How to best utilize PCT declarations

WIPO PCT Webinar Series

Session 3

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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 51bis.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 26ter)

- 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
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
    E-mail: pct.infoline@wipo.int

■ Questions about the ePCT
  - Contact PCT eServices Help Desk:
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