

## **International Patent Cooperation Union (PCT Union)**

### **Assembly**

#### **Fifty-Fifth (24<sup>th</sup> Ordinary) Session Geneva, July 6 to 14, 2023**

#### **AMENDMENT OF THE AGREEMENT CONCERNING THE FUNCTIONING OF THE UKRAINIAN INTELLECTUAL PROPERTY INSTITUTE AS AN INTERNATIONAL SEARCHING AUTHORITY AND INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY UNDER THE PCT**

*Document prepared by the International Bureau*

#### **BACKGROUND**

1. At its forty-ninth session, held in Geneva from October 2 to 11, 2017, the Assembly extended the appointment of the State Enterprise “Ukrainian Intellectual Property Institute” (Ukrpatent) as an International Searching Authority and International Preliminary Examining Authority under the PCT, and approved the text of a draft agreement between the Ministry of Economic Development and Trade of Ukraine and the International Bureau (see documents PCT/A/49/2, Annex XIX and PCT/A/49/5, paragraphs 41 to 43). The agreement came into force on January 1, 2018.
2. Following the Resolution of the Cabinet of Ministers of Ukraine No. 943 with effect from November 8, 2022, the State Organization “Ukrainian National Office for Intellectual Property and Innovations” (UANIPIO) took over responsibility for, *inter alia*, patent processing, including the roles of receiving Office, International Searching Authority and International Preliminary Examining Authority under the PCT.

### **AMENDMENT OF AGREEMENT**

3. UANIPIO is the successor body to Ukrpatent for the purpose of patent processing. It retains all the examiners, search facilities, IT systems and other facilities and expertise of Ukrpatent and is substantively the body appointed by the Assembly.

4. It is proposed to amend the agreement to reflect the names of the Ministry (now the Ministry of Economy of Ukraine) and of the Office. Article 11(1) of the agreement indicates that amendments to the main body of the agreement are subject to the approval of the Assembly.

5. The proposed amendments are set out in the Annex to this document.

6. *The Assembly of the PCT Union is invited:*

*(i) to note the contents of document PCT/A/55/3; and*

*(ii) to approve the amendments to the agreement between the Ministry of Economic Development and Trade of Ukraine and the International Bureau as set out in the Annex to document PCT/A/55/3.*

[Annex follows]

DRAFT AMENDMENTS TO THE AGREEMENT<sup>1</sup>

AGREEMENT

between the Ministry of ~~Economic Development and Trade~~ Economy of Ukraine  
and the International Bureau of the World Intellectual Property Organization

in relation to the functioning of the ~~State Enterprise “Ukrainian Intellectual Property Institute”~~  
State Organization “Ukrainian National Office for Intellectual Property and Innovations”  
as an International Searching Authority and International Preliminary Examining Authority  
under the Patent Cooperation Treaty

**Preamble**

The Ministry of ~~Economic Development and Trade~~ Economy of Ukraine and the International  
Bureau of the World Intellectual Property Organization,

*Considering* that the PCT Assembly, having heard the advice of the PCT Committee for  
Technical Cooperation, has appointed the State Enterprise “Ukrainian Intellectual Property  
Institute” as an International Searching and Preliminary Examining Authority under the Patent  
Cooperation Treaty and approved this Agreement in accordance with Articles 16(3) and 32(3),

*Considering that the State Organization “Ukrainian National Office for Intellectual Property and  
Innovations” has taken on the patent processing responsibilities performed by the State  
Enterprise “Ukrainian Intellectual Property Institute”.*

*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;

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<sup>1</sup> Proposed additions and deletions are indicated, respectively, by underlining and striking through the text  
concerned.

- (g) “the Authority” means the ~~State Enterprise “Ukrainian Intellectual Property Institute”~~ [State Organization “Ukrainian National Office for Intellectual Property and Innovations”](#);
- (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.

(2) 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 International Search and Preliminary Examination Guidelines.

(3) The Authority shall maintain a quality management system in compliance with the requirements set out in the PCT International Search and Preliminary Examination Guidelines.

(4) 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 specified in Annex A to this Agreement, 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 and that any other requirements regarding such application as specified in Annex A to this Agreement have been met.

(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 specified in Annex A to this Agreement, 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 and, where applicable, that 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).

(4) The Authority shall conduct supplementary international searches in accordance with Rule 45*bis* to the extent decided by it, as set out in Annex B to this Agreement.

#### **Article 4** **Subject Matter Not Required to Be Searched or Examined**

The Authority shall not be obliged to search, by virtue of Article 17(2)(a)(i), or 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 C 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 D to this Agreement.

(2) The Authority shall, under the conditions and to the extent set out in Annex D 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 (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 D 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 the classification of the subject matter according to the International Patent Classification. The Authority may, in addition, in accordance with Rules 43.3 and 70.5, indicate the classification of the subject matter according to any other patent classification specified in Annex E to this Agreement to the extent decided by it as set out in that Annex.

## **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 F.

## **Article 8** **International-Type Search**

The Authority shall carry out international-type searches to the extent decided by it as set out in Annex G to this Agreement.

## **Article 9** **Entry into Force**

This Agreement shall enter into force on January 1, 2018.

## **Article 10** **Duration and Renewability**

This Agreement shall remain in force until December 31, 2027. The parties to this Agreement shall, no later than July 2026, 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 Ministry of ~~Economic Development and Trade~~ Economy of Ukraine; and, notwithstanding paragraph (4), they shall take effect on the date agreed upon by them.

(3) The Ministry of ~~Economic Development and Trade~~ Economy of Ukraine may, by a notification to the Director General of the World Intellectual Property Organization:

- (i) add to the indications of States and languages contained in Annex A to this Agreement;
- (ii) amend the indications on supplementary international searches contained in Annex B to this Agreement;
- (iii) amend the schedule of fees and charges contained in Annex D to this Agreement;
- (iv) amend the indications on patent classification systems contained in Annex E to this Agreement;
- (v) amend the indications on languages of correspondence contained in Annex F to this Agreement;

- (vi) amend the indications on international-type searches contained in Annex G to this Agreement.
- (4) Any amendment notified under paragraph (3) shall take effect on the date specified in the notification, provided that:
- (i) for an amendment to Annex B to the effect that the Authority shall no longer conduct supplementary international searches, that date is at least six months later than the date on which the notification is received by the International Bureau, and
  - (ii) for any change in the currency or amount of fees or charges contained in Annex D, for any addition of new fees or charges, and for any change in the conditions for and the extent of refunds or reductions of fees contained in Annex D, that date is at least two months 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, 2027:
- (i) if the Ministry of ~~Economic Development and Trade~~ [Economy](#) of Ukraine 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 Ministry of ~~Economic Development and Trade~~ [Economy](#) of Ukraine 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.

*[Annexes to the agreement not reproduced here]*

[End of Annex and of document]