

2022 Virtual PCT Training Seminar

Session 11

Understanding and Using the Five Kinds of PCT Declarations

Tuesday, March 8, 2022



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 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)

Helpful PCT Resources

- WIPO’s PCT Distance Learning Course
- WIPO video series (Matthias Reischle)
- WIPO’s PCT Applicant’s Guide
- The PCT listserv (email discussion group)
- PCT section of the *Ant-Like Persistence* blog

Helpful PCT Resources

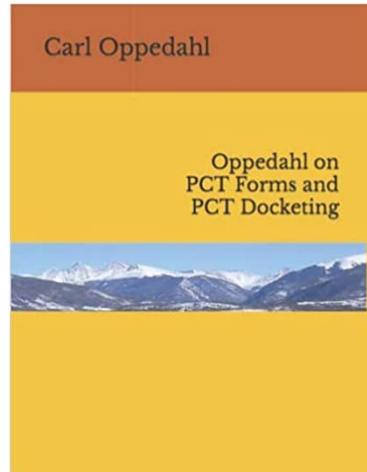
- WIPO's PCT Help Desk
 - +41 22 338 83 38
- USPTO's PCT Help Desk
 - +1 571 272 4300
- Make sure you are subscribed to WIPO's *PCT Newsletter*

Upcoming ePCT Webinars That I Will Be Presenting

- Intro to ePCT, why ePCT is important, getting a user ID and password, setting up 2FA
- Making sure your US priority documents are available to DAS, best practices for filing US priority documents, Certificates of Availability, setting up alerts
- Handshakes, eOwners, eEditors, eViewers, access rights groups, employee first day of work, employee last day of work
- Shared address books, collaborative workflow, sharing with clients, sharing with outside counsel
- Getting to know your ePCT workbench, portfolios, office profiles, cloning, ePCT actions
- Getting pending PCT applications into your workbench, going back to January 1, 2009, archiving old applications
- Filing a new US PCT application in RO/US using ePCT
- Filing a new US PCT application in RO/IB using ePCT
- ePCT actions and communications with the IB
- External signatures and PCT declarations
- Sequence listings and ePCT
- Using ePCT to e-file in ISAs and IPEAs, filing Demands
- Doing 92bis changes
- Docketing of PCT applications and making use of ePCT notifications
- Publication front page preview, generating reports of outstanding Forms ISA/202, generating reports of applications with outstanding priority documents

Don't want to miss them? Subscribe to the PCT listserv or subscribe to my blog (or both).

Helpful PCT Resources



- The fifty PCT forms that you are most likely to encounter
- Which dockets to set or clear when these forms arrive
- What dates and check boxes to check on the forms
- Warning signs that you can detect from the forms
- Order through your local bookstore
- Also available at shop.oppedahl.com
- Also available on Amazon
- ISBN-13 : 979-8766914655
- Paperback : 218 pages
- A bargain at USD 89

Knowing When and How to File PCT Declarations with a PCT Application

Five Kinds of Declarations

All must be filed by the 4-and-16 date if they are to be effective...

- Four months from the filing date, or
 - Sixteen months from the priority date,
- ... whichever is later.

(Really it is okay if you get them in by technical preparations for publication day.)

Practice Tip

Age the declarations by at least one day so that they will not count toward the extra-cost page count.

Five Kinds of PCT Declarations

1. Declaration as to the identity of the inventor
2. Declaration as to the applicant's entitlement, as at the international filing date, to apply for and be granted a patent
3. Declaration as to the applicant's entitlement, as at the international filing date, to claim priority of the earlier application
4. Declaration of inventorship (only for the purposes of the United States of America)
5. Declaration as to non-prejudicial disclosures or exceptions to lack of novelty

Why We Care about PCT Declarations

PCT declarations, especially declarations 2 and 3, can save us enormous amounts of time and energy when compared with authentications that might be required in some offices around the world.

Astonishingly, declarations 2 and 3 get filed in only about 1% of PCT applications.

Treatment by DO/Eos of Declarations 1, 2, 3, & 4

Where the request contains a declaration complying with Rule 4.17(i) to (iv), a designated Office may not (except if it has informed the International Bureau to the contrary) require any document or evidence relating to the subject matter of that declaration unless it reasonably doubts the veracity of the declaration concerned.

See Practical Advice, PCT Newsletter, September 2017

1. Declaration as to the Identity of the Inventor

Most Designated/Elected Offices require that the Applicant provide the identity of the inventor or inventors.

As a general matter you will have provided this information in your PCT Request.

If you did, then there is no need for PCT Declaration number 1.

Inventor names are not, however, required to get a PCT filing date.

Declaration 1 provides a way to hand in this information after filing.

See also Rule 92*bis*.

