



# Practice Update

**Patents**  
**December 2007**

## Declaration of Entitlement

Amendments to the *Patent Rules* which came into force on June 2, 2007 introduced the requirement to file a Declaration of Entitlement to declare the applicant's right to file a patent application on behalf of the inventor(s). The Declaration of Entitlement relates only to events occurring before the Canadian filing date (which in the case of a PCT national phase application is the international filing date).

In applications having a filing date of June 2, 2007 or later, a transfer of title occurring before the filing date must now be declared by filing a Declaration of Entitlement. The alternatives available in the Declaration of Entitlement can be found in paragraph 3(2) of Form 3 to Schedule I of the amended *Patent Rules*. The Declaration of Entitlement may be part of the Petition, or filed as a separate document. In the case of a PCT national phase entry, if a Declaration of Entitlement was not filed under Rule 4.17 of the PCT regulations it can be filed as a separate document with the Request for National Entry.

Practitioners should be aware that to avoid a completion fee, the Declaration of Entitlement must be filed on or before the deadline set out in subsections 94.(2) and (3) of the *Patent Rules*. CIPO will generally issue a Courtesy Letter informing the applicant that, in order to avoid payment of a completion fee, the Declaration of Entitlement is due on or before the relevant due date. If no Declaration is filed by the relevant due date, CIPO will, pursuant to subsection 94.(1), send a formal requisition for completion of the application.

Under the transitional provisions, in applications having a filing date earlier than June 2, 2007, the applicant has the option of either complying with the requirements of section 37 of the Rules as they read before June 2, 2007 (i.e. registering documents and evidence to establish that the applicant is the legal representative of the inventor) or filing a Declaration of Entitlement. Many Courtesy Letters issuing shortly after the new Rules came into force did not recite both options, but CIPO has indicated to IPIC that both options are available and this is reflected in the Courtesy Letters and requisitions currently being sent.

IPIC recommends that in all cases, even where a Declaration of Entitlement is filed, practitioners should still consider registering an assignment. This may give the assignee priority under section 51 of the *Patent Act* which the Declaration of Entitlement may not confer.

Further, in all cases, any change in title occurring after the filing date must still be established by registering an assignment. However, it is IPIC's understanding that in respect of PCT national phase applications CIPO will not require submission of an assignment to reflect a change in ownership occurring between filing and entry into the national phase, provided the change is documented in a Form 306 issued by WIPO.

Finally, IPIC recommends separating the declaration of entitlement from the petition in view of s.53.(1) of the *Patent Act*, which provides, in part, that a patent is void if any material allegation in the petition is untrue.

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**Caution:**

These practice updates are based on experiences of IPIC members and are offered freely in case they might be of assistance in your practice. Be aware, however, that the practice updates do not necessarily represent the official position of the Canadian Intellectual Property Office on any particular topic and, therefore, caution should be exercised in relying on them.