Declarations under PCT Rule 4.17

16 & 18 July 2024

Q&A Report

No.	Questions	Answers
I.	I. General Issues about Declarations	
1	Are declarations mandatory for future PCT filings via ePCT?	No, the declarations are not mandatory in PCT applications. It is optional for applicant to submit declarations.
2	I have filed a first PCT international application. Do I now have to file declarations?	
3	Can I submit corrected declaration after the PCT application is published?	The time limit for correcting or adding a declaration is 16 months from the priority date. Any correction or addition which is received by the International Bureau after that time limit is considered to have been received on the last day of the time limit, if it reaches the International Bureau before the technical preparations for international publication have been completed. See <u>PCT Rule 26<i>ter</i>.1</u> .
4	How can I change the declaration that I made before? It is still within 16 months from priority date. I added my own wording and a wrong file which is not necessary, I am the applicant and the inventor.	Please submit a corrected declaration to IB to replace the defective one. A corrected version of the declaration can be submitted to the IB within the time limit under <u>PCT Rule 26ter.1</u> . You can use ePCT <u>Action – Declarations under Rule 4.17</u> to prepare and submit the declaration, or if you have a corrected PDF version yourself, simply use the <u>Upload</u>
5	How does one correct a declaration? If a Declaration as to applicant's entitlement to apply for and be granted a patent was filed but the date was entered incorrectly for the assignment date of an assignee, what step(s) are needed to correct that? Does a new declaration with the correct date need to be filed?	Document function to submit it to the application through ePCT.

6	If I mistakenly indicated the inventor in the PCT application only as "inventor" and not as "inventor and applicant", could I correct this mistake with a Declaration 4.17?	No, this should be corrected by filing a request for change under <u>PCT Rule 92<i>bis</i></u> to change the status from "inventor only" to "applicant and inventor".
7	When the applicants have different % of the patent, can this be specified in a specific declaration?	That is not provided by the PCT during the international phase, be it in declarations or otherwise. If, however, the standardized wording, meant for standard situations, does not fit, then the declaration should not be used but the unusual situation would need to be explained and possibly evidenced in the national phase.
8	If I have not used ePCT for the declarations, but submitted in the format prescribed, and signed and uploaded will it be accepted?	If they are submitted in the prescribed format and standardized wording according to the Administrative Instructions, Sections 211-215 within the time limit, they will be accepted. The use of ePCT is not mandatory, but highly recommended for ensuring efficiency and correctness.
9	Is there an advantage in filing a declaration after the 16M time limit?	There is no advantage of filing declarations at the time of filing or after filing within the time limit, except that at the time of filing, declarations are counted as part of the RO/101 and if the application page counts over 30 pages, you will need to pay a fee for each extra page. Declarations filed after filing are not subject to a fee.
		If it's after the completion of technical preparations for publication, you can submit the declarations directly to the designated Offices at the time of national phase entry. It should still have the same effect, that the designated Office should not ask you for evidence unless they doubt the veracity of the declaration.
10	What does it mean to "return [] to the applicant" a defective Declaration of Inventorship? Does that practice of return apply to such Declarations filed via ePCT?	This applies to the situation where a hard original copy of declaration of inventorship with the inventor(s)' signature(s) is sent to the IB. When using ePCT, as the declaration is in electronic form and accessible by using your WIPO Account, there is no such a "return the original copy" procedure.
11	How can I see in ePCT whether a Declaration has been submitted? If it is not provided in the Request.	In order to check the documents including declarations in ePCT, you need to have access rights to the application concerned.
Ш.	Declaration (ii) and (iii)	
12	In the case of inventors assign their rights to research center (= employer) and the research center to the filing company (headquarter) by intra group contract, which kind of declaration is to be used?	In this case, declaration (ii) "applicant's entitlement to apply for and be granted a patent" can be used.
13	If the applicant for the PCT the same as for the priority application, would you need to choose (ii) and (iii) or just (iii)?	The declaration (iii) is useful to state the applicant's entitlement when the applicant of the PCT application is different with the applicant of the earlier application.

