

**Making best use of PCT Declarations
in your PCT application**

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Disclaimer

This is not legal advice. Reading these slides or attending this seminar 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

Upcoming webinar

Tuesday, December 3, 2024. 11AM to 12:30 PM Mountain time. *Making best use of ePCT to manage your PCT applications.* This webinar will be of potential interest to attendees in all locations.

<https://blog.oppedahl.com/pct-webinars/>

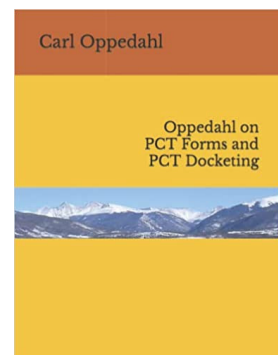
Upcoming live in-person seminar

- Attend a 2½-day live in-person Patent Cooperation Treaty seminar in beautiful Colorado, near the Denver airport. Maybe also attend an optional half-day program specifically directed to docketing of the PCT.
- Tuesday, January 7 to Thursday, January 9, 2025
- Network with other PCT enthusiasts during the breaks
- Ask questions live and face-to-face
- **Discount coupon expires December 4**
- <https://blog.oppedahl.com/attend-a-2%bd-day-live-in-person-patent-cooperation-treaty-seminar-in-beautiful-colorado/>

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A PCT Form arrives in your PCT case ...

- What docket may you clear because the PCT Form has arrived?
- What docket, if you had not previously set, should count as a warning of a docket failure?
- What dates and check-boxes should you closely review on the PCT Form and what is not so important to review on the PCT Form?
- What new dockets should you set?
- What next steps should be carried out?
- What, if anything, needs to be reported to the client?



<https://shop.oppedahl.com>

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Helpful PCT resources

- WIPO's PCT Distance Learning Course
- WIPO video series (Matthias Reischle)
 - **Learn the PCT: Episode 4 - Declarations under Rule 4.17**
 - <https://www.youtube.com/watch?v=9j8-lZBksbg>
 - Twelve thousand views and 76 “likes”!
- The PCT listserv (email discussion group)
 - https://oppedahl-lists.com/mailman/listinfo/pct_oppedahl-lists.com
 - Over 900 members
- PCT section of the *Ant-Like Persistence* blog

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Recordings now available

| | | |
|---|---------------------------|--|
| Best practices for filing a PCT application in RO/US (Thursday, November 7, 2024) | recording | presentation materials |
| Best practices for presentation of priority claim in a PCT application (Tuesday, November 12, 2024) | recording | presentation materials |
| Choosing a Receiving Office for your PCT application (Thursday, November 14, 2024) | recording | presentation materials |
| Choosing an International Searching Authority for your PCT application (Tuesday, November 19, 2024) | recording | presentation materials |
| Choosing between US national phase entry or bypass continuation from your PCT application (Thursday, November 21, 2024) | recording | presentation materials |

<https://blog.oppedahl.com/pct-webinars/>

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Knowing when and how to file PCT Declarations with a PCT Application

Five kinds of Declarations

To use the declarations through the PCT publication process, all must be filed by the 4-and-16 date ...

- 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.)

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What if you miss the 4-and-16 date?

You can also submit any of PCT
Declarations i, ii, iii, and iv directly to the
Designated Office!

See PCT Rule 51*bis*.2

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Practice tip

If you are considering filing one or more PCT Declarations, and if you are at risk of using up your free page count (30 sheets), consider aging the PCT Declarations by at least one day

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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 (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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Each of the PCT Declarations
must be worded correctly:
"magic words"

Guess what?

ePCT will save you from getting the magic words wrong

Did I mention that it is good to make use of ePCT?

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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 the missing information using Declaration number 1.

If you miss the 4-and-16 date, you can submit PCT Declaration number 1 directly to the Designated Office.

