

WIPO



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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

PCT COMMITTEE FOR TECHNICAL COOPERATION

Thirteenth Session

Geneva, September 22 and 23, 1992

APPOINTMENT OF THE CHINESE PATENT OFFICE AS
AN INTERNATIONAL SEARCHING AND
PRELIMINARY EXAMINING AUTHORITY

Memorandum prepared by the International Bureau

1. The appointment of the Chinese Patent Office as an International Searching and Preliminary Examining Authority is on the agenda of the twentieth session of the Assembly of the PCT Union, which will meet, together with other Governing Bodies of WIPO and the Unions administered by WIPO, from September 21 to 29, 1992. Document PCT/A/XX/1 is the working document for that issue and is reproduced in the Annex to the present document.
2. Article 16(3)(e) of the Patent Cooperation Treaty (PCT) provides that "Before the Assembly [of the PCT Union] makes a decision on the appointment of any national Office [as an International Searching Authority]..., the Assembly shall ... seek the advice of the Committee for Technical Cooperation..." (hereinafter referred to as "the Committee"). Under Article 32(3) of the PCT, "The provisions of Article 16(3) shall apply, mutatis mutandis, in respect of International Preliminary Examining Authorities."
3. The Committee is invited to give its advice on this matter, particularly on paragraphs 15 to 21 and Annex I of document PCT/A/XX/1 (Annex to the present document).

[Annex follows]

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WORLD INTELLECTUAL PROPERTY ORGANIZATION
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INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

ASSEMBLY

Twentieth Session (12th Extraordinary)
Geneva, September 21 to 29, 1992

ACCESSION OF CHINA
TO THE PCT

Memorandum prepared by the International Bureau

Introduction

1. China has informed the Director General of WIPO that it intends to accede to the Patent Cooperation Treaty (PCT) under the conditions specified in this document. It is to be noted that the contents of the present document have the agreement of the Chinese Patent Office.
2. China has a patent system since 1985 and is, from the same time, a member of the Paris Union. It has a modern patent office with around 350 patent examiners and a rich collection of documentation. In 1991, the Chinese Patent Office received some 11,400 applications for patents for inventions, of which some 4,000 or 35% came from applicants outside China ("foreign applicants"). These numbers have been gradually reached from zero in six years. Further substantial increase of these numbers is predictable for three reasons. Firstly, the awareness of Chinese inventors and industry of the importance of patenting their inventions will continue to grow. Secondly, the number of instances where foreigners wish to establish economic relations (frequently involving the assignment or licensing of patents) with Chinese enterprises will also continue to grow. Thirdly, according to the Chinese Patent Office, the entry into force of the revised Chinese patent law, which is expected to occur on January 1, 1993, will enlarge the scope of available patent protection, since it will be possible under the revised law to obtain patents for chemical and pharmaceutical products. It is, therefore, in the interest of both China and the other countries that the simpler, cheaper and legally more secure procedures that the PCT offers be available also in China.
3. Accession by China would require the fulfillment of the following three conditions--each completely compatible with the PCT--namely,
 - (i) that international applications can be filed with the Chinese Patent Office in the Chinese language,
 - (ii) that the international applications so filed be published by the International Bureau in Chinese (with an English translation of the title of the invention and the abstract),
 - (iii) that the Chinese Patent Office be appointed as an International Searching Authority (ISA) and an International Preliminary Examining Authority (IPEA).
4. The fulfillment of these conditions would make, in PCT procedures, the position of the Chinese language, as a language of filing and publication, the same as that of the German, Japanese, Russian and Spanish languages, and would, as far as the status of ISA and IPEA is concerned, place the Chinese Patent Office on the same footing with the Patent Offices of Australia, Austria, Japan, the Russian Federation, Sweden, the United States of America and the European Patent Office.
5. Each of these conditions is examined separately in the following.

The Chinese language as a language of international applications

6. PCT Rule 12.1(a) provides that "Any international application shall be filed in the language...specified in the agreement concluded between the International Bureau and the International Searching Authority competent for the international searching of that application..." Since it is assumed that the Chinese Patent Office would be an ISA and would be competent for the international searching of international applications filed with the Chinese Patent Office, the agreement between the International Bureau and the Chinese Patent Office would specify that the Office will accept to search international applications filed in Chinese.