		Whether you need a declaration (ii) depends on your case, for example, if the applicant is a legal entity, you can submit a declaration (ii) to state why the applicant is entitled to apply for and be granted the patent under the PCT application, such as, declaring that all inventors are employees of the legal entity.
14	Generally speaking, is more weight given to declarations (ii) and (iii) based on the assertion used (i.e., by way of assignment vs. employment obligations, etc.), or are they treated essentially the same by countries when entering the national stage?	Declarations must simply be accepted if they comply with the standardized wording and if the designated Office has no reasonable doubt as to the veracity of the declaration. There is nothing more "weigh" or less.
15	In cases where PCT applicant is different than priority Applicant, and where rights were transferred between companies, such as inventors assign to Company A (Applicant in Priority), and prior to international filing, Company A assigns to Company B, how to proceed with declaration, if Company A will not be listed in request?	There is an option "Other(specify)" for you to indicate a third party who is not listed in the request.
16	 Please would you demonstrate how best to complete the declaration ii) entitlement to apply for and be granted in the following situation: Where the inventor is employed by an entity (non-applicant - X) and there is an agreement between their employer and the Applicant Y. So X is entitled by virtue of employment of inventor and there is an agreement between employer X and applicant Y. 	
17	Will there be a feature update so that declarations 2 and 3 can be filled out at the same time when relying on the same assignment? The names and dates are the same and it's very time consuming when there are many inventors, whereas an option like "these details also apply to declaration 3" would cut down on the manual data entry.	While declaration (ii) and (iii) are different and need to be prepared separately even though the same matter (e.g. same assignment) applies, there are ongoing discussions at the IB about simplifying the steps of declaration (ii) and (iii) when multiple applicants and/or inventors are involved, for example when the same assignment is concerned, to allow selecting multiple parties in one step under the same priority and the same matter. You will be notified by us once any update is done in ePCT.
18	Declarations related to a priority and assignment are complicated, particularly when having multiple applicants, requiring the same info too many times. Is it planned to simplify the cascade-menu?	
19	What is the difference between "Agreement" and "Assignment"?	It depends on the national law. Generally, an agreement is a mutual understanding between two or more parties regarding their rights and responsibilities. Assignment, on the other hand, concerns the transfer of rights from one party to another. Under Rule 4.17(ii) and the

		Administrative Instructions Section 212, the applicant is expected to use the agreement or assignment to describe the type of contract between the parties.
20	Does "events prior to the filing date" mentioned throughout the presentation, e.g., dates of assignment, include the PCT filing date itself?	Yes, "events prior to the filing date" regarding declarations (ii) and (iii) include those occurred before, or on, the international filing date.
21	In Declaration (ii), can a document containing the original signature of the inventor be uploaded, or is it not recommended nor mandatory?	The signature is not required for declaration (ii) and can be omitted. The IB would not consider the (superfluous) signature as defect as long as the standard wording is fine.
22	If you have an assignment of the priority application to the applicant, do you also need an assignment of the IA, signed before filing of the IA, in order to file the declaration of entitlement, or is the assignment of the priority application acceptable on its own?	The assignment of the earlier application/priority is sufficient for the applicant to file the declaration (iii).
		Regarding the declaration (ii), it depends on the provisions of the assignment. If all rights relating to the same invention in the earlier application/priority have been transferred to the applicant according to the assignment, there is no need to have another assignment for the PCT application.
23	I believe you can use a Declaration in the PCT to avoid having to provide a certified assignment copy to India for the Indian National Phase. Which declaration would I use so that we can avoid having to do this?	If the assignment was executed prior to filing the PCT application, then you can typically use declaration (ii) and (iii), depending on the entitlement you wish to declare, not limited to India.
24	Is there a way to determine which states will accept a 4.17(ii) declaration in lieu of furnishing assignment at national entry?	All contracting States are bound by the provisions relating to the declaration. There are no reservations or notifications of incompatibility left. They were all withdrawn in the last two decades.
25	I filed PCT applications with completed declarations (ii) and (iii), but some designated countries still want a separate assignment signed by inventors. Why?	They should not. I suggest you check with the local agent whether it is really the Office that requests it or only the local agent. Should it really be the Office, please sent us (<u>PCT Infoline</u>) the number of the case and preferably also related correspondence for further assistance.
III.	Declaration (iv): Inventorship for US Designation	
26	When it comes to Declaration (iv) "Declaration of inventorship (only for purposes of the designation of the US), what are the advantages of filing the executed declaration during international phase?	In the national phase, inventors may be difficult to be reached (they may have moved to a different country or company). It is advantageous to have their signatures on file at an earlier stage.
27	Do USPTO Substitute Statements (AIA/02) when inventor is unreachable or refuses to sign go to section (iv)?	Yes. Substitute statements (PTO/AIA/02) may be executed with respect to an inventor whose signature cannot be obtained on a declaration. For example, where the inventor is deceased, legally incapacitated, cannot be found or reached after diligent effort, or refuses to execute.