Offices which specifically mention this Declaration number 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 number 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

Example of PCT declaration number 1

| | | |
|---|---|---|
| VIII-1-1 | Declaration: Identity of the Inventor Declaration as to the identity of the inventor (Rules 4.17(i) and 51bis.1(a)(ii)) | in relation to this international application |
| Name (LAST, First) Address | KUMAR, Jonnala Kotes of Post Box No-6, 176061 India is the inventor of the subject matter for which protection is sought by way of this international application | |
| Name (LAST, First) Address | BABU, Garikapatidyva Kiran of Post Box No.6, 176061 India is the inventor of the subject matter for which protection is sought by way of this international application | |
| Name (LAST, First) Address | KAUL, Vijay Kumar of Post Box No-6, 176061 India is the inventor of the subject matter for which protection is sought by way of this international application | |
| Name (LAST, First) Address | AHUJA, Paramvir Singh of Post Box No-6, 176061 India is the inventor of the subject matter for which protection is sought by way of this international application | |
| This declaration is made for the purposes of: | | all designations |

| | | |
|-------------------------------|--|--|
| VIII-1-1 | Declaration: Identity of the Inventor Declaration as to the identity of the inventor (Rules 4.17(i) and 51bis.1(a)(i)) | In relation to this international application |
| Name (LAST, First) Address | CELLA, Charles Howard of 501 East Las Olas Blvd., Suite 200 Fort Lauderdale, Florida 33301 United States of America is the inventor of the subject matter for which protection is sought by way of this international application | |
| Name (LAST, First) Address | BUNIN, Andrew of 501 East Las Olas Blvd., Suite 200 Fort Lauderdale, Florida 33301 United States of America is the inventor of the subject matter for which protection is sought by way of this international application | |
| Name (LAST, First) Address | CARDNO, Andrew of 501 East Las Olas Blvd., Suite 200 Fort Lauderdale, Florida 33301 United States of America is the inventor of the subject matter for which | |

Imagine the case where, at PCT filing time,
there is some lack of clarity as to who belongs
on the inventor list

PCT Declaration number 1 might save the day

This procedure allows you to play “hide the ball” as to who is on
your inventor list

This would avoid the potential embarrassment of doing a 92*bis*
change and then TYFNIL having to explain why you did the 92*bis*
change

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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.

Polling question

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.

If you miss the 4-and-16 date, you can submit PCT Declaration number 1 directly to the Designated Office.

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Designated/Elected Offices which specifically mention this Declaration number 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

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Designated/Elected Offices which specifically mention this Declaration number 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 number 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 number 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

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Designated/Elected Offices which specifically mention this Declaration number 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

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Examples of PCT declaration number 2

| | | |
|---------------|---|--|
| VIII-2-1 | Declaration: Entitlement to apply for and be granted a patent Declaration as to the applicant's entitlement, as at the international filing date, to apply for and be granted a patent (Rules 4.17(ii) and 51bis.1(a)(ii)), in a case where the declaration under Rule 4.17(iv) is not appropriate: Name (LAST, First) | In relation to this international application EVONIK OPERATIONS GMBH is entitled to apply for and be granted a patent by virtue of the following: |
| VIII-2-1 (iv) | | an assignment from JOHNSON, Andrea to EVONIK CORPORATION, dated 22 June 2023 (22.06.2023) |
| VIII-2-1 (iv) | | an assignment from CRYAR, Brandon to EVONIK CORPORATION, dated 23 May 2023 (23.05.2023) |
| VIII-2-1 (iv) | | an assignment from DANKERT, John R. to EVONIK CORPORATION, dated 06 June 2023 (06.06.2023) |
| VIII-2-1 (iv) | | an assignment from EVONIK CORPORATION to EVONIK OPERATIONS GMBH, dated 29 June 2023 (29.06.2023) |

PCT

(original sous forme électronique)

