



C. PCT 1032
-21.1

May 2, 2005

Madam,
Sir,

*Proposed modification of the requirements as to signature of the
declaration of inventorship referred to under PCT Rule 4.17(iv)*

This Circular is addressed to your Office in its capacity as a receiving Office and, in so far as the United States of America is concerned, as designated Office under the Patent Cooperation Treaty (PCT) for the purposes of consultation under Rule 89.2(b). It is also addressed to interested intergovernmental organizations as well as certain non-governmental organizations representing users of the PCT system.

This circular concerns proposed modifications to Section 214(a) of the Administrative Instructions under the PCT and consequential modifications to Box No. VIII (iv) of Form PCT/RO/101 entitled: "Declaration of Inventorship", to the Notes to Form PCT/RO/101 and to paragraph 192C(ii) of the PCT Receiving Office Guidelines. As suggested by the United States Patent and Trademark Office (USPTO), it is hereby proposed to no longer provide for the possibility for inventors to sign Box No. X of Form PCT/RO/101 instead of the declaration itself. This Circular therefore proposes a series of changes the result of which would be that the Declaration of Inventorship referred to in Rules 4.17(iv) and 51*bis*.1(a)(iv) must itself be signed in all cases.

Present Section 214(a) prescribes that for the purposes of the designation of the United States of America, the signature of the inventor is required on the Declaration of Inventorship, unless that same inventor has signed the Request form (PCT/RO/101) and the declaration is filed together with the international application. The possibility for inventors to sign in Box No. X has proven to be confusing for applicants and, from an administrative point of view, difficult to handle by the International Bureau and the designated Office of the United States of America. Moreover, since under Rule 26.2*bis*(a), in force since January 1, 2004, it is sufficient, if there is more than one applicant, that the request be signed by only one of them, the situation in which all applicants and inventors would sign Box No. X of the request at the time of filing of the international application has become even more exceptional than in the past.

/...

The proposed modifications requiring the inventors to always sign the Declaration of Inventorship itself would greatly improve the handling of the declaration at the International Bureau and the USPTO.

Comments on the proposed modifications

Your Office is invited to comment on the proposed modifications to

- ./ Section 214(a) of the Administrative Instructions (Annex I), Form PCT/RO/101
- ./ (Annex II), and paragraph 192C(ii) of the PCT Receiving Office Guidelines
- ./ (Annex III). All proposed modifications are indicated by vertical lines in the margin. In respect of the Administrative Instructions and the PCT Receiving Office Guidelines, proposed additions and deletions are also indicated, respectively, by underlining and striking through of the text concerned. Comments, if any, are invited to be provided by June 2, 2005, preferably by fax to (+41 22) 910 00 30 or by e-mail to pct.legal@wipo.int.

Yours sincerely,



Francis Gurry
Deputy Director General

Enclosures: Annex I—Proposed modifications to Section 214 of the Administrative Instructions

Annex II—Proposed modifications to Form PCT/RO/101

Annex III—Proposed modifications to paragraph 192C of the PCT Receiving Office Guidelines

PROPOSED MODIFICATIONS TO SECTION 214
OF THE PCT RECEIVING OFFICE GUIDELINES

Section 214
Declaration of Inventorship

(a) A declaration of inventorship, referred to in Rule 4.17(iv), that is made for the purposes of the designation of the United States of America shall be worded as follows:

“Declaration of inventorship (Rules 4.17(iv) and 51*bis*.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, first and sole (if only one inventor is listed below) or joint (if more than one inventor is listed below) inventor of the subject matter which is claimed and for which a patent is sought.

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 26*ter*).

I hereby declare that my residence, mailing address, and citizenship are as stated next to my name.

I hereby state that I have reviewed and understand the contents of the above-identified international application, including the claims of said application. I have identified in the request of said application, in compliance with PCT Rule 4.10, any claim to foreign priority, and I have identified below, under the heading “Prior Applications,” by application number, country or Member of the World Trade Organization, day, month and year of filing, any application for a patent or inventor’s certificate filed in a country other than the United States of America, including any PCT international application designating at least one country other than the United States of America, having a filing date before that of the application on which foreign priority is claimed.