28	If a declaration of inventorship is considered to be received outside the time limit, does it mean it will not be acceptable by US Patent Office during national phase entry?	Even if the applicant missed the time limit to add/correct declarations during the International Phase, they can still submit it during the national phase entry.
29	For use of Dec (iv), can this be done at the same time as filing and the inventor sign after filing of the application? Or must it be completed by the inventor before filing the PCT?	All declarations can be submitted at the time of filing or after filing. If a declaration (iv) is prepared in PDF format, it can be submitted at the time of filing without the inventor's signature. However, it leads to additional fees if the total pages go over 30. A notification will also be issued requesting a correction of the declaration. If you use ePCT to prepare a declaration (iv) at the time of filing, the inventor's signature should be collected before submitting the application – missing this signature will prevent you from filing the application.
30	Where to put application no. in declaration 4.17(iv) after filing application.	There is a dedicated field to enter the application number, in the 4 th paragraph of the standardized wording of the Administrative Instructions, Section 214, as follows: "This declaration is directed to international application No. PCT/ (if furnishing declaration pursuant to <u>Rule 26<i>ter</i></u>)."
31	When preparing Declaration (iv) one by one, are all the inventors listed in the declaration when downloading the prepared declaration?	Yes, when using ePCT, all inventors' information will be included by default in the draft declaration (iv) that you can download even if you only selected/prepared and collected one inventor's signature.
32	It would be nice to be able to add all inventors simultaneously in the declaration of inventorship.	It's possible to add all inventors simultaneously in Declaration (i) "Identity of the inventor". However, for Declaration (iv) "Inventorship", each inventor should be added separately to first verify the bibliographic data which are uploaded by the system (e.g., name, address, etc.). Secondly, this declaration should be signed and dated by each inventor and different signature types may be selected (text string signature, image signature or using the external signature function). Therefore, the inventors should be added one by one.
33	Is a properly executed USPTO Declaration form acceptable to upload?	For the PCT procedure during the international phase, normally the PCT declaration should be used. However, it is up to the DO/US whether to ultimately accept a US national form
34	Is the USPTO form Declaration (37 CFR 1.63) For Utility or Design Application Using an Application Data Sheet (37 CFR 1.76) AIA/01 suffice to file with the PCT?	during the national phase. If it is furnished at the time of national phase entry, the US form may be used.
35	Can I upload my own version of a Combined Declaration/Assignment with the proper wording to satisfy Declaration IV?	Declaration (iv) must be worded according to the Administrative Instructions, Section 214. A combined Declaration/Assignment does not comply with this requirement. The IB nevertheless will record it as declaration (iv), but issue IB/370 to notify the applicant that the standardized working is not used, and the applicant can correct it.

