

# WIPO



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WORLD INTELLECTUAL PROPERTY ORGANIZATION  
GENEVA

INTERNATIONAL PATENT COOPERATION UNION  
(PCT UNION)

ASSEMBLY

First Session (1<sup>st</sup> Extraordinary)\*  
Geneva, April 10 to 14, 1978

APPOINTMENT OF INTERNATIONAL SEARCHING AUTHORITIES AND  
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITIES AND  
APPROVAL OF AGREEMENTS BETWEEN THOSE AUTHORITIES AND  
THE INTERNATIONAL BUREAU

*Addendum to document PCT/A/I/3 prepared by the International Bureau*

1. The present document is an addendum to document PCT/A/I/3.
2. The Annex to this document contains the draft of the Agreement between the Patent Office of the United Kingdom and the International Bureau of the World Intellectual Property Organization in relation to the functioning of the Patent Office of the United Kingdom as an International Preliminary Examining Authority under the Patent Cooperation Treaty. The said draft Agreement has been initialed by both parties on March 13, 1978, and March 20, 1978, respectively. The draft Agreement is submitted to the Assembly for approval.
3. The draft Agreement contained in the Annex reflects the consent of the Patent Office of the United Kingdom to be appointed as International Preliminary Examining Authority which is one of the conditions of appointment under Articles 16 (3) (b) and 32 (3).

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\* "Editor's Note: This electronic document has been created from the paper original and may contain errors. Please bring any such errors to the attention of the PCT Legal Division by e-mail at [pct.legal@wipo.int](mailto:pct.legal@wipo.int)"

4. *The Assembly is invited*

(i) *to approve the draft Agreement contained in the Annex;*

(ii) *to appoint, after signature of the Agreement contained in the Annex, the Patent Office of the United Kingdom as an International Preliminary Examining Authority for a period of 15 years from the date of entry into force of the Agreement.*

[Annex follows]

ANNEX

Agreement between the Patent  
Office of the United Kingdom and the  
International Bureau of the  
World Intellectual Property Organization  
in relation to the functioning of the  
Patent Office of the  
United Kingdom as an International  
Preliminary Examining Authority under  
the Patent Cooperation Treaty.

Preamble

WHEREAS the States party to the Patent Cooperation Treaty, done at Washington on June 19, 1970, constitute a Union for cooperation in the filing, searching and examination of applications for the protection of inventions, and for rendering special technical services, the said Union being known as the International Patent Cooperation Union;

AND WHEREAS Articles 16(3) (b) and 32(3) of the Patent Cooperation Treaty provide, inter alia, that the appointment of a national Office as an International Preliminary Examining Authority by the Assembly of the International Patent Cooperation Union shall be conditional on the conclusion of an Agreement between the national Office and the International Bureau of the World Intellectual Property Organization;

AND WHEREAS it is recognized that the participation of the Patent Office of the United Kingdom as an International Preliminary Examining Authority in matters affecting international preliminary examination will contribute to the successful implementation of the Patent Cooperation Treaty;

