

WIPO



PCT/A/30/7

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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

ASSEMBLY

Thirtieth (13th Ordinary) Session
Geneva, September 24 to October 3, 2001

REPORT

adopted by the Assembly

1. The Assembly was concerned with the following items of the Consolidated Agenda (document A/36/1): 1, 2, 4, 5, 6, 7, 8, 12, 17, 24, 27 and 28.
2. The report on the said items, with the exception of item 17, is contained in the General Report (document A/36/15).
3. The report on item 17 is contained in the present document.
4. Mr. Jørgen Smith (Norway) was elected Chair of the Assembly; Mr. Wang Jingchuan (China) and Mr. Miklós Bendzsel (Hungary) were elected Vice-Chairs.
5. Mr. Jørgen Smith (Norway), presided over the meeting of the Assembly.

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ITEM 17 OF THE CONSOLIDATED AGENDA:

MATTERS CONCERNING THE PCT UNION

Proposed Amendment of the Schedule of Fees Annexed to the Regulations Under the PCT

6. Discussions were based on document PCT/A/30/1.
7. The Delegation of Algeria expressed its support for the proposal and stressed that it would be desirable in the future to move towards a single fee to be paid, irrespective of the number of designations made.
8. The Delegation of the Republic of Korea supported the proposal which, in its view, would contribute to the progressive development of the PCT system and foster broader access to patent protection.
9. The Delegation of Colombia supported the proposal which, in its opinion, would entail substantial benefits for PCT users.
10. The Delegation of Israel supported the proposal, noting that it represented an important step towards PCT reform.
11. The Delegation of France supported the proposal, agreeing with the view expressed by the Delegation of Algeria in favor of a future single fee irrespective of the number of designations, and noting that this would be in line with PCT reform objectives.
12. The Delegation of the Netherlands, while it was not against the proposal, questioned whether it would be wise to reduce PCT fee income when the special reserve fund was becoming depleted. In response, the International Bureau confirmed that the impact of the proposal on the finances of the Organization had been taken into account in the Program and Budget for 2002-2003.
13. The representative of IFIA while supporting the proposal, noted that official fees were not a major expense for applicants compared with patent attorneys' charges. He also favored speedy action towards reducing the designation fee to zero and eliminating the concept of designations.
14. The Assembly unanimously adopted the amendment of the Schedule of Fees as set out in Annex I to this report and decided that it would enter into force on January 1, 2002.

Reform of the Patent Cooperation Treaty

15. Discussions were based on document PCT/A/30/2.
16. The Delegation of Austria recalled that the PCT had a membership of 112 countries as of July this year and noted the importance of reform for customers and Offices. The report of the Committee on Reform of the PCT correctly focused, in the short term, on simplifying and streamlining PCT procedures by way of amendment of the PCT Regulations. The Delegation

stated its strong support for the establishment of a working group that addressed the most obvious and urgent matters required to attain the common goals identified by the Committee.

17. The Delegation of Algeria expressed its satisfaction with what had been accomplished in only one year of the PCT reform process. The Delegation noted that the high number of proposals which had been submitted for consideration by the Committee was an indication of how important the PCT was for both developed and developing countries. There was an enormous need to change the current system and the setting up of a working group was a good initiative. The Delegation stressed that for the system to be more user-friendly, it should ensure a better distribution of tasks among the PCT Authorities and a streamlining of procedures.

18. The Delegation of Ukraine expressed its satisfaction with the work which had already been achieved by the Committee. The Delegation supported the establishment of a working group and agreed with the matters to be referred to it. It emphasized the need to focus on reduction of costs.

19. The Delegation of Colombia supported the procedure proposed by the Committee but did not necessarily agree with all the matters to be considered during the reform process. Enhanced international harmonization under the PCT should be restricted to formal requirements and not cover the grant of substantive rights. The Delegation stressed that reform of the PCT should not digress from its legal framework, that is, relating to the filing of international applications and the establishment of international search and preliminary examination reports, as well as the dissemination of technical information.

20. The Delegation of France agreed that the PCT should be reformed so as to make the system more user-friendly by streamlining procedures. The Delegation noted that the first stage of the reform process should not go beyond the agreed mandate. The Delegation recalled that the Assembly, at its session in September 2000, had agreed that the second stage of the reform process would begin only upon harmonization of the substantive law of patents.

21. The Delegation of Slovakia stated that it fully supported the process of PCT reform and the Committee's recommendations concerning the establishment of a working group as well as the matters to be referred to it. The Delegation stressed the need to conform PCT requirements to those in the Patent Law Treaty, in particular with regard to filing date requirements.

22. The representative of FICPI recognized that the backlog which International Authorities were currently facing needed to be addressed, but believed that the current timeframe for the establishment and publication of international search reports should not be revised. There were other means to address the current situation, such as appointing more International Searching and Preliminary Examining Authorities as well as sub-contracting international search and preliminary examination work to Offices of other PCT Contracting States, which did not act in such capacities, but that did, or could have, the necessary resources to perform these tasks.

23. The Assembly

(i) took note of the report of the first session of the Committee on Reform of the PCT contained in document PCT/R/1/26, and

(ii) unanimously approved the Committee's recommendations concerning the establishment of a working group, the matters to be referred to the working group, and the work program of the Committee and the working group between the September 2001 and September 2002 sessions of the Assembly, as set out, respectively, in paragraphs 67 and 68, 69 to 75, and 205 of the Committee's report.