| | | |
|---------------|--|---|
| VIII-2-1 | Déclaration : Droit de demander et d'obtenir un brevet Déclaration relative au droit du déposant, à la date du dépôt international, de demander et d'obtenir un brevet (règles 4.17.ii) et 51bis.1.a)ii), dans le cas où la déclaration selon la règle 4.17.iv) n'est pas appropriée : Nom (NOM DE FAMILLE, prénom) : | Concernant la présente demande internationale ARKEMA FRANCE a le droit de demander et d'obtenir un brevet en vertu : |
| VIII-2-1 (iv) | | d'une cession de ARKEMA INC à ARKEMA FRANCE, daté du 01 juillet 2011 (01.07.2011) |
| VIII-2-1 (ii) | | du fait que ARKEMA INC possède ce droit en qualité d'employeur de l'inventeur, ANDERSSON, Jonathan |
| VIII-2-1 (ii) | | du fait que ARKEMA INC possède ce droit en qualité d'employeur de l'inventeur, BITTNER, Ainsley |
| VIII-2-1 (ii) | | du fait que ARKEMA INC possède ce droit en qualité d'employeur de l'inventeur, KLANG, Jeffrey |
| VIII-2-1 (ii) | | du fait que ARKEMA INC possède ce droit en qualité d'employeur de l'inventeur, MCGRAIL, Brendan |
| VIII-2-1 (ii) | | du fait que ARKEMA INC possède ce droit en qualité d'employeur de l'inventeur, WOLF, William |

Box No. VIII (ii) DECLARATION: ENTITLEMENT TO APPLY FOR AND BE GRANTED A PATENT

The declaration must conform to the standardized wording provided for in Section 212; see Notes to Boxes Nos. VIII, VIII (i) to (v) (in general) and the specific Notes to Box No. VIII (ii). If this Box is not used, this sheet should not be included in the request.

Declaration as to the applicant's entitlement, as at the international filing date, to apply for and be granted a patent (Rules 4.17(ii) and 51bis.1(a)(ii)), in a case where the declaration under Rule 4.17(iv) is not appropriate:

In relation to this international application PCT/EP2024/063364

PARI Pharma GmbH

is entitled to apply for and be granted a patent by virtue of the following:

PARI Pharma GmbH is entitled as employer of the inventors:

STOECKL, Carolin;
HOFFMANN, Tobias;
HEINE, Benjamin;
REINHART, Markus;
DENIS, Dr. Thomas

The whole point of PCT Declaration Number 2

The whole point of PCT Declaration Number 2 is to explain why the applicant list is not identical to the inventor list

If your applicant list is not identical to your inventor list, then maybe you ought to go to the trouble of preparing and filing PCT Declaration Number 2

Note that if you find yourself unable to prepare PCT Declaration Number 2 (e.g. no clarity as to ownership) then you probably have much bigger problems to attend to

Another way to say this is that if PCT Declaration Number 2 is part of your standard procedure, then any failed attempt to prepare PCT Declaration Number 2 will alert you to such potential bigger problems

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Polling question

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What is the most frequent geographic location of PCT practitioners who fail to make use of PCT Declaration Number 2 when it would be helpful to do so?

The United States

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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: 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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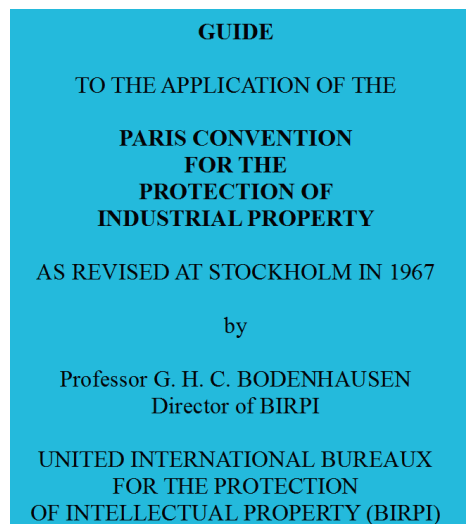
Paris Convention

You should have and read a copy of Bodenhausen

The definitive exegesis of the Paris Convention

Get the PDF for free from WIPO and print it yourself

Or purchase on Lulu and it will cost less than the cost of the toner or ink to print the PDF



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Polling question

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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

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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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 are considering filing a PCT Declaration and you are at risk of using up your free page count (30 sheets), consider aging the PCT Declaration by at least one day

If you miss the 4-and-16 date, you can submit PCT Declaration number 1 directly to the Designated Office.

