

WIPO



PCT/AAQ/VII/5

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DATE: August 16, 1976

WORLD INTELLECTUAL PROPERTY ORGANIZATION  
GENEVA

**PATENT COOPERATION TREATY**

**INTERIM ADVISORY COMMITTEE FOR ADMINISTRATIVE QUESTIONS**

**Seventh Session**

**Geneva, November 1 to 8, 1976**

DRAFT MODEL AGREEMENT BETWEEN AN INTERNATIONAL SEARCHING AUTHORITY AND THE  
INTERNATIONAL BUREAU

prepared by the International Bureau

Background to This Document

1. The PCT Interim Advisory Committee for Administrative Questions (hereinafter referred to as "the Interim Committee"), at its sixth session, held in Geneva from October 27 to November 3, 1975, included in its program for 1976 continuation of work on the elaboration, in the light of the recommendations of the Interim Committee, of a Draft Model Agreement between the International Bureau and an International Searching Authority (see the report of the sixth session, document PCT/AAQ/VI/21, paragraph 135(v)).

2. The Interim Committee, at its sixth session, considered a first draft of the Model Agreement prepared by the International Bureau. The Interim Committee noted that, once the revision of the draft in the light of the comments made at that session had been completed, it would be sent by the International Bureau to all prospective International Searching Authorities (hereinafter referred to as "the prospective Authorities") and to the Interim Committee of the European Patent Organisation", (EPO), with a request for their comments, and to the extent possible, all indications necessary for the preparation of drafts of individual agreements for each of the prospective Authorities.

Request for Comments on the Draft Model Agreement

3. In accordance with the decision of the Interim Committee, the International Bureau sent to the prospective International Searching Authorities Circular Letter No. 2395, dated January 6, 1976, with the request that they should either mark up the revised Draft Model Agreement, attached to the Circular Letter, with any changes they would recommend, or make comments in any other way they might desire. It was recalled that the comments should furnish the International Bureau with all indications necessary for the preparation of drafts of individual agreements for each of the prospective Authorities. Responses containing observations involving points of substance were received from the following prospective Authorities: Japanese Patent Office, State Committee for Inventions and Discoveries of the USSR Council of Ministers, Swedish Patent Office, United States Patent and Trademark Office. Consideration of the Draft Model Agreement was not completed by

the Interim Committee of the EPO at the time of preparation of this document and, in general, responses were not therefore received from the Interim Committee of the EPO or from prospective Authorities, other than the Swedish Patent Office, involved in a consideration of the Draft Model Agreement within the framework of the Interim Committee of the EPO.

#### Annexes to This Document

4. The Draft Model Agreement, as further revised by the International Bureau in the light of the responses received, is annexed to this document (Annex A). Circular Letter No. 2395 is reproduced in Annex B to this document. Since the text of the Draft Model Agreement annexed to the said Circular Letter appears in the Annexes to this document containing the responses from the prospective Authorities, it is not reproduced in Annex B.

5. Also annexed to this document are all the responses received from the prospective International Searching Authorities to Circular Letter No. 2395, namely:

Annex C: response from the German Patent Office

Annex D: response from the State Committee for Inventions and Discoveries of the USSR Council of Ministers

Annex E: response from the United States Patent and Trademark Office

Annex F: response from the Japanese Patent Office

Annex G: response from the Swedish Patent Office

#### The Present Revised Draft

6. Bearing in mind that there is a certain degree of disparity between the responses that have been received, that not much in terms of indications necessary for the preparation of drafts of individual agreements has been furnished so far and that not all prospective Authorities have yet provided comments, it is apparent that the time is not yet ripe to proceed to the negotiation of individual agreements with prospective Authorities. Nevertheless, the comments received have provided a basis for the preparation of a revised Draft Model Agreement which, after further discussion in the Interim Committee and any amendment thought necessary, could be used as a basis for the negotiation of individual agreements. It has therefore been thought best to revise the Draft Model Agreement for consideration by the Interim Committee at its present session.

7. The present Draft Model Agreement has been prepared taking into account the comments made by the prospective Authorities. Some changes of a drafting nature, and others of a more substantial kind, mainly affecting the amendment and termination of the Agreement, have been made on the initiative of the International Bureau.

8. In one or two cases, provisions have been left in their original form even though there has been a clear indication, in the responses received from prospective Authorities, of the need to consider changes (e.g., responses in relation to Article 5 dealing with documentation facilities). This has been done since not all the prospective Authorities have yet responded on this question and since it is considered that the issues raised are important ones on which discussion might best take place on the basis of the original text. Furthermore, some of the relevant provisions are of a nature probably requiring substantial negotiation on an individual basis, since the situation differs from Authority to Authority. Amendments made to the Model Agreement now reflecting the situation of one or some, but not all Authorities, would therefore not seem to be very useful at this stage.

9. Furthermore, the International Bureau has been conscious of the fact that the agreements finally negotiated will be subject to the approval of the Assembly and it has been thought preferable to have at least one further opportunity for discussion within the Interim Committee in order that the prospective Authorities and the International Bureau may have the benefit of any views held by other interested parties when they come to negotiate the final agreements.

10. The Interim Committee is invited to comment on the revised Draft Model Agreement and to advise the International Bureau concerning the further action it should take in the elaboration of drafts for individual agreements.

DRAFT MODEL AGREEMENT BETWEEN AN INTERNATIONAL  
SEARCHING AUTHORITY AND THE INTERNATIONAL BUREAU

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Agreement between .....(\*) and the International Bureau of the World Intellectual Property Organization in relation to the functioning of .....(\*) in the capacity of an International Searching Authority appointed under the Patent Cooperation Treaty.

#### Preamble

WHEREAS the States party to the Patent Cooperation Treaty, done at Washington on June 19, 1970, constitute a Union for cooperation in the filing, searching, and examination of applications for the protection of inventions, and for rendering special technical services, the said Union being known as the International Patent Cooperation Union;

AND WHEREAS it is recognized that the participation of the ..... (\*) as an International Searching Authority in matters affecting international search will contribute to the successful implementation of the Patent Cooperation Treaty;

AND WHEREAS Article 16(3) (b) of the Patent Cooperation Treaty provides, inter alia, that the appointment of an Office or intergovernmental Organization as an International Searching Authority by the Assembly of the International Patent Cooperation Union shall be subject to the conclusion of an Agreement between the Office or intergovernmental Organization and the International Bureau;

IT IS HEREBY AGREED between the .....(\*), hereinafter called the "Authority," and the International Bureau of the World Intellectual Property Organization, hereinafter called the "International Bureau," as follows:

#### Article 1

##### Terminology Used in the Agreement

(1) For the purpose of this Agreement, the "Treaty" means the Patent Cooperation Treaty done at Washington on June 19, 1970; the "Regulations" means the Regulations under the Treaty; the "Administrative Instructions" means the Administrative Instructions under the Treaty; "Article" (except where a specific reference is made to an Article of this Agreement) means an Article of the Treaty; "Rule" means a Rule of the Regulations; and "International Bureau" means the International Bureau as defined in Article 2(xix) of the Treaty.

(2) All other terms and expressions used in this Agreement are to be understood in the same sense as that in which they are used in the Treaty.

#### Article 2

##### Basic Obligation

(1) The Authority shall, except in respect of subject matter which, pursuant to Article 7 of this Agreement, the Authority is not required to search, carry out international searches in accordance with, and perform such other functions of an International Searching Authority as are provided under, the Treaty, the Regulations, the Administrative Instructions and this Agreement. The Authority undertakes to apply and observe all the common rules of international search.

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(\*) Reference will be made to a national Office or intergovernmental Organization

(2) The Authority and the International Bureau shall, having regard to their respective functions under the Treaty, the Regulations, the Administrative Instructions and this Agreement, each render, to the extent possible, assistance to the other in relation to the performance, by the other, of its functions thereunder.

### Article 3

#### Competence of International Searching Authority<sup>1</sup>

Subject to Article 6 of this Agreement, the Authority undertakes to act as an International Searching Authority [for all international applications] [for international applications of the kinds specified in Annex A of this Agreement] filed:

- (i) with the receiving Offices of, or acting for, [all States] [the States specified in Annex A of this Agreement], and
- (ii) in the languages specified in Annex A of this Agreement.

### Article 4

#### Minimum Personnel Requirements

(1) The Authority shall maintain a staff of at least .... fulltime employees with sufficient technical qualifications to carry out international searches under the Treaty.

(2) The Authority shall maintain a staff which is capable of searching in the required technical fields and which has language facilities to understand the following languages: .....<sup>2</sup>

### Article 5

#### Documentation Facilities

(1) The Authority shall maintain and use for search purposes, in addition to the minimum documentation facilities properly arranged for search purposes specified in the Regulations (Rule 34), the following documentation facilities:<sup>3</sup>  
(cite groups of documents outside Rule 34 as to time or as to country coverage)  
.....

- 
- 1 A Contracting State has the option to consider only one International Searching Authority or several such Authorities as competent to search international applications filed with its national Office and must inform the International Bureau of its choice. Where it considers several Authorities as competent, it must identify in its communication to the International Bureau each such Authority. In the latter situation, the identification may indicate either that all such Authorities are competent for the same kinds of international applications, leaving the choice to the applicant, or that certain of such Authorities are competent for one kind of international application and certain others are competent for other kinds of international applications (Article 16(2) and PCT Rules 35.1 and 35.2).
  - 2 Both of the language facilities required under Rule 36.1(iii) and any further language facilities should be referred to here.
  - 3 The Authority may wish to, and even should, maintain and use such documentation outside Rule 34, but no significant changes should be made without informing the International Bureau.

(2) Where a patent document is republished once or more than once, as such or as a granted patent, the Authority shall keep, in accordance with Rule 34.1(d), the following versions of such patent documents in its minimum documentation: .... (Examples: Offenlegungsschrift of the Federal Republic of Germany, Tokkyo Kokaikoho of Japan (as far as the English language abstracts are generally available) and the Première Publication of France).<sup>4</sup>

#### Article 6

##### Number or Kinds of International Applications Processed

The limitations which, in accordance with Article 65(1), the Authority will apply, for a transitional period of .... years, on the number or kinds<sup>5</sup> of international applications it will accept for searching are as follows .....

#### Article 7

##### Subject Matter Not Required To be Searched

The subject matter<sup>6</sup> specified in Rule 39.1 which the Authority will not search by virtue of Article 17(2)(a)(i) is specified in Annex B of this Agreement.

#### Article 8

##### Fees and Charges<sup>7</sup>

(1) A schedule of all fees of the Authority, and any other charges which the Authority is entitled to make, in relation to its function as an International Searching Authority, is set out in Annex C of this Agreement.

(2) The Authority shall, to the extent and under the conditions set out in Annex C of this Agreement, refund the whole or part of the search fee paid where a search report can be wholly or partially based on the results of an earlier international or international-type search<sup>8</sup> made by the Authority.

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4 The Regulations give the Authority the faculty of providing for substitution by a kind of document other than those specified herein (see Rule 34.1(d)).