1. Declaration as to the Identity of the Inventor

It will be appreciated that by definition, you will not include PCT Declaration number 1 with the PCT application on filing day.

The assumption is that if you did not provide the inventor names and addresses on filing day, you will docket the 4-and-16 date and provide them using Declaration number 1.

Offices which Specifically Mention This Declaration #1

Name and address of the inventor if they have not been furnished in the
“Request” part of the international application:

AE, AZ, BB, BG, BH, BN, BW, BZ, CH, CL, CO, CR, DE, DJ, DK, DO, EA, EC, EG,
EP, FI, GB, GE, GT, HN, HU, IR, IS, JO, KH, KR, KW, LK, LU, MD, MG, MN,
MW, MY, NA, NG, NI, NO, OA, OM, PA, PE, PG, PH, PT, QA, RO, SA, SC, SD,
SE, SG, SK, SM, SV, TH, TT, TZ, VN, ZM

Offices which Specifically Mention This Declaration #1

Name of the inventor if this has not been indicated in the “Request” part of the
international application: AL, AU, CN, ES

Name, address **and nationality** of the inventor if they have not been furnished
in the “Request” part of the international application: IN

Discussion of Examples of PCT Declaration #1

2. Declaration as to the Applicants Entitlement, as at the International Filing Date, to Apply for and be Granted a Patent

This declaration does not apply to situations where the applicant's entitlement was acquired only ***after the international filing date***.

Note that this does not apply in the simple case where the inventor and applicant are the same person.

In general, the triggering event is that the applicant is not the same as the inventor or inventors.

In some Offices a triggering event is that the applicant is not a natural person.

2. Declaration as to the Applicants Entitlement, as at the International Filing Date, to Apply for and be Granted a Patent

The filer who fails to satisfy an Office by means of this Declaration may need to carry out a legalization or authentication.

Notarization, authentication, consulate.

Many courier packages.

Many fees.

2. Declaration as to the Applicants Entitlement, as at the International Filing Date, to Apply for and be Granted a Patent

This declaration might be provided on PCT filing day.

This declaration might be provided later, so long as it is provided by the 4-and-16 date.

If you provide it at least one day later, this saves money on extra-page fees.

Designated/Elected Offices which Specifically Mention This Declaration #2

AL: If someone, other than the inventor, applies for a patent, the application shall contain a declaration indicating the applicant's right to the invention. Any document relating to any transfer or assignment of the right to the application.

Statement or notice as to the applicant's entitlement to apply for and be granted a patent: AU, BN, CL, DE, DJ, DO, GT, HN, JO, KH, IR, KW, MX, NI, PA, PE, SA, SK, TH

Declaration justifying the applicant's right to a patent if he is not the inventor: AZ, BB, BH, BW, BZ, GH, LK, NA, OM, MW, MY, PG, PL, RO, RS, SC, TR, TT, ZM

Designated/Elected Offices which Specifically Mention This Declaration #2

CA: If the applicant is not the inventor, either a declaration that the applicant is the legal representative of the inventor or a declaration as to the applicant's entitlement to apply for and be granted a patent in accordance with PCT Rule 4.17.

CR: Instrument of assignment or transfer of the right to the application

Instrument of assignment or transfer where the applicant is not the inventor: CU, CZ, IN, LS, MZ, VN

Designated/Elected Offices which Specifically Mention This Declaration #2

EE: Declaration concerning the right of the applicant to apply for a patent where the applicant is not an inventor **or where the applicant is a legal entity**

Statement justifying the applicant's right to the invention where **the applicant is not** the inventor or **the only inventor**: FI, SM

GE: Deed of transfer where the applicant is not the inventor

Designated/Elected Offices which Specifically Mention This Declaration #2

IS: If the applicant is someone other than the inventor, the application must state how the applicant acquired title to the invention

MD: Any document relating to any transfer of rights

MG: Deed of assignment or declaration concerning the inventor and the right of the applicant to apply for a patent

MN: Assignment deed where the applicant is not the inventor

Designated/Elected Offices which Specifically Mention This Declaration #2

NO: If someone other than the inventor applies for a patent, the application shall contain a declaration from the applicant stating his right to the invention, or a deed of transfer

PH: Instrument of assignment of the international application if the applicant is not the inventor

PT: Deed of assignment or transfer if the applicant is not the inventor

ZA: Proof of assignment or transfer of rights where the applicant is not the inventor



Discussion of Examples of PCT Declaration #2

3. Declaration as to the Applicant's Entitlement, as at the International Filing Date, to Claim Priority of the Earlier Application

This declaration does not apply to situations where the applicant' entitlement was acquired ***only after the international filing date.***

What we are talking about is situations where the PCT applicant is not the applicant who filed the earlier application, or where the PCT applicant's name has changed since the date on which the earlier application was filed.