I hereby acknowledge the duty to disclose information that is known by me to be material to patentability as defined by 37 C.F.R. § 1.56, including for continuation-in-part applications, material information which became available between the filing date of the prior application and the PCT international filing date of the continuation-in-part application.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Name: ...

Residence: ... (city and either US state, if applicable, or country)

Mailing Address: ...

Citizenship: ...

Prior Applications: ...

Inventor’s Signature: ... ~~(if not contained in the request, or if declaration is corrected or added under Rule 26*ter* after the filing of the international application.~~ The signature must be that of the inventor, not that of the agent)

Date: ... ~~(of signature which is not contained in the request, or of the declaration that is corrected or added under Rule 26ter after the filing of the international application)~~”

(b) Where there is more than one inventor and all inventors do not sign the same declaration referred to in paragraph (a), each declaration shall indicate the names of all the inventors.

(c) Any correction or addition under Rule 26ter.1 of a declaration referred to in paragraph (a) shall take the form of a declaration referred to in that paragraph and be signed by the inventor. In addition, any such correction shall be entitled “Supplemental declaration of inventorship (Rules 4.17(iv) and 51bis.1(a)(iv))”.

[Annex II follows]

PROPOSED MODIFICATIONS OF FORM PCT/RO/101

PCT

REQUEST

The undersigned requests that the present international application be processed according to the Patent Cooperation Treaty.

For receiving Office use only

International Application No.

International Filing Date

Name of receiving Office and "PCT International Application"

Applicant's or agent's file reference
(if desired) (12 characters maximum)

Box No. I TITLE OF INVENTION	
Box No. II APPLICANT <input type="checkbox"/> This person is also inventor	
Name and address: (Family name followed by given name; for a legal entity, full official designation. The address must include postal code and name of country. The country of the address indicated in this Box is the applicant's State (that is, country) of residence if no State of residence is indicated below.)	Telephone No.
	Facsimile No.
	Teleprinter No.
	Applicant's registration No. with the Office
State (that is, country) of nationality:	State (that is, country) of residence:
This person is applicant for the purposes of: <input type="checkbox"/> all designated States <input type="checkbox"/> all designated States except the United States of America <input type="checkbox"/> the United States of America only <input type="checkbox"/> the States indicated in the Supplemental Box	
Box No. III FURTHER APPLICANT(S) AND/OR (FURTHER) INVENTOR(S)	
Name and address: (Family name followed by given name; for a legal entity, full official designation. The address must include postal code and name of country. The country of the address indicated in this Box is the applicant's State (that is, country) of residence if no State of residence is indicated below.)	This person is: <input type="checkbox"/> applicant only <input type="checkbox"/> applicant and inventor <input type="checkbox"/> inventor only (If this check-box is marked, do not fill in below.)
	Applicant's registration No. with the Office
State (that is, country) of nationality:	State (that is, country) of residence:
This person is applicant for the purposes of: <input type="checkbox"/> all designated States <input type="checkbox"/> all designated States except the United States of America <input type="checkbox"/> the United States of America only <input type="checkbox"/> the States indicated in the Supplemental Box	
<input type="checkbox"/> Further applicants and/or (further) inventors are indicated on a continuation sheet.	
Box No. IV AGENT OR COMMON REPRESENTATIVE; OR ADDRESS FOR CORRESPONDENCE	
The person identified below is hereby/has been appointed to act on behalf of the applicant(s) before the competent International Authorities as: <input type="checkbox"/> agent <input type="checkbox"/> common representative	
Name and address: (Family name followed by given name; for a legal entity, full official designation. The address must include postal code and name of country.)	Telephone No.
	Facsimile No.
	Teleprinter No.
	Agent's registration No. with the Office
<input type="checkbox"/> Address for correspondence: Mark this check-box where no agent or common representative is/has been appointed and the space above is used instead to indicate a special address to which correspondence should be sent.	

Sheet No.

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 51bis.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, first and sole (if only one inventor is listed below) or joint (if more than one inventor is listed below) inventor of the subject matter which is claimed and for which a patent is sought.

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 my residence, mailing address, and citizenship are as stated next to my name.

