

**RFP N° PTD/10/075**

**ANNEX I - TERMS OF REFERENCE  
for the provision of  
Marketing/Pricing Consultancy Services  
for the  
Patent Cooperation Treaty (PCT),  
the Madrid system,  
the Hague system, and  
the WIPO Arbitration and Mediation Center**

**World Intellectual Property Organization (WIPO)**

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## **1 INTRODUCTION**

1. WIPO is an intergovernmental organization headquartered in Geneva, Switzerland, and is one of the 16 Specialized Agencies of the United Nations system of organizations. WIPO is responsible for promotion of the protection of intellectual property throughout the world. For further information on WIPO, see [http://www.wipo.int/about-wipo/en/what\\_is\\_wipo.html](http://www.wipo.int/about-wipo/en/what_is_wipo.html).

2. In addition to working toward the balanced evolution of the international normative framework for intellectual property, facilitating the use of intellectual property for development, and the accomplishment of WIPO's other strategic goals, WIPO operates a number of fee-funded services in relation to various aspects of the international intellectual property system: in particular, the Patent Cooperation Treaty (PCT), the Madrid System for the International Registration of Marks, the Hague System for the International Registration of Industrial Designs, and the WIPO Arbitration and Mediation Center. Each of these services is described in more detail below.

## 1.1 PATENT COOPERATION TREATY (PCT)

3. The PCT is an international treaty, administered by the World Intellectual Property Organization (WIPO), between 142 Paris Convention countries. The PCT makes it possible to seek patent protection for an invention simultaneously in each of a large number of countries by filing a single “international” patent application instead of filing several separate national or regional patent applications. The granting of patents remains under the control of the national or regional patent Offices in what is called the “national phase”. The PCT simplifies and reduces the cost of the pursuit of multinational patent protection.

4. More information on the PCT can be found at <http://www.wipo.int/pct/en>. Of particular help in understanding the PCT might be the overview publication *Protecting your Inventions Abroad: Frequently Asked Questions about the Patent Cooperation Treaty (PCT)*, a PCT distance learning course (available at [http://www.wipo.int/pct/en/distance\\_learning/index.html](http://www.wipo.int/pct/en/distance_learning/index.html)), PCT training materials ([http://www.wipo.int/pct/en/seminar/basic\\_1/index.html](http://www.wipo.int/pct/en/seminar/basic_1/index.html)), and relevant PCT statistics (as contained in the 2009 PCT Yearly Review: [http://www.wipo.int/export/sites/www/ipstats/en/statistics/pct/pdf/901e\\_2009.pdf](http://www.wipo.int/export/sites/www/ipstats/en/statistics/pct/pdf/901e_2009.pdf)).

5. In 2009, approximately 155,900 PCT applications were filed. Each one includes a fee of 1,330 Swiss francs (plus 15 francs for each page over 30) which comes to WIPO for its part in the processing of the applications and overseeing the PCT system.

6. According to page 32 of the 2009 PCT Yearly Review, the PCT in 2008<sup>1</sup> had a 52% market share. That means that 52% of all non-resident patent filings worldwide are national phase entries from PCT applications. What it also means is that a significant number of non-resident patent filings worldwide are filed in a way other than through the PCT system, the traditional Paris Convention-based route being the most used alternative. One of the purposes of this marketing initiative is to see what measures, if any, could be implemented which would increase the market share of the PCT.

### 1.1.1 Marketing the PCT—background

7. The users of the PCT service are:

- mainly corporations submitting applications for inventions produced by their employees (see Annex 1 for list of largest users from 2009);
- universities submitting applications for inventions produced by faculty, staff and graduate students;
- small and medium sized enterprises (SMEs);
- individuals.

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<sup>1</sup> Because of the delays in getting the data from the national patent offices, the latest full year available is 2008

8. WIPO has never engaged in traditional marketing of the PCT. WIPO has, however, disseminated information about the PCT to its users and potential users in the intellectual property community in various forms and via various channels and means, such as:

- a) the PCT portion of the WIPO website which includes:
  - i. Information resources such as the *PCT Newsletter* and the *PCT Applicant's Guide* (which were both historically subscription-based publications);
  - ii. Access to a PCT distance learning course, and information about PCT seminars and webinars;
  - iii. Email services, allowing the user to subscribe and have PCT information sent to him;
- b) PCT seminars and presentations, offered for attorneys and paralegals via commercial organizers, bar associations, law schools, professional associations and individual applicant companies. Advertising for these events has been done by all of those sources (and via the website and PCT Newsletter) to their members and communities;
- c) Visits to and discussions with large PCT users;
- d) Efforts to reach out to various sectors of applicants (for example, to universities);
- e) Relations/connections with national and regional Patent Offices;
- f) Merchandising—in past years, we have done some PCT-related merchandising, like the current USB keys, the PCT Wheel co-produced with a law firm, PCT mousepads, etc. which were distributed at seminars and presentations.

