

ePCT webinar series

External signatures and PCT declarations

Webinar 11
Thursday, May 11, 2023, 10AM Mountain Time

Carl Oppedahl
<https://blog.oppedahl.com>

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Disclaimer

Watching this webinar, or reading these slides, does not make you my firm's client and does not make me your attorney. This webinar is intended to be educational.

At times I will wear either of two hats. At times I will be presenting purely factual information, the same way that a WIPO person might present. At other times I will be sharing opinions and preferences. Please join me in appreciating these two distinct hats.

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Upcoming ePCT webinars

Webinar 12. Thursday, May 18, 2023, 10AM Mountain Time. Sequence listings and ePCT. Note that this is ***not*** about how to create a sequence listing. This webinar assumes you already know how to create a sequence listing. This webinar talks about things that you need to know in ePCT that relate to sequence listings.

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Upcoming ePCT webinars

Webinar 13. Thursday, June 1, 2023, 10AM Mountain Time. Docketing of PCT applications and making use of ePCT notifications. Suggested companion purchase: *Oppedahl on PCT Forms and PCT Docketing*.

Using ePCT to e-file in ISAs and IPEAs, filing Demands.

Doing 92*bis* changes.

Publication front page preview, generating reports of outstanding Forms ISA/202, generating reports of applications with outstanding priority documents.

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Upcoming ePCT webinars

How to register? Go to

https://blog.oppedahl.com/?page_id=8978.

How to learn of future webinars? Subscribe to my blog (<https://blog.oppedahl.com/>), or subscribe to the PCT listserv (https://oppedahl-lists.com/mailman/listinfo/pct_oppedahl-lists.com).

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Recordings

- Webinar 1. Thursday, March 2, 2023. Intro to ePCT, why ePCT is important, getting a user ID and password, setting up 2FA. [Download the presentation materials](#). [View the recording](#) (1:13).
- Webinar 2. Thursday, March 9, 2023. Why attorneys need to learn about ePCT, why you cannot simply delegate stuff to support staff. [Download the presentation materials](#). [View the recording](#) (1:05).
- Webinar 3. Thursday, March 16, 2023. Making sure your US priority documents are available to DAS, best practices for filing US priority documents, Certificates of Availability, setting up alerts. [Download the presentation materials](#). [View the recording](#) (1:21).
- Webinar 4. Thursday, March 23, 2023. Handshakes, eOwners, eEditors, eViewers, access rights groups, employee first day of work, employee last day of work. [Download the presentation materials](#). [View the recording](#) (1:20).
- Webinar 5. Thursday, March 30, 2023. Shared address books, collaborative workflow, sharing with clients, sharing with outside counsel. [Download the presentation materials](#). [View the recording](#) (1:10).
- Webinar 6. Tuesday, April 4, 2023. Getting to know your ePCT workbench, portfolios, office profiles, cloning, ePCT actions. [Download the presentation materials](#). [View the recording](#) (1:15).
- Webinar 7. Thursday, April 13, 2023. Getting pending PCT applications into your workbench, going back to January 1, 2009, archiving old applications. [Download the presentation materials](#). [View the recording](#) (0:39).
- Webinar 8. Thursday, April 20, 2023. Filing a new PCT application in RO/US using ePCT. [Download the presentation materials](#). [View the recording](#) (1:13).
- Webinar 9. Thursday, April 27, 2023. Filing a new PCT application in RO/IB using ePCT. [Download the presentation materials](#). [View the recording](#) (1:05).