5 The Authority may provide in its Agreement with the International Bureau, transitionally, for limitations on the number and kinds of international applications that such Authority will undertake to process. In such cases, the Assembly of the International Patent Cooperation Union shall adopt the procedures necessary for the gradual application of the Treaty in respect to the number or kinds of international applications to be processed. Alternatively, another International Searching Authority may undertake to perform the remaining searches for the Contracting State(s) concerned. This provision also applies to the preparation of international-type searches under Article 15(5) of the PCT (Article 65(1)).

6 The Treaty gives the Authority the faculty of excluding certain subject matter (e.g., plant varieties, computer programs, etc.) from international search (Article 17(2)(a)(i) and Rule 39). Such subject matter should be listed in the Annex.

7 In the interests of administrative efficiency, the search fee should be collected with the transmittal fee and basic fee part of the international fee at the time of the filing of the international application, although Rule 16.1(b) in conjunction with Rule 15.4(a) provides, in certain cases, for a possibility of later payment.

8 The earlier international or international-type search must relate to an application the priority of which is claimed in a later international application. (See Rule 16.3)

(3) The fee which the Authority will charge for the translation of the international application, according to Rule 48.3(b), whenever such application is filed in a language other than one of those prescribed for the publication of the international application in Rule 48.3(a), is set out in Annex C of this Agreement.

#### Article 9

##### Review Board

The Authority shall provide, in accordance with Rule 40.2(c) and (d), a .... [three-member board or special instance or competent higher authority] to examine protests in respect of additional fees where the international application is found not to comply with the requirement of unity of invention. The said [three-member board or special instance or competent higher authority] is designated in Annex D of this Agreement.

#### Article 10

##### Time Limit for Preparation of International Search Reports or Declarations

The Authority shall establish international search reports, or declarations under Article 17(2) (a), within the time limits<sup>9</sup> specified in the first two sentences of Rule 42.1.

#### Article 11

##### Classification

Any other classification<sup>10</sup> of the subject matter which the Authority will apply, in addition to the International Patent Classification, is indicated in Annex E of this Agreement.

#### Article 12

##### International-Type Search<sup>11</sup>

(1) The Authority shall make an international-type search on all national applications filed in the States referred to in Annex A of this Agreement as far as such is permitted by the law of, and is requested by, any such State.

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9 In negotiating the Agreement, the Authority may avail itself of the opportunity to negotiate slightly longer time limits for the preparation of international search reports or declarations for the first three years after entry into force of the Treaty (see Rule 42.1, last sentence).

10 Since the normal indication of classification is according to the International Patent Classification (see Rule 43.3(a)), such indication of symbols of another classification system constitutes the exception.

11 International-type search is obligatory, to the extent to which the national law of the State concerned so provides and the national Office of that State subjects applications filed with it to such search (Article 15(5) (b)). It is optional for the applicant to the extent to which the national law of the State concerned so provides and no obligatory search of the kind referred to above is prescribed (Article 15(5) (a)). The obligatory international-type search assists national Offices in particular of developing countries to establish an effective filter for national applications not using the PCT route. The optional international-type search assists prospective PCT applicants in determining, at an early date, whether or not to seek protection for their domestic origin inventions in one or more foreign countries via the PCT route.

(2) The Authority shall make an international-type search on national applications filed in the States referred to in Annex A of this Agreement whose national laws so permit, and where the applicant so requests.

(3) Where the national application is not in a language in which the Authority has undertaken to search international applications under Article 3 of this Agreement, the international-type search shall be carried out on a translation in a language which the Authority has undertaken to accept for international applications under Article 3 of this Agreement.

### Article 13

#### Information Service and Technical Assistance<sup>12</sup>

The Authority shall supply the International Bureau with such information services and such other contributions to the technical assistance program under Chapter IV of the Treaty as are practicable within the existing facilities of the Authority and as may be agreed.

### Article 14

#### Entry Into Force of the Agreement

This Agreement shall enter into force upon approval by the Assembly. The Agreement together with an indication of the date of its entry into force shall be published in the Gazette by the International Bureau.

### Article 15

#### Duration and Renewability of the Agreement

This Agreement shall remain in force for a period of .... years.<sup>13</sup> It shall be renewable for a period of .... years subject to the approval of, and the extension of the appointment of the Authority for that period by, the Assembly.

### Article 16

#### Amendment

(1) Without prejudice to paragraphs (2) and (3), amendments may be made to this Agreement by agreement between the parties hereto and shall take effect upon approval of those amendments by the Assembly, or, if a later date is specified in the amendments, on that date.

(2) Without prejudice to the provisions of paragraph (3), amendments may be made to the Annexes of this Agreement by agreement between the parties hereto and shall take effect upon notification in the Gazette or, if a later date is specified in the amendments, on that date.

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<sup>12</sup> This Article provides the basis for negotiating with the Authority its participation in patent information services to be established and technical assistance to developing countries to be provided under Chapter IV of the PCT.

<sup>13</sup> The period specified and the period of appointment as an International Searching Authority should be identical.



(3) The Authority may, by notice in writing given to the International Bureau:

(a) add to the kinds of applications and the languages listed in Annex A of this Agreement and to the documentation facilities listed in Article 5 of this Agreement;

(b) amend the limitations, specified in Article 6 of this Agreement, on the number or kinds of international applications it will accept for searching, but only so as to increase the number or kinds of applications it will so accept;

(c) subject to paragraph (4), amend the schedule of fees and other charges contained in Annex C of this Agreement;<sup>14</sup> and

(d) amend Annex E of this Agreement by omitting classifications specified therein or adding classifications thereto.

(4) The schedule of fees and other charges shall not be amended during the first year after the entry into force of this Agreement or thereafter at an interval of less than one year from a previous amendment of the schedule. Any amendment of the schedule shall take effect one month after publication of the notification of the amendment in the Gazette pursuant to paragraph (5), or, if a later date has been specified by the Authority, on the date specified by the Authority.

(5) The International Bureau shall publish promptly in the Gazette any amendment of this Agreement agreed between the parties and approved by the Assembly under paragraph (1), any amendment of this Agreement agreed between the parties under paragraph (2), and any notification received by it under paragraph (3).

#### Article 17

#### Termination of the Agreement<sup>15</sup>

(1) This Agreement shall terminate:

(a) if the Authority gives the Director General of the International Bureau written notice to terminate this Agreement; or

(b) if the Director General of the International Bureau, with the approval of the Assembly, gives the Authority written notice to terminate this Agreement.

(2) The termination of this Agreement under paragraph (1) shall take effect one year after receipt of the notice by the other party.

(3) Notwithstanding paragraph (2), if:

(a) notice to terminate this agreement is given by the Authority under paragraph (1); and

(b) at the same time [the country of the Authority denounces] [all such countries as are both member States of the Authority and Contracting States under the Treaty, and have not previously denounced the Treaty, denounce] the Treaty under Article 66,

the notice to terminate this Agreement shall take effect [at the same time as the denunciation of the Treaty takes effect] [at such time as the denunciation of the Treaty becomes effective for all such countries].

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14 The question could be further studied whether substantial increases in the amounts specified in the schedule should not be subject to the agreement of the parties or even to approval by the Assembly.

15 Since the existence of the Agreement is a condition of the appointment of an International Searching Authority, the termination of the Agreement can only be expected to be considered on the basis that the termination of the appointment of an International Searching Authority by the Assembly was also desired.

IN WITNESS WHEREOF the parties hereto have executed this Agreement.

DONE in duplicate at ....., this ..... day of ....., in originals in the .....  
and ..... languages, each text being equally authentic.

For the Authority by:

For the International Bureau by:

[Listing of PCT Provisions relevant to  
Articles of the Agreement follows]

LISTING OF PCT PROVISIONS RELEVANT TO ARTICLES OF THE AGREEMENT

General	The Agreement	PCT Article 16(3)(b), PCT Article 17(1) (Procedural Matters) Rules 12, 42, 89.1(b)
Article 1	Terminology Used in the Agreement	PCT Article 2
Article 2	Basic Obligation	_____
Article 3	Competence of International Searching Authority	PCT Articles 16(2), 16(3)(b) Rules 12, 35.1 and 35.2
Article 4	Minimum Personnel Requirements	PCT Rule 36.1(i)(iii)
Article 5	Documentation Facilities	
	(1) Minimum Documentation	PCT Article 16(3)(c), Rule 34, Rule 36.1(ii)
	(2) Expansion of Minimum Documentation	PCT Rule 34
Article 6	Number or Kinds of International Applications Processed	PCT Article 65(1)
Article 7	Subject Matter Not Required To Be Searched	PCT Article 17(2)(a)(i) Rule 39.1(i) to (vi), Rule 15.4(a)
Article 8	Fees and Charges	
	(1) Search Fee	PCT Article 3(4)(iv), Rules 16.1 and 86.1(ii)
	(2) Fee Refund	PCT Rules 16.3 and 41.1
	(3) Fee for Translation	PCT Rule 48.3
	(4) Charge for Copies	PCT Rule 44.3
Article 9	Review Board	PCT Rule 40.2(c) and (d)
Article 10	Time Limit for Preparation of International Search Reports or Declarations	PCT Rule 42.1
Article 11	Classification	PCT Article 18, Rule 43
Article 12	International-Type Search	PCT Article 15(5)(a) to (c), Rule 41
Article 13	Information Service and Technical Assistance	PCT Articles 50 and 51
Article 14	Entry Into Force of the Agreement	PCT Article 16(3)(e)
Article 15	Duration and Renewability of the Agreement	PCT Article 16(3)(e)
Article 16	Amendment	_____
Article 17	Termination of the Agreement	PCT Article 16(3)(3)

[Annex B follows]



WORLD INTELLECTUAL PROPERTY ORGANIZATION  
ORGANISATION MONDIALE DE LA PROPRIÉTÉ INTELLECTUELLE

C.2395  
PCT 20

January 6, 1975

It would be appreciated if you could let us have a marked-up copy of the revised edition of the draft Model Agreement, or any other comments that you would wish to provide, on or before April 1, 1976.

C. 2395  
PCT 20

January 6, 1976

Sincerely yours,

K. Pfanner  
Deputy Director General

Sir,

I have the honor to send you herewith two copies of the revised edition of the document entitled Draft Model Agreement between an International Searching Authority and the International Bureau. The first edition of said Agreement was established by the International Bureau of WIPO (see document PCT/AAQ/VI/8) for the PCT Interim Advisory Committee for Administrative Questions during its recent sixth session held in Geneva.

The present revised edition was established by the International Bureau on the basis of the advice provided by the Interim Committee in its sixth session for the purpose of seeking comments thereon in writing from all prospective International Searching Authorities and the Interim Committee of the European Patent Organisation (see paragraphs 111-128 of the Report of the Sixth Session, document PCT/AAQ/VI/21).

It is recalled that these comments are, to the extent possible, intended to assist the International Bureau by furnishing it with all indications necessary for the preparation of drafts of individual agreements for each of the prospective Authorities.