9. WIPO has made some efforts in the past to identify those corporations not using PCT and reach out to them to understand the lack of use and provide updated information PCT and its benefits, but these have not been sustained efforts. We are in the process currently of doing this again, and getting the feedback of these companies.

### **1.1.2 Alternate pricing in PCT—background**

10. In addition to the general pricing information provided above, the PCT contains a fee structure which provides fee reductions for certain classes of PCT applicants from specified countries. It also contains reductions for those who file their applications by electronic means and/or in electronic form. We have begun to analyze whether criteria can be formulated to extend fee reductions to small and medium-sized enterprises, and in principle this issue should be discussed at the next session of the PCT Working Group in June 2010. Potentially, such reductions could be extended to universities, research institutions and non-profits. Some PCT applicants have attempted to prevail on WIPO to restructure its fees so that applicants which only intend to pursue patent protection in a very limited number of countries would be able to pay a much lower fee, and have argued that providing for such a scheme would result in increased numbers of filings. We are concerned about the net financial impact of such a scheme.

## 1.2 MADRID SYSTEM

11. The international registration of marks is governed by two international treaties, namely the Madrid Agreement concerning the International Registration of Marks from 1891 and the Protocol relating to the Madrid Agreement concerning the International Registration of Marks from 1989. The Madrid system is administered by the International Bureau of WIPO. The Madrid system has 85 Contracting Parties, where two are only members of the Agreement.

12. The Madrid system provides for trademark protection in a simple, efficient, flexible, user-friendly and time and cost-effective manner. The Madrid system makes it possible to obtain trademark protection in more than 80 countries by filing one single international trademark application instead of filing several separate national or regional applications. The treaties and the Regulations provide the basic principles and mechanism of the system, governing the formal conditions for an international registration, while the domestic laws and Regulations of the Contracting Parties govern the substantive conditions for granting the protection in each relevant territory.

13. More information on the Madrid system can be found at <http://www.wipo.int/madrid/en/>.

The general information and the Frequently Asked Questions about the Madrid system may be of particular help. Relevant statistics under the Madrid system can be found at <http://www.wipo.int/madrid/en/statistics/>.

14. In 2009, the International Bureau received more than 35,000 (35,195) international applications, which was a decrease of about 16% compared to 2008 (42,075) due to the global downturn in economic activity. By the first nine months of 2010, there has been an increase of 12%.

15. The target of the Sector (non-official) for 2010 to 2015 is to receive twice as many international applications in 2015 based on 2008-numbers. In order to do so, the system will have to experience between the years 2010 and 2015, an average annual growth in the two-digit area (about 13%). In the period between the years 1996 and 2009, the average annual growth rate of applications under the system has been 4.4%.

16. According to numbers from 2008, the share of non-resident applications received by IP Offices worldwide through the Madrid system was 38.8%. This means that more than one third of all trademark applications filed by non-residents worldwide came through the Madrid system.

### 1.2.1 Marketing the Madrid system - background

17. At the end of the year 2009, more than 500,000 (515,562) international registrations were active in the International Register. These international registrations involved almost 170,000 (169,939) right holders, of which almost 80% can be categorized as small and medium sized enterprises (SME) because they have only 1-2 marks. Larger corporations represent the remaining 20% of the right-holders. Of the more than 500,000 registrations in force, about 32% belong to SMEs as they have 1-2 marks, while larger corporations own the remaining 68% of the registrations.

18. The source of income in the Madrid system is different than in the PCT. The fee structure of the Madrid system consists of two components; the basic fee to be paid to WIPO for filing an international application and the individual fee to be paid to each designated Contracting Party. Changing the basic fee will not increase necessarily in a substantial way the income to WIPO as a large part of the surplus of that basic fee is divided among the Contracting Parties which have opted for the complementary fee and not the individual fee, in other words, Madrid, since its conception, has been an income-sharing system.

19. Any substantial increase in income for the Madrid system has to come from an increase of filings of international applications. Compared to the PCT-system, there is an under-utilization of the Madrid system in major countries like the USA, China, Japan, Korea and Australia among others. In addition to an increase of number of filings through promoting better use of the Madrid system in current member States, what is also needed is an expansion of the geographical scope of the system, meaning acquiring new member States. The Madrid system is older than the PCT-system, but it is still not as mature as the PCT in relation to number of filings and the number of Contracting Parties. The PCT is already a truly global system whereas the Madrid is in the process of becoming one.