IMPACT Project and PCT Electronic Filing Project Status Reports

24. Discussions were based on document PCT/A/30/3.

25. The Delegation of Mexico stated that it was very pleased to see the progress on both projects, noting especially the importance of the electronic filing project to the Mexican Institute of Industrial Property. The Delegation also noted that the electronic filing project represented the first step of what the International Bureau had promised to developing countries during the negotiation of the Patent Law Treaty so as to allow them to be ready to handle electronic filings by 2005.

26. The Delegation of Cuba thanked the International Bureau for the progress on these projects, and noted, in particular, that access to information was very important for developing countries. It hoped that such progress would continue in the future.

27. The Delegation of Israel noted that the Israel Patent Office attached great importance to its membership in the IMPACT External User Focus Group. The Delegation congratulated the International Bureau and the IMPACT Project Team for the excellent work they had carried out in the development of the new system for the electronic communication of PCT-related documents, and noted that this new system met all of its needs and expectations.

28. The Delegation of the Republic of Korea expressed its hope that implementation of the IMPACT Project would take place as planned.

29. The Assembly took note of the progress reports on the IMPACT Project and the PCT Electronic Filing Project contained in document PCT/A/30/3.

Proposed Modifications of Time Limits Fixed in Article 22(1) of the PCT

30. Discussions were based on documents PCT/A/30/4 and PCT/A/30/4 Add.

31. The Delegation of Brazil, while stating that it was not opposed to the proposal, emphasized that the quality of PCT search and examination results needed to be improved. One had to consider the implications of the proposal on developing countries like Brazil which were making considerable efforts to reduce their backlog in examination of patent applications and to provide improved services to users. The Delegation was concerned that, while the proposal would resolve, in the short term, the problem faced by International Preliminary Examining Authorities, it might cause other problems for countries like Brazil which relied heavily on international preliminary examination reports. Further consideration would be needed if the current growth rate in PCT filings were to continue. The Delegation was also concerned about the effect of the delayed issuance of those reports. In particular, the proposal would have the effect of extending the period of legal uncertainty in respect of third parties and could prevent investors from making decisions until they received the results of substantive national examination. Even though many PCT applicants made use of

international preliminary examination only in order to “buy time,” many others used international preliminary examination reports as a basis for deciding whether and where to enter the national phase. One result of the proposed amendment might be an increase in the number of applications which entered the national phase without international preliminary examination reports, which would result in national Offices having to bear the full burden of examination as to patentability.

32. The Delegation of Mexico expressed its support for the proposal since it was necessary to maintain and even improve the quality of international preliminary examination reports which were an essential element of the Mexican patent system. The Delegation stated that the proposal represented a first step towards definitive reform of the PCT system.

33. The Delegation of Algeria supported the proposal, stating that it would benefit small and medium-sized enterprises, especially those in developing countries, since it would give them more time to decide whether or not to enter the national phase.

34. The Delegation of India, speaking on behalf of the Asian Group, expressed support for the proposal, but noted that the implications for developing countries and small Offices had to be understood and that such Offices would in all likelihood need appropriate supplemental assistance under WIPO’s program and budget.

35. The Delegation of Bulgaria, speaking on behalf of the Central European and Baltic States, expressed full support for the proposal, not only because it contained advantages for all users but also in the light of the proposed transitional measures.

36. The Delegation of Venezuela, speaking on behalf of the PCT Contracting States which are members of the Group of Latin American and Caribbean Countries, expressed its gratitude for the willingness of the International Bureau to provide additional information concerning the possible impact of the proposal on the countries in the region. The Group, while supporting the proposal, wished to emphasize the following points: first, this type of change should not constitute a precedent; second, the decision to adopt the proposal should not prejudice the ongoing PCT reform process; and third, possible repercussions of the proposal on small Offices should be carefully considered, bearing in mind that it was difficult to assess the long term effects.

37. The Delegation of Azerbaijan, speaking on behalf of the Central Asian, Caucasus and Eastern European Countries, supported the proposal.

38. The Delegation of Switzerland stated that, in view of the current situation, any measure aimed at reducing the workload of International Authorities should be welcomed. The Delegation strongly supported the proposal and considered it an urgent measure intended to improve the operation of the PCT. While recognizing the necessity to have a wide-ranging discussion on improvements in the PCT system, the Delegation noted that a short-term solution was by all means necessary. The Delegation noted that the envisaged reform could lead to a decrease in the number of international preliminary examination reports by about 30%, but that should not be a drawback for national Offices. Finally, the Delegation added that the proposal would not reduce transparency and legal certainty for third parties, noting that the time limit for the publication of international search reports had not been modified.

39. The Delegation of France agreed with the views of the Delegation of Switzerland and added that the current exercise was in fact bringing the law into conformity with users’

practice. The proposal would not affect the right of applicants to enter the national phase before the end of the 30-month period. This measure was probably not sufficient to alleviate the current situation, but other solutions could be examined by the working group on reform of the PCT. In any case, new technologies should be increasingly used in the establishment of international preliminary examination reports and their communication to applicants.