It would no doubt facilitate preparation of these drafts of individual agreements if you would mark up a copy of the revised edition of the draft Model Agreement with any changes you recommend. The marking could be done by hand, so that the proposed changes can be easily distinguished from the revised edition prepared by us. This does not, of course, exclude the possibility of making comments in any other way you may desire.

./.

[Annex C follows]

PCT/AAQ/VII/5  
ANNEX B

DER PRÄSIDENT  
DES DEUTSCHEN PATENTAMTS

8000 MÜNCHEN 2, den March 5, 1976  
Zweibrückenstraße 12  
Fernruf (0 89) 2 19 51      Fernschreiber 5 2J 534  
Fernrufdurchwahl (0 89) 21 95      Hausruf \_\_\_\_\_  
Geschäfts-Nr. 9330/10 H5 Bln. Bd. III 44/  
Bitte in der Antwort die vorstehende Geschäftsnummer angeben. 76  
AZ: 9330/10

- 2 -

Dr. Klaus Pfanner  
Deputy Director General  
World Intellectual Property  
Organization (WIPO)  
32, chemin des Colombettes  
CH - 1211 G e n e v e 20

Re: Comments on the Draft of a Model Agreement between  
an International Searching Authority and the Inter-  
national Bureau

Ref.: Circular C. 2395 PCT 20 of January 6, 1976


Dear Dr. Pfanner,

In the revised draft of the Agreement referred to above,  
the amendments have been considered as advanced by the  
delegations in the last session of the Interim Advisory  
Committee for Administrative Questions. I am grateful to  
the International Bureau for the establishment of this  
new draft.

Although the German Patent Office is envisaged to be an  
International Searching Authority, according to the Pro-  
tocol of Centralization to the European Patent Convention,  
however, the Federal Republic of Germany will, upon the  
entry into force of the Convention, renounce its activity  
as International Searching Authority under the Cooperation  
Treaty for the German Patent Office in favour of the Euro-  
pean Patent Office. This means that the German Patent Of-  
fice will not conclude an Agreement corresponding to the  
Draft Model Agreement with the International Bureau.

At the same time the Draft of the above Model Agreement  
has been submitted to the delegations of Working Group II  
of the Interim Committee of the European Patent Organiza-  
tion and shall be discussed at the next session of the  
Working Group from May 11 until May 13, 1976, in order to  
issue a comment for the European Patent Office in its  
capacity as International Searching Authority. Therefore  
I should like to refrain from giving a detailed comment  
at the moment and shall coordinate my opinion with that  
of the other delegations represented in Working Group II.

Sincerely yours,

  
Dr. Häusser

[Annex D follows/L'annexe D suit]

PCT/AAQ/VII/5  
ANNEX C/ANNEXE C

DER PRÄSIDENT  
DES DEUTSCHEN PATENTAMTS

8000 MÜNCHEN 2, den March 5, 1976  
Zweibrückenstraße 12  
Fernruf (0 89) 2 19 51 Fernschreiber 5 2J 534  
Fernrufdurchwahl (0 89) 21 95 Hausruf \_\_\_\_\_  
Geschäfts-Nr. 9330/10 H5 Bln. Bd. III 44/  
Bitte in der Antwort die vorstehende Geschäftsnummer angeben. 76  
AZ: 9330/10

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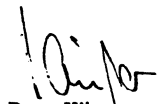
Dr. Klaus Pfanner  
Deputy Director General  
World Intellectual Property  
Organization (WIPO)  
32, chemin des Colombettes  
CH - 1211 Genf 20

At the same time the Draft of the above Model Agreement has been submitted to the delegations of Working Group II of the Interim Committee of the European Patent Organization and shall be discussed at the next session of the Working Group from May 11 until May 13, 1976, in order to issue a comment for the European Patent Office in its capacity as International Searching Authority. Therefore I should like to refrain from giving a detailed comment at the moment and shall coordinate my opinion with that of the other delegations represented in Working Group II.

Re: Comments on the Draft of a Model Agreement between an International Searching Authority and the International Bureau

Ref.: Circular C. 2395 PCT 20 of January 6, 1976

Sincerely yours,

  
Dr. Häusser

Dear Dr. Pfanner,

In the revised draft of the Agreement referred to above, the amendments have been considered as advanced by the delegations in the last session of the Interim Advisory Committee for Administrative Questions. I am grateful to the International Bureau for the establishment of this new draft.

Although the German Patent Office is envisaged to be an International Searching Authority, according to the Protocol of Centralization to the European Patent Convention, however, the Federal Republic of Germany will, upon the entry into force of the Convention, renounce its activity as International Searching Authority under the Cooperation Treaty for the German Patent Office in favour of the European Patent Office. This means that the German Patent Office will not conclude an Agreement corresponding to the Draft Model Agreement with the International Bureau.

[Annex D follows/L'annexe D suit]

PCT/AAQ/VII/5  
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Agreement between . . . . (\*) and the International Bureau of the World Intellectual Property Organization in respect of the functioning of . . . . (\*) as an International Searching Authority under the Patent Cooperation Treaty.

Preamble

WHEREAS the States party to the Patent Cooperation Treaty constitute a Union for cooperation in the filing, searching, and examination of applications for the protection of inventions, and for rendering special technical services, the said Union being known as the International Patent Cooperation Union; and

WHEREAS it is recognized that the participation of the . . . . (\*) as an International Searching Authority in matters affecting international search will contribute to the successful implementation of the Patent Cooperation Treaty.

WHEREAS having regard to Article 16(3) (b) of the Patent Cooperation Treaty done at Washington on 19 June 1970 [the . . . . (\*) ~~hereinafter called the "Authority,"~~ and the International Bureau of the World Intellectual Property Organization, ~~hereinafter called the "International Bureau,"~~ hereby agree as follows:

Article 1

Terminology Used in Agreement

(1) For the purpose of this Agreement, the "Treaty" means the Patent Cooperation Treaty done at Washington on 19 June 1970; the "Regulations" means the Regulations under the Treaty; the "Administrative Instructions" means the Administrative Instructions under the Regulations; ~~"Article" means an Article of the Treaty,~~ ~~"Rule" means a Rule of the Regulations,~~ "International Bureau" means the International Bureau as defined in Article 2 (xix) of the Treaty; and the "Authority" means ~~the International Searching Authority,~~ . . . . .

(2) All other terms and expressions used in this Agreement are to be understood in the same sense in which they are used in the Treaty.

Article 2

Basic Obligation

~~With respect to the subject matter covered by this Agreement, the Authority agrees to carry out searches in accordance with the Treaty while complying with the requirements set forth in the Treaty, in the Regulations and in the Administrative Instructions and, subject to the said requirements, with the provisions of this Agreement.~~

(SEE attached sheet)

(\*) Reference will be made to a national Office or intergovernmental Organization

Article 3

Competence of International Searching Authority<sup>1</sup>

~~The Authority agrees to act as an International Searching Authority for international applications filed during the term of this Agreement:~~

- (i) with the receiving Offices of, or acting for, all States, or of, or acting for, the States specified in Annex A to this Agreement, and
- (ii) in the languages specified in Annex A, and
- (iii) for the kinds of international applications specified in Annex A.

Annex A may be amended by mutual agreement at any time during the duration of the Agreement, in particular by adding or deleting States, languages or certain kinds of international applications. (SEE ATTACHED SHEET)

Article 4

Minimum Personnel Requirements

- (1) The Authority shall maintain during the term of its appointment ~~a minimum requirement of at least 100~~ full-time employees with sufficient technical qualifications to carry out searches.
- (2) The Authority ~~shall~~ <sup>shall</sup> ~~maintain~~ <sup>during the term of its appointment</sup> a staff which is capable of searching the required technical fields and which has the language facilities to understand ~~the following languages:~~ <sup>those languages in which the minimum documentation referred to in Rule 34 of the Regulations is written or is translated.</sup>

Article 5

Documentation Facilities

- (1) The Authority agrees to maintain and use for search purposes during the term of its appointment, ~~in addition to the minimum documentation facilities properly arranged for search purposes specified in the Regulations (Rule 34), the following documentation facilities:~~ <sup>and also</sup> (cite groups of documents outside Rule 34 as to time or as to country coverage)<sup>3</sup> . . . . .
- (2) Where a patent document is republished once or more than once, as such or as granted patent, the Authority agrees to keep, in accordance with Rule 34.1(d), ~~the following versions of each patent document in its minimum documentation:~~ <sup>at least one</sup> (Examples: Offenlegungsschrift of the Federal Republic of Germany, Tokkyo Kohaikou of Japan (as far as the English language abstracts are generally available) and the Première Publication of France).<sup>4</sup>

<sup>1</sup> A Contracting State has the option to consider only one International Searching Authority or several such Authorities as competent to search international applications filed with its national Office and must inform the International Bureau of its choice. Where it considers several Authorities as competent, it must identify in its communication to the International Bureau each such Authority. In the latter situation, the identification may indicate that either all such Authorities are competent for the same kinds of international applications leaving the choice to the applicant or that certain of such Authorities are competent for one kind of international application and certain others competent for other kinds of international applications (Article 16(2) and PCT Rules 35.1 and 35.2).

<sup>2</sup> Both of the language facilities required under Rule 36.1(iii) and any further language facilities should be referred to here.

<sup>3</sup> In negotiating the Agreement, the Authority may maintain and use such documentation outside Rule 34, but no significant changes should be made without informing the International Bureau.

<sup>4</sup> The Regulations give the faculty to the Authority to provide for substitution by a kind of document other than those specified herein. (See Rule 34.1(d)).

~~Article 6~~

~~Number or Kinds of International Applications Processed~~

~~For a transitional period of . . . . . years, the Authority shall apply the following limitation on the number or kinds of international applications which it will accept for searching under Article 65 of the Treaty:~~

Article ~~6~~ 6

Subject Matter not Required to be Searched

Annex ~~B~~ <sup>C</sup> to this Agreement defines the subject matter<sup>6</sup> which the Authority will not search under Article 17(2) (a) (i) as specified in Rule 39.1.

Article ~~8~~ 7

Fees<sup>7</sup>

- (1) Annex ~~B~~ <sup>D</sup> to this Agreement contains a schedule of all fees of the Authority which are related to its function as an International Searching Authority. ~~That Annex may be modified by the Authority not more frequently than once a year. Such modification will take effect one month after its publication by the International Bureau.~~
- (2) The Authority shall, to the extent and under the conditions set forth in Annex ~~B~~ <sup>E</sup> to this Agreement, refund the whole or part of the search fee paid where a search report can be wholly or partially based upon the results of an earlier international or "international-type" search.<sup>8</sup>

~~(3) The Authority shall charge a fee, as prescribed in Annex C to this Agreement, for the translation of the international application, according to Rule 48.3(b), whenever such application is filed in a language other than one of those prescribed for the publication of the international application in Rule 48.3(a).~~

<sup>5</sup> The Authority may provide in its agreement with the International Bureau, transitionally, for limitations on the number and kind of international applications that such Authority will undertake to process. In such cases, the Assembly of Contracting States shall adopt the procedures necessary for the gradual application of the Treaty in respect to the number or kind of international applications to be processed. Alternatively, another International Searching Authority may undertake to perform the remaining searches for the Contracting State(s) concerned. This provision also applies to the preparation of international-type searches under Article 15(5) of the PCT (Article 65(1)).