Designated/Elected Offices specifically mentioning Declaration number 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 number 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

Examples of PCT declaration number 3

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| Box No. VIII (iii) | DECLARATION: ENTITLEMENT TO CLAIM PRIORITY |
|---|--|
| <i>The declaration must conform to the standardized wording provided for in Section 213; see Notes to Boxes Nos. VIII, VIII (i) to (v) (in general) and the specific Notes to Box No. VIII (iii). If this Box is not used, this sheet should not be included in the request.</i> | |
| Declaration as to the applicant's entitlement, as at the international filing date, to claim the priority of the earlier application specified below, where the applicant is not the applicant who filed the earlier application or where the applicant's name has changed since the filing of the earlier application (Rules 4.17(iii) and 51 bis.1(a)(iii)): | |
| <p>in relation to international application PCT/US2006/031171 filed on August 10, 2006;</p> <p>SMITHKLINE BEECHAM CORPORATION is entitled to claim priority of earlier application no. US60/707,370 filed August 11, 2005 in the United States of America by virtue of the following:</p> <p>An assignment from :</p> <p>Jennifer COLONELL, 24 Cross Street, Belmont, MA 02478 USA to SMITHKLINE BEECHAM CORPORATION, One Franklin Plaza, PO Box 7929, Philadelphia, Pennsylvania 19101, USA, dated December 07, 2006;</p> <p>Hugh C. CRENSHAW, c/o GlaxoSmithKline, Corporate Intellectual Property Department, Five Moore Drive, PO Box 13398, Research Triangle Park, NC 27709 to SMITHKLINE BEECHAM CORPORATION, One Franklin Plaza, PO Box 7929, Philadelphia, Pennsylvania 19101, USA, dated December 01, 2006</p> <p>Assignment Recordation Date: 12/11/2006 Reel/Frame: 018609/0346</p> | |

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PCT

(Original in Electronic Form)

| | | |
|---------------|---|--|
| VIII-3-1 | Declaration: Entitlement to claim priority Declaration as to the applicant's entitlement, as at the international filing date, to claim the priority of the earlier application specified below, where the applicant is not the applicant who filed the earlier application or where the applicant's name has changed since the filing of the earlier application (Rules 4.17(iii) and 51bis.1(a)(iii)) Name | In relation to this international application CILAG GMBH INTERNATIONAL is entitled to claim priority of earlier application No. US 17/246,017 by virtue of the following: |
| VIII-3-1 (iv) | | an assignment from SHELTON, IV, Frederick E. to CILAG GMBH INTERNATIONAL, dated 12 May 2021 (12.05.2021) |
| VIII-3-1 (iv) | | an assignment from ARONHALT, Taylor W. to CILAG GMBH INTERNATIONAL, dated 11 May 2021 (11.05.2021) |
| VIII-3-1 (iv) | | an assignment from ZEINER, Mark S. to CILAG GMBH INTERNATIONAL, dated 11 May 2021 (11.05.2021) |
| VIII-3-1 (iv) | | an assignment from ADAMS, Shane R. to CILAG GMBH INTERNATIONAL, dated 11 May 2021 (11.05.2021) |
| VIII-3-1 (iv) | | an assignment from WONG, Jordan B. to CILAG GMBH INTERNATIONAL, dated 11 May 2021 (11.05.2021) |
| VIII-3-1 (iv) | | an assignment from BAKOS, Gregory J. to CILAG GMBH INTERNATIONAL, dated 12 May 2021 (12.05.2021) |
| VIII-3-1 (iv) | | an assignment from HENSEL, Adam D. to CILAG GMBH INTERNATIONAL, dated 11 May 2021 (11.05.2021) |

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PCT REQUEST

Original (for SUBMISSION)

| | | |
|---------------|---|---|
| VIII-3-1 | Declaration: Entitlement to claim priority Declaration as to the applicant's entitlement, as at the international filing date, to claim the priority of the earlier application specified below, where the applicant is not the applicant who filed the earlier application or where the applicant's name has changed since the filing of the earlier application (Rules 4.17(iii) and 51bis.1(a)(iii)) Name | In relation to this international application ETHICON ENDO-SURGERY, INC. is entitled to claim priority of earlier application No. 13/974,205 by virtue of the following: |
| VIII-3-1(i v) | | an assignment from SHELTON, IV, Frederick E. to ETHICON ENDO-SURGERY, INC., dated 29 August 2013 (29.08.2013) |