20. Increasing the Madrid membership of countries that play important roles in international trade (G-20) (India, Brazil, Canada, Mexico, Argentina, Saudi Arabia and South-Africa) will boost the use of the Madrid system. The accession of other member States from Asia (Malaysia, Thailand, the Philippines and Indonesia) will strengthen regional trade (APEC) with current members States like USA, China, Japan, Korea and Australia.

21. Another priority of the International Bureau is the identification of factors that may hinder use or result in increased use of the system. According to some users, especially large corporations, the mechanism of central attack is keeping them from actually using the system to its full potential. This concern is particularly acute in the new members of the Madrid System (USA, Japan, Australia, Korea, among others). This issue is being dealt with within the framework of the Working Group; the International Bureau is gathering information trying to get an estimate of the real use of central attack and not the over-dimensioned assumption that reigns today.

22. Even though WIPO has never engaged in traditional marketing of the Madrid system, WIPO has, however given information about the Madrid system to its users and potential users in various forms and through various channels and means like the following:

- a) The Madrid portion of the website which includes information resources like:
  - Free publications (“Madrid System for the International Registration of Marks – Report for 2009” in English, Spanish and French; “The Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement: Objectives, Main Features, Advantages” in English, Spanish, French, Portuguese and Russian; “Trademarks – “The Madrid System for the International Registration of Marks” in English and French.

- Informational videos about the system: Guide to the International Registration of Marks under the Madrid Agreement and the Madrid Protocol in English, Spanish and French. Translation of the Guide into Russian and Chinese are being prepared;
- b) Madrid seminars and presentations, offered for attorneys/agents and paralegals and for current and potential users of the system. Seminars are being held at WIPO but also through commercial organizers, bar associations, international organizations, law schools, etc. Advertising for these events has been done by all of those sources and via the website to their members and communities;
- c) Visits to and discussions with large Madrid users;
- d) Receiving study visits at WIPO from national offices (current and potential member states), international and intergovernmental organizations, universities, users of the Madrid system;
- e) Efforts to reach out to various sectors (for example through international organizations (INTA; ECTA, Marques) ;
- f) Relations/connections with national and regional IP Offices;
- g) Merchandizing – we have a USB key containing the full legal framework on the Madrid system and the Hague system (treaties, Regulations, Guide and informational videos), which we have distributed at special events, seminars, presentations.
- h) New promotion activities:
  - organizing roving seminars for major users;
  - promotion materials, specifically tailored to certain countries and regions, in national languages, in order to target users and potential users directly; and
  - identifying types of industries filing for trademark protection abroad and not using the Madrid system, in order to promote better use directly to the users.

### **1.2.2 Alternate pricing in Madrid system - background**

23. In future Working Group meetings, we may also discuss issues like new pricing for new-services to be provided by the International Bureau and a possible restructuring of the fee-system. However as mentioned above, changing the basic fee will not necessarily increase much the income for WIPO due to the income-sharing system. There will also be an increase of income due to renewals, as we have experienced an increase of international registrations in the last years which will be up for renewal every ten years. However, any substantial increase in income will only come via an increase of filings of international applications/subsequent designations.

### 1.3 HAGUE SYSTEM

24. Like the Madrid system and unlike the PCT, the Hague Agreement is an international registration system. As such, it offers the possibility to obtain protection for industrial designs in any selected Members by means of a single international application that then matures into a central international registration, entered in the International Register held by the International Bureau of WIPO. Thus, an international registration replaces a whole series of registrations that otherwise would need to be prosecuted and managed locally in each Member. Each Member Office retains the right to refuse protection as far as its jurisdiction is concerned but may only do so on substantive grounds. The possibility of filing under the Hague Agreement is only open to “nationals” of Hague Members. There are currently 55 member countries and two member intergovernmental organizations, namely the EU and the African Intellectual Property Organization.

25. More information on the Hague System can be found at [www.hague.int/hague](http://www.hague.int/hague) , and notably the basic “Main Features and Advantages” brochure, FAQs and the Annual Report for 2009 ([www.wipo.int/hague/en/statistics/index.html](http://www.wipo.int/hague/en/statistics/index.html)). However, one current aspect that needs to be stressed is the complexity of the legal framework of the Hague system, as it is constituted by three “Acts” with distinct but overlapping memberships. Users from Members bound by the 1999 Act only do not have access to members bound by the 1960 Act, and vice-versa (the outdated 1934 Act can be ignored for any promotion purposes as WIPO has succeeded in getting its application of to be frozen as of January 1, 2010). In practice the International Bureau promotes accession to the latest Act and one of the goals is to have all current Hague members bound by the 1999 Act.