36	Can we upload the declaration (iv) in PDF format also when preparing the declaration after filing?	Yes, you can use the <u>Upload Document function</u> in ePCT to upload the properly signed declaration (iv) in PDF format, preferably together with a cover letter indicating the purpose of the submission.
37	If we are unable to send the declaration (for US) for signature through ePCT but instead must send the PDF to inventors for signature, how do we properly incorporate it into our ePCT submission?	If you prepare a declaration (iv) in PDF format, you can use the <u>Upload Document function</u> in ePCT to submit it.
38	Regarding the suggestion that the editable PDF be used for a separate wet-ink signature on Declaration (iv), does that editable PDF have any connection to ePCT, whereby fields of the PDF would be automatically populated from bibliographic information already entered into the International Application?	No, the editable PDF form has no connection with ePCT and needs to be filled in manually. However, it can then be submitted via ePCT using the <u>Upload Document function</u> .
39	In the US, if the attorney uses their own declarations, such as, a WORD doc where the inventor hand signs and returns to us, instead of the declaration (iv) option to send out declarations. Which we normally file as a separate document but have received rejections of our declarations, because we didn't use any of the declaration choices in ePCT. Which option should the attorney be selecting to keep using their own WORD doc and does ePCT count the pages?	If you file declarations after filing, no page count for fees will be applied. If you do not wish to use the ePCT Action, you can use the <u>Upload Document function</u> to submit your declarations in PDF format. As long as the wording and format (including necessary name, address, application number, signature, etc.) comply with the Administrative Instructions, Sections 211 to 215, the declaration will be accepted.
40	What is the purpose of the declarations of inventorship (US only) duly filled in and signed by the inventor to the IB, if entering the US national phase is needed to file one more time the signed assignment in order to provide evidence of assignment of rights to the applicant?	Depending on your case, after submitting declaration (ii) and/or (iii), normally the designated Office(s) should not request the relevant assignment. However, the declaration (iv) is for the inventorship, and it does not replace any assignment when it is needed in the US. It replaces only the US oath/declaration.
41	If I submit a Declaration (iv), would our US agent still need a separate assignment? Or would the declaration be sufficient and is it no longer necessary to submit any documents at the USPTO during the national phase?	In addition, we recommend filing declaration (iv) during the international phase as a good practice because inventors may not be reachable after some time. Also, the declaration become visible on the PATENTSCOPE to inform third parties.
42	For the Dec (iv), is it required that inventors date the dec even though the date is optional on USPTO declarations form?	Yes, the declaration (iv) under PCT Rule 4.17 should be signed and dated by all inventors.

43	In the US, the Declaration does not require address of citizenship of inventor if the 371c application is filed with an Application Data Sheet. Why does the PCT require this information on the Declaration of inventorship?	Declaration (iv), the declaration of inventorship, does not require the nationality of the inventor(s). The indication of a country here refers only to the residence and mailing address. The residence (city and either US state, if applicable, or country) and mailing address (this could be also the address of a company) are required by the standard wording as defined in Section 214 of the Administrative Instructions under the PCT, see https://www.wipo.int/pct/en/texts/ai/s214.html . The USPTO has informed us that the US Oath/Declaration is designed to be filed with the ADS. However, since the ADS (while recommended) is not required for PCT national phase entry, they require the relevant information to be included in declarations (iv) made under PCT Rule 4.17.
44	Why does the PCT require the residence and mailing address when the US does not (as long as the information is provided on the Application Data Sheet)?	
45	When the Declaration needs the inventor address, can we use the company address or do we need the actual address of the inventors?	The PCT (Rule 4) does not require that the inventor's address be a home address. It is good practice and very common to indicate the company's address instead of the private one.
46	If a declaration is subsequently filed. Are electronic signatures (such as Docusign) accepted?	The IB treats DocuSign as an image signature (image signatures are accepted under Annex F of the Administrative Instructions). In the Fall we intend to have a Practical Advice in the PCT Newsletter about signatures.
47	If you didn't get all signatures and have to delete a request for filing, will a 'full set' declaration be filed if you add the other inventors decl after filing? Will it just add to the existing decl?	Inventors can sign different "full sets" (for ex. if they are not in the same location). But when they sign, they should have a full set, meaning a copy listing all other inventors. In other words, the full set should list all inventors, even if all signatures are not on it. It is possible to submit a declaration (iv) at the time of filing even if some inventors' signatures
48	What if you get some signatures on the PCT Request and then later get signatures on the PDF form. How do you submit a "full set"?	are missing. You can then provide another declaration (iv) at the time of hing even it some inventors' signature previously missing so to make this declaration complete. Each of these two declaration (iv) should list all inventors and is considered as "a complete(/full) declaration" even though the are two different copies of the complete declaration (iv).
49	I filed an incomplete 4.17(iv) declaration without all of the inventors' signatures with the intention of filing the final signature when received. Consequently, I received a defect notice, does this invalidate the declaration?	You can submit another copy of the declaration (iv) bearing the signatures of all inventors to replace the incomplete declaration (iv) on file, or submit another copy including the signatures previously missing to supplement the filed one so to make it a complete declaration (iv).
50	Regarding the Declaration (iv) "Declaration of inventorship (only for purposes of the designation of the US), would it be acceptable if it is filed in a different language (other than English)? Would the USPTO require a translation during the National Phase?	The declarations provided during the international phase should be in the language of the application. The DO/US has agreed to accept the standardized Declaration (iv) in any language for national phase entry. Alternatively, you can prepare it in English and file the declaration directly with the DO/US at the time of national phase entry.
51	Do you know if a simple translation would be sufficient, or a signed Declaration of the Translator is required?	