40. Speaking on behalf of Group B, the Delegation of France recalled that Group B had already pledged its support for the proposal to modify the time limits fixed in Article 22(1) of the PCT in a statement made earlier under another agenda item.

41. The Delegation of Saint Lucia, speaking also on behalf of the Delegation of Antigua and Barbuda, expressed its sympathy for the views of the Delegation of Brazil and stated that it could support the proposal under the conditions expressed by the Delegation of Venezuela on behalf of the Group of Latin American and Caribbean Countries. The Delegation stressed the need to take into account the particular situation of countries, such as Saint Lucia and Antigua and Barbuda, which did not have the technical means to assess the implications of such a modification of time limits, noting also that recently adopted patent legislation provided for reliance on international preliminary examination reports.

42. The Delegation of Slovakia supported the proposal, noting that the fact that most Slovak applicants chose the Chapter II procedure was a sign that the time limit of 30 months had proven to be more user-friendly than the time limit of 20 months.

43. The representative of the EAPO welcomed the proposal, which would benefit both applicants and International Authorities.

44. The representative of the EPO expressed the EPO's gratitude to the delegations which had expressed support for the proposal. He noted that the applicable time limit for entry into the regional phase before the EPO had already been amended to 31 months from the priority date in all cases (Rule 107 of the Regulations under the European Patent Convention). He emphasized that the true benefit of that amendment could only be achieved through a concerted approach by all Contracting States. In view of the increasing number of filings under the PCT and the rising backlog in Offices, it had become essential that resources of Offices be used optimally. Those applicants who were only interested in "buying time" should not have to comply with the formal requirement of requesting international preliminary examination, and international preliminary examination reports should be established only for those applicants who were truly interested in obtaining them. International search reports, which were at the very heart of the PCT procedure, were of interest to all applicants and therefore had to retain their present quality. With respect to some of the concerns voiced by delegations, the representative of the EPO emphasized three main points. First, many applications did not enter the national phase under PCT Chapter II or, if they did, no amendments were made to the applications in light of the comments contained in the international preliminary examination reports, so that the work done by International Preliminary Examining Authorities was of no benefit in terms of further prosecution of those applications. Second, in respect of those applications which did enter the national phase, not all elected Offices were in a position to readily distinguish between those cases in which the applicant had shown a genuine interest and those where the applicant had merely wanted to "buy time." The result of the proposal, in this connection, would be that elected Offices could be confident that, where international preliminary examination reports were made available, they would be "quality products." Third, the representative recalled that, within the context of PCT reform, there were a number of interesting suggestions which could bring about

significant improvements in the processing of international applications, such as an enhanced international search report which would include an opinion on patentability.

45. The representative of IFIA expressed support for the proposal, which would benefit applicants, especially independent inventors and small and medium-sized enterprises, by providing a *de facto* 30-month priority period. He praised the expeditious manner in which the proposal had been tabled and considered, and asked that similar expeditious treatment be given in the future to reductions of PCT fees for independent inventors and small and medium-sized enterprises.

46. The representative of FICPI queried whether the proposal was in the best interest of the public. The representative noted, however, that some Offices had already unilaterally extended the time limit under Article 22(3), with the effect that users would have to deal with different time limits for different Offices, thereby adding greater complexity and confusion with the risk of errors being made by applicants. The representative observed that it was important that the applicable time limit under Article 22 be harmonized amongst all national and regional Offices.

47. The representative of AIPPI expressed full support for the proposal.

48. The Director General confirmed that all concerns expressed during the discussion were noted and fully understood, and that they would be taken into account in the context of PCT reform as well as in the framework of WIPO's Cooperation for Development Program.

49. The Assembly

(i) unanimously adopted the modifications of the time limits fixed in Article 22(1) of the PCT as set out in Annex II to this report and the amendments of Rule 90*bis* as set out in Annex III to this report, and

(ii) unanimously adopted the decisions, as set out in Annex IV to this report, relating to entry into force and transitional arrangements in respect of those provisions.

Appointment of the Spanish Patent and Trademark Office as an International Preliminary Examining Authority; Amendment of the Agreement Between the Spanish Patent and Trademark Office and the International Bureau of WIPO

50. Discussions were based on document PCT/A/30/5.

51. The Delegations of Algeria, Brazil, Equatorial Guinea, Colombia, Sudan, Romania, Costa Rica, China and Sweden supported the appointment of the Spanish Patent and Trademark Office as an International Preliminary Examining Authority.

52. The Delegation of Croatia supported the appointment of the Spanish Patent and Trademark Office as an International Preliminary Examining Authority. It also noted that the national law of Croatia had recently been modified to allow for the granting of patents by their Office based on the decisions of other Offices; to this end, the Office had concluded agreements with several other Offices, namely, those of Austria, Australia, Japan, China, the Russian Federation, Germany and Sweden, and would conclude further agreements with other Offices in the near future.