I hereby state that I have reviewed and understand the contents of the above-identified international application, including the claims of said application. I have identified in the request of said application, in compliance with PCT Rule 4.10, any claim to foreign priority, and I have identified below, under the heading "Prior Applications," by application number, country or Member of the World Trade Organization, day, month and year of filing, any application for a patent or inventor's certificate filed in a country other than the United States of America, including any PCT international application designating at least one country other than the United States of America, having a filing date before that of the application on which foreign priority is claimed.

Prior Applications:

I hereby acknowledge the duty to disclose information that is known by me to be material to patentability as defined by 37 C.F.R. § 1.56, including for continuation-in-part applications, material information which became available between the filing date of the prior application and the PCT international filing date of the continuation-in-part application.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Name:

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

Mailing Address:

Citizenship:

Inventor's Signature: **Date:**
(The signature must be that of the inventor, not that of the agent)

Name:

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

Mailing Address:

Citizenship:

Inventor's Signature: **Date:**
(The signature must be that of the inventor, not that of the agent)

This declaration is continued on the following sheet, "Continuation of Box No. VIII (iv)".

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in relation to [this] international application [No. PCT/...],

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

- (i) ... (name) of ... (address) is the inventor of the subject matter for which protection is sought by way of [the] [this] international application
- (ii) ... (name) [is] [was] entitled as employer of the inventor, ... (inventor's name)
- (iii) an agreement between ... (name) and ... (name), dated ...
- (iv) an assignment from ... (name) to ... (name), dated ...
- (v) consent from ... (name) in favor of ... (name), dated ...
- (vi) a court order issued by ... (name of court), effecting a transfer from ... (name) to ... (name), dated ...
- (vii) transfer of entitlement from ... (name) to ... (name) by way of ... (specify kind of transfer), dated ...
- (viii) the applicant's name changed from ... (name) to ... (name) on ... (date)
- (ix) this declaration is made for the purposes of (include as applicable):
 - (a) all designations [except the designation of the United States of America]
 - (b) the following designations for national and/or regional patents: ..."

Either (a) or (b) of item (ix) should always be included in the declaration. The remainder of the items may be incorporated as is necessary to explain the applicant's entitlement. ***This declaration is only applicable to those events which have occurred prior to the international filing date.*** The possible kinds of transfer of entitlement in item (vii) include merger, acquisition, inheritance, donation, etc. Where there has been a succession of transfers from the inventor, the order in which transfers are listed should follow the actual succession of transfers, and items may be included more than once, as necessary to explain the applicant's entitlement. Where the inventor is not indicated in Box No. II or No. III, this declaration may be presented as a combined declaration explaining the applicant's entitlement to apply for and be granted a patent and identifying the inventor. In such a case, the introductory phrase of the declaration must be as follows:

"Combined 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)) and as to the identity of the inventor (Rules 4.17(i) and 51bis.1(a)(i)), in a case where the declaration under Rule 4.17(iv) is not appropriate:"

The remainder of the combined declaration must be worded as indicated in the preceding paragraphs.

For details as to the declaration as to the identity of the inventor, see the Notes to Box No. VIII (i), above.

BOX No. VIII (iii)

Declaration as to the Applicant's Entitlement to Claim Priority of the Earlier Application (Rule 4.17(iii) and Section 213): The declaration must be worded as follows, with such inclusion, omission, repetition and re-ordering of the matters listed as items (i) to (viii) as is necessary to explain the applicant's entitlement:

"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)):

in relation to [this] international application [No. PCT/...],

... (name) is entitled to claim priority of earlier application No. ... by virtue of the following:

- (i) the applicant is the inventor of the subject matter for which protection was sought by way of the earlier application
- (ii) ... (name) [is] [was] entitled as employer of the inventor, ... (inventor's name)
- (iii) an agreement between ... (name) and ... (name), dated ...
- (iv) an assignment from ... (name) to ... (name), dated ...
- (v) consent from ... (name) in favor of ... (name), dated ...
- (vi) a court order, issued by ... (name of court), effecting a transfer from ... (name) to ... (name), dated ...
- (vii) transfer of entitlement from ... (name) to ... (name) by way of ... (specify kind of transfer), dated ...
- (viii) the applicant's name changed from ... (name) to ... (name) on ... (date)
- (ix) this declaration is made for the purposes of (include as applicable):
 - (a) all designations
 - (b) the following designations for national and/or regional patents: ..."

