



How to best utilize PCT declarations

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What we will cover....



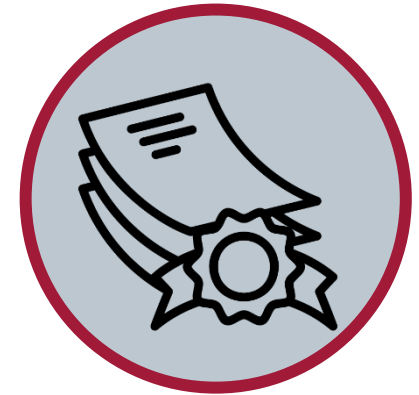
What



Why



How



Effect

Poll questions



Types of declarations under Rule 4.17

- Identity of the inventor
- Applicant's entitlement to apply for and be granted a patent
- Applicant's entitlement to claim priority of an earlier application
- Declaration as to inventorship (for the US designation only)
- Non-prejudicial disclosures or exceptions to lack of novelty

Why use declarations (1)?

- Purpose: anticipate national phase requirements during the international phase (Rule 51*bis*.2)
 - Avoid having to provide (certified) copies of certain documents (e.g. assignment documents) in the national phase
 - Avoid having to obtain signatures of inventors at national phase entry time
- Declarations are optional

Why use declarations (2)?

- No documents or evidence as to that matter required by the designated/elected Office unless:
 - that Office may reasonably doubt the veracity of the declaration; and/or
 - evidence concerning non-prejudicial disclosures or exceptions to lack of novelty required

Formal requirements

- Must use standardized wording (Sections 211 to 215 of the Administrative Instructions)
 - Automatically contained in e-filing software
- Pick and choose the elements of declaration as needed
- Don't declare something that is not true!
- Signature requirements

Declaration of inventorship (Rule 4.17(iv)) (for US designation only)


- Name all inventors in one declaration
- All inventors must sign and date
- Signatures may appear on different copies of the same complete declaration
- Signature does not have to be an original (fax copy)
- DO/US accepts a seal as signature when the international application is filed with receiving Offices which accept seals as signatures

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Addition/correction of declarations (Rule 26*ter*)

- Filed with International Bureau
- Time limit: 16 months from the priority date (additional time if received by the International Bureau before the technical preparations for international publication have been completed)
- The receiving Office or International Bureau may invite the applicant to correct any defective declaration
- No provision to withdraw declarations

Publication of declarations

- Mentioned on the front page of the international application
- The full text of the declarations will be published as part of the international application

(12) INTERNATIONAL APPLICATION PUBLISHED UNDER THE PATENT COOPERATION TREATY (PCT)

(19) World Intellectual Property Organization
International Bureau

(43) International Publication Date
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29 April 2020 (29.04.2020)

(25) Filing Language: English

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(81) Designated States (unless otherwise indicated, for every kind of national protection available): AE, AG, AL, AM, AO, AT, AU, AZ, BA, BB, BG, BH, BN, BR, BW, BY, BZ, CA, CH, CL, CN, CO, CR, CU, CZ, DE, DJ, DK, DM, DO, DZ, EC, EE, EG, ES, FI, GB, GD, GE, GH, GM, GT, HN, HR, HU, ID, IL, IN, IR, IS, JO, JP, KE, KG, KH, KN, KP, KR, KW, KZ, LA, LC, LK, LR, LS, LU, LY, MA, MD, ME, MG, MK, MN, MW, MX, MY, MZ, NA, NG, NI, NO, NZ, OM, PA, PE, PG, PH, PL, PT, QA, RO, RS, RU, RW, SA, SC, SD, SE, SG, SK, SL, ST, SV, SY, TH, TJ, TM, TN, TR, TT, TZ, UA, UG, US, UZ, VC, VN, WS, ZA, ZM, ZW.

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Declarations under Rule 4.17:

- as to the identity of the inventor (Rule 4.17(ii))
- as to the applicant's entitlement to claim the priority of the earlier application (Rule 4.17(iii))
- of inventorship (Rule 4.17(iv))

Published:

- with international search report (Art. 21(3))
- in black and white; the international application as filed contained color or greyscale and is available for download from PATENTSCOPE

(54) Title: INTELLIGENT LOCKS AND KEYS

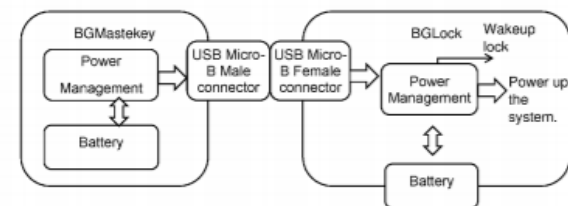


Fig. 8

(57) Abstract: An electronic lock comprises a controller which is a lock controller, an electromechanical lock mechanism operable between a locked state and an unlocked state and controlled by the controller, a wireless data transceiver and a key interface; and an electronic key for operation of the lock is disclosed. The key interface comprises a plurality of physical terminals including an identification terminal and a pair of data terminals. The controller is configured to change to perform subsequent data communication via the wireless transceiver after completion of the initial data communication.

WO 2021/116780 A1

Additional pointers

- Don't use national forms in the international phase (e.g., a combined declaration of inventorship/power of attorney) since they lack standardized wording
- No further page fee would be required if furnished after filing
- If a defective declaration is not corrected during the international phase:
 - does not affect the processing of the declaration by the International Bureau
 - DOs/EOs may accept defective declaration
- Declarations can also be furnished directly to DO/EOs

Effect in the national phase (1)

- Certain special requirements of DO/EOs will have been anticipated, e.g.:

- ☐ US oath or declaration of inventorship
- ☐ Assignment documents

- Conditions:

- ☐ timely and formally correctly submitted
- ☐ DO/EO does not reasonably doubt the veracity of the declarations

Effect in the national phase (2)

■ However, if DO/EO nevertheless requests further evidence:

- ❑ Confirm with local agent that the Office has refused the declaration
- ❑ Push-back against request, if possible
- ❑ Bring cases to the attention of the International Bureau

Poll answers



Questions?



PCT Resources

■ General questions about the PCT

□ Contact the PCT Information Service:

Telephone: +41 22 338 83 38

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■ Questions about the ePCT

□ Contact PCT eServices Help Desk:

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