

WIPO



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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION (PCT UNION)

ASSEMBLY

Fourteenth Session (9th Extraordinary)
Geneva, September 8 to 12, 1986

REPORT

Adopted by the Assembly

INTRODUCTION

1. The Assembly was concerned with the following items of the Consolidated Agenda (documents AB/XVII/1.Rev. and 1.Rev.Add.): 1, 2, 4, 9, 10, 10*bis*, 14 and 15.
2. The report on the said items, with the exception of items 10 and 10*bis*, is contained in the General Report (document AB/XVII/11).
3. The report on items 10 and 10*bis* is contained in this document.

ITEM 10 OF THE CONSOLIDATED AGENDA:

ACCESSION OF GREECE AND SPAIN TO THE PATENT COOPERATION TREATY

4. Discussions were based on document PCT/A/XIV/1.

5. The Delegation of Spain stated that, for the PCT to become more attractive to the Spanish-speaking countries, it was necessary that the Spanish language be fully recognized in the framework of that Treaty, which implied that three objectives had to be reached: the admittance of Spanish as a language of filing and of publication of international applications, the incorporation of Spanish language patent documents into the PCT minimum documentation, and the possibility for a Spanish-speaking patent office to become an International Searching Authority. The revision of Rules 12, 34 and 48 of the Regulations under the PCT made it possible to reach the first two objectives. As to the acquisition of the status of an International Searching Authority, the Patent Office of Spain was undertaking a number of internal reforms which would make it possible for it to become, in due course, an International Searching Authority. The Delegation informed the Assembly that the internal procedure for accession to the PCT had already been initiated and added that such accession would be facilitated by a declaration of the Assembly expressing its willingness to appoint, in due course, the Patent Office of Spain as an International Searching Authority.

6. The Delegation of Greece thanked the member States of the PCT Union for their interest in inviting Greece to accede to the PCT and said that it would inform the government authorities of its country of the decision of the Assembly.

7. The Representative of the European Patent Office (EPO) stated that the EPO as a regional Office was naturally interested in PCT matters. He expressed his appreciation and admiration for the skillful and sustained efforts of WIPO in successfully promoting this important Treaty. For the PCT user, the interaction between the European Patent Convention (EPC) and the PCT was an essential feature. It was therefore highly desirable that any new member of the EPO ratify or accede to the PCT as soon as possible in order to maintain for the applicant the possibility of designating all EPC countries in the international application. The EPO had taken measures to permit consolidation of a European application designating any EPC country not yet a party to the PCT and an international application designating all other EPC countries in a so-called Euro/PCT designation. However, the full advantages of the PCT would be available only if PCT membership covered all EPC States. The EPO was therefore ready to give full assistance to the countries becoming new members of the EPC in overcoming any obstacle in adhering to the PCT. The intention of Spain to act as an International Searching Authority under the PCT was to be warmly welcomed. The Patent Office of Spain would fulfill an important function in searching and processing PCT applications.

8. The Delegations of France, Switzerland, Norway, Romania, the Soviet Union, the United States of America and Germany (Federal Republic of) supported the proposals contained in paragraph 5 of document PCT/A/XIV/1.

9. The Assembly unanimously declared that it would very much welcome the early accession to the PCT of Greece and Spain as well as of all the other countries not yet party to the PCT and invited those countries to join them in the PCT Union. Furthermore, the Assembly unanimously declared its willingness to appoint the Patent Office of Spain as an International Searching Authority under the PCT once all the conditions prescribed by the PCT and the Regulations thereunder were fulfilled, in particular, those which must be fulfilled by any Office acting as International Searching Authority.

10. The Delegation of Brazil stated that the National Institute of Industrial Property (INPI) of its country was contemplating to become an International Searching Authority under the PCT.

11. The Director General noted with interest the desire of the Brazilian INPI to become an International Searching Authority and said that the International Bureau was at the disposal of that Office to discuss the necessary procedures.

ITEM 10*bis* OF THE CONSOLIDATED AGENDA:

APPOINTMENT OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
AS AN INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY
UNDER THE PATENT COOPERATION TREATY

12. Discussions were based on document PCT/A/XIV/2.

13. The Delegation of the United States of America welcomed the proposals contained in paragraph 3 of document PCT/A/XIV/2. It was anticipated that, in October 1986, the authority to withdraw the reservation under Article 64(1) of the PCT would be given and the necessary implementing legislation would be adopted by the United States Congress, so that the withdrawal of the reservation could be effected before the next ordinary session of the Assembly. Discussion of the agreement between the United States Patent and Trademark Office (USPTO) and the International Bureau had begun. It was expected that the amended agreement would be similar in substance to the agreements already concluded by the International Bureau with the other industrial property offices acting both as International Searching Authorities and as International Preliminary Examining Authorities.

14. The Assembly decided that it was not necessary, before making the proposed appointment, to seek the advice of the PCT Committee for Technical Cooperation.

15. The Assembly decided to provisionally appoint the USPTO as an International Preliminary Examining Authority, and to approve in advance the required amendments to the existing agreement between the USPTO and the International Bureau provided that the amended agreement would, in substance, be similar to the agreements already concluded by the International Bureau with the other industrial property offices acting both as International Searching Authorities and International Preliminary Examining Authorities. It was understood that the appointment would become effective only once the United States of America was bound by the provisions of Chapter II of the PCT, that the agreement, once amended, would be promptly communicated by the International Bureau to all Contracting States of the PCT and that the Assembly at its first session following the amendment of the existing agreement (probably in September 1987) would be invited to confirm the appointment of the USPTO as an International Preliminary Examining Authority.

16. As regards the existing agreements with the International Searching and Preliminary Examining Authorities, the International Bureau recalled that, except for the agreement with the United Kingdom Patent Office, which would expire in 1993 and was not renewable, the existing agreements would expire in 1988 or in early 1989 (and, in the case of the agreement with the Australian Patent Office, in early 1990). That meant that the Assembly would have

to approve the renewal of the agreements in its 1987 ordinary session. Since the agreements could not be simply renewed because they contained obsolete provisions or provisions which required adaptation to the changes made in the Regulations under the PCT in 1984, it was intended to amend them so that new texts would be submitted to the Assembly in 1987. At the same time, that procedure would allow further harmonization of the substance and wording of the agreements. There were presently some differences which, in the opinion of the International Bureau based on the experience gained since 1978, could and should be eliminated. Naturally, some differences would have to be maintained here and there, particularly in the annexes to the agreements, which dealt with particular questions such as languages and fees, but the objective would be to have texts as identical as possible. The procedure would be the following. The International Bureau would approach each International Searching and Preliminary Examining Authority with a uniform new text which, it was hoped, would be acceptable to each of them. Once the new agreements were agreed upon with each Authority, the International Bureau would prepare a document for the 1987 ordinary session of the Assembly containing the texts of the new agreements, which would all enter into force on January 1, 1988, and be valid for 10 years, namely, until December 31, 1997.

17. The Assembly noted the statement reflected in the previous paragraph.

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