53. The Delegation of Ukraine expressed its support for the appointment of the Spanish Patent and Trademark Office as an International Preliminary Examining Authority and praised the Office for the excellent work it had performed over the last years as an International Searching Authority.
54. The Delegation of the Netherlands, referring to PCT Articles 16(3)(c) and (e) and 32(3), queried whether the advice of the PCT Committee for Technical Cooperation had been sought prior to the appointment of the Spanish Patent and Trademark Office as an International Preliminary Examining Authority. The International Bureau replied that, in 1986, when the United States Patent and Trademark Office, already an International Searching Authority, was appointed as an International Preliminary Examining Authority, the same questions had arisen, and the Assembly had concluded that it was not necessary, before making the proposed appointment, to seek the advice of the PCT Committee for Technical Cooperation (see document PCT/A/XIV/3). This was because such advice had been sought in connection with the appointment of the United States Patent and Trademark Office as an International Searching Authority. The International Bureau believed that the same procedure should be followed in the present instance since the situation was the same.
55. The Delegation of Azerbaijan supported the appointment of the Spanish Patent and Trademark Office as an International Preliminary Examining Authority. In reply to a question raised by that Delegation on the differences in the amounts of certain fees charged by International Preliminary Examining Authorities, the International Bureau pointed out that, under the PCT, the amounts of the fees contained in Annexes C of the Agreements were fixed unilaterally by the Authorities concerned.
56. The Delegation of the Republic of Korea supported the appointment of the Spanish Patent and Trademark Office as an International Preliminary Examining Authority, stressing the importance of this appointment for Spanish-speaking applicants and expressing its hope that it would also significantly reduce the workload of the European Patent Office as International Preliminary Examining Authority.
57. The Delegation of Ecuador welcomed the appointment of the Spanish Patent and Trademark Office as an International Preliminary Examining Authority and referred to its close linguistic and cultural ties to Spain.
58. The Delegation of Cuba expressed full support for the appointment of the Spanish Patent and Trademark Office as an International Preliminary Examining Authority and emphasized the importance of this decision for Spanish-speaking countries.
59. The Delegation of Mexico expressed full support for the appointment of the Spanish Patent and Trademark Office as an International Preliminary Examining Authority, praising the Office for its excellent work and noting the importance of this decision for the whole PCT system. The Delegation referred to the tight links in the field of technical cooperation between the Mexican Institute of Industrial Property and the Spanish Patent and Trademark Office and stressed the relevance of the appointment of the Spanish Patent and Trademark Office as an International Preliminary Examining Authority for Latin American countries.
60. The Delegation of Morocco expressed full support for the appointment of the Spanish Patent and Trademark Office as an International Preliminary Examining Authority, noting the close ties between the Moroccan and Spanish Offices based on a cooperation agreement.

61. The Director General informed the Assembly that the Spanish Patent and Trademark Office had been implementing a project on technical cooperation with Latin American countries, focusing on patent procedures, especially those concerning the PCT. This initiative was presented in the framework of the 9th Iberoamerican Summit of Heads of States and Presidents of Governments, held in 1999 in Havana. The Director General noted the Spanish Patent and Trademark Office's initiative which funded on-the-job training programs for patent examiners from Spanish-speaking Latin American countries, with an overall objective of promoting and improving use of the PCT system. The project encompassed training programs covering receiving Office functions, international search and the roles of designated and elected Offices under the PCT. It was expected that the project would include training on procedures relating to international preliminary examination once the Spanish Patent and Trademark Office became an International Preliminary Examining Authority. The Director General cited this initiative as an example of fruitful cooperation, stating that it contributed positively to better use of the PCT, industrial property in general and development of human resources.

62. The Delegation of Spain thanked the Assembly for its support. The Delegation noted that the Spanish Patent and Trademark Office had acted as an International Searching Authority since 1993, which benefited not only the Iberoamerican States party to the PCT but also the PCT system in general. The Delegation referred to the cooperation agreement on international search between the European Patent Office, the Swedish Patent Office and the Spanish Patent and Trademark Office. The Delegation stated that the experience acquired by the Spanish Patent and Trademark Office, both as an International Searching Authority and, since the introduction of national examination, in the national granting procedure, qualified the Office to obtain the status of an International Preliminary Examining Authority.

63. The Assembly

(i) unanimously appointed the Spanish Patent and Trademark Office as International Preliminary Examining Authority, with effect as indicated in paragraph 4 of document PCT/A/30/5, and

(ii) unanimously approved the text of the amended Agreement between the Spanish Patent and Trademark Office and the International Bureau, as set out in Annex V to this report.

Amendment of the Agreement Between the European Patent Organisation and the International Bureau of WIPO Relating to the Functioning of the European Patent Office as an International Searching and Preliminary Examining Authority under the PCT

64. Discussions were based on document PCT/A/30/6.

65. The representative of the EPO referred to the fact that the universal competence of the EPO as an International Searching and Preliminary Examining Authority had significantly contributed to the great success of the PCT, with however the consequence that the EPO was now performing an increasingly disproportionate share of international searches and preliminary examinations (61% and 58%, respectively, in 2000). Taking into account the minimum of 10% annual growth rate in filings experienced over several years, and even 23% in 2000, the expected continued strain on the EPO could easily be understood, as well as the

effect such growth rates had on the ability of the EPO to cope with its obligation of ensuring timely processing of patent applications under the European Patent Convention and granting of European patents. On the latter point, the EPO faced growing criticism from applicants in respect of Euro-direct applications, more than 50% of which originated from outside Europe, noting the strict time limits provided under the PCT for performing search and preliminary examination work. The EPO was therefore proposing a modest change to the Agreement which would allow it to restrict its competence as an International Searching and Preliminary Examining Authority for a limited period: (i) to applicants from Contracting States of the European Patent Convention and to applicants from States whose national Offices did not act as an International Searching and Preliminary Examining Authority, or (ii) in respect of certain technical fields, or (iii) in respect of the number of international applications concerned. The representative of the EPO confirmed that the proposed amendment to the Agreement would not affect the current situation with regard to those applicants whose national Offices did not act as International Searching and Preliminary Examining Authorities; indeed, the EPO would continue to act for those applicants.