26. In 2009 the International Bureau received 1,796 international applications for a total of 8,464 designs, an about 10% increase compared to 2008. This is in stark contrast with the peak of 2000, where 21,134 designs in 4,334 international registrations were recorded in the International Register. This decline is almost entirely attributable to the introduction in 2003 of the EU’s Registered Community Design (RCD), allowing applicants to obtain design protection throughout the EU via a single application, and this at a time when the majority of Hague filings were made from and for European countries. Although the EU became a 1999 Act Member in January 2008, this failed to spark filings as much as had been expected, because by that time users across Europe had long forgotten about the Hague system. It’s not until late 2009 that WIPO engaged into targeted promotion in the EU. The forecast for 2010 thus far is an increase of about 30% in filings. However, the potential for increased market share within the EU remains high.

#### 1.3.1 Marketing the Hague—background

27. About 65% of the 7,728 holders of active registrations on December 31, 2009 only had a single international registration in their name. Those that had more than 10 represented some 4.1% of all holders and had a combined portfolio of 20,63% of all registrations in force. These figures would suggest that, although some large companies are known to use the system, it’s mostly individuals or SMEs that currently do so.

28. Recently, and increasingly so since 2008, WIPO has been disseminating information about the Hague to its users and potential users in the intellectual property community in various forms and via various channels and means, such as:

- a) the Hague portion of the WIPO website which includes:
  - i. Information resources such as the *Information Notices* and the *Guide to the International Registration of Industrial Designs*
  - ii. An Email-alert service, allowing users to subscribe and have Hague information sent to them; this service is linked to the Madrid identical service so that users of the latter system also receive Hague related information
- b) Hague seminars and presentations, offered for attorneys and paralegals via commercial organizers, bar associations, law schools, professional associations and individual applicant companies. Advertising for these events has been done by all of those sources (and via the website) to their members and communities;
- c) Relations/connections with national and regional Patent Offices;
- d) Merchandising—in past years, we have done some Hague-related merchandising, like the current USB keys, which were distributed at seminars and presentations. This is often done in combination with Madrid.

29. Since the end of 2009, WIPO has made some efforts to identify those corporations or IP firms using EU's RCD directly and started reaching out to them to understand the lack of use and provide updated information on the Hague and its benefits. It's hard, however, to assess how much of the 40% increase in filings for the first 9-months of 2010 is attributable to these efforts.

30. In 2010, WIPO also conducted a thorough review of the website of all offices of EU member States and started engaging them into providing information about the availability of the Hague system to their national users. It is expected that this will have some positive impacts as some offices were convinced that the system was not available to their users and were disseminating that erroneous and harmful message.

### **1.3.2 Alternate pricing in Hague—background**

#### *Current fee structure of the Hague system*

31. The fee structure in connection with an international application consists of :

- (i) a basic fee, whose exact amount depends on the number of designs;
- (ii) for each Member designated in the application, either a standard designation fee (level one, two or three, depending on the quality of the examination performed by the Member's office) or an individual designation fee fixed by that Member (reserved for full novelty examination offices). Standard or individual, the amounts depend on the number of designs.
- (iii) a publication fee, for each reproduction to be published plus, if the application is filed on paper, a fee for each page of reproductions beyond the first.
- (iv) if the description exceeds 100 words, a fee per additional word.



32. At the time of renewal (every five years), WIPO receives a renewal basic fee (subject to a 50% surcharge in case of late payment). Standard or individual designation fees are also collected for each Member in respect of which the international registration is renewed. All these depend on the number of designs to be renewed. Furthermore, WIPO charges a fee in respect of miscellaneous recordings, such as change in ownership, change of name/address of the holder, renunciation and limitation.

### **1.3.3 Recent and possible future changes to the fee structure**

33. Since 2008, for applicants from a Least Developed Country (LDC), or linked to an intergovernmental organization the majority of whose member States are LDCs, the fees are reduced to 10% of the prescribed amounts. The concept of 3 different levels of the “standard designation fee” (see item (ii), above) also was introduced in 2008 under political pressure to have a structure that better reflected the actual workload of member offices. In 2008 still, the fee structure was simplified by eliminating the distinction between reproductions to be published in black and white and reproductions to be published in color and introducing a single fee per reproduction. This was welcome.

34. An analysis of the financial impact of the substitution of a flat publication fee per design for the current fee per reproduction is ongoing (at present, an international application contains, in average, five designs and four reproductions per design, i.e. in average, 20 reproductions). Preliminary simulations show that so as to allow WIPO to break even in its revenues, the level at which the flat fee would have to be set would trigger a severe relative increase in the total of fees in respect of 50% of the applications. Reducing the revenues is not an option.