<sup>6</sup> The Treaty gives the faculty to the Authority not to exclude certain subject matter (e.g., plant varieties, computer programs, etc.) from international search (Article 17(2) (a) (i) and Rule 39). Such subject matter should be listed in the Annex.

<sup>7</sup> In the interest of administrative efficiency, the search fee should be collected with the transmittal fee and basic fee part of the international fee at the time of the filing of the international application, although Rule 16.1(b) in conjunction with Rule 15.4(a) provides in certain cases for a possibility of later payment.

<sup>8</sup> The earlier international or "international-type" search must relate to an application the priority of which is claimed in a later international application before the whole or part of the search fee must be refunded. (See Rule 16.3)



Article 8

Review Board

The Authority agrees to establish, in accordance with Rule 40.2(c) and (d), a ..... [three-member board or special instance or competent higher authority] to examine protests in respect of additional fees where the international application is found not to comply with the requirement of unity of invention.

Article 9

Time Limit for Preparation of International  
Search Reports or Declarations

The Authority agrees to establish international search reports or the declaration referred to in Article 17(2)(a) within the time limits<sup>9</sup> specified in the first two sentences of PCT Rule 42.1.

Article 10

Classification

~~Annex D to this Agreement shall indicate any other classification<sup>10</sup> of the subject matter in addition to the International Patent Classification which the Authority shall apply.~~ (SEE attached SHEET)

Article 11

International-Type Search<sup>11</sup>

~~(1) The Authority shall provide an "international-type" search report on all national applications filed in the States listed in Annex E to this Agreement as far as such search is requested by any such State.~~

~~(2) The Authority shall provide at the request of an applicant an "international-type" search report on a national application filed in the States listed in Annex E to this Agreement.~~

~~(3) The "international-type" search shall be carried out on a translated national application when such application is not in a language prescribed for international applications.~~ (SEE attached SHEET)

<sup>9</sup> In negotiating the agreement, the Authority may avail itself of the opportunity to negotiate slightly longer time limits for the preparation of international search reports or declarations for the first three years after entry into force of the Treaty (see Rule 42.1, last sentence).

<sup>10</sup> Since the normal indication of classification is according to the International Patent Classification (see Rule 43.3(a)), such indication of symbols of another classification system constitutes the exception.

<sup>11</sup> International-type search is obligatory, to the extent to which the national law of the State concerned so provides, and the national Office of that State subjects applications filed with it to such search (Article 15(5)(b)). It is optional for the applicant to the extent to which the national law of the State concerned so provides and no obligatory search of the kind referred to above is prescribed (Article 15(5)(a)). The obligatory international-type search assists national Offices in particular of developing countries to establish an effective filter for national applications not using the PCT route. The optional international-type search assists prospective PCT applicants in determining, at an early date, whether or not to seek protection for their domestic origin inventions in one or more countries.

Article 12

Information Service and Technical Assistance<sup>12</sup>

The Authority shall supply to the International Bureau such information services as may be agreed and such other contributions to the technical assistance program under Chapter IV of the Treaty as are practicable within the existing facilities of the Authority.

Article 13

Entry into Force of the Agreement

This Agreement shall enter into force upon approval by the Assembly.

Article 14

Duration and Renewability of the Agreement

This Agreement is concluded for ..... years. It shall be renewable for a period of ..... years subject to the approval of the Assembly. Should the Assembly fail to render a decision prior to ..... months before the termination of this Agreement, the Agreement shall be considered renewed for a period of ..... years.

Article 15

Amendment

~~This Agreement and any Annexes thereto may be amended at any time by agreement between the parties.~~ (SEE attached SHEET)

Article 16

Termination of the Agreement

Either party may terminate this Agreement by denouncing it. The denunciation shall be by written notice addressed to the other party. The Agreement shall terminate one year after the date of receipt of the notice by the other party.

<sup>12</sup> This Article provides the basis for negotiating with the Authority its participation in patent information services to be established and technical assistance to developing countries to be provided under Chapter IV of the PCT.

LISTING OF PCT PROVISIONS RELEVANT TO ARTICLES OF THE  
AGREEMENT

In witness whereof the undersigned have signed this Agreement.

Done in duplicate at ..... this ..... day of ..... in originals in the .....  
and ..... languages, each text being equally authentic.

For the Authority by:

Name: .....

Title: .....

For the International Bureau by:

Name: .....

Title: .....

[Listing of PCT Provisions relevant to  
Articles of the Agreement follows]

General	The Agreement	PCT Article 16(3)(b), PCT Article 17(1) (Procedural Matters) Rules 12, 42, 89.1(b)
Article 1	Terminology Used in Agreement	PCT Article 2
Article 2	Basic Obligation	—
Article 3	Competence of International Searching Authority	PCT Articles 16(2), 16(3)(b), 65(i) Rules 12, 35.1 and 35.2
Article 4	Minimum Personnel Requirements	PCT Rule 36.1(i)(iii)
Article 5	Documentation Facilities	
	(1) Minimum Documentation	PCT Article 16(3)(c), Rule 34, Rule 36.1(ii)
	(2) Expansion of Minimum Documentation	PCT Rule 34
<del>Article 6</del>	<del>Number or Kinds of Inter- national Applications Processed</del>	<del>PCT Article 65(1)</del>
Article 76	Subject Matter Not Required to be Searched	PCT Article 17(2)(a)(i) Rule 39.1(i) to (vi), Rule 15.4(a)
Article 77	Fees	
	(1) Search Fee	PCT Article 3(4)(iv), Rules 16.1 and 86.1(ii)
	(2) Fee Refund	PCT Rules 16.3 and 41.1
	(3) Fee for Translation	PCT Rule 48.3
Article 78	Review Board	PCT Rule 40.2(c) and (d)
Article 79	Time Limit for Preparation of International Search Reports or Declarations	PCT Rule 42.1
Article 10	Classification	PCT Article 18, Rule 43
Article 11	International-Type Search	PCT Article 15(5)(a) to (c), Rule 41
Article 12	Information Service and Technical Assistance	PCT Articles 50 and 51
Article 13	Entry into Force of the Agreement	PCT Article 16(3)(e)
Article 14	Duration and Renewability of the Agreement	PCT Article 16(3)(e)
Article 15	Amendment	—
Article 16	Termination of the Agreement	PCT Article 16(3)(e)

ATTACHED SHEETS TO DRAFT MODEL  
AGREEMENT BETWEEN AN INTERNATIONAL SEARCHING  
AUTHORITY AND THE INTERNATIONAL BUREAU

ARTICLE 2

Basic Obligation

With respect to the subject matter covered by this Agreement, the Authority agrees to apply and observe all the common rules of international search and to fulfil all other obligations set forth in the Treaty, Regulations, Administrative Instructions, and this Agreement, and the International Bureau carrying out the functions prescribed to it by the Treaty, Regulations, Administrative Instructions, and this Agreement, agrees to contribute as much as possible to the work of such an Authority in its function of an International Searching Authority.

ARTICLE 3

Competence of International

Searching Authority

1) The Authority agrees to act as an International Searching Authority for international applications filed during the term of this Agreement:

- a) in the..... language (languages), and
- b) with all the receiving Offices, or with the receiving Offices specified in Annex A to this Agreement, which specified this International Searching Authority as competent

- (i) for any international application filed covering all these applications, or
- (ii) for certain kinds of international applications covering all the applications of these kinds.

(CONTINUED)

2) Notwithstanding the provisions of paragraph (1) of this Article during the transitional period of.... years, the Authority shall apply in accordance with the Article 65 (1) of the Treaty the limitations on the number and kinds of international applications specified in Annex B to this Agreement.

ARTICLE 10

Classification

- 1) The Authority agrees to indicate the classification of the subject matter in accordance with the latest edition of the International Patent Classification.
- 2) The Authority shall also indicate the classification of the subject matter in accordance with....

ARTICLE 11

"International - Type" Search

In accordance with the Article 15(5)(c) of the Treaty the agreement of the Authority to act as an International Searching Authority, while complying with the Article 3 of this Agreement, shall provide for an "international-type" search for national applications of the respective States if the national law of such States permits so.

(CONTINUED)

ARTICLE 15

Amendment

1) The limitations specified in Annexes A,B, and C to this Agreement may be reduced or cancelled by the Authority at any time.

2) Both the list of documentation facilities contained in Article 5(1) of this Agreement, and the list of languages contained in Article 3(1)(a) of this Agreement, may be replenished by the Authority at any time.

3) The list of additional classifications contained in Article 10(2) of this Agreement may be amended by the Authority at any time.

4) The list of the fees prescribed by the Authority contained in Annex D to this Agreement may be amended by the Authority not more frequently than once a year. Such an amendment will take effect one month after its publication by the International Bureau.

5) Other amendments to the Articles of and Annexes to this Agreement may be made upon the agreement of the parties and will take effect upon approval by the Assembly.

EXPLANATORY NOTES

to the Soviet proposals in respect of "Draft Model Agreement between an International Searching Authority and the International Bureau"

I. PREAMBLE

It is proposed to exclude the mentioning of the shortenings because they are given in Article 1, and also the sentence concerning the three preceding sentences (in fact the final sentence of Preamble) should be given a fresh paragraph.

II. ARTICLE 1

It is proposed not to use the shortenings for "Articles" and "Rules" lest they should be confused with the "articles of this Agreement". The word "Authority" should rather stand for either national Office or intergovernmental organization.

III. ARTICLE 2

In our opinion the proposed text is more adequate to the meaning of Article 16(3)(b) of the Treaty.

IV. ARTICLE 3

In our opinion the proposed text is more adequate to the meaning of Article 16(2) of the Treaty and Rules 35.1 and 35.2 of the Regulations while reflecting the discussion that took place at the latest session of the Interim Committee.

It is also proposed to transfer hereto the text of Article 6 thus covering all the limitations for international search.

V. ARTICLE 4

It is proposed to bring the text of this Article into compliance with the text of Rule 36.1(i) and 36.1(iii). All staff changes in an Authority within the limits provided for in the PCT, concern only that Authority.

VI. ARTICLE 5

In the first sentence it is proposed to stress the obli-

gatory nature of the minimum documentation. The proposed text of the second sentence in our opinion is more adequate to the meaning of Rule 34.1(d) of the Regulations. This text allows to replace certain republished documents in the minimum documentation.

#### VII. ARTICLE 6

It is proposed to transfer the text of this Article to Article 3. (see note 4).

#### VIII. ARTICLE 7(former 8)

It is proposed to transfer all references to the procedure of modifying and amending the Agreement to the respective Article.