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In the (relatively rare) case where there is no priority claim, then by definition you will have no reason to file PCT Declaration Number 3

In the (hopefully fairly common) case where the applicant list for the priority claim is a perfect match for the applicant list for the PCT application, then by definition you will have no reason to file PCT Declaration Number 3

The whole point of PCT Declaration Number 3 is to explain a case where the applicant list for the PCT application is not identical to the applicant list for the priority application

If your applicant list for your PCT application is not identical to your applicant list for your priority application, then maybe you ought to go to the trouble of preparing and filing PCT Declaration Number 3

Note that if you find yourself unable to prepare PCT Declaration Number 3 (e.g. no clarity as to the apparent discrepancy) then you probably have much bigger problems to attend to

Another way to say this is that if PCT Declaration Number 3 is part of your standard procedure, then any failed attempt to prepare PCT Declaration Number 3 will alert you to such potential bigger problems

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Polling question

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What is the most frequent geographic location of PCT practitioners who fail to make use of PCT Declaration Number 3 when it would be helpful to so?

The United States

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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 particular PCT application is entry into the US national phase from that PCT application, 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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Polling question

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Postponing the filing of PCT Declaration number 4

If you are at risk of using up your free page count (30 sheets),
consider aging the PCT Declarations by at least one day

But try not to postpone more than one day!

If you miss the 4-and-16 date, you can submit PCT Declaration
number 1 directly to the Designated Office (namely to the
USPTO).

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Filing of PCT Declaration number 4

Inventors die and get run over by trucks

Inventors disappear

Other things happen with inventors

The sooner you get PCT Declaration Number 4 into the case, the sooner you get to stop worrying about things like this

Of course also obtain inventor signatures on Assignments

Of course record such assignments within three months of execution (35 USC § 261)

Do not foot-drag such recordation until after US national-phase entry

Do not foot-drag the rounding-up of inventor signatures until after US national-phase entry

Note that the prospect of preparing Declaration Number 2 might prompt you to pay attention to such Assignments

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India

I have heard that India asks for this Declaration.

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Examples of PCT declaration number 4

Sheet No. 8

Box No. VIII (iv) DECLARATION: INVENTORSHIP (only for the purposes of the designation of the United States of America)
The declaration must conform to the following standardized wording provided for in Section 214: see Notes to Boxes Nos. VIII, VIII (i) to (v) (in general) and the specific Notes to Box No. VIII (iv). If this Box is not used, this sheet should not be included in the request.

**Declaration of Inventorship (Rules 4.17(iv) and 51Abis.1(a)(iv))
for the purposes of the designation of the United States of America:**

I hereby declare that I believe I am the original inventor or an original joint inventor of a claimed invention in the application.

This declaration is directed to the international application of which it forms a part (if filing declaration with application).

This declaration is directed to international application No. PCT/..... (if furnishing declaration pursuant to Rule 26ter).


I hereby declare that the above-identified international application was made or authorized to be made by me.

I hereby acknowledge that any willful false statement made in this declaration is punishable under 18 U.S.C. 1001 by fine or imprisonment of not more than five (5) years, or both.

Name: Nestor Ivan SEGURA

Residence: Oakville, Ontario, CANADA
(city and either US state, if applicable, or country)

Mailing Address: 1248 Roundwood Circle
Oakville, Ontario, Canada L6M 4A4

Inventor's Signature:  Date: May 05 - 2023
(The signature must be that of the inventor, not that of the agent)

When you enter the US national phase, the PCT Declaration Number 4 might be in French or German or Spanish or Russian or Chinese or Japanese or Portuguese or Korean or Arabic

In our firm's experience, when the PCT Declaration Number 4 is not in English, sometimes the DO/EO clerk will fail to pay attention to it

See *Training material for the USPTO*, December 10, 2019

<https://blog.oppedahl.com/training-material-for-the-uspto/>

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We know that in a US national-phase case, PCT Declaration Number 4 gives you a free pass on having to file Form PCT/AIA/01

Does PCT Declaration Number 4 give you a free pass on having to file Form PCT/AIA/01 in a **bypass continuation** case?

The answer should be "yes". Every "magic word" that 37 CFR § 1.63 says you must provide can be found identically in PCT Declaration Number 4.