## **1.4. WIPO ARBITRATION AND MEDIATION CENTER**

35. The WIPO Center is an international and neutral dispute resolution provider established in 1994 with its seat in Geneva, and a regional office in Singapore since May 2010. A full presentation of the WIPO Center can be found at [www.wipo.int/amc](http://www.wipo.int/amc).

36. Operating on a not-for-profit basis, the WIPO Center offers time- and cost-effective, balanced and accessible alternative dispute resolution (ADR) procedures for intellectual property and related commercial disputes between private parties. These include mediation, expedited arbitration, arbitration and expert determination, as well as domain name dispute resolution. The WIPO Mediation, Arbitration and Expedited Arbitration Rules were developed by leading experts in dispute resolution and intellectual property in 1994 and updated in 2002, and the WIPO Expert Determination Rules were developed in 2007 (available at [www.wipo.int/freepublications/en/arbitration/446/wipo\\_pub\\_446.pdf](http://www.wipo.int/freepublications/en/arbitration/446/wipo_pub_446.pdf)).

37. The procedures offered by the WIPO Center are widely recognized as particularly appropriate for cases arising out of intellectual property related transactions, in particular technology (e.g., licensing, R&D and distribution) and entertainment (e.g., copyright, production, formats), and can reduce the cost of conducting parallel litigation in several jurisdictions.

38. As an administering institution, the WIPO Center administers disputes under WIPO ADR Rules through an active case management system, which includes assistance in the appointment of mediators and arbitrators, management of fees and deposits, facilitation of case communication, as well as logistical and technical assistance (including hearing rooms, interpretation and secretarial assistance). In particular, parties in WIPO ADR cases can use the WIPO Electronic Case Facility (WIPO ECAF), an electronic online case communication tool ([www.wipo.int/amc/en/ecaf](http://www.wipo.int/amc/en/ecaf)). In order to be able to assist parties in WIPO cases to select mediators, arbitrators and experts for each case, the WIPO Center maintains a database of over 1,500 mediators and arbitrators from over 70 countries, to which further candidates are added.

39. The WIPO Center charges administrative fees for the administration of its ADR procedures. See for example, the Schedules of Fees for WIPO Mediation: <http://www.wipo.int/amc/en/mediation/fees/>, for WIPO Arbitration and Expedited Arbitration: <http://www.wipo.int/amc/en/arbitration/fees/> and for the Uniform Domain Name Dispute Resolution Policy: <http://www.wipo.int/amc/en/domains/fees/index.html>.

40. To date, the WIPO Center has administered over 220 mediation and arbitration cases (most of which have been filed in the last five years), in addition to over 18,000 domain name cases under the Uniform Domain Name Dispute Resolution Policy (UDRP). The WIPO Center's Caseload page provides an overview about the number of cases, subject matter, business areas and parties involved in WIPO mediation and arbitration cases: <http://www.wipo.int/amc/en/center/caseload.html> (see Annex II). The WIPO Center also develops tailored dispute resolution schemes adapted to the particular needs of specific sectors in collaboration with associations and other entities that face recurrent disputes, such as the Uniform Domain Name Dispute Resolution Policy (see [www.wipo.int/amc/en/domains](http://www.wipo.int/amc/en/domains)), WIPO Expedited Arbitration for AGICOA (see [www.wipo.int/amc/en/arbitration/agicoa](http://www.wipo.int/amc/en/arbitration/agicoa)), and WIPO Mediation and Expedited Arbitration for Film and Media, (see [www.wipo.int/amc/en/film](http://www.wipo.int/amc/en/film)).

41.. In addition, the WIPO Center also acts as a resource center and thereby raises awareness about the role of ADR in different industry and business sectors. It provides procedural guidance to interested parties and entities, as well as ADR-related capacity building and technical assistance.

42. A particular challenge relating to the WIPO Center is the strong competition from other ADR Providers, in many cases well established and often with captive national markets (e.g., International Chamber of Commerce, National Arbitration Forum, American Arbitration Association, Czech Court of Arbitration, Swiss Chambers of Commerce). Although not specialized in intellectual property, many institutions administer intellectual property disputes.

#### **1.4.1 Marketing the WIPO Center – background**

43. The users of the WIPO Center's services are:

- large corporations
- small and medium sized enterprises (SMEs)
- collecting societies
- universities

- individuals, such as inventors, artists and producers

44. In terms of marketing methods used so far, the WIPO Center has disseminated information about its ADR services to existing and potential users of WIPO ADR in different intellectual property related sectors, through different means:

- a) Developing and distributing WIPO Center information materials and guides in different languages, including:
  - on the WIPO Center's website;
  - through WIPO Center publications and procedural guides (such as the WIPO Mediation and Arbitration Guides);
  - contributions to general WIPO publications;
  - responding to queries relating to specific disputes and providing guidance on WIPO ADR clauses, submission to WIPO ADR procedures and domain name disputes (e.g. [arbiter.mail@wipo.int](mailto:arbiter.mail@wipo.int));
  - mailings, e-mailings and subscriptions to news updates;
  - external publications on intellectual property and ADR and participation in external surveys;
- b) WIPO ADR training, including:
  - annual workshops on mediation, arbitration and domain name dispute resolution;
  - sector-specific training programs (e.g., Workshops on ADR in Research and Development (R&D) Collaborations, IT, Telecom);
- c) WIPO Center presentations and seminars at conferences organized by intellectual property associations, commercial organizers, bar associations, law schools, corporate visits including through electronic means (e.g. webinars and videoconferencing), by selected WIPO Neutrals, in collaboration with other WIPO Divisions and Regional Offices and national Intellectual Property Offices.

45. In order to further identify the specific dispute resolution needs in technology transactions, the WIPO Center is currently undertaking an "International Survey on Dispute Resolution in Technology Transactions" in collaboration with such associations as LES, AIPPI and AUTM. This Survey should contribute to gaining more precise statistical data on dispute resolution of technology disputes and help inform the WIPO Center's provision of ADR services.

46. Based on the feedback on the experience of existing users of WIPO ADR services and the response to the WIPO Center's Survey mentioned above, the WIPO Center aims to:

- generate further guidance to potential users, as well as statistics and improved related databases and tools;
- identify new intellectual property related sectors and their specific ADR needs;
- address specific ADR needs of stakeholders in Asia and other growth regions, in particular with the assistance of the WIPO Center's new office in Singapore;
- strengthen the joint promotion of the different "WIPO Services".

### **1.4.2 Alternate pricing of Center services**

47. In terms of fees, there is a constant need to respond to market realities, varying amounts in dispute in different intellectual property sectors, and competition from other ADR providers. In that light, the WIPO Center provides reduced Schedules of Fees for different WIPO ADR user groups and certain sectors (e.g., Format Recognition and Protection Association (FRAPA), Association of University Technology Managers (AUTM), WIPO Expedited Arbitration for AGICOA, WIPO Mediation and Expedited Arbitration for Film and Media).

## **2 REQUIREMENTS**

48. WIPO requires experienced marketing and pricing professionals to help it evaluate:

- a) how WIPO can more effectively market its fee-based services (PCT, Madrid, Hague, Arbitration/Mediation);
- b) how WIPO could more effectively price these fee-based services;<sup>2</sup>
- b) how customer orientation could be improved by, for example, assessing potential mismatches between these services and the needs of the customers using these services;
- c) how available data from and about customers (including but not limited to data already held by the WIPO services) could be used to provide better customer service and increase revenues.

49. It is critical to be able to assess the impact of any such efforts.

### **2.1 Deliverables**

50. The successful bidder will be asked to prepare and submit a finalized report with clear recommendations addressing WIPO's requirements as per paragraphs 48 and 49 of this document and reflecting input and comments of WIPO program managers, as appropriate. The details of the report shall be agreed to by WIPO and the successful bidder.

### **2.2 Conditions**

51. The cost of this activity is expected not to exceed 50,000 Swiss francs and the report is expected to be completed and submitted to WIPO during the first quarter of 2011. The specific delivery date shall be agreed to by WIPO and the successful bidder. Bidders are asked to provide an indication of the time they would require to complete the assignment.

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<sup>2</sup>For example, by examining the current fee structures of those services, and analyzing other possible pricing models for upside potential while preserving (and, if possible, enhancing) the existing revenue streams.

52. Subject to WIPO's satisfaction with the results of the work and a continued business need, additional project modules may be envisioned. Areas where WIPO may need additional consulting services may include maximization of the organization's revenue potential, such as generating ideas for new revenue-generating activities and/or services. Bidders are asked to provide information on their experience and ability to carry out assignments in these additional project modules.

