

## **Patent Cooperation Treaty (PCT) Working Group**

**Seventh Session  
Geneva, June 10 to 13, 2014**

### **RIGHT TO PRACTICE BEFORE THE RECEIVING OFFICE OF THE INTERNATIONAL BUREAU**

*Document prepared by the International Bureau*

#### **SUMMARY**

1. It is proposed that any person who has the right to practice before the national Office of any PCT Contracting State should have the right to practice before the receiving Office of the International Bureau, irrespective of the nationality or residence of the applicants. Such a person would, when appointed, have the right also to practice before the International Bureau as such, the International Searching Authority and, where relevant the International Preliminary Examining Authority and any Authority specified for supplementary search.

#### **BACKGROUND**

2. In 2013, around 750 international applications were received by the receiving Office of the International Bureau (7 per cent of its total) where the applicant wished to appoint an agent who was not clearly competent to act according to Rules 83 and 90.

3. In such cases, the receiving Office of the International Bureau is forced to treat the purported agent as merely an “address for correspondence” and cannot accept the signature of the purported agent in place of that of the applicant, even though a power of attorney may have been provided. This causes significant extra work in seeking replacement signatures for the international application, documents received with the international application and other documents received later on in the process.

4. In general, the intended agent is qualified to act before the national Office of one country, but that country is different from the one of which the applicant is a national or resident. A majority of these cases were ones which had been transferred under Rule 19.4 to the International Bureau from an original receiving Office which finds itself not competent to act, for example because the applicants are neither nationals of, nor resident in the relevant State. In 90 per cent of those cases, the relevant agent would have been competent to act before the original receiving Office.

5. The International Bureau recognizes the importance of professional standards, but routinely acts on behalf of all PCT Contracting States. As such, it has no need for a “local” address for correspondence and does not require an agent to have specialized knowledge of one national procedure above that of any other.

6. There seems to be no practical reason to prevent an applicant from appointing a qualified person as agent simply because their qualification relates to the “wrong” national Office. The additional work involved for both applicants and the International Bureau in seeking replacement signatures does not result in a practical benefit for anyone.

## **PROPOSAL**

7. It is proposed to amend Rule 83.1 *bis*(a) as set out in the Annex to this document to offer the right to practice before the receiving Office of the International Bureau to any person who has the right to practice before the national Office of any PCT Contracting State (or a regional Office acting for any PCT Contracting State), irrespective of the nationality or residence of the applicant.

8. If so appointed, such a person would, as at present, also have the right to act before any of the other Offices having functions in the international phase.

9. In principle, it would be possible to limit the proposal to “Rule 19.4” cases where the agent would have been competent to act before the Office where the international application was originally deposited. However, this seems to risk the possibility of international applications deliberately being filed with a non-competent Office which could have been sent directly to the receiving Office of the International Bureau, simply to permit the use of a preferred agent. This might cause almost as much additional work as the proposal seeks to eliminate. Consequently, the International Bureau would not propose extending the right to practice subject to any such limitation.

10. *The Working Group is invited to consider the proposal set out in the Annex to this document.*

[Annex follows]

## PROPOSED AMENDMENTS TO THE PCT REGULATIONS<sup>1</sup>

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<sup>1</sup> Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned. Certain provisions that are not proposed to be amended may be included for ease of reference.

## Rule 83

### Right to Practice before International Authorities

#### 83.1 [No change] Proof of Right

The International Bureau, the competent International Searching Authority, and the competent International Preliminary Examining Authority, may require the production of proof of the right to practice referred to in Article 49.

#### 83.1bis Where the International Bureau Is the Receiving Office

(a) Any person who has the right to practice before the national Office of, or acting for, ~~a~~ any Contracting State ~~of which the applicant or, if there are two or more applicants, any of the applicants is a resident or national~~ shall be entitled to practice in respect of the international application before the International Bureau in its capacity as receiving Office under Rule 19.1(a)(iii).

(b) [No change] Any person having the right to practice before the International Bureau in its capacity as receiving Office in respect of an international application shall be entitled to practice in respect of that application before the International Bureau in any other capacity and before the competent International Searching Authority and competent International Preliminary Examining Authority.

#### 83.2 [No change] Information

(a) The national Office or the intergovernmental organization which the interested person is alleged to have a right to practice before shall, upon request, inform the International Bureau, the competent International Searching Authority, or the competent International Preliminary Examining Authority, whether such person has the right to practice before it.

(b) Such information shall be binding upon the International Bureau, the International Searching Authority, or the International Preliminary Examining Authority, as the case may be.

**Rule 90 [No change]**

**Agents and Common Representatives**

*90.1 [No change] Appointment as Agent*

(a) A person having the right to practice before the national Office with which the international application is filed or, where the international application is filed with the International Bureau, having the right to practice in respect of the international application before the International Bureau as receiving Office may be appointed by the applicant as his agent to represent him before the receiving Office, the International Bureau, the International Searching Authority, any Authority specified for supplementary search and the International Preliminary Examining Authority.

(b) A person having the right to practice before the national Office or intergovernmental organization which acts as the International Searching Authority may be appointed by the applicant as his agent to represent him specifically before that Authority.

(b-bis) A person having the right to practice before the national Office or intergovernmental organization which acts as the Authority specified for supplementary search may be appointed by the applicant as his agent to represent him specifically before that Authority.

(c) A person having the right to practice before the national Office or intergovernmental organization which acts as the International Preliminary Examining Authority may be appointed by the applicant as his agent to represent him specifically before that Authority.

(d) An agent appointed under paragraph (a) may, unless otherwise indicated in the document appointing him, appoint one or more sub-agents to represent the applicant as the applicant's agent:

(i) before the receiving Office, the International Bureau, the International Searching Authority, any Authority specified for supplementary search and the International Preliminary Examining Authority, provided that any person so appointed as sub-agent has the right to practice before the national Office with which the international application was filed or to practice in respect of the international application before the International Bureau as receiving Office, as the case may be;

(ii) specifically before the International Searching Authority, any Authority specified for supplementary search or the International Preliminary Examining Authority, provided that any person so appointed as sub-agent has the right to practice before the national Office or intergovernmental organization which acts as the International Searching Authority, the Authority specified for supplementary search or the International Preliminary Examining Authority, as the case may be.

*90.2 to 90.6 [No change]*

[End of Annex and of document]