It is also proposed to exclude from this Article the third sentence because it concerns one of the prescribed fees and consequently is covered by the first sentence.

#### IX. ARTICLE 10(former 11)

It is proposed to stress the significance of International Patent Classification in the text of this Article.

#### X. ARTICLE 11(former 12)

In our opinion the proposed text is more adequate to the meaning of Article 15(5) of the Treaty because it provides for similar limitations for international search and "international - type" search, and stresses the right of a national law to establish some restrictions for national applicants.

#### XI. ARTICLE 15(former 16)

The proposed text provides for various ways to amend the Agreement.



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

Annex to Circular No. 2395  
of January 6, 1976

Revised

DRAFT MODEL AGREEMENT BETWEEN AN INTERNATIONAL  
SEARCHING AUTHORITY AND THE INTERNATIONAL BUREAU

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April 28, 1976

Mr. K. Pfanner  
Deputy Director General  
World Intellectual Property  
Organization  
32, chemin des Colombettes  
1211 Geneva 20, Switzerland

Dear Mr. Pfanner:

Enclosed is this Office's response to your Circular No. 2395 asking for comments on the draft model agreement between the International Bureau and an International Searching Authority.

As you had suggested, our proposed changes, as well as some general comments, have been introduced by hand into a copy of the agreement.

Sincerely,

C. Marshall Dann  
Commissioner of Patents  
and Trademarks

Enclosure

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PCT/AAQ/VII/5  
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*Concerning the appointment and*

Agreement between . . . . (\*) and the International Bureau of the World Intellectual Property Organization in respect of the functioning of . . . . (\*) as an International Searching Authority under the Patent Cooperation Treaty.

Preamble

WHEREAS the States party to the Patent Cooperation Treaty constitute a Union for cooperation in the filing, searching, and examination of applications for the protection of inventions, and for rendering special technical services, the said Union being known as the International Patent Cooperation Union; and

WHEREAS it is recognized that the participation of the . . . . (\*) as an International Searching Authority in matters affecting international search will contribute to the successful implementation of the Patent Cooperation Treaty.

WHEREAS having regard to Article 16(3) (b) of the Patent Cooperation Treaty done at Washington on 19 June 1970 the . . . . (\*) hereinafter called the "Authority" and the International Bureau of the World Intellectual Property Organization, hereinafter called the "International Bureau", hereby agree as follows:

*Why not June 19, 1970 as in PCT following Article 69*

Article 1

Terminology Used in Agreement

(1) For the purpose of this Agreement, the "Treaty" means the Patent Cooperation Treaty done at Washington on 19 June 1970 the "Regulations" means the Regulations under the Treaty; the "Administrative Instructions" means the Administrative Instructions under the Regulations; "Article" means an Article of the Treaty; "Rule" means a Rule of the Regulations; "International Bureau" means the International Bureau as defined in Article 2 (xix) ~~of the Treaty~~ and the "Authority" means the International Searching Authority.

*← This definition of Article is not followed*

(2) All other terms and expressions used in this Agreement are to be understood in the same sense in which they are used in the Treaty.

*in that the parts of this Agreement are called "Article"*

*and such other functions specifically called for by* Article 2

Basic Obligation

(1) With respect to the subject matter covered by this Agreement, the Authority agrees to carry out searches ~~in accordance with the Treaty, while complying with the requirements set forth in the Treaty, in the Regulations, and in the Administrative Instructions, and, subject to the said requirements, with the provisions of this Agreement.~~

*P this Agreement and*

(2) With respect to the subject matter covered by this Agreement, the International Bureau agrees to carry out those functions specifically called for by the Treaty, the Regulations, this Agreement and the Administrative Instructions.

(\*) Reference will be made to a national office or intergovernmental organization

*Rule 89.1 (b) seems to say that the Administrative Instructions are drafted in accord with the agreements, whereas "Article 2" as drafted seems to say that the agreements are subservient to the Administrative Instructions.*

Article 3

Competence of International Searching Authority<sup>1</sup>

The Authority agrees to act as an International Searching Authority for international applications filed during the term of this Agreement:

- (i) with the receiving Offices of, or acting for [ all States, ]  
~~or of, or acting for, [the States specified in Annex A to this Agreement,]~~ and
- (ii) in the languages specified in Annex A, and
- (iii) for the kinds of international applications specified in Annex A.

Annex A may be amended by mutual agreement at any time during the duration of the Agreement, in particular by adding or deleting States, languages or certain kinds of international applications.

Article 4

Minimum Personnel Requirements

- (1) The Authority shall maintain during the term of its appointment a minimum requirement of at least 100 full-time employees with sufficient technical qualifications to carry out searches.
- (2) The Authority agrees to maintain a staff which is capable of searching the required technical fields and which has the language facilities to understand the following languages: ~~.....~~ *at least those languages in which the minimum documentation referred to in Rule 34 is written or is translated.*

*"Term of Appointment" and "Term of Agreement" may or may not be the same and they appear to be used interchangeably throughout Agreement. Consistency of terminology should be checked.*

Article 5

Documentation Facilities

- (1) The Authority agrees to maintain and use for search purposes during the term of its appointment, in addition to the minimum documentation facilities properly arranged for search purposes specified in the Regulations (Rule 34), the following documentation facilities: {cite groups of documents outside Rule 34 as to time or as to country coverage}<sup>3</sup> .....
- (2) Where a patent document is republished once or more than once, as such or as granted patent, the Authority agrees to keep, in accordance with Rule 34.1(d), the following versions of such patent documents in its minimum documentation: ..... (Examples: Offenlegungsschrift of the Federal Republic of Germany, Tokkyo Kokaikoho of Japan (as far as the English language abstracts are generally available) and the Première Publication of France).<sup>4</sup>

*The maintaining of documentation beyond that required under Rule 34 in Article 5(1) or in specifying which document will be kept under Article 5(2) both go beyond the requirements of the PCT for ISA's.*

<sup>1</sup> A Contracting State has the option to consider only one International Searching Authority or several such Authorities as competent to search international applications filed with its national Office and must inform the International Bureau of its choice. Where it considers several Authorities as competent, it must identify in its communication to the International Bureau each such Authority. In the latter situation, the identification may indicate that either all such Authorities are competent for the same kinds of international applications leaving the choice to the applicant or that certain of such Authorities are competent for one kind of international application and certain others competent for other kinds of international applications (Article 16(2) and PCT Rules 35.1 and 35.2).

<sup>2</sup> Both of the language facilities required under Rule 36.1(iii) and any further language facilities should be referred to here.

<sup>3</sup> In negotiating the Agreement, the Authority may maintain and use such documentation outside Rule 34, but no significant changes should be made without informing the International Bureau.

<sup>4</sup> The Regulations give the faculty to the Authority to provide for substitution by a kind of document other than those specified herein. (See Rule 34.1(d)).

*If maintained or least delete word "of" neither the need to introduce the maintaining or use of documentation outside Rule 34 into the negotiating of the Agreement nor the need to inform the International Bureau of changes in such documentation is part of the PCT. (See footnote 4)*

Article 6

Number or Kinds of International Applications Processed

For a transitional period of . . . . . years, the Authority shall apply the following limitation on the number or kinds<sup>5</sup> of international applications which it will accept for searching under Article 65 of the Treaty: . . . . .

Article 7

Subject Matter not Required to be Searched

Annex B to this Agreement defines the subject matter<sup>6</sup> which the Authority will not search under Article 17(2)(a)(1) as specified in Rule 39.1.

Article 8

Fees<sup>7</sup>

- (1) Annex C to this Agreement contains a schedule of all fees of the Authority which are related to its function as an International Searching Authority. That Annex may be modified by the Authority not more frequently than once a year. Such modification will take effect one month after its publication by the International Bureau.

*What is basis for this?*

- (2) The Authority shall, to the extent and under the conditions set forth in Annex C to this Agreement, refund the whole or part of the search fee paid where a search report can be wholly or partially based upon the results of an earlier international or "international-type" search.<sup>8</sup>

*See note below*

- (3) The Authority shall charge a fee, as prescribed in Annex C to this Agreement, for the translation of the international application, according to Rule 48.3(b), whenever such application is filed in a language other than one of those prescribed for the publication of the international application in Rule 48.3(a).

*The charging of this fee is discretionary with the ISA*

<sup>5</sup> The Authority may provide in its agreement with the International Bureau, transitionally, for limitations on the number and kind of international applications that such Authority will undertake to process. In such cases, the Assembly of Contracting States shall adopt the procedures necessary for the gradual application of the Treaty in respect to the number or kind of international applications to be processed. Alternatively, another International Searching Authority may undertake to perform the remaining searches for the Contracting State(s) concerned. This provision also applies to the preparation of international-type searches under Article 15(5) of the PCT (Article 65(1)).

<sup>6</sup> The Treaty gives the faculty to the Authority not to ~~exclude~~ <sup>search</sup> certain subject matter (e.g., plant varieties, computer programs, etc.) from international search (Article 17(2)(a)(1) and Rule 39). Such subject matter should be listed in the Annex.

<sup>7</sup> In the interest of administrative efficiency, the search fee should be collected with the transmittal fee and basic fee part of the international fee at the time of the filing of the international application, although Rule 16.1(b) in conjunction with Rule 15.4(a) provides in certain cases for a possibility of later payment.

<sup>8</sup> The earlier international or "international-type" search must relate to an application the priority of which is claimed in a later international application before the whole or part of the search fee must be refunded. (See Rule 16.3)

*Rule 16.3 is more limiting than Article 8(2) above or footnote 8. The earlier international search must have been made by the same ISA.*



Article 9

*[indicate]* Review Board

The Authority agrees to establish, in accordance with Rule 40.2(c) and (d), a ..... [three-member board or special instance or competent higher authority] to examine protests in respect of additional fees where the international application is found not to comply with the requirement of unity of invention.

Article 10

Time Limit for Preparation of International Search Reports or Declarations

The Authority agrees to establish international search reports or the declaration referred to in Article 17(2) (a) within the time limits specified in the first two sentences of ~~PCT~~ Rule 42.1.

Article 11

Classification

Annex D to this Agreement shall indicate any other classification<sup>10</sup> of the subject matter in addition to the International Patent Classification which the Authority shall apply.

Article 12

International-Type Search<sup>11</sup>

- (1) The Authority shall provide an "international-type" search report on all national applications filed in the States listed in Annex E to this Agreement as far as such search is requested by any such State.
- (2) The Authority shall provide at the request of an applicant an "international-type" search report on a national application filed in the States listed in Annex E to this Agreement.

*Doesn't follow language  
of Article 15(5)(c).*

- (3) The "international-type" search shall be carried out on a translated national application when such application is not in a language prescribed for international applications.

<sup>9</sup> In negotiating the agreement, the Authority may avail itself of the opportunity to negotiate slightly longer time limits for the preparation of international search reports or declarations for the first three years after entry into force of the Treaty (see Rule 42.1, last sentence).