Either (a) or (b) of item (ix) should always be included in the declaration. The remainder of the items may be incorporated as is necessary to explain the applicant's entitlement. ***This declaration is only applicable to those events which have occurred prior to the international filing date.*** In addition, this declaration is only applicable where the person or name of the applicant is different from that of the applicant who filed the earlier application from which priority is claimed. For example, this declaration may be applicable where only one applicant out of five is different from the applicants indicated in respect of an earlier application. The possible kinds of transfer of entitlement in item (vii) include merger, acquisition, inheritance, donation, etc. Where there has been a succession of transfers from the applicant in respect of the earlier application, the order in which transfers are listed should follow the actual succession of transfers, and items may be included more than once, as necessary to explain the applicant's entitlement.

BOX No. VIII (iv)

Declaration of Inventorship (Rule 4.17(iv) and Section 214): The standardized wording for the declaration is pre-printed in Box No. VIII (iv).

The name, residence, address and citizenship must be included for each inventor. If the name and address of an inventor is not written in the Latin alphabet, the name and address must be indicated in the Latin alphabet. All inventors must sign and date the declaration even if they do not all sign the same copy of the declaration (Section 214(b)).

If there are more than two inventors, those other inventors must be indicated on the "Continuation of Box No. VIII (i) to (v)" sheet. The continuation sheet should be entitled "Continuation of Box No. VIII (iv)," must indicate the name, residence, address and citizenship for those other inventors, and at least the name and address in the Latin alphabet. In such a case, the "complete declaration" includes Box No. VIII (iv) and the continuation sheet. All inventors must sign and date a complete declaration even if they do not all sign the same copy of the complete declaration, and a copy of each separately signed complete declaration must be submitted (Section 214(b)).

Where the declaration was not included in the request, but is furnished later, the PCT application number MUST be indicated within the text of Box No. VIII (iv).

BOX No. VIII (v)

Declaration as to Non-prejudicial Disclosures or Exceptions to Lack of Novelty (Rule 4.17(v) and Section 215): The declaration must be worded as follows, with such inclusion, omission, repetition and re-ordering of the matters listed as items (i) to (iv) as is necessary:

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

in relation to [this] international application [No. PCT/...],

... (*name*) declares that the subject matter claimed in [the] [this] international application was disclosed as follows:

- (i) kind of disclosure (*include as applicable*):
 - (a) international exhibition
 - (b) publication
 - (c) abuse
 - (d) other: ... (*specify*)
- (ii) date of disclosure: ...
- (iii) title of disclosure (*if applicable*): ...
- (iv) place of disclosure (*if applicable*): ...
- (v) this declaration is made for the purposes of (*include as applicable*):
 - (a) all designations
 - (b) the following designations for national and/or regional patents: ...”

Either (a), (b), (c) or (d) of item (i) should always be included in the declaration. Item (ii) should also always be included in the declaration. Either (a) or (b) of item (v) should always be included in the declaration. Items (iii) and (iv) may be incorporated depending upon the circumstances.

BOX No. IX

Items Constituting the International Application: The number of sheets of the various parts of the international application must be given in the check list in Arabic numerals. Sheets containing any of Boxes Nos. VIII (i) to (v) must be counted as part of the request.

Where the application contains disclosure of one or more *nucleotide and/or amino acid sequences*, the applicant has the following three options.

First, the applicant may choose to file the sequence listing and/or tables related thereto *on paper only* (“option (a)”), in which case the number of sheets of the listing and/or tables, respectively, must be indicated under item (a) in the left column of Box No. IX (and therefore included in the total number of sheets), noting that a copy of the sequence listing and/or a copy of the tables, in electronic form, may accompany the international application but only for the purposes of international search under Rule 13ter and/or Section 802(b-quarter); in such a case, check-boxes Nos. 9, 9(i) and/or 10(i) and, where applicable, 9(iii) and/or 10(iii) must be marked in the right column of Box No. IX.

Second, the applicant may choose to file the sequence listing and/or tables related thereto *in electronic form only*, under Section 801(a)(i) (“option (b)”), in which case check-boxes b(i) and/or b(ii) must be marked but the spaces for the number of sheets of the sequence listing and/or tables, respectively, under item (a) must be left blank; the type and number of carriers must also be indicated on the dotted lines at the bottom

of the left column; in addition, check-boxes Nos. 9, 9(ii) and/or 10(ii) and, where applicable, 9(iii) and/or 10(iii) must be marked if additional copies of the sequence listing and/or tables in electronic form are furnished.