## Annex 1

## Largest PCT applicants by number of applications published--2009

2009 Ranking	Applicant's Name	Country of Origin	PCT application published in 2009	Change from 2008
1	PANASONIC CORPORATION	JP	1,891	+162
2	HUAWEI TECHNOLOGIES CO., LTD.	CN	1,847	+110
3	ROBERT BOSCH GMBH	DE	1,586	+313
4	KONINKLIJKE PHILIPS ELECTRONICS N.V.	NL	1,295	-256
5	QUALCOMM INCORPORATED	US	1,280	+373
6	TELEFONAKTIEBOLAGET LM ERICSSON (PUBL)	SE	1,240	+256
7	LG ELECTRONICS INC.	KR	1,090	+98
8	NEC CORPORATION	JP	1,069	+244
9	TOYOTA JIDOSHA KABUSHIKI KAISHA	JP	1,068	-296
10	SHARP KABUSHIKI KAISHA	JP	997	+183
11	SIEMENS AKTIENGESELLSCHAFT	DE	932	-157
12	FUJITSU LIMITED	JP	817	-167
13	BASF SE	DE	739	+18
14	3M INNOVATIVE PROPERTIES COMPANY	US	688	+25
15	NOKIA CORPORATION	FI	663	-342
16	MICROSOFT CORPORATION	US	644	-161
17	SAMSUNG ELECTRONICS CO., LTD.	KR	596	-43
18	NXP B.V.	NL	593	+186
19	mitsubishi electric corporation	JP	569	+66
20	HEWLETT-PACKARD DEVELOPMENT COMPANY, L.P.	US	554	+58
21	MOTOROLA, INC.	US	538	-240
22	E.I. DUPONT DE NEMOURS AND COMPANY	US	509	-8
23	ZTE CORPORATION	CN	502	+173
24	ELECTRONICS AND TELECOMMUNICATIONS RESEARCH INSTITUTE	KR	452	+7
25	SONY ERICSSON MOBILE COMMUNICATIONS AB	SE	435	+33
26	BSH BOSCH UND SIEMENS HAUSGERÄTE GMBH	DE	413	+19
27	CANON KABUSHIKI KAISHA	JP	401	+121
27	INTERNATIONAL BUSINESS MACHINES CORPORATION	US	401	-263
29	BAKER HUGHES INCORPORATED	US	375	+79
30	DAIKIN INDUSTRIES, LTD.	JP	374	+4

31	mitsubishi heavy industries, ltd.	JP	373	+158
32	DAIMLER AG	DE	362	+126
32	KYOCERA CORPORATION	JP	362	+30
34	THOMSON LICENSING	FR	359	-103
35	SUMITOMO CHEMICAL COMPANY, LIMITED	JP	352	+89
36	THE PROCTER & GAMBLE COMPANY	US	341	-71
37	CONTINENTAL AUTOMOTIVE GMBH	DE	334	-98
38	SONY CORPORATION	JP	328	+21
39	KABUSHIKI KAISHA TOSHIBA	JP	326	+113
40	THE REGENTS OF THE UNIVERSITY OF CALIFORNIA	US	321	-26
41	HONDA MOTOR CO., LTD.	JP	318	+125
42	NOKIA SIEMENS NETWORKS OY	FI	313	+245
43	EASTMAN KODAK COMPANY	US	311	+12
44	GENERAL ELECTRIC COMPANY	US	307	-19
44	MONDOBIOTECH LABORATORIES AG	LI	307	+307
46	DOW GLOBAL TECHNOLOGIES INC.	US	304	+19
47	INA-SCHAEFFLER KG	DE	299	-77
48	APPLIED MATERIALS, INC.	US	296	+99
49	CORNING INCORPORATED	US	285	+57
50	ALCATEL LUCENT	FR	283	+71
50	PIONEER CORPORATION	JP	283	-214

**Comparison of PCT, Madrid and Hague filings for 2009:  
Usage of the Madrid and Hague systems by the top 100 PCT users**

STD_APPLT	ORIG	PCT	Madrid	Hague
PANASONIC CORPORATION	JP	1,891		
HUAWEI TECHNOLOGIES CO., LTD.	CN	1,847		
ROBERT BOSCH GMBH	DE	1,582	7	
KONINKLIJKE PHILIPS ELECTRONICS N.V.	NL	1,295	38	33
QUALCOMM INCORPORATED	US	1,279		
TELEFONAKTIEBOLAGET LM ERICSSON (PUBL)	SE	1,239	2	
LG ELECTRONICS INC.	KR	1,090	11	
NEC CORPORATION	JP	1,069		
TOYOTA JIDOSHA KABUSHIKI KAISHA	JP	1,067		
SHARP KABUSHIKI KAISHA	JP	997		
SIEMENS AKTIENGESELLSCHAFT	DE	931	44	
FUJITSU LIMITED	JP	817		