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Today's topics

- External signatures
- PCT declarations

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“external signature” process is new and improved

- In the old days, if you had two signers and if one of the signers failed to act within seven days, then you lost the progress with the other signers who had already signed
- A recent change allows you to preserve the progress that was made with those who had already signed
- This is very helpful for any document requiring two or more signatures
 - Inventor declarations
 - Cases having two or more applicants

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External signatures

- This “external signature” stuff is for dinosaurs
- If you can get the person to create a WIPO user ID and password and 2FA, using ePCT, this is much better
- If they do the signing through ePCT, they get to see what they are signing
- With “external signature” you have to somehow get the proposed document into the hands of the would-be signer separately
- These are extra steps for you and extra steps for the would-be signer

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Benefits of getting the dinosaur to learn how to log in

- The dinosaur can e-sign documents directly (no “external signature” needed)
- The dinosaur can monitor status going forward
- The dinosaur can see file contents going forward
- The dinosaur can cease being a dinosaur

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DECLARATIONS

Prepare a new declaration
 Attach an existing declaration

Select Declaration type:

- (i) Identity of the inventor
- (ii) Entitlement to Apply for and Be Granted a Patent
- (iii) Entitlement to Claim Priority of the Earlier Application
- (iv) Inventorship (US)
- (v) Non-Prejudicial disclosures

Signing declarations as part of the PCT application package

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SIGNATURE

Name OPPEDAHL, Carl Name of signatory
 Signature /Carl OPPEDAHL/
 Capacity / Position in company Agent

Name *

OPPEDAHL, Carl (Agent)

Signature type *

Text signature
 Image signature
 External signature

Signature [should include name] *

/ Carl OPPEDAHL /

Signing the the PCT Request (Form PCT/RO/101)

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SUBMIT REQUEST

Add informal message

Signature type

- Text signature
- Image signature
- Document(s) signed by Applicant/Agent included in the attachment[s]
- External Signature

Signatory *

Signature [should include name] *

/ /

Cancel Save draft Submit

Just a few of the many Actions for which external signature may be used:

- PCT Declarations 1, 2, 3, 4, and 5
- 92bis change request
- Withdraw international application
- Create Power of Attorney
- Submit Chapter II Demand
- Article 19 amendment
- Upload documents

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SIGNATURE Tissue

Name *

BARDINI, Ann [Applicant and inventor]

Signature type *

- Text signature
- Image signature
- External signature

Email address *

ann.bardini@wipo.int

Cancel Add

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Save draft Preview R0/101 Close **Review & send for signature**

SIGNATURE

Name BARDINI, Ann	Name of signatory	Capacity / Position in company
Signature /Send signature request to ann.bardini@wipo.int/		

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WIPO | ePCT

External signature request - New IA - Ref1234

You are requested to review and sign the following document by clicking on the link below

Document type	New IA
External signature request ID	jhH6K2hHW7De
Requested by	Ann Bardini ann.bardini@wipo.int
Date/Time	14 May 2018 14:12:00 CEST
Request expires on	21 May 2018 14:09:24 CEST

The content of the document requiring review and signature will be made available to you by the person who submitted the external signature request
 Link to access the external signature request [Click here](#)

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WIPO | ePCT EXTERNAL SIGNATURE REQUEST MAY 14, 2018 2:18 PM CEST ENGLISH

EXTERNAL SIGNATURE REQUEST

The content of the document requiring review and signature will be made available to you by the person who submitted the external signature request

Document type New IA External signature request ID jh8K2hHW7dc	International Application Number Requested by Ann Bardini	Applicant/agent's file reference RefT234 Date and time 14 May 2018 14:09:24 CEST
---	---	---

Select action *
Approve and sign document

Name
BARDINI, Ann

Signature of Applicant/Agent *
 Text signature
 Image signature

Should include name

Signature *

Submit

17

WIPO | ePCT EXTERNAL SIGNATURE REQUEST MAY 14, 2018 2:18 PM CEST ENGLISH

EXTERNAL SIGNATURE REQUEST

The content of the document requiring review and signature will be made available to you by the person who submitted the external signature request

Document type New IA External signature request ID jh8K2hHW7dc	International Application Number Requested by Ann Bardini	Applicant/agent's file reference RefT234 Date and time 14 May 2018 14:09:24 CEST
---	---	---

Select action *
Reject document

Name
BARDINI, Ann

Remark *

Submit

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WIPO | ePCT | EXTERNAL SIGNATURE REQUEST MAY 14, 2018 2:18 PM CEST ENGLISH

EXTERNAL SIGNATURE REQUEST

The person who submitted the external signature request will be notified that the following document has been signed.

