

Patent Cooperation Treaty (PCT) Working Group

**Eleventh Session
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DELEGATION OF DESIGNATED OR ELECTED OFFICE FUNCTIONS

Document prepared by the International Bureau

SUMMARY

1. This document proposes to amend the PCT Regulations to provide Contracting States with the possibility to delegate designated and elected Office functions to the Office of any other Contracting State or an intergovernmental organization.

BACKGROUND

2. In the past, a number of Contracting States have expressed the wish for more flexibility within the PCT System with a view to expressly allowing Contracting States which are not Member States of a regional patent treaty to effectively “close the national route” by delegating designated and elected Office functions to an Office of another Contracting State or an intergovernmental organization. Applicants would then no longer be able to enter the national phase directly before the national Office of such a “delegating” Contracting State. Instead, patent protection for such a State would only be available “via” the Office or intergovernmental organization to which the designated and elected Office function had been delegated, once a patent had been granted by that Office or intergovernmental organization. In this situation, the effects of that granted patent would be extended to the “delegating” Contracting State on the basis of a bilateral agreement between that State and the Contracting State of the Office or the intergovernmental organization to which the designated and elected Office functions had been delegated.

3. In the view of the International Bureau, the current PCT legal framework only allows for a State to “close the national route” if the State is also a party to a regional patent treaty within the meaning of Article 45(1). Where such a State has closed the national route, the regional Office

acts as the competent designated or elected Office in line with Article 2(xiii) and (xiv), thereby allowing the applicants to seek protection in that State via the PCT-regional route under Article 4(1)(ii) and Article 45(2)¹. At present, there is no express provision in the PCT which would allow a State not party to a regional patent treaty to close its national route in that way.

4. The International Bureau recognizes that it may be desirable in some instances for a Contracting State which is not a member State of a regional patent treaty to delegate some or all of the PCT functions usually carried out by its national Office, notably for reasons of efficiency, economy, capacity or any other purposes. In this regard, Rule 19.1(b) expressly provides that a Contracting State may delegate its receiving Office functions to the Office of another Contracting State or an intergovernmental organization. At present, 37 Contracting States have taken advantage of this possibility and have delegated receiving Office functions, on the basis of a bilateral agreement, to the Office of another Contracting State or to an intergovernmental organization, including the International Bureau².

PROPOSAL

5. It is thus proposed to amend the Regulations, as set out in the Annex to the present document, by adding a new Rule (Rule 50*bis*) which would expressly allow a Contracting State to delegate its designated Office functions to the national Office of any other Contracting State or to any intergovernmental organization. It is further proposed to amend Rule 76.5 so as to extend the application of proposed new Rule 50*bis* to the elected Office functions.

6. By agreeing to accept the delegation of the designated and elected Office functions, the Office or intergovernmental organization to which those functions have been delegated would assume all rights and obligations in respect of the “delegating” Contracting State designated or elected in an international application and would have to perform all delegated functions in accordance with the PCT.

7. Under proposed new Rule 50*bis*, the delegating Contracting State would be required to notify the International Bureau of any “delegation” agreement; the International Bureau would then promptly publish any such notification in the Gazette (and would also reflect any such information in the *PCT Applicant's Guide*).

8. *The Working Group is invited to comment on the proposed amendments to the Regulations set out in the Annex to this document.*

[Annex follows]

¹ For a table of States for which only a regional patent can be obtained, see http://www.wipo.int/pct/en/texts/reg_des.html.

² See Annex C of the *PCT Applicant's Guide* at <http://www.wipo.int/pct/en/appguide/index.jsp>.

PROPOSED AMENDMENTS TO THE PCT REGULATIONS³

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³ Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned.

Rule 50bis

Designated Office Functions

50bis.1 Delegation of Designated Office Functions

(a) Any Contracting State may agree with another Contracting State or any intergovernmental organization that the national Office of the latter State or the intergovernmental organization shall, for all or some purposes, act instead of the national Office of the former State as designated Office in respect of international applications in which the former State has been designated.

(b) Any agreement referred to in paragraph (a) shall promptly be notified to the International Bureau by the Contracting State which delegates the functions of designated Office to the national Office of another Contracting State or an intergovernmental organization. The International Bureau shall promptly publish any such notification in the Gazette.

Rule 76

Translation of Priority Document;

Application of Certain Rules to Procedures before Elected Offices

76.1 to 76.4 [No Change]

76.5 Application of Certain Rules to Procedures before Elected Offices

Rules 13~~ter~~.3, 20.8(c), 22.1(g), 47.1, 49, 49~~bis~~, 49~~ter~~.[50bis](#) and 51~~bis~~ shall apply, provided that:

(i) [No change] any reference in the said Rules to the designated Office or to the designated State shall be construed as a reference to the elected Office or to the elected State, respectively;

(ii) to (v) [No change]

[End of Annex and of document]