is possible!
EPO has planted many flowers … … in the PCT garden (1)

EPO as International Searching Authority

- PCT-CLAR and PCT Direct services
- Preliminary opinion in case of non-unity
- Info sheet on search strategy
EPO has planted many flowers …
… in the PCT garden (2)

EPO as International Preliminary Examination Authority

- top-up search

- 3-person Examination division endorsing the final product

- Increases your chances to get a grant at the EPO when entering the EP phase
You may export your invention ...  
... all over the world using PCT-PPH
Filing electronically at the EPO

- Filing at the EPO electronically within the legal framework
- PCT Demands, PCT SFDs
- Regional Phase
- e-filing options (eOLF, EPO web-based filing options)
- ePCT filing

https://www.epo.org/applying/online-services/online-filing-20.html
Secure Access to EPO Online Services

- Smart card: eOLF & Web-based
  
  - [https://www.epo.org/applying/online-services/online-filing/download.html](https://www.epo.org/applying/online-services/online-filing/download.html)

- Alternative Access: User id & Password (Web Form Filing & Fee Payment Service)
Potential to receive documents electronically

- EP Documents if you have a European presence with a European Representative / association / applicant filing on your behalf.

- PCT Documents if you have a European presence with a European Representative / association / applicant filing on your behalf.

- SP 2023 (looking at Electronic Communications for International Agents)

- WIPOs e-PCT....

- Register Alert
### Searching the EPO register

**SAFETY BRAKE FOR A COUNTERWEIGHT ACTIVATED BY A TENSION MEMBER**
- **Application No.** EP18306757
- **Publication No.** EP3670416
- **Applicant** Otis Elevator Company
- **Representative** Schmitt-Nilsson Schraud Waibel Wohlfart Patentanwälte Partnerschaft mbB
- **IPC** B66B5/12

**METHOD AND DEVICE FOR MONITORING CHAIN TENSION**
- **Application No.** EP18213959
- **Publication No.** EP3670419
- **Applicant** Otis Elevator Company
- **Representative** Schmitt-Nilsson Schraud Waibel Wohlfart Patentanwälte Partnerschaft mbB
- **IPC** B66B23/02
  - 01N5/04

**DEVICE AND METHOD FOR MONITORING AN ELEVATOR SYSTEM**
- **Application No.** EP19209794
- **Publication No.** EP3663248
- **Applicant** Otis Elevator Company
- **Representative** Schmitt-Nilsson Schraud Waibel Wohlfart Patentanwälte Partnerschaft mbB
- **IPC** B66B1/34
  - B66B9/00
  - B66B13/14
### Setting up an automatic notification

#### Search results

- **Refine search**
- **Export** (CSV | XLS)
- **Print**

**Sort by** Application No. **Sort order** ascending

**Add** results of current page to list of monitored applications

**Delete** results of current page from list of monitored applications

289 items found, displaying 1 to 20

**Search term(s):** applicant = Otis and filing-date = 2018

<table>
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<th>Application No.</th>
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<th>Representative</th>
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**SAFETY BRAKE FOR A COUNTERWEIGHT ACTIVATED BY A TENSION MEMBER**

**METHOD AND DEVICE FOR MONITORING CHAIN TENSION**

**DEVICE AND METHOD FOR MONITORING AN ELEVATOR SYSTEM**
### Setting up action notifications

#### Preferences

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<th>Notification</th>
<th>Monitoring Profiles</th>
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<th>Import and Export</th>
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</table>

Choose a profile to define the events you would like to be informed about.

**Profile:**
- Main events (Substantial procedural actions)

#### List of events

These comprise those actions which have a substantial influence on the status of the European patent application or the European patent insofar as the EPO is competent.

- A-publication
- Separate publication of search report
- Grant of patent (B1 publication)
- Patent maintained in amended form (B2 publication)
- Limitation of patent (B3 publication)
- Withdrawal by applicant
- Application deemed to be withdrawn
- Refusal of application
- Intention to grant a European patent
- No notice of opposition filed within time limit
- Filing of notice of opposition
- Rejection of opposition
- Revocation of patent in opposition proceedings
- Revocation of patent by the patent proprietor
- Closure of opposition proceedings
- Renewal fee paid
- Lapse of patent in a contracting state
- Licence

[Check all] [Check none]
Paying fees online at the EPO

| Deposit account at the EPO | ▪ Debit orders can be submitted via OLF 2.0, ePCT, CMS, OLF
  ▪ **Online Fee Payment**, including also batch payments and deposit account management |
| Credit card | ▪ Exclusively via the **online service for paying fees and claiming refunds** (SAP e-commerce) |
| Bank transfer | ▪ Via the **online service for paying fees and claiming refunds** (SAP e-commerce) |

Towards one centralised fee payment service (SAP e-commerce)
Features and benefits of Central Fee Payment Service

https://www.epo.org/fee-payment-service/en/login

- Service accessed with user ID and password, without smart card
- Display of fees due and time limits for a selected application
- Batch payments upload in csv or xml format
- Rejection of erroneous payments (double payments, closed applications etc.)
- Payment methods: credit card and preparation of bank transfer → deposit account coming end 2021
- Payment confirmation available in the service
Refunds at the EPO – two methods as from April 2019

Electronic refund instruction to deposit account

DEPA information coded automatically to the file

Refund credited to deposit account

No refund instructions provided

Two letters:
1) refund advice
2) refund code

Claim refund via online service to bank/deposit account
New Rule 82\textit{quarter.2} PCT (since 1 July 2020)

- Excuse of delays in meeting a time limit due to the \textit{unavailability of electronic means of communication}

- To be used by Offices in cases of \textit{unforeseen outages} or \textit{scheduled maintenance}

- \textbf{Safeguard} triggered by a notification submitted to WIPO (published on WIPO’s website)

- Does \textbf{not apply} to the priority period or to the time limit for entering the national phase
New WIPO Standard ST. 26 (sequence listings)

- Sequences of nucleotides or amino acids must be presented as a sequence listing in a given format

- Today, WIPO Standard ST.25 (text format)

- As of 1.1.2022, WIPO Standard ST. 26 (XML)

- Benefits: single sequence listing for int. and national phases + enhance accuracy and quality
New WIPO Standard ST. 26 (sequence listings)

- “big bang scenario”: all Offices to transition to ST. 26 on 1.1.2022; filing date as the reference date

- ST. 26 XML to be prepared with WIPO Sequence; V1.0.0 + User Manual available on WIPO website

- Interested in testing and reporting your feedback? Please write to standards@wipo.int
New Rules 20.5bis and 40bis PCT

- Legal basis for the **correction** of an erroneously filed element or part of the int. Application

- Correct element or part furnished for the purpose of **incorporation by reference or not**

- Applicable to any international application filed **on or after 1 July 2020**
Amended Rules 71 and 94 PCT

- Require that the **IPEA transmit copies** of certain documents in its file to WIPO

- Chapter 2 files made available by WIPO **to the public** on the elected Office's behalf

- Apply to any document received or established by the IPEA **on or after 1 July 2020**
Further questions

Now
via chat to "All Panelists"

Later
via e-mail to  
support@epo.org
international_pct_affairs@epo.org