52	Does the Declaration of inventorship (iv) can be beneficial for other countries except the US?	The wording of the Declaration of inventorship (iv) is specifically made for the purpose of the designation of the US (Administrative Instructions, Section 214). We are aware that DO/IN also recognizes this declaration (iv).
53	What will happened if I submit the declaration with one of the inventor's name spell slight wrong? If I did not realize this mistake because that was the name that the inventor used. Will it affect any litigation result?	The name of the inventor in the declaration (iv) for inventorship for the designation of US should be the same name indicated in the request form. If it's spelt slightly wrong, then a corrected version of the declaration should be submitted to the IB. If the name is also incorrect in the request form, then a request under <u>PCT Rule 92<i>bis</i></u> should be submitted to the IB to correct the inventor's name.
IV.	Declaration (iv): Inventorship for US Designation - Extern	al Signature Function
54	Is the external signature function now available for declarations of inventorship (iv) filed after the international application has been filed? This was not formerly the case. If so, this is a good improvement.	The external signature function is available in ePCT when preparing declaration (iv) regardless of whether it is at the time of filing or after filing.
55	Regarding external signatures: From which WIPO-email- address will the automatic request for signature be sent to the inventors? (Maybe some clients must add that email address to a whitelist, to prevent spam-blocking)	The email address sending the external signature request is epct-noreply@wipo.int
56	As an Agent, it would be useful to be able to type a message to the client to explain that the Inventor needs to sign, and it is a legitimate email from WIPO. Could there be a free text in the email to potentially add some instruction?	Thank you for your suggestion. As the declaration to be signed should be made available to the inventor by you outside of ePCT, for example via a separate email, we suggest that you inform the inventor in your email that he/she will receive an email from epct-noreply@wipo.int (WIPO) with any instructions you would like to add. Meanwhile, we pass your comment to our development team for evaluation.
57	If you don't have inventor email addresses, can you still use ePCT to generate the Declaration of Inventorship for the US and send a PDF copy to the main contact to forward on to the inventors?	The inventor's email address is not mandatory unless an external signature is requested. You can prepare the declaration in PDF format and send it to the inventor for signing, which is perfectly acceptable.
58	Can all the declarations (iv) for external signature be sent to one email address (i.e. the applicant's email)?	The inventor should receive the external signature request in their own email address. Nevertheless, technically, it's possible to send all requests to one email address and then forward to different inventors.
59	Is it possible to enter more than one email address for the External signature function? Example: If the inventor is an employee of the applicant, it could be useful to be able to	Only one email address can be inserted into the email address field when the external signature option is selected. The same applies to the email address for correspondence indicated in box (iv) of the request form for communication purposes. However, you can send