Third, the applicant may choose to file the sequence listing and/or tables related thereto *both in electronic form and on paper*, under Section 801(a)(ii) (“option (c)”), in which case the number of sheets (on paper) of the sequence listing and/or tables, respectively, must be indicated under item (a) in the left column of Box No. IX (although those numbers of sheets will not be taken into account for calculation of the international filing fee) and check-boxes c(i) and/or c(ii), respectively, must be marked; the type and number of carriers must also be indicated on the dotted lines at the bottom of the left column; in addition, check-boxes Nos. 9, 9(ii) and/or 10(ii) and, where applicable, 9(iii) and/or 10(iii) must be marked if additional copies of the sequence listing and/or tables in electronic form are furnished.

Under all three options described above, the sequence listing must be presented as a separate part of the description (“sequence listing part of description”) in accordance with the standard contained in Annex C of the Administrative Instructions. Also, tables related to a sequence listing must be presented in accordance with the standard contained in Annex C-bis of the Administrative Instructions.

Items Accompanying the International Application:

Where the international application is accompanied by certain items, the applicable check-boxes must be marked, any applicable indication must be made on the dotted line after the applicable item, and the number of such items should be indicated at the end of the relevant line; detailed explanations are provided below only in respect of those items which so require.

Check-box No. 4: Mark this check-box where a copy of a general power of attorney is filed with the international application; where the general power of attorney has been deposited with the receiving Office, and that Office has accorded to it a reference number, that number may be indicated.

Check-box No. 5: Mark this check-box where a statement explaining the lack of signature of an inventor/applicant for the purposes of the United States of America is furnished together with the international application (see also Notes to Box No. X).

Check-box No. 7: Mark this check-box where a translation of the international application for the purposes of international search (Rule 12.3) is filed together with the international application and indicate the language of that translation.

Check-box No. 8: Mark this check-box where a filled-in Form PCT/RO/134 or any separate sheet containing indications concerning deposited microorganisms and/or other biological material is filed with the international application. If Form PCT/RO/134 or any sheet containing the said indications is included as one of the sheets of the description (as required by certain designated States (see the *PCT Applicant's Guide*, Volume I/B, Annex L)), do not mark this check-box (for further information, see Rule 13bis and Section 209).

Check-box No. 9: Where the international application contains a sequence listing and a copy thereof in electronic form is required by the ISA under Rule 13ter, the applicant may furnish the listing in electronic form (together with the required statement) to the receiving Office with the international application, in which case check-boxes Nos. 9, 9(i) and, where applicable, 9(iii) must be marked. Where the applicant has chosen option (b) or option (c) mentioned above, and an additional copy or copies of the sequence listing in electronic form are required under Section 804, the applicant may furnish such additional copies together with the international application, in which case check-boxes Nos. 9, 9(ii) and, where

PROPOSED MODIFICATIONS TO PARAGRAPH 192C
OF THE PCT RECEIVING OFFICE GUIDELINES

192C. Where the request contains one or more declarations referred to in Rule 4.17, the receiving Office may check (Rule 26*ter*.2(a)) that:

(i) each declaration is worded as prescribed by Sections 211 to 215, as applicable, and indicates the designated States to which it applies (as explained in the Notes to the request form). The standardized wording of the declaration of inventorship which is applicable only for the purpose of the designation of the United States of America is pre-printed in Box No. VIII (iv) since no part of that wording may be omitted by the applicant;

(ii) any declaration of inventorship in Box No. VIII (iv) is signed and dated directly by the inventor for the United States of America, ~~unless that inventor himself has signed the request~~—a signature by an appointed agent is not sufficient for that purpose.

The receiving Office carries out no further checks on any declarations contained in the request form. In particular, it does not check that the name(s) and address(es) of the person(s) making a declaration correspond to the name(s) and address(es) of the applicant(s) or inventor(s) indicated in Boxes Nos. II and III of the request form. It also does not check for the purposes of which State a given declaration is made under Rule 4.17.

[End of Annex III]