66. The Delegation of Algeria supported the proposed amendment and expressed its understanding for the EPO's concerns, noting that applicants were suffering from the workload situation and the consequential delays in issuance of reports. Furthermore, with delayed reports, applicants were also at a disadvantage in the context of registration systems, such as in Algeria. Other solutions could be found in the framework of PCT reform. The Delegation expressed the hope that the EPO would in the future be in a position to return to its universal competence.

67. The Assembly unanimously approved the text of the amended Agreement between the European Patent Organisation and the International Bureau, as set out in Annex VI to this report.

[Annexes follow]

ANNEX I

AMENDMENT OF
THE REGULATIONS UNDER THE PCTSCHEDULE OF FEES
(with effect from January 1, 2002)

Fees	Amounts
1. Basic Fee: (Rule 15.2(a))	
(a) if the international application contains not more than 30 sheets	650 Swiss francs
(b) if the international application contains more than 30 sheets	650 Swiss francs plus 15 Swiss francs for each sheet in excess of 30 sheets
2. Designation Fee: (Rule 15.2(a))	
(a) for designations made under Rule 4.9(a)	140 Swiss francs per designation, provided that any designation made under Rule 4.9(a) in excess of 5 shall not require the payment of a designation fee
(b) for designations made under Rule 4.9(b) and confirmed under Rule 4.9(c)	140 Swiss francs per designation
3. Handling Fee: (Rule 57.2(a))	233 Swiss francs

Reductions

4. The total amount of the fees payable under items 1 and 2(a) is reduced by 200 Swiss francs if the international application is, in accordance with and to the extent provided for in the Administrative Instructions, filed on paper together with a copy thereof in electronic form.
5. All fees payable (where applicable, as reduced under item 4) are reduced by 75% for international applications filed by any applicant who is a natural person and who is a national of and resides in a State whose per capita national income is below US\$3,000 (according to the average per capita national income figures used by the United Nations for determining its scale of assessments for the contributions payable for the years 1995, 1996 and 1997); if there are several applicants, each must satisfy those criteria.

[Annex II follows]

ANNEX II

MODIFICATIONS OF ARTICLE 22
OF THE PCT

Article 22
Copy, Translation, and Fee, to Designated Offices

(1) The applicant shall furnish a copy of the international application (unless the communication provided for in Article 20 has already taken place) and a translation thereof (as prescribed), and pay the national fee (if any), to each designated Office not later than at the expiration of 30 months from the priority date. Where the national law of the designated State requires the indication of the name of and other prescribed data concerning the inventor but allows that these indications be furnished at a time later than that of the filing of a national application, the applicant shall, unless they were contained in the request, furnish the said indications to the national Office of or acting for the State not later than at the expiration of 30 months from the priority date.

(2) Where the International Searching Authority makes a declaration, under Article 17(2)(a), that no international search report will be established, the time limit for performing the acts referred to in paragraph (1) of this Article shall be the same as that provided for in paragraph (1).

(3) Any national law may, for performing the acts referred to in paragraphs (1) or (2), fix time limits which expire later than the time limit provided for in those paragraphs.

[Annex III follows]

AMENDMENTS OF RULE 90bis
OF THE REGULATIONS UNDER THE PCT

Rule 90bis
Withdrawals

90bis.1 Withdrawal of the International Application

(a) The applicant may withdraw the international application at any time prior to the expiration of 30 months from the priority date.

(b) and (c) [No change]

90bis.2 Withdrawal of Designations

(a) The applicant may withdraw the designation of any designated State at any time prior to the expiration of 30 months from the priority date. Withdrawal of the designation of a State which has been elected shall entail withdrawal of the corresponding election under Rule 90bis.4.

(b) to (e) [No change]

90bis.3 Withdrawal of Priority Claims

(a) The applicant may withdraw a priority claim, made in the international application under Article 8(1), at any time prior to the expiration of 30 months from the priority date.

(b) to (e) [No change]

90bis.4 to 90bis.7 [No change]

[Annex IV follows]

ANNEX IV

DECISIONS RELATING TO ENTRY INTO FORCE
AND TRANSITIONAL ARRANGEMENTS

(1) The modifications of the time limits fixed in Article 22(1) set out in Annex II shall, subject to paragraphs (2) and (3), enter into force on April 1, 2002. The modifications shall apply, so far as any designated Office is concerned, to any international application in respect of which the period of 20 months from the priority date expires on or after the date on which the modifications enter into force in respect of that Office and in respect of which the acts referred to in Article 22(1) have not yet been performed by the applicant.

(2) If, on October 3, 2001, any such modification is not compatible with the national law applied by a designated Office, it shall not apply in respect of that Office for as long as it continues not to be compatible with that law, provided that the said Office notifies the International Bureau accordingly by January 31, 2002. The notification shall be promptly published by the International Bureau in the Gazette.