BASF SE	DE	739	30	
3M INNOVATIVE PROPERTIES COMPANY	US	688		
NOKIA CORPORATION	FI	661	16	9
MICROSOFT CORPORATION	US	644	27	
SAMSUNG ELECTRONICS CO., LTD.	KR	596	3	
NXP B.V.	NL	593	6	
mitsubishi electric corporation	JP	569	19	
HEWLETT-PACKARD DEVELOPMENT COMPANY, L.P.	US	554		
MOTOROLA, INC.	US	538		
ZTE CORPORATION	CN	517		
E.I. DUPONT DE NEMOURS AND COMPANY	US	509	14	
ELECTRONICS AND TELECOMMUNICATIONS RESEARCH INSTITUTE	KR	452		
SONY ERICSSON MOBILE COMMUNICATIONS AB	SE	435	10	
BSH BOSCH UND SIEMENS HAUSGERÄTE GMBH	DE	413	7	
CANON KABUSHIKI KAISHA	JP	401	3	
INTERNATIONAL BUSINESS MACHINES CORPORATION	US	401	7	
BAKER HUGHES INCORPORATED	US	375		
DAIKIN INDUSTRIES, LTD.	JP	374		
MITSUBISHI HEAVY INDUSTRIES, LTD.	JP	373		
DAIMLER AG	DE	362	21	20
KYOCERA CORPORATION	JP	362		
THOMSON LICENSING	FR	359		
SUMITOMO CHEMICAL COMPANY, LIMITED	JP	352		
THE PROCTER & GAMBLE COMPANY	US	341	4	108
CONTINENTAL AUTOMOTIVE GMBH	DE	334		
SONY CORPORATION	JP	328	7	
KABUSHIKI KAISHA TOSHIBA	JP	326		
THE REGENTS OF THE UNIVERSITY OF CALIFORNIA	US	320		
HONDA MOTOR CO., LTD.	JP	318		
NOKIA SIEMENS NETWORKS OY	FI	313		
EASTMAN KODAK COMPANY	US	311		
GENERAL ELECTRIC COMPANY	US	307		
MONDOBIOTECH LABORATORIES AG	LI	307		
DOW GLOBAL TECHNOLOGIES INC.	US	303		
INA-SCHAEFFLER KG	DE	299		
APPLIED MATERIALS, INC.	US	296		
CORNING INCORPORATED	US	285		
PIONEER CORPORATION	JP	283		
ALCATEL LUCENT	FR	281		
NIKON CORPORATION	JP	267		
FRAUNHOFER-GESELLSCHAFT ZUR FÖRDERUNG DER ANGEWANDTEN FORSCHUNG E.V.	DE	265		



FUJIFILM CORPORATION	JP	264		
SCHLUMBERGER CANADA LIMITED	CA	264		
HENKEL KGAA	DE	261	98	5
BOSTON SCIENTIFIC SCIMED, INC.	US	256		
MURATA MANUFACTURING CO., LTD.	JP	254		
ZF FRIEDRICHSHAFEN AG	DE	253	30	
RENAULT S.A.S.	FR	252	17	
NTT DOCOMO, INC.	JP	249		
DSM IP ASSETS B.V.	NL	241	39	
COMMISSARIAT A L'ENERGIE ATOMIQUE	FR	238		
MEDTRONIC, INC.	US	236		
PANASONIC ELECTRIC WORKS CO., LTD.	JP	235		
F. HOFFMANN-LA ROCHE AG	CH	225	7	
BRIDGESTONE CORPORATION	JP	223	17	
ILLINOIS TOOL WORKS INC.	US	221		
FRANCE TELECOM	FR	220	6	
NOVARTIS AG	CH	218	136	
KONICA MINOLTA OPTO, INC.	JP	214		
KIMBERLY-CLARK WORLDWIDE, INC.	US	212		
OLYMPUS CORPORATION	JP	212		
OSRAM GESELLSCHAFT MIT BESCHRÄNKTER HAFTUNG	DE	212	19	
LG CHEM, LTD.	KR	210		
PHILIPS INTELLECTUAL PROPERTY & STANDARDS GMBH	DE	202		
ASTRAZENECA AB	SE	195	7	
HONEYWELL INTERNATIONAL INC.	US	193		
NITTO DENKO CORPORATION	JP	192		
HITACHI, LTD.	JP	190	10	
MICRON TECHNOLOGY, INC.	US	182		
FREESCALE SEMICONDUCTOR, INC.	US	181		
NTN CORPORATION	JP	181		
TOKYO ELECTRON LIMITED	JP	181		
CATERPILLAR INC.	US	178		
ASAHI GLASS COMPANY, LIMITED	JP	177		
INTEL CORPORATION	US	176	8	
LUCENT TECHNOLOGIES INC.	US	174		
SHELL INTERNATIONALE RESEARCH MAATSCHAPPIJ B.V.	NL	174		
THE BOEING COMPANY	US	174		
L'OREAL	FR	170	70	
NESTEC S.A.	CH	170		
IDEMITSU KOSAN CO., LTD.	JP	167		
KONICA MINOLTA MEDICAL & GRAPHIC, INC.	JP	161		
GM GLOBAL TECHNOLOGY OPERATIONS, INC.	US	160		

UNILEVER PLC	GB	160	35	14
APPLE COMPUTER, INC.	US	159		