	CC the applicant's inhouse IP Team, so they can follow up internally.	the external signature request to yourself for example, once received, nothing will prevent you from forwarding that email to the inventor and CC any other party/ies.
60	What happens if an external signature is not signed within the 7-day period?	One day before the expiration date, a reminder email will be sent. If the declaration is still not signed and the request expired, a new external signature request should be sent.
61	I understand the declaration link expires in 7 days. How long before filing the application can you send out the declaration? (If you know it may take an inventor 3 weeks to sign - can you send out a month before the filing deadline?)	The external signature request can be sent as soon as you start to prepare your international application in ePCT, but the link will still be valid for 7 days. We would suggest that you get contact with the inventor in advance and send the request for signature when the inventor is available to sign within 7 days.
62	When I prepare Declaration (iv), there is language stating the link is only good for 7 days. However, there is also language that includes an actual date when it expires which is always much later than the 7 days. Why is this?	We understand the link you mentioned is for the external signature request to collect signature of an inventor. It is valid for 7 days after sending. We also understand that the other time limit you referred to is either the time limit to file your international application to maintain the priority date (for a draft application), or the time limit for submitting the draft declaration (for a post-filing Action), which is also indicated in the email notification for the external signature request.
63	What does the message sent to the inventor requesting signature for Declaration (iv) look like?	Please refer to the webinar recording on declarations under PCT Rule 4.17, starting at 30- minute mark, for an example of the notification.
64	Is there an email notification which is sent to the preparer of the IA application when each inventor signs or must the preparer log in to ePCT to see the status of each signature?	The person who prepares the application and sends the requests for external signature to the inventors will receive an email notification when each signature is received. This person then can login to ePCT to check the signature(s).
65	Do the Declarations with external signatures need to be submitted before the international filing date? Meaning, would we be able to still file the PCT application if the signatures are not complete?	If you have an external signature request pending, it blocks the filing of the application. You can cancel this request and delete the corresponding declaration (iv), then file your application. After filing, you can use ePCT Action to prepare and submit a declaration (iv) containing the inventor's signature which you could not obtain before filing.
66	If some (but not all) of the inventors have signed the Declaration for use in the US, can you save the signed declaration to use in national phase entry instead of deleting it?	You can download and save a draft declaration (iv) prepared in ePCT even though it does not include all inventors' signatures and submit it to DO/US at the national entry. It is up to the DO/US whether to ultimately accept it.
67	Is the same external signature used for powers of attorney?	The external signature option is available when preparing a power of attorney in ePCT before filing an application and is not in the post-filing Action for power of attorney.

۷.	Miscellaneous Questions	
68	After submitting my PCT application using ePCT and it was processed, I see in Workbench: IA Status: Access suspended. What does this mean?	It means that a request under <u>PCT Rule 92<i>bis</i></u> has been received at the International Bureau and access is suspended until the IB processes the change and issues Form PCT/IB/306. Then an automatic notification will be sent to the address for service for the applicant/agent to restore access rights of the application. You can refer to our FAQ article " <u>IA Status: Access</u> suspended and Access rights pending confirmation".
69	Can claims be amended at the international stage and/or new inventors added?	The claims can be amended under Article 19 after issuance of the international search report (and within the prescribed time limit). They can also be amended during the Chapter II procedure (which is optional).
		Inventors can be added in accordance with <u>PCT Rule 92<i>bis</i></u> .
70	Can an Indian agent file PCT application for French applicant at IB.	To determine whether a person can act as an agent for applications filed with RO/IB, we look to the requirements for the competent receiving Office (RO). If there is just a French applicant, we look to the <u>PCT Applicant's Guide</u> - <u>RO/FR</u> , which indicates:
		"Who can act as agent? Any natural or legal person registered to practice before the Office".
		<u>RO/EP</u> would also be considered as competent RO and they require that the agent be qualified to practice before the EPO.
		Thus, an Indian agent would not be competent to be appointed as an agent to represent a French applicant.
71	Is there's an option to use the same information as the first named agent when adding subsequent agents, instead of needing to separately add the information each time an agent is added.	I assume that you refer to adding agents at the time of creating a new IA in ePCT. By simply ticking the option "Same address as the first named agent", you can avoid entering the same address for the other agents. It's also recommended to record the parties (applicants, inventors, agents) in your address book in ePCT in order to use it when entering data, instead of typing the information for each new application.