7. The draft of the agreement is attached as Annex I.

8. It is proposed that PCT Rules 10.1(f) and 11.9(b) and (e) be amended to take into account the specificity of Chinese characters.

9. Annex II contains the text of Rules 10 and 11 as proposed to be amended.

Publication of international applications in Chinese

10. PCT Rule 48.3(a) provides that "If the international application is filed in English, French, German, Japanese, Russian or Spanish, that application shall be published in the language in which it was filed."

11. It is proposed that that Rule be amended by inserting "Chinese" in the list of the languages mentioned above.

12. A consequential change is that "Chinese" be added to the list of languages also in Rule 48.3(b).

13. It is proposed that that Rule be amended accordingly.

14. Annex II contains the text of Rule 48 as proposed to be amended.

Appointment of the Chinese Patent Office as an ISA and an IPEA

15. PCT Article 16 provides that "International Searching Authorities shall be appointed by the Assembly [of the PCT Union]" (paragraph (3)(a)), that "Any national Office...satisfying the requirements referred to in subparagraph (c) may be appointed as International Searching Authority" (*ibidem*), that "Appointment shall be conditional on the consent of the national Office... to be appointed and the conclusion of an agreement, subject to approval by the Assembly, between such Office...and the International Bureau" (paragraph (3)(b)). The draft of the agreement is contained in Annex I.

16. PCT Article 16 also provides that "Before the Assembly makes a decision on the appointment of any national Office [as an ISA]..., the Assembly shall hear the interested Office...and seek the advice of the Committee of Technical Cooperation..." (paragraph (3)(e)). The said Committee has been convened for September 22, 1992; it will be seized of the present document, and its advice will be communicated to the Assembly when it meets from September 22 to 29, 1992. (It is planned that this item will be considered by the Assembly on September 24, 1992.)

17. Similar provisions apply to the appointment of IPEAs (see PCT Article 32(3)), and a procedure similar to that described in the preceding paragraph will be applied to such appointment.

18. The draft of the agreement attached as Annex I deals also with the appointment as IPEA.

19. The said draft agreement is similar to those in force between WIPO and the presently existing ISAs and IPEAs, except on one point described in paragraph 20, below.

20. The minimum requirements set out in PCT Rules 36.1 and 63.1 for ISAs and IPEAs are met by the Chinese Patent Office, except that, as regards the minimum documentation referred to in PCT Rule 34, and which includes, according to present estimates, around 18 million patent documents, some 1.85 million are for the time being missing. They are indicated in Annex III. The procurement of those documents by the Chinese Patent Office has, however, started and will gradually be completed latest within five years from the day on which China becomes bound by the PCT. A corresponding undertaking of the Chinese Patent Office is contained in Article 2(3) of the draft agreement attached as Annex I.

21. The International Bureau proposes that the Assembly accept the proposed maximum five-year grace period, in view of the fact that the number of the temporarily missing patent documents is relatively small (only some 10% of the total number of documents) and that most of them (some 75% of the 1.85 million) are from the period between 1920 and 1945, that is, a relatively distant period whose documents are rarely needed since the art they cover is also covered by the more recent documents.

22. The Assembly of the PCT Union is invited

(i) to amend PCT Rules 10.1(f), 11.9(b) and (e) and 48.3(a) and (b) as set out in Annex II effective on the date on which China becomes bound by the PCT,

(ii) to hear the representative of the Chinese Patent Office as required in PCT Article 16(3)(e),

(iii) to approve the draft agreement between the Chinese Patent Office and WIPO as set out in Annex I, and

(iv) to appoint the Chinese Patent Office as an ISA and an IPEA.