(3) Any notification sent to the International Bureau under paragraph (2) may be withdrawn at any time. Such withdrawal shall be promptly published by the International Bureau in the Gazette and the modifications shall enter into force two months after the date of such publication or on such earlier or later date as may be indicated in the notice of withdrawal.

(4) It is recommended that any Contracting State whose national law is not compatible with the modifications take urgent action to amend its law to make it compatible so that a notification does not have to be given under paragraph (2) or, if such a notification must be given, so that it can be withdrawn under paragraph (3) as soon as possible thereafter.

(5) The amendments of Rule 90*bis* set out in Annex III shall enter into force on April 1, 2002.

[Annex V follows]

ANNEX V

AMENDED AGREEMENT
BETWEEN THE SPANISH PATENT AND TRADEMARK OFFICE
AND THE INTERNATIONAL BUREAU OF
THE WORLD INTELLECTUAL PROPERTY ORGANIZATION

in relation to the functioning of the Spanish Patent and Trademark Office
as an International Searching Authority and
International Preliminary Examining Authority
under the Patent Cooperation Treaty

Preamble

The Spanish Patent and Trademark Office and the International Bureau of the World Intellectual Property Organization,

Considering that the Agreement of October 1, 1997, under Article 16(3)(b) of the Patent Cooperation Treaty in relation to the functioning of the Spanish Patent and Trademark Office as an International Searching Authority under the Patent Cooperation Treaty entered into force on January 1, 1998, and will remain in force until December 31, 2007,

Considering Article 32(3) of the Patent Cooperation Treaty in relation to the functioning of national Offices and intergovernmental organizations as International Preliminary Examining Authorities under the Patent Cooperation Treaty,

Desirous to continue the functioning of the Spanish Patent and Trademark Office as an International Searching Authority and to start its functioning as an International Preliminary Examining Authority, under the Patent Cooperation Treaty,

Hereby agree as follows:

Article 1
Terms and Expressions

- (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) "the Authority" means the Spanish Patent and Trademark Office;
 - (h) "the International Bureau" means the International Bureau of the World Intellectual Property Organization.

(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 Authority 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 apply and observe all the common rules of international search and of international preliminary examination and, in particular, shall be guided by the PCT Search Guidelines and the PCT Preliminary Examination Guidelines.

(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 considered to be appropriate by both the Authority and the International Bureau, mutual assistance in the performance of their functions thereunder.

Article 3

Competence of Authority

(1) The Authority shall act as International Searching Authority for any international application filed with the receiving Office of, or acting for, any Contracting State provided that the receiving Office specifies the Authority for that purpose, that such application, or a translation thereof furnished for the purposes of international search, is in the language or one of the languages specified in Annex A to this Agreement and, where applicable, that the Authority has been chosen by the applicant.

(2) The Authority shall act as International Preliminary Examining Authority for any international application filed with the receiving Office of, or acting for, any Contracting State provided that the receiving Office specifies the Authority for that purpose, that such application, or a translation thereof furnished for the purposes of international preliminary examination, is in the language or one of the languages specified in Annex A to this Agreement, that, where applicable, the Authority has been chosen by the applicant, and that any other requirements regarding such application as specified in Annex A to this Agreement have been met.

(3) Where an international application is filed with the International Bureau as receiving Office under Rule 19.1(a)(iii), paragraphs (1) and (2) apply as if that application had been filed with a receiving Office which would have been competent under Rule 19.1(a)(i) or (ii), (b) or (c) or Rule 19.2(i).

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 examine, by virtue of Article 34(4)(a)(i), any international application to the extent that it considers that such application relates to subject matter set forth in Rule 39.1 or 67.1, as the case may be, with the exception of the subject matter specified in Annex B to 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 Authority and International Preliminary Examining Authority, is set out in Annex C to this Agreement.

(2) The Authority shall, under the conditions and to the extent set out in Annex C to this Agreement:

- (i) refund the whole or part of the search fee paid, or waive or reduce the search fee, where the 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);
- (ii) refund the search fee 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 to 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 or one of the languages indicated, having regard to the language or languages indicated in Annex A and to the language or languages whose use is authorized by the Authority under Rule 92.2(b), in Annex D.

Article 8 International-Type Search

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

Article 9 Entry into Force

This Agreement, as amended, shall enter into force one month after the date on which the Authority notifies the Director General of the World Intellectual Property Organization that it is ready to start functioning as an International Preliminary Examining Authority.

Article 10 Duration and Renewability

This Agreement shall remain in force until December 31, 2007. The parties to this Agreement shall, no later than January 2007, 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 to 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 a notification to the Director General of the World Intellectual Property Organization:

- (i) add to the indications of languages contained in Annex A to this Agreement;
- (ii) amend the schedule of fees and charges contained in Annex C to this Agreement;
- (iii) amend the indications of languages of correspondence contained in Annex D to this Agreement.

(4) Any amendment notified under paragraph (3) shall take effect on the date specified in the notification, provided that, for any increase of fees or 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

(1) This Agreement shall terminate before December 31, 2007:

- (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 third day of October 2001, in two originals in the English and Spanish languages, each text being equally authentic.