3. Declaration as to the Applicant's Entitlement, as at the International Filing Date, to Claim Priority of the Earlier Application

The main point here is Article 4 of the Paris Convention

“Same applicant or successor in title”

Some Offices which take the view that the entitlement needs to have been satisfied chronologically prior to filing the second application (here, the PCT application)

Examples: Europe, UK, Japan

Preparation and filing of Declaration number 3 will prompt the practitioner to think about “same applicant or successor in title” issue

3. Declaration as to the Applicant's Entitlement, as at the International Filing Date, to Claim Priority of the Earlier Application

Think of any US case filed prior to September 16, 2012.

Think of US cases filed on or after September 16, 2012 where the filer did not establish a non-inventor applicant.

Think of a US provisional that was filed with a provisional cover sheet (and not an ADS).

Joint development agreements.

This declaration number 3 is not relevant to an application that lacks a priority claim.



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3. Declaration as to the Applicant's Entitlement, as at the International Filing Date, to Claim Priority of the Earlier Application

Note that some Offices use the terminology of assignment of “the priority application” and others use the terminology of “the right of priority”.



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3. Declaration as to the Applicant's Entitlement, as at the International Filing Date, to Claim Priority of the Earlier Application

The filer who fails to satisfy an Office by means of this Declaration may need to carry out a legalization or authentication.

Notarization, authentication, consulate.

Many courier packages.

Many fees.

3. Declaration as to the Applicant's Entitlement, as at the International Filing Date, to Claim Priority of the Earlier Application

This declaration might be provided on PCT filing day.

This declaration might be provided later, so long as it is provided by the 4-and-16 date.

If you provide it at least one day later, this saves money on extra-page fees.

Designated/Elected Offices Specifically Mentioning Declaration #3:

Assignment deed of the priority right where the applicants are not identical:

AP, BG, BY, CN, CU, CZ, EA, EC, ES, KG, KZ, LU, MD, OA, PH, TJ, TM, UA, UZ, VN

Statement or notice as to the applicant's entitlement to claim priority of the earlier application: AU, CL, DJ, DO, GT, HN, KW, MG, MK, NI, PA, PE, PL, SA, SK, SM, TR

BN: Evidence of entitlement to claim priority of earlier application.

Designated/Elected Offices Specifically Mentioning Declaration #3:

Evidence of entitlement to claim priority where the applicant is not the applicant who filed the earlier application: CR, JO, KH, MY, NA, PG, SC, ZA, ZM

SAOSIT

We emphasize that if the filer faces a potential SAOSIT problem, it is ***never*** the case that a PCT Declaration Number 3 will, by itself, fix the potential SAOSIT problem.

It will always be the case that some ***other activity***, such as an Assignment executed prior to the filing of the PCT application, will be needed to fix the potential SAOSIT problem.

Discussion of Examples of PCT Declaration #3

4. Declaration of Inventorship (Only for the Purposes of the United States of America)

This is the direct counterpart to Form AIA/01, declaration of inventorship.

For a US practitioner whose first contact with a PCT application is entry into the US national phase, the chief significance is that foreign counsel may have already attended to this PCT Declaration number 4.

Before preparing Form AIA/01, check Patentscope or ePCT to see whether foreign counsel already obtained signatures on Declaration number 4.

Postponing the Filing of PCT Declaration #4

This can save extra-page fees.

Discussion of Examples of PCT Declaration #4

5. Declaration as to Non-Prejudicial Disclosures or Exceptions to Lack of Novelty

Examples are disclosures resulting from abuse, disclosures at certain exhibitions and disclosures by the applicant during a certain period of time.

Designated/Elected Offices Specifically Mentioning Declaration #5:

CR (Costa Rica): Evidence concerning non-prejudicial disclosures or exceptions to lack of novelty, such as disclosures resulting from abuse, disclosures at certain exhibitions and disclosures by the applicant during a certain period of time.

OM (Oman): Declaration concerning non-prejudicial disclosures or exceptions to lack of novelty, such as disclosures resulting from abuse, disclosures at certain exhibitions and disclosures by the applicant during a certain period of time.

Designated/Elected Offices Specifically Mentioning Declaration #5:

SK (Slovakia): Declaration as to non-prejudicial disclosures or exceptions to lack of novelty.

Best practice: Consult competent counsel in any of these three jurisdictions well before the end of the 4-and-16 time period to determine language to be used in Declaration number 5.

Postponing the Filing of PCT Declaration #5

This can save extra-page fees.

Discussion of Examples of PCT Declaration #5

Possible Live Demo of ePCT with PCT Declarations

Possible Lookup in Patentscope of Real Cases with PCT Declarations

What Lies Ahead?

- 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!