[Annexes follow]

Draft Agreement between
the CHINESE PATENT OFFICE
and the WORLD INTELLECTUAL PROPERTY ORGANIZATION in relation to the
functioning of the CHINESE PATENT OFFICE as an
International Searching and International Preliminary
Examining Authority under the Patent Cooperation Treaty

The Chinese Patent Office and the World Intellectual Property Organization
hereby agree as follows:

Article 1

Terms and Expressions Used in the Agreement

- (1) For the purposes of this Agreement:
 - (a) "Treaty" means the Patent Cooperation Treaty;
 - (b) "Regulations" means the Regulations under the Treaty;
 - (c) "Administrative Instructions" means the Administrative Instructions under the Treaty;
 - (d) "Article" (except where a specific reference is made to an Article of this Agreement) means an Article of the Treaty;
 - (e) "Rule" means a Rule of the Regulations;
 - (f) "Contracting State" means a State party to the Treaty;
 - (g) "Authority" means the Chinese Patent Office.
- (2) All other terms and expressions used in this Agreement which are also used in the Treaty, the Regulations or the Administrative Instructions have, for the purposes of this Agreement, the same meaning as in the Treaty, the Regulations and the Administrative Instructions.

Article 2

Basic Obligations

(1) The Authority shall carry out international search and international preliminary examination in accordance with, and perform such other functions of an International Searching and International Preliminary Examining Authority as are provided under the Treaty, the Regulations, the Administrative Instructions and this Agreement. In carrying out international search and international preliminary examination, the Authority shall be guided by the Guidelines for International Search and for International Preliminary Examination to be Carried Out under the Patent Cooperation Treaty. The Authority shall apply and observe all the common rules of international search and of international preliminary examination.

(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, render, to the extent possible, mutual assistance in the performance of their functions thereunder.

(3) The Authority undertakes to acquire any missing part of the minimum documentation referred to in Rule 34.1 within five years of the entry into force of this Agreement.

Article 3

Competence of Authority

(1) The Authority shall act as an International Searching Authority for all international applications filed with the receiving Office of, or acting for, any Contracting State indicated in Annex A of this Agreement, provided that the receiving Office specifies the Authority for that purpose and that such applications are in one of the languages specified in Annex A of this Agreement.

(2) The Authority shall act as an International Preliminary Examining Authority for all international applications filed with the receiving Office of, or acting for, any Contracting State indicated in Annex A of this Agreement, provided that the receiving Office specifies the Authority for that purpose and that such applications are in one of the languages specified in Annex A of this Agreement.

Article 4

Subject Matter Not Required to be
Searched or Examined

The Authority shall not be obliged to search, by virtue of Article 17(2)(a)(i), or shall not be obliged to examine, by virtue of Article 34(4)(a)(i), any international application to the extent that it considers that the international application relates to subject matter set forth in Rule 39.1 or Rule 67.1, as the case may be, with the exception of the subject matter specified in Annex B of this Agreement.

Article 5

Fees and Charges

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

(2) The Authority shall, under the conditions and to the extent set out in Annex C of this Agreement, refund the whole or part of the search fee paid where an international search report can be wholly or partly based on the results of an earlier search made by the Authority (Rules 16.3 and 41.1) or where the international application is withdrawn or considered withdrawn before the start of the international search.

(3) The Authority shall, under the conditions and to the extent set out in Annex C of this Agreement, refund the whole or part of the preliminary examination fee paid where the demand is considered as if it had not been submitted (Rule 58.3) or where the demand or the international application is withdrawn by the applicant before the start of the international preliminary examination.

Article 6

Classification

For the purposes of Rules 43.3(a) and 70.5(b), the Authority shall indicate solely the International Patent Classification.

Article 7

Languages of Correspondence Used by the Authority

For the purposes of correspondence, including forms, other than with the International Bureau, the Authority shall use the language, specified in Annex A of this Agreement, which is the language of the international application.

Article 8

International-Type Search

The Authority shall carry out international-type searches to the extent decided by it.

Article 9

Entry Into Force of the Agreement

This Agreement shall enter into force on the day on which China becomes bound by the PCT.

Article 10

Duration and Renewability of the Agreement

This Agreement shall remain in force for five years. At the latest four years after its entry into force, the parties to this Agreement shall start negotiations for its renewal.