For the Spanish Patent and
Trademark Office by:

For the International Bureau by:

José López Calvo
Director General
Spanish Patent and Trademark Office

Kamil Idris
Director General
World Intellectual Property Organization

**Annex A
Languages**

Under Article 3 of the Agreement, the Authority specifies the following language:

Spanish.

**Annex B
Subject Matter Not Excluded from Search or Examination**

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

all subject matter searched or examined in Spanish national applications.

**Annex C
Fees and Charges**

Part I. Schedule of Fees and Charges

Kind of fee or charge	Amount (Spanish pesetas)	Amount (Euros)
Search fee (Rule 16.1(a))	157,235 ¹	945 ¹
Additional fee (Rule 40.2(a))	157,235 ¹	945 ¹
Preliminary examination fee (Rule 58.1(b))	78,860	473.96
Additional fee (Rule 68.3(a))	78,860	473.96
Cost of copies (Rules 44.3(b) and 71.2(b))		
– national documents, per document	610	3.67
– foreign documents, per document	859	5.16
Cost of copies (Rule 94.2) per document	37	0.22

Part II. Conditions for and Extent of Refunds or Reductions of Fees

(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 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, 25%, 50%, 75% or 100% of the search fee paid shall be refunded, depending upon the extent to which the Authority benefits from that earlier search.

¹ This fee is reduced by 75% where the applicant or, if there are two or more applicants, each applicant is a natural person and is a national of and resides in a State not party to the European Patent Convention, which fulfils the requirements for the corresponding reduction of certain PCT fees as specified in the Schedule of Fees annexed to the PCT Regulations (see also corresponding footnote to the Annex C(IB) and *PCT Gazette* No. 50/1995, pages 19233 and 19234), and in accordance with the decision of the EPO's Administrative Council of October 11, 2000 (OJ EPO 2000, 446).

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

(5) When 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 D
Languages of Correspondence

Under Article 7 of the Agreement, the Authority specifies the following language:

Spanish.

[Annex VI follows]

ANNEX VI

AMENDED AGREEMENT
BETWEEN THE EUROPEAN PATENT ORGANISATION
AND THE INTERNATIONAL BUREAU OF
THE WORLD INTELLECTUAL PROPERTY ORGANIZATION

in relation to the functioning of the European Patent Office
as an International Searching Authority and
International Preliminary Examining Authority
under the Patent Cooperation Treaty

Preamble

The European Patent Organisation and the International Bureau of the World Intellectual Property Organization,

Considering that the Agreement of October 1, 1997, under Articles 16(3)(b) and 32(3) of the Patent Cooperation Treaty, as well as Articles 154 and 155 of the European Patent Convention, in relation to the functioning of the European Patent Office as an International Searching Authority and International Preliminary Examining Authority under the Patent Cooperation Treaty was concluded for a period of 10 years from January 1, 1998, to December 31, 2007,

Desirous to continue the functioning of the European Patent Office as an International Searching Authority and International Preliminary Examining Authority under the Patent Cooperation Treaty,

Hereby agree as follows:

Article 1
Terms and Expressions

- (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) "the Authority" means the European Patent Office;
 - (h) "the International Bureau" means the International Bureau of the World Intellectual Property Organization;
 - (i) "Convention" means the Convention on the Grant of European Patents (European Patent Convention).

- (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 Authority 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 apply and observe all the common rules of international search and of international preliminary examination and, in particular, shall be guided by the PCT Search Guidelines and the PCT Preliminary Examination Guidelines.

(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 considered to be appropriate by both the Authority and the International Bureau, mutual assistance in the performance of their functions thereunder.

Article 3 **Competence of Authority**

(1) The Authority shall act as International Searching Authority for any international application filed with the receiving Office of, or acting for, any Contracting State, provided that the receiving Office specifies the Authority for that purpose, that such application, or a translation thereof furnished for the purposes of international search, is in the language or one of the languages specified in Annex A to this Agreement and, where applicable, that the Authority has been chosen by the applicant.

(2) The Authority shall act as International Preliminary Examining Authority for any international application filed with the receiving Office of, or acting for, any Contracting State, provided that the receiving Office specifies the Authority for that purpose, that, for such application, the international search is or has been performed by the Authority or the industrial property Office of a State party to the Convention and, where applicable, that the Authority has been chosen by the applicant.

(3) Where an international application is filed with the International Bureau as receiving Office under Rule 19.1(a)(iii), paragraphs (1) and (2) apply as if that application had been filed with a receiving Office which would have been competent under Rule 19.1(a)(i) or (ii), (b) or (c) or Rule 19.2(i).

(4)(a) Notwithstanding paragraphs (1) and (2), if the work load of the Authority reaches such a level that, because of its then existing facilities, it cannot perform the tasks assumed by it under this Agreement without risks for its proper functioning under the Convention, the Authority may

(i) entrust any industrial property Office of a State party to the Convention with work in respect of international search or international preliminary examination to be carried out under the responsibility of the Authority;

(ii) notify the International Bureau either that it will not carry out international search or international preliminary examination or both in respect of international applications filed with any receiving Office of or acting for a State whose nationals or residents may choose that Office acting as an International Searching and/or International Preliminary Examining Authority or that it will carry out international search or international preliminary examination or both in respect of such international applications but only for a given number of applications each year or only in respect of certain fields of technology.