If your PCT Declaration Number 4 is in French or German or Spanish or Russian or Chinese or Japanese or Portuguese or Korean or Arabic, then you would probably need to provide a certified translation

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This protects you from the “walking corpse” problem

<https://blog.oppedahl.com/a-new-category-of-walking-corpse-us-patents/>

May 14, 2015 blog article

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What is the most frequent geographic location of PCT practitioners who fail to make use of PCT Declaration Number 4 when it would be helpful to do so?

The United States

(Many experienced practitioners in Europe and Asia regularly make use of PCT Declaration Number 4)

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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:

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

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Designated/Elected Offices specifically mentioning Declaration number 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 number 5

This can save extra-page fees.

Examples of PCT declaration number 5

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PCT/US00/20173

Statement Concerning Non-Prejudicial Disclosures or Exceptions to Lack of Novelty

Samples of this product were provided to prospective purchasers in Japan on July 25, 1999.

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Box No. VIII (v) DECLARATION: NON-PREJUDICIAL DISCLOSURES OR EXCEPTIONS TO LACK OF NOVELTY
The declaration must conform to the standardized wording provided for in Section 21.5; see Notes to Boxes Nos. VIII, VIII (i) to (v) (in general) and the specific Notes to Box No. VIII (v). If this Box is not used, this sheet should not be included in the request.

Declaration as to non-prejudicial disclosures or exceptions to lack of novelty (Rules 4.17(v) and 51bis.1(a)(v)):

In relation to international application PCT/NL2005/000249,
 DRIESSEN Maarten Willem declares that the subject matter claimed in the international
 application was disclosed as follows:

Benelux-trademark No. 0711498

Publicationdate 12/2002

Title Eikelontbloter

This declaration was made for the purposes of all designations.

Upcoming webinar

Tuesday, December 3, 2024. 11AM to
 12:30 PM Mountain time. *Making
 best use of ePCT to manage your
 PCT applications.* This webinar will
 be of potential interest to attendees in
 all locations.

<https://blog.oppedahl.com/pct-webinars/>

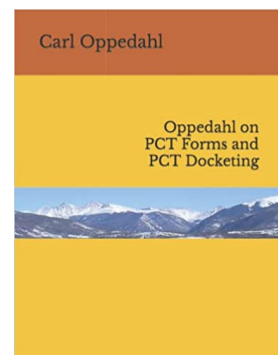
Upcoming live in-person seminar

- Attend a 2½-day live in-person Patent Cooperation Treaty seminar in beautiful Colorado, near the Denver airport. Maybe also attend an optional half-day program specifically directed to docketing of the PCT.
- Tuesday, January 7 to Thursday, January 9, 2025
- Network with other PCT enthusiasts during the breaks
- Ask questions live and face-to-face
- Discount coupon expires December 4
- <https://blog.oppedahl.com/attend-a-2%bd-day-live-in-person-patent-cooperation-treaty-seminar-in-beautiful-colorado/>

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A PCT Form arrives in your PCT case ...

- What docket may you clear because the PCT Form has arrived?
- What docket, if you had not previously set, should count as a warning of a docket failure?
- What dates and check-boxes should you closely review on the PCT Form and what is not so important to review on the PCT Form?
- What new dockets should you set?
- What next steps should be carried out?
- What, if anything, needs to be reported to the client?



<https://shop.oppedahl.com>

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Recordings now available

| | | |
|---|---------------------------|--|
| Best practices for filing a PCT application in RO/US (Thursday, November 7, 2024) | recording | presentation materials |
| Best practices for presentation of priority claim in a PCT application (Tuesday, November 12, 2024) | recording | presentation materials |
| Choosing a Receiving Office for your PCT application (Thursday, November 14, 2024) | recording | presentation materials |
| Choosing an International Searching Authority for your PCT application (Tuesday, November 19, 2024) | recording | presentation materials |
| Choosing between US national phase entry or bypass continuation from your PCT application (Thursday, November 21, 2024) | recording | presentation materials |

<https://blog.oppedahl.com/pct-webinars/>

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Please complete the evaluation questionnaire

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Thank you!