Article 11

Amendment

(1) Without prejudice to paragraphs (2) and (3), amendments may, subject to approval by the Assembly of the International Patent Cooperation Union, be made to this Agreement by agreement between the parties hereto; they shall take effect on the date agreed upon by them.

(2) Without prejudice to paragraph (3), amendments may be made to the Annexes of this Agreement by agreement between the Director General of the World Intellectual Property Organization and the Authority; they shall take effect on the date agreed upon by them.

(3) The Authority may, by notice in writing given to the Director General of the World Intellectual Property Organization:

(i) add to the States and languages listed in Annex A of this Agreement;

(ii) amend the schedule of fees and other charges contained in Annex C of this Agreement.

(4) Any amendment notified under paragraph (3) shall take effect on the date specified by the Authority, provided that for any increase of fees or other charges contained in Annex C that date is at least one month later than the date on which the notification is received by the International Bureau.

Article 12

Termination of the Agreement

(1) This Agreement shall terminate before the expiration of the five-year period referred to in Article 10 of this Agreement:

(i) if the Authority gives the Director General of the World Intellectual Property Organization written notice to terminate this Agreement; or

(ii) if the Director General of the World Intellectual Property Organization 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, unless a longer period is specified in such notice or unless both parties agree on a shorter period.

IN WITNESS WHEREOF the parties hereto have executed this Agreement.

DONE at Geneva, this ..th day of, in two originals in the Chinese and English languages, each text being equally authentic.

For the Authority by:

For the World Intellectual Property
Organization by:

ANNEX A

STATES AND LANGUAGES

Under Article 3 of the Agreement, the Authority

(i) shall act for the following States:

China,

any developing country that the Authority will specify;

(ii) specifies the following languages:

Chinese,

English.

ANNEX B

SUBJECT MATTER NOT EXCLUDED
FROM SEARCH OR EXAMINATION

The subject matter set forth in Rule 39.1 or Rule 67.1 which, under Article 4 of the Agreement, is not excluded from search or examination, is the following:

Subject matter which is searched or examined in Chinese national applications.

ANNEX C

FEEES AND CHARGES FOR INTERNATIONAL SEARCH
AND PRELIMINARY EXAMINATION

Part I: Schedule of Fees and Charges

<u>Kind of fee or charge</u>	<u>Amount</u> (RMB Yuan)
Search fee (Rule 16.1(a)).....	800
Additional fee (Rule 40.2(a))	800
Preliminary examination fee (Rule 58.1(b))	800
Additional fee (Rule 68.3(a))	800
Cost of copies (Rules 44.3(b), 71.2(b) and 94.1)	2 per page

Part II: Conditions and Extent of Refunds of the Search Fee and of the Preliminary Examination Fee

(1) Any amount paid by mistake, without cause, or in excess of the amount due, for fees indicated in Part I shall be refunded.

(2) Where the international application is withdrawn or is considered withdrawn, under Article 14(1), (3) or (4), before the start of the international search, the amount of the search fee paid shall be fully refunded.

(3) Where the Authority benefits from an earlier search to the full extent or to a substantially prevailing portion, 75% of the search fee paid shall be refunded.

(4) In the cases provided for under Rule 58.3, the amount of the preliminary examination fee paid shall be fully refunded.

(5) If the international application or the demand is withdrawn before the start of the international preliminary examination, the amount of the preliminary examination fee paid shall be fully refunded.

[Annex II follows]

PROPOSED AMENDMENTS TO
PCT RULES 10, 11 AND 48

Rule 10

Terminology and Signs

10.1 Terminology and Signs

(a) to (e) [No change]

(f) When the international application or its translation is in Chinese, English or Japanese, the beginning of any decimal fraction shall be marked by a period, whereas, when the international application or its translation is in a language other than Chinese, English or Japanese, it shall be marked by a comma.

10.2 [No change]

Rule 11

Physical Requirements of the International Application

11.1 to 11.8 [No change]

11.9 Writing of Text Matter

(a) [No change]

(b) Only graphic symbols and characters, chemical or mathematical formulae, and certain characters in the Chinese or Japanese language may, when necessary, be written by hand or drawn.