(b) Any limitation under subparagraph (a)(ii) shall take effect on the date agreed upon between the receiving Office and the Authority and specified in the notification, provided that that date is at least one month later than the date on which the notification is received by the International Bureau. If such a date is not agreed upon by the receiving Office and the Authority, the limitation shall take effect three months from the date of receipt of the notification by the Authority to the International Bureau. The International Bureau shall promptly publish in the Gazette any notification under this subparagraph.

(c) The initial duration of any limitation under subparagraph (a)(ii) shall not exceed a period of three years and may be extended one or more times for a period not exceeding two years provided that notice of three months is given prior to the expiration of the preceding period.

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 examine, by virtue of Article 34(4)(a)(i), any international application to the extent that it considers that such application relates

to subject matter set forth in Rule 39.1 or 67.1, as the case may be, with the exception of the subject matter specified in Annex B to 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 functions as an International Searching Authority and International Preliminary Examining Authority, is set out in Annex C to this Agreement.

(2) The Authority shall, under the conditions and to the extent set out in Annex C to this Agreement:

- (i) refund the whole or part of the search fee paid, or waive or reduce the search fee, where the 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);
- (ii) refund the search fee 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 to 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 or one of the languages indicated, having regard to the language or languages indicated in Annex A and to the language or languages whose use is authorized by the Authority under Rule 92.2(b), in Annex D.

Article 8
International-Type Search

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

Article 9
Entry into Force

This Agreement, as amended, shall enter into force on November 1, 2001.

Article 10
Duration and Renewability

This Agreement shall remain in force until December 31, 2007. The parties to this Agreement shall, no later than January 2007, 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 to this Agreement by agreement between the Director General of the World Intellectual Property Organization and the President of the European Patent Office; they shall take effect on the date agreed upon by them.

(3) The President of the European Patent Office may, by a notification to the Director General of the World Intellectual Property Organization:

- (i) add to the indications of languages contained in Annex A to this Agreement;
- (ii) amend the schedule of fees and charges contained in Annex C to this Agreement;
- (iii) amend the indications of languages of correspondence contained in Annex D to this Agreement.

(4) Any amendment notified under paragraph (3) shall take effect on the date specified in the notification, provided that, for any increase of fees or 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

(1) This Agreement shall terminate before December 31, 2007:

- (i) if the European Patent Organisation 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 European Patent Organisation 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 _____, in two originals in the English, French and German languages, each text being equally authentic.

For the European Patent Organisation by:

For the International Bureau by:

Ingo Kober
President
European Patent Office

Kamil Idris
Director General
World Intellectual Property Organization

**Annex A
Languages**

Under Article 3 of the Agreement, the Authority specifies the following languages:

English, French, German, and, where the receiving Office is the industrial property Office of Belgium or the Netherlands, Dutch.

**Annex B
Subject Matter Not Excluded from Search or Examination**

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

all subject matter searched or examined under the European patent grant procedure in application of the equivalent provisions of the Convention.

**Annex C
Fees and Charges**

Part I. Schedule of Fees and Charges

Kind of fee or charge	Amount (Euro)
Search fee (Rule 16.1(a))	945 ¹
Additional fee (Rule 40.2(a))	945 ¹
Preliminary examination fee (Rule 58.1(b))	1,533 ¹
Additional fee (Rule 68.3(a))	1,533 ¹
Protest fee (Rules 40.2(e) and 68.3(e))	1,022
Cost of copies (Rules 44.3(b), 71.2(b) and 94.1), per page	0.60

Part II. Conditions for and Extent of Refunds or Reductions of Fees

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

(3) Where the Authority benefits from an earlier search (including a privately commissioned “standard” search) already made by the Authority on an application whose priority is claimed for the international application, the following refund of the search fee shall be made:

- (i) no supplementary search performed: refund of 100%;

¹ This fee is reduced by 75% where the applicant or, if there are two or more applicants, each applicant is a natural person and is a national of and resides in a State not party to the European Patent Convention, which fulfils the requirements for the corresponding reduction of certain PCT fees as specified in the Schedule of Fees annexed to the PCT Regulations (see also corresponding footnote to the Annex C(IB) and *PCT Gazette* No. 50/1995, pages 19233 and 19234), and in accordance with the decision of the EPO’s Administrative Council of October 11, 2000 (OJ EPO 2000, 446).

- (ii) supplementary search performed in the documentation relating to one or more subdivisions consulted in the earlier search or extended to one or more subdivisions not yet consulted: refund of 75%;
 - (iii) supplementary search performed in the documentation relating to one or more subdivisions already consulted and extended to one or more subdivisions not yet consulted: refund of 50%;
 - (iv) supplementary search performed in the documentation relating to subdivisions concerning a new aspect of the invention claimed (for instance, cases where the international application is based on several earlier applications only one of which was the subject of an earlier search report): refund of 25%.
- (4) In the cases provided for under Rule 58.3, the amount of the preliminary examination fee paid shall be fully refunded.
- (5) Where the international application or the demand is withdrawn before the start of the international preliminary examination, 75% of the preliminary examination fee paid shall be refunded.

Annex D
Languages of Correspondence

Under Article 7 of the Agreement, the Authority specifies the following languages:

English, French or German, depending on the language in which the international application is filed or translated.

[End of Annex and of document]