Document type New IA External signature request ID jhH6K2hHW7Dc	International Application Number Requested by Ann Bardini	Applicant/agent's file reference Ref1234 Date and time 14 May 2018 14:08:24 CEST
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WIPO | ePCT

ePCT Notification: Document signed - New IA - Ref1234

This is to notify you that the following document has been signed

Document name	New IA
Signature request ID	jhH6K2hHW7Dc
Signed by	BARDINI, Ann ann.bardini@wipo.int
Date/Time	14 May 2018 14:19:58 CEST

NOTE: This is an informal notification for information only.
 Access the international application directly in [ePCT](#)

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EXTERNAL SIGNATURE REQUEST

You have already signed the following document.

Please contact the person who submitted the external signature request:

- Document name: New IA - TEST-Ref1234
- Signature request ID: jhH6K2hHW7Dc
- Sent by: Ann Bardini
- Date/time: 14 May 2018 14:09:24 CEST
- Signed on: 14 May 2018 14:19:58 CEST

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External signature

- Times out in seven days
- Everybody gets a reminder at six days

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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” day.)

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Practice tip

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

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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

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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

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Treatment by DO/EOs of Declarations 1, 2, 3, and 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

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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*.

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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.

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2. Declaration as to the applicant's 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

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2. Declaration as to the applicant's 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.

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2. Declaration as to the applicant's 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.

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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

This declaration does not apply to situations where the applicant's 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.

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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 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

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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

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

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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

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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.

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Postponing the filing of PCT Declaration number 4

This can save extra-page fees.

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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.

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Designated/Elected Offices specifically mentioning Declaration number 5:

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

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Postponing the filing of PCT Declaration number 5

This can save extra-page fees.

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Save draft Preview R0/101 Close Review & File

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 Attach an existing declaration

Select Declaration type:

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- (iii) Entitlement to Claim Priority of the Earlier Application
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- (v) Non-Prejudicial disclosures

Signing declarations as part of the PCT application package

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Declaration as follow-on submission

DATA DOCUMENTS FEES ACTIONS ACCESS RIGHTS TIMELINE NATIONAL PHASE ENTRY HISTORY Close

▼ ACTIONS

Select Action

Action *

- Amendments Under Article 19 [text format only]
- Create Power of Attorney
- Declarations under Rule 4.17
- Licensing Availability Request
- Make international application available to DAS
- Observations on close prior art
- Obtain priority document from DAS
- Online Payment
- Prepare and submit indications relating to biological material [R0/134]
- Request for Early Publication
- Rule 92bis change request
- Submit Chapter II Demand
- Translation for international publication
- Update File Reference
- Upload Documents
- Withdraw Chapter II Demand

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Declaration as follow-on submission

DATA DOCUMENTS FEES ACTIONS ACCESS RIGHTS TIMELINE NATIONAL PHASE ENTRY HISTORY Close

ACTIONS

DECLARATIONS UNDER RULE 4.17

Current date and time at recipient Office: Thursday, 11 May 2023, 16:58 CEST
Deadline to submit draft action: Thursday, 21 September 2023 24:00:00 CEST

Date 11 May 2023

Select Declaration type

- (i) Identity of the inventor
- (ii) Entitlement to Apply for and Be Granted a Patent
- (iii) Entitlement to Claim Priority of Earlier Application
- (iv) Inventorship [US]
- (v) Non-Prejudicial disclosures

Document Type

47

Declaration as follow-on submission

SUBMIT REQUEST

Add informal message

Signature type

- Text signature
- Image signature
- Document[s] signed by Applicant/Agent included in the attachment[s]
- External Signature

Signatory *

Signature (should include name) *

/ /

Cancel Save draft Submit

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Docketing

- Docket to check for receipt of Form PCT/IB/371 (Oppedahl on PCT Forms, pages 125-126)
- When it arrives, check to see that it acknowledges you were timely
- Check the Publication Preview to see that the Declaration appears there

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Please complete the evaluation questionnaire

- Yes please complete it
- Pay it forward

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Thank you

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