(c) The typing shall be 1 1/2-spaced.*

(d) All text matter shall be in characters the capital letters of which are not less than 0.21 cm high, and shall be in a dark, indelible color, satisfying the requirements specified in Rule 11.2.*

(e) As far as the spacing of the typing and the size of the characters are concerned, paragraphs (c) and (d) shall not apply to texts in the Chinese or Japanese language.

11.10 to 11.14 [No change]

* No changes are proposed to be made in paragraphs (c) and (d) of Rule 11.9, which are reproduced because they are referred to in paragraph (e) of that Rule.

Rule 48*

International Publication

48.1 and 48.2 [No change]

48.3 Languages

(a) If the international application is filed in Chinese, English, French, German, Japanese, Russian or Spanish, that application shall be published in the language in which it was filed.

(b) If the international application is filed in a language other than Chinese, English, French, German, Japanese, Russian or Spanish, that application shall be published in English translation. The translation shall be prepared under the responsibility of the International Searching Authority, which shall be obliged to have it ready in time to permit international publication by the prescribed date, or, where Article 64(3)(b) applies, to permit the communication under Article 20 by the end of the 19th month after the priority date. Notwithstanding Rule 16.1(a), the International Searching Authority may charge a fee for the translation to the applicant. The International Searching Authority shall give the applicant an opportunity to comment on the draft translation. The International Searching Authority shall fix a time limit reasonable under the circumstances of the case for such comments. If there is no time to take the comments of the applicant into account before the translation is communicated or if there is a difference of opinion between the applicant and the said Authority as to the correct translation, the applicant may send a copy of his comments, or what remains of them, to the International Bureau and each designated Office to which the translation was communicated. The International Bureau shall publish the essence of the comments together with the translation of the International Searching Authority or subsequently to the publication of such translation.

(c) [No change]

48.4 to 48.6 [No change]

[Annex III follows]

* The only amendment consists of the addition of the word "Chinese" in paragraphs (a) and (b) of Rule 48.3.

DOCUMENTS FORMING PART OF THE PCT MINIMUM
DOCUMENTATION WHICH, ON THE DATE OF THIS DOCUMENT,
THE CHINESE PATENT OFFICE DOES NOT HAVE IN ITS
POSSESSION OR DOES NOT HAVE ACCESS TO

	<u>Number of documents</u>
1. <u>Documents issued by France</u>	
1.1 Patents issued from 1920 to 1939	355,801
1.2 Certificates of addition (to patents) issued from 1920 to 1939	29,401
1.3 Certificates of addition (to patents) issued from 1973 to 1985	143
1.4 Patents for medicaments issued from 1972 to 1979	38
1.5 Certificates of addition (to patents for medicaments) issued from 1961 to 1965	112
1.6 Certificates of additions (to patents for medicaments) issued from 1972 to 1979	<u>12</u>
Total number of documents issued by France	385,507
2. <u>Documents issued by the former Reichspatentamt</u>	
2.1 Patents issued from 1920 to 1945	<u>452,617</u>
Total number of documents issued by the former Reichspatentamt	452,617
3. <u>Documents issued by Germany</u>	
3.1 Published examined applications issued from 1955 to 1957	34,803
3.2 Published non-examined applications issued from 1968 to 1977	<u>399,035</u>
Total number of documents issued by Germany	433,838
4. <u>Documents issued by Switzerland</u>	
4.1 Published examined applications issued from 1962 to present	9,056
4.2 Patents (including patents of addition) issued from 1920 to 1950	<u>180,948</u>
Total number of documents issued by Switzerland	190,004

5.	<u>Documents issued by the United Kingdom</u>	
5.1	Complete specifications issued from 1920 to 1939	<u>380,215</u>
	Total number of documents issued by the United Kingdom	380,215
6.	<u>Documents issued by the United States of America</u>	
6.1	Reissued patents issued from 1920 to 1957	<u>9,629</u>
	Total number of documents issued by the United States of America	<u>9,629</u>
	GRAND TOTAL	<u>1,851,810</u>

[End of Annex and of document]