<sup>10</sup> Since the normal indication of classification is according to the International Patent Classification (see Rule 43.3(a)), such indication of symbols of another classification system constitutes the exception.

<sup>11</sup> International-type search is obligatory, to the extent to which the national law of the State concerned so provides, and the national Office of that State subjects applications filed with it to such search (Article 15(5) (b)). It is optional for the applicant to the extent to which the national law of the State concerned so provides and no obligatory search of the kind referred to above is prescribed (Article 15(5) (a)). The obligatory international-type search assists national Offices in particular of developing countries to establish an effective filter for national applications not using the PCT route. The optional international-type search assists prospective PCT applicants in determining, at an early date, whether or not to seek protection for their domestic origin invention or one or more foreign countries via the PCT route.

*Why limited to optional? Also true of obligatory*

Article 13

Information Service and Technical Assistance<sup>12</sup>

The Authority shall supply to the International Bureau such information services ~~as may be agreed~~ and such other contributions to the technical assistance program under Chapter IV of the Treaty as are practicable within the existing facilities of the Authority ~~and as may be agreed~~.

*The agreement equates terms of appointment to "term of agreement" and "date of entry into force" with "date of approval by the Assembly" which may be the case.*

Article 14

Entry into Force of the Agreement

This Agreement shall enter into force upon approval by the Assembly.

Article 15

Duration and Renewability of the Agreement

This Agreement is concluded for ..... years. It shall be renewable for a period of ..... years subject to the approval of the Assembly. Should or may not the Assembly fail to render a decision prior to ..... months before the termination of this Agreement, the Agreement shall be considered renewed for a period of ..... years.

Article 16

Amendment

*Articles...*  
This Agreement and any Annexes ~~thereto~~ may be amended at any time by agreement between the parties.

Article 17

Termination of the Agreement

Either party may terminate this Agreement by denouncing it. The denunciation shall be by written notice addressed to the other party. The Agreement shall terminate one year after the date of receipt of the notice by the other party.

*As the Agreement enters into force upon approval by the Assembly, approval of the Assembly should also be required for a termination initiated by the International Bureau.  
A State may denounce the Treaty and it takes effect in six months (Article 66). Why should this denouncement not take effect for a year?*

<sup>12</sup> This Article provides the basis for negotiating with the Authority its participation in patent information services to be established and technical assistance to developing countries to be provided under Chapter IV of the ~~PCT~~ Treaty.

In witness whereof the undersigned have signed this Agreement.

Done in duplicate at ..... this ..... day of ..... in originals in the .....  
and ..... languages, each text being equally authentic.

For the Authority by:

Name: .....

Title: .....

For the International Bureau by:

Name: .....

Title: .....

[Listing of PCT Provisions relevant to  
Articles of the Agreement follows]

[Annex F follows/L'annexe F suit]

LISTING OF PCT PROVISIONS RELEVANT TO ARTICLES OF THE  
AGREEMENT

General	The Agreement	PCT Article 16(3)(b), PCT Article 17(1) (Procedural Matters) Rules 12, 42, 89.1(b)
Article 1	Terminology Used in Agreement	PCT Article 2
Article 2	Basic Obligation	—
Article 3	Competence of International Searching Authority	PCT Articles 16(2), 16(3)(b) Rules 12, 35.1 and 35.2
Article 4	Minimum Personnel Requirements	PCT Rule 36.1(i)(iii)
Article 5	Documentation Facilities	
	(1) Minimum Documentation	PCT Article 16(3)(c), Rule 34, Rule 36.1(ii)
	(2) Expansion of Minimum Documentation	PCT Rule 34
Article 6	Number or Kinds of Inter- national Applications Processed	PCT Article 65(1)
Article 7	Subject Matter Not Required to be Searched	PCT Article 17(2)(a)(i) Rule 39.1(i) to (vi) <b>Rule 15.4(a)</b>
Article 8	Fees	
	(1) Search Fee	PCT Article 3(4)(iv), Rules 16.1 and 86.1(ii)
	(2) Fee Refund	PCT Rules 16.3 and 41.1
	(3) Fee for Translation	PCT Rule 48.3
Article 9	Review Board	PCT Rule 40.2(c) and (d)
Article 10	Time Limit for Preparation of International Search Reports or Declarations	PCT Rule 42.1
Article 11	Classification	PCT Article 18, Rule 43
Article 12	International-Type Search	PCT Article 15(5)(a) to (c), Rule 41
Article 13	Information Service and Technical Assistance	PCT Articles 50 and 51
Article 14	Entry into Force of the Agreement	PCT Article 16(3)(e)
Article 15	Duration and Renewability of the Agreement	PCT Article 16(3)(e)
Article 16	Amendment	—
Article 17	Termination of the Agreement	PCT Article 16(3)(e)

PATENT OFFICE  
JAPANESE GOVERNMENT

4-3, Kasumigaseki 3-chome  
Chiyoda-ku, Tokyo, Japan


TOKU SO 429/51  
April 28, 1976

Dr. K. Pfanner  
Deputy Director General  
World Intellectual Property Organization  
32, chemin des Colombettes  
1211 Geneva 20, Switzerland

Dear Sir:

I have the honor to inform you that in reply to your letter C. 2395, PCT 20 dated Jan. 6, 1976, a copy of the Draft Model Agreement is being returned to your Office. Further, our comments are mentioned on the additional sheets, also enclosed with this letter.

Yours truly,

  
Yoshio Nakata  
Director General  
General Administration Department

Encl:  
As stated above

The Comments of the Japanese Patent Office on the Draft Model Agreement between an International Searching Authority and the International Bureau

1. Article 4 (2)

We propose to revise it as follows:

(2) The Authority agrees to maintain a staff which is capable of searching the required technical fields and which has the language facilities to understand at least those languages in which the minimum documentation referred to in Rule 34 is written or is translated.

2. Article 5 (1)

We propose to revise it as follows:

(1) The Authority agrees to maintain and use during the term of its appointment, the minimum documentation referred to in Rule 34, properly arranged for search purposes.

Basis: By the PCT treaty text and by its regulations, it is not provided to make obligatory for International Searching Authorities to maintain and use documents other than those stipulated by Rule 34.

3. Article 5 (2)

This provision should <sup>be</sup> eliminated. Basis: The purport of the provision of Rule 34.1 (d) relevant to this proposed provision is that it is not necessary to keep in the document collection of an International Searching Authority, more than one version of a document which is republished once or more than once, and also it does not make it obligatory to keep a specific version of documents.

4. Article 8 (1)

The 3rd sentence should be revised as follows: "Such modification shall be promptly published by the International Bureau and it will take effect one month after its publication by the International Bureau, unless the later date of taking effect of such modification is designated by an International Searching Authority, in which case such modification will take effect from the date

designated by the said International Searching Authority.

5. Article 8 (2)

To clarify the purport of this Article, the required conditions provided for refunding of search fee (Rule 16.3) should be specified here.

6. Article 11

A passage "as mentioned in Rule 43.3 (a)" should be inserted before "in addition to".

Annex to Circular No. 2395  
of January 6, 1976

Revised

DRAFT MODEL AGREEMENT BETWEEN AN INTERNATIONAL  
SEARCHING AUTHORITY AND THE INTERNATIONAL BUREAU

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Agreement between .....(\*) and the International Bureau of the World Intellectual Property Organization in respect of the functioning of .....(\*) as an International Searching Authority under the Patent Cooperation Treaty.

Preamble

WHEREAS the States party to the Patent Cooperation Treaty constitute a Union for cooperation in the filing, searching, and examination of applications for the protection of inventions, and for rendering special technical services, the said Union being known as the International Patent Cooperation Union; and

WHEREAS it is recognized that the participation of the .....(\*) as an International Searching Authority in matters affecting international search will contribute to the successful implementation of the Patent Cooperation Treaty.

WHEREAS having regard to Article 16(3) (b) of the Patent Cooperation Treaty done at Washington on 19 June 1970 the .....(\*) hereinafter called the "Authority" and the International Bureau of the World Intellectual Property Organization, hereinafter called the "International Bureau", hereby agree as follows:

Article 1

Terminology Used in Agreement

(1) For the purpose of this Agreement, the "Treaty" means the Patent Cooperation Treaty done at Washington on 19 June 1970; the "Regulations" means the Regulations under the Treaty; the "Administrative Instructions" means the Administrative Instructions under the Regulations; "Article" means an Article of the Treaty; "Rule" means a Rule of the Regulations; "International Bureau" means the International Bureau as defined in Article 2 (xix) of the Treaty; and the "Authority" means the International Searching Authority.

(2) All other terms and expressions used in this Agreement are to be understood in the same sense in which they are used in the Treaty.

Article 2

Basic Obligation

With respect to the subject matter covered by this Agreement, the Authority agrees to carry out searches in accordance with the Treaty while complying with the requirements set forth in the Treaty, in the Regulations and in the Administrative Instructions and, subject to the said requirements, with the provisions of this Agreement.

---

(\*) Reference will be made to a national Office or intergovernmental Organization

Article 3

Competence of International Searching Authority<sup>1</sup>

The Authority agrees to act as an International Searching Authority for international applications filed during the term of this Agreement:

- (i) with the receiving Offices of, or acting for, all States, or of, or acting for, the States specified in Annex A to this Agreement, and
- (ii) in the languages specified in Annex A, and
- (iii) for the kinds of international applications specified in Annex A.

Annex A may be amended by mutual agreement at any time during the duration of the Agreement, in particular by adding or deleting States, languages or certain kinds of international applications.

Article 4

Minimum Personnel Requirements

(1) The Authority shall maintain during the term of its appointment a minimum requirement of at least . . . . full-time employees with sufficient technical qualifications to carry out searches.

~~(2) The Authority agrees to maintain a staff which is capable of searching the required technical fields and which has the language facilities to understand the following languages: . . . . .<sup>2</sup>~~

See par-1 of the attached sheets.

Article 5

Documentation Facilities

~~(1) The Authority agrees to maintain and use for search purposes during the term of its appointment, in addition to the minimum documentation facilities properly arranged for search purposes specified in the Regulations (Rule 34), the following documentation facilities: (cite groups of documents outside Rule 34 as to time or as to country coverage)<sup>3</sup>~~

See par-2 of the attached sheets.

~~(2) Where a patent document is republished once or more than once, as such or as granted patent, the Authority agrees to keep, in accordance with Rule 34.1(d), the following versions of such patent documents in its minimum documentation: (Examples: Offenlegungsschrift of the Federal Republic of Germany, Tokkyo Kokaikoho of Japan (as far as the English language abstracts are generally available) and the Première Publication of France).<sup>4</sup>~~

See par-3 of the attached sheets.

<sup>1</sup> A Contracting State has the option to consider only one International Searching Authority or several such Authorities as competent to search international applications filed with its national Office and must inform the International Bureau of its choice. Where it considers several Authorities as competent, it must identify in its communication to the International Bureau each such Authority. In the latter situation, the identification may indicate that either all such Authorities are competent for the same kinds of international applications leaving the choice to the applicant or that certain of such Authorities are competent for one kind of international application and certain others competent for other kinds of international applications (Article 16(2) and PCT Rules 35.1 and 35.2).

<sup>2</sup> Both of the language facilities required under Rule 36.1(iii) and any further language facilities should be referred to here.

<sup>3</sup> In negotiating the Agreement, the Authority may maintain and use such documentation outside Rule 34, but no significant changes should be made without informing the International Bureau.

<sup>4</sup> The Regulations give the faculty to the Authority to provide for substitution by a kind of document other than those specified herein. (See Rule 34.1(d)).

Article 6

Number or Kinds of International Applications Processed

For a transitional period of . . . . . years, the Authority shall apply the following limitation on the number or kinds<sup>5</sup> of international applications which it will accept for searching under Article 65 of the Treaty: . . . . .

Article 7

Subject Matter not Required to be Searched

Annex B to this Agreement defines the subject matter<sup>6</sup> which the Authority will not search under Article 17(2) (a) (i) as specified in Rule 39.1.

Article 8

Fees<sup>7</sup>

(1) Annex C to this Agreement contains a schedule of all fees of the Authority which are related to its function as an International Searching Authority. That Annex may be modified by the Authority not more frequently than once a year. ~~Such modification will take effect one month after its publication by the International Bureau.~~

See par-4 of the attached sheets.

(2) The Authority shall, to the extent and under the conditions set forth in Annex C to this Agreement, refund the whole or part of the search fee paid where a search report can be wholly or partially based upon the results of an earlier international or "international-type" search.<sup>8</sup>

See par-5 of the attached sheets.

(3) The Authority shall charge a fee, as prescribed in Annex C to this Agreement, for the translation of the international application, according to Rule 48.3(b), whenever such application is filed in a language other than one of those prescribed for the publication of the international application in Rule 48.3(a).

<sup>5</sup> The Authority may provide in its agreement with the International Bureau, transitionally, for limitations on the number and kind of international applications that such Authority will undertake to process. In such cases, the Assembly of Contracting States shall adopt the procedures necessary for the gradual application of the Treaty in respect to the number or kind of international applications to be processed. Alternatively, another International Searching Authority may undertake to perform the remaining searches for the Contracting State(s) concerned. This provision also applies to the preparation of international-type searches under Article 15(5) of the PCT (Article 65(1)).

<sup>6</sup> The Treaty gives the faculty to the Authority not to exclude certain subject matter (e.g., plant varieties, computer programs, etc.) from international search (Article 17(2) (a) (i) and Rule 39). Such subject matter should be listed in the Annex.

<sup>7</sup> In the interest of administrative efficiency, the search fee should be collected with the transmittal fee and basic fee part of the international fee at the time of the filing of the international application, although Rule 16.1(b) in conjunction with Rule 15.4(a) provides in certain cases for a possibility of later payment.

<sup>8</sup> The earlier international or "international-type" search must relate to an application the priority of which is claimed in a later international application before the whole or part of the search fee must be refunded. (See Rule 16.3)

Article 9

Review Board

The Authority agrees to establish, in accordance with Rule 40.2(c) and (d), a ..... [three-member board or special instance or competent higher authority] to examine protests in respect of additional fees where the international application is found not to comply with the requirement of unity of invention.

Article 10

Time Limit for Preparation of International  
Search Reports or Declarations

The Authority agrees to establish international search reports or the declaration referred to in Article 17(2) (a) within the time limits specified in the first two sentences of PCT Rule 42.1.

Article 11

Classification

Annex D to this Agreement shall indicate any other classification<sup>10</sup> of the subject matter in addition to the International Patent Classification which the Authority shall apply.

See  
par-6 of  
the attach-  
ed sheets.

Article 12

International-Type Search<sup>11</sup>

(1) The Authority shall provide an "international-type" search report on all national applications filed in the States listed in Annex E to this Agreement as far as such search is requested by any such State.

(2) The Authority shall provide at the request of an applicant an "international-type" search report on a national application filed in the States listed in Annex E to this Agreement.

(3) The "international-type" search shall be carried out on a translated national application when such application is not in a language prescribed for international applications.

<sup>9</sup> In negotiating the agreement, the Authority may avail itself of the opportunity to negotiate slightly longer time limits for the preparation of international search reports or declarations for the first three years after entry into force of the Treaty (see Rule 42.1, last sentence).

<sup>10</sup> Since the normal indication of classification is according to the International Patent Classification (see Rule 43.3(a)), such indication of symbols of another classification system constitutes the exception.

<sup>11</sup> International-type search is obligatory, to the extent to which the national law of the State concerned so provides, and the national Office of that State subjects applications filed with it to such search (Article 15(5) (b)). It is optional for the applicant to the extent to which the national law of the State concerned so provides and no obligatory search of the kind referred to above is prescribed (Article 15(5) (a)). The obligatory international-type search assists national Offices in particular of developing countries to establish an effective filter for national applications not using the PCT route. The optional international-type search assists prospective PCT applicants in determining, at an early date, whether or not to seek protection for their domestic origin inventions in one or more foreign countries via the PCT route.

Article 13

Information Service and Technical Assistance<sup>12</sup>

The Authority shall supply to the International Bureau such information services as may be agreed and such other contributions to the technical assistance program under Chapter IV of the Treaty as are practicable within the existing facilities of the Authority.

Article 14

Entry into Force of the Agreement

This Agreement shall enter into force upon approval by the Assembly.

Article 15

Duration and Renewability of the Agreement

This Agreement is concluded for ..... years. It shall be renewable for a period of ..... years subject to the approval of the Assembly. Should the Assembly fail to render a decision prior to ..... months before the termination of this Agreement, the Agreement shall be considered renewed for a period of ..... years.

Article 16

Amendment

This Agreement and any Annexes thereto may be amended at any time by agreement between the parties.

Article 17

Termination of the Agreement

Either party may terminate this Agreement by denouncing it. The denunciation shall be by written notice addressed to the other party. The Agreement shall terminate one year after the date of receipt of the notice by the other party.

<sup>12</sup> This Article provides the basis for negotiating with the Authority its participation in patent information services to be established and technical assistance to developing countries to be provided under Chapter IV of the PCT.

LISTING OF PCT PROVISIONS RELEVANT TO ARTICLES OF THE  
AGREEMENT

In witness whereof the undersigned have signed this Agreement.

Done in duplicate at ..... this ..... day of ..... in originals in the .....  
and ..... languages, each text being equally authentic.

For the Authority by:

Name: .....

Title: .....

For the International Bureau by:

Name: .....

Title: .....

[Listing of PCT Provisions relevant to  
Articles of the Agreement follows]

General	The Agreement	PCT Article 16(3)(b), PCT Article 17(1) (Procedural Matters) Rules 12, 42, 89.1(b)
Article 1	Terminology Used in Agreement	PCT Article 2
Article 2	Basic Obligation	—
Article 3	Competence of International Searching Authority	PCT Articles 16(2), 16(3)(b) Rules 12, 35.1 and 35.2
Article 4	Minimum Personnel Requirements	PCT Rule 36.1(1)(iii)
Article 5	Documentation Facilities	
	(1) Minimum Documentation	PCT Article 16(3)(c), Rule 34, Rule 36.1(ii)
	(2) Expansion of Minimum Documentation	PCT Rule 34
Article 6	Number or Kinds of Inter- national Applications Processed	PCT Article 65(1)
Article 7	Subject Matter Not Required to be Searched	PCT Article 17(2)(a)(i) Rule 39.1(i) to (vi), Rule 15.4(a)
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	(1) Search Fee	PCT Article 3(4)(iv), Rules 16.1 and 86.1(ii)
	(2) Fee Refund	PCT Rules 16.3 and 41.1
	(3) Fee for Translation	PCT Rule 48.3
Article 9	Review Board	PCT Rule 40.2(c) and (d)
Article 10	Time Limit for Preparation of International Search Reports or Declarations	PCT Rule 42.1
Article 11	Classification	PCT Article 18, Rule 43
Article 12	International-Type Search	PCT Article 15(5)(a) to (c), Rule 41
Article 13	Information Service and Technical Assistance	PCT Articles 50 and 51
Article 14	Entry into Force of the Agreement	PCT Article 16(3)(e)
Article 15	Duration and Renewability of the Agreement	PCT Article 16(3)(e)
Article 16	Amendment	—
Article 17	Termination of the Agreement	PCT Article 16(3)(e)

[Annex G follows/L'annexe G suit]



Stockholm, May 7, 1976

ad. a.

Mr. K. Pfanner  
Deputy Director General  
WIPO  
32, chemin des Colombettes  
CH-1211 Genève 20  
Schweiz

Annex to Circular No. 2395  
of January 6, 1976

Revised

DRAFT MODEL AGREEMENT BETWEEN AN INTERNATIONAL  
SEARCHING AUTHORITY AND THE INTERNATIONAL BUREAU

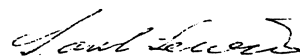
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Sir,

I am hereby returning a copy of the Draft Model Agreement etc. (see your Circular letter C. 2395 PCT 20 of January 6, 1976) marked up in accordance with your suggestion. The remarks are to Articles 8 and 12. Furthermore I would like to make the observation with regard to Article 17, that the time limit of one year may be rather short if an office has to readjust its personnel number to a redundancy situation.

At the same time I regret that due to unforeseen circumstances this reply has been delayed beyond the time limit recommended by you, and hope this will not cause any inconvenience.

Sincerely yours

  
Saul Lewin

Deputy Director General

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Agreement between . . . . (\*) and the International Bureau of the World Intellectual Property Organization in respect of the functioning of . . . . (\*) as an International Searching Authority under the Patent Cooperation Treaty.

Preamble

WHEREAS the States party to the Patent Cooperation Treaty constitute a Union for cooperation in the filing, searching, and examination of applications for the protection of inventions, and for rendering special technical services, the said Union being known as the International Patent Cooperation Union; and

WHEREAS it is recognized that the participation of the . . . . (\*) as an International Searching Authority in matters affecting international search will contribute to the successful implementation of the Patent Cooperation Treaty.

WHEREAS having regard to Article 16(3) (b) of the Patent Cooperation Treaty done at Washington on 19 June 1970 the . . . . (\*) hereinafter called the "Authority" and the International Bureau of the World Intellectual Property Organization, hereinafter called the "International Bureau", hereby agree as follows:

Article 1

Terminology Used in Agreement

(1) For the purpose of this Agreement, the "Treaty" means the Patent Cooperation Treaty done at Washington on 19 June 1970; the "Regulations" means the Regulations under the Treaty; the "Administrative Instructions" means the Administrative Instructions under the Regulations; "Article" means an Article of the Treaty; "Rule" means a Rule of the Regulations; "International Bureau" means the International Bureau as defined in Article 2 (xix) of the Treaty; and the "Authority" means the International Searching Authority.

(2) All other terms and expressions used in this Agreement are to be understood in the same sense in which they are used in the Treaty.

Article 2

Basic Obligation

With respect to the subject matter covered by this Agreement, the Authority agrees to carry out searches in accordance with the Treaty while complying with the requirements set forth in the Treaty, in the Regulations and in the Administrative Instructions and, subject to the said requirements, with the provisions of this Agreement.

---

(\*) Reference will be made to a national Office or Intergovernmental Organization

Article 3

Competence of International Searching Authority<sup>1</sup>

The Authority agrees to act as an International Searching Authority for international applications filed during the term of this Agreement:

- (i) with the receiving Offices of, or acting for, all States, or of, or acting for, the States specified in Annex A to this Agreement, and
- (ii) in the languages specified in Annex A, and
- (iii) for the kinds of international applications specified in Annex A.

Annex A may be amended by mutual agreement at any time during the duration of the Agreement, in particular by adding or deleting States, languages or certain kinds of international applications.

Article 4

Minimum Personnel Requirements

- (1) The Authority shall maintain during the term of its appointment a minimum requirement of at least ..... full-time employees with sufficient technical qualifications to carry out searches.
- (2) The Authority agrees to maintain a staff which is capable of searching the required technical fields and which has the language facilities to understand the following languages : .....<sup>2</sup>

Article 5

Documentation Facilities

- (1) The Authority agrees to maintain and use for search purposes during the term of its appointment, in addition to the minimum documentation facilities properly arranged for search purposes specified in the Regulations (Rule 34), the following documentation facilities: (cite groups of documents outside Rule 34 as to time or as to country coverage)<sup>3</sup> . . . . .
- (2) Where a patent document is republished once or more than once, as such or as granted patent, the Authority agrees to keep, in accordance with Rule 34.1(d), the following versions of such patent documents in its minimum documentation: ..... (Examples: Offenlegungsschrift of the Federal Republic of Germany, Tokkyo Kokaikoho of Japan (as far as the English language abstracts are generally available) and the Première Publication of France).<sup>4</sup>

<sup>1</sup> A Contracting State has the option to consider only one International Searching Authority or several such Authorities as competent to search international applications filed with its national Office and must inform the International Bureau of its choice. Where it considers several Authorities as competent, it must identify in its communication to the International Bureau each such Authority. In the latter situation, the identification may indicate that either all such Authorities are competent for the same kinds of international applications leaving the choice to the applicant or that certain of such Authorities are competent for one kind of international application and certain others competent for other kinds of international applications (Article 16(2) and PCT Rules 35.1 and 35.2).

<sup>2</sup> Both of the language facilities required under Rule 36.1(iii) and any further language facilities should be referred to here.

<sup>3</sup> In negotiating the Agreement, the Authority may maintain and use such documentation outside Rule 34, but no significant changes should be made without informing the International Bureau.

<sup>4</sup> The Regulations give the faculty to the Authority to provide for substitution by a kind of document other than those specified herein. (See Rule 34.1(d)).

Article 6

Number or Kinds of International Applications Processed

For a transitional period of . . . . . years, the Authority shall apply the following limitation on the number or kinds of international applications which it will accept for searching under Article 65 of the Treaty: . . . . .

Article 7

Subject Matter not Required to be Searched

Annex B to this Agreement defines the subject matter<sup>6</sup> which the Authority will not search under Article 17(2) (a) (i) as specified in Rule 39.1.

Article 8

Fees<sup>7</sup>

(1) Annex C to this Agreement contains a schedule of all fees of the Authority which are related to its function as an International Searching Authority. That Annex may be modified by the Authority not more frequently than once a year. Such modification will take effect one month after its publication by the International Bureau.

(2) The Authority shall, to the extent and under the conditions set forth in Annex C to this Agreement, refund the whole or part of the search fee paid where a search report can be wholly or partially based upon the results of an earlier international or "international-type" search.<sup>8</sup>

[Whenever the] [does] ~~the Authority shall charge a fee, as prescribed in Annex C to this Agreement,~~ for the translation of the international application, according to Rule 48.3(b), whenever such application is filed in a language other than one of those prescribed for the publication of the international application in Rule 48.3(a), it shall be as prescribed in Annex C to this Agreement.]

<sup>5</sup> The Authority may provide in its agreement with the International Bureau, transitionally, for limitations on the number and kind of international applications that such Authority will undertake to process. In such cases, the Assembly of Contracting States shall adopt the procedures necessary for the gradual application of the Treaty in respect to the number or kind of international applications to be processed. Alternatively, another International Searching Authority may undertake to perform the remaining searches for the Contracting State(s) concerned. This provision also applies to the preparation of international-type searches under Article 15(5) of the PCT (Article 65(1)).

<sup>6</sup> The Treaty gives the faculty to the Authority not to exclude certain subject matter (e.g., plant varieties, computer programs, etc.) from international search (Article 17(2) (a) (i) and Rule 39). Such subject matter should be listed in the Annex.

<sup>7</sup> In the interest of administrative efficiency, the search fee should be collected with the transmittal fee and basic fee part of the international fee at the time of the filing of the international application, although Rule 16.1(b) in conjunction with Rule 15.4(a) provides in certain cases for a possibility of later payment.

<sup>8</sup> The earlier international or "international-type" search must relate to an application the priority of which is claimed in a later international application before the whole or part of the search fee must be refunded. (See Rule 16.3)

[\* Art. 8(3) does not agree with Rule 48.3(b). When worded in such agreement, it appears to be superfluous.]

Article 9

Review Board

The Authority agrees to establish, in accordance with Rule 40.2(c) and (d), a ..... [three-member board or special instance or competent higher authority] to examine protests in respect of additional fees where the international application is found not to comply with the requirement of unity of invention.

Article 10

Time Limit for Preparation of International Search Reports or Declarations

The Authority agrees to establish international search reports or the declaration referred to in Article 17(2) (a) within the time limits<sup>9</sup> specified in the first two sentences of PCT Rule 42.1.

Article 11

Classification

Annex D to this Agreement shall indicate any other classification<sup>10</sup> of the subject matter in addition to the International Patent Classification which the Authority shall apply.

Article 12

International-Type Search<sup>11</sup>

(1) The Authority shall provide an "international-type" search report on all national applications filed in the States listed in Annex E to this Agreement as far as such search is requested by any such State.

(2) The Authority shall provide at the request of an applicant an "international-type" search report on a national application filed in the States listed in Annex E to this Agreement.

(3) The "international-type" search shall be carried out on a translated national application when such application is not in a language ~~prescribed for international applications~~. [specified in Annex to this agreement.]

[ no such prescription exists! ]

<sup>9</sup> In negotiating the agreement, the Authority may avail itself of the opportunity to negotiate slightly longer time limits for the preparation of international search reports or declarations for the first three years after entry into force of the Treaty (see Rule 42.1, last sentence).

<sup>10</sup> Since the normal indication of classification is according to the International Patent Classification (see Rule 43.3(a)), such indication of symbols of another classification system constitutes the exception.

<sup>11</sup> International-type search is obligatory, to the extent to which the national law of the State concerned so provides, and the national Office of that State subjects applications filed with it to such search (Article 15(5)(b)). It is optional for the applicant to the extent to which the national law of the State concerned so provides and no obligatory search of the kind referred to above is prescribed (Article 15(5)(a)). The obligatory international-type search assists national offices in particular of developing countries to establish an effective filter for national applications not using the PCT route. The optional international-type search assists prospective PCT applicants in determining, at an early date, whether or not to seek protection for their domestic origin inventions in one or more foreign countries via the PCT route.

Article 13

Information Service and Technical Assistance<sup>12</sup>

The Authority shall supply to the International Bureau such information services as may be agreed and such other contributions to the technical assistance program under Chapter IV of the Treaty as are practicable within the existing facilities of the Authority.

Article 14

Entry into Force of the Agreement

This Agreement shall enter into force upon approval by the Assembly.

Article 15

Duration and Renewability of the Agreement

This Agreement is concluded for ..... years. It shall be renewable for a period of ..... years subject to the approval of the Assembly. Should the Assembly fail to render a decision prior to ..... months before the termination of this Agreement, the Agreement shall be considered renewed for a period of ..... years.

Article 16

Amendment

This Agreement and any Annexes thereto may be amended at any time by agreement between the parties.

Article 17

Termination of the Agreement

Either party may terminate this Agreement by denouncing it. The denunciation shall be by written notice addressed to the other party. The Agreement shall terminate one year after the date of receipt of the notice by the other party.

[This time may be too short, e.g., if an Authority has to readjust its personnel resources.]

<sup>12</sup> This Article provides the basis for negotiating with the Authority its participation in patent information services to be established and technical assistance to developing countries to be provided under Chapter IV of the PCT.

In witness whereof the undersigned have signed this Agreement.

Done in duplicate at ..... this ..... day of ..... in originals in the .....  
and ..... languages, each text being equally authentic.

For the Authority by:

Name: .....

Title: .....

For the International Bureau by:

Name: .....

Title: .....

[Listing of PCT Provisions relevant to  
Articles of the Agreement follows]

[End of Annexes/Fin des annexes]  
[End of document/Fin du document]

LISTING OF PCT PROVISIONS RELEVANT TO ARTICLES OF THE  
AGREEMENT

General	The Agreement	PCT Article 16(3)(b), PCT Article 17(1) (Procedural Matters) Rules 12, 42, 89.1(b)
Article 1	Terminology Used in Agreement	PCT Article 2
Article 2	Basic Obligation	—
Article 3	Competence of International Searching Authority	PCT Articles 16(2), 16(3)(b) Rules 12, 35.1 and 35.2
Article 4	Minimum Personnel Requirements	PCT Rule 36.1(i)(iii)
Article 5	Documentation Facilities	
	(1) Minimum Documentation	PCT Article 16(3)(c), Rule 34, Rule 36.1(ii)
	(2) Expansion of Minimum Documentation	PCT Rule 34
Article 6	Number or Kinds of Inter- national Applications Processed	PCT Article 65(1)
Article 7	Subject Matter Not Required to be Searched	PCT Article 17(2)(a)(i) Rule 39.1(i) to (vi), Rule 15.4(a)
Article 8	Fees	
	(1) Search Fee	PCT Article 3(4)(iv), Rules 16.1 and 86.1(ii)
	(2) Fee Refund	PCT Rules 16.3 and 41.1
	(3) Fee for Translation	PCT Rule 48.3
Article 9	Review Board	PCT Rule 40.2(c) and (d)
Article 10	Time Limit for Preparation of International Search Reports or Declarations	PCT Rule 42.1
Article 11	Classification	PCT Article 18, Rule 43
Article 12	International-Type Search	PCT Article 15(5)(a) to (c), Rule 41
Article 13	Information Service and Technical Assistance	PCT Articles 50 and 51
Article 14	Entry into Force of the Agreement	PCT Article 16(3)(e)
Article 15	Duration and Renewability of the Agreement	PCT Article 16(3)(e)
Article 16	Amendment	—
Article 17	Termination of the Agreement	PCT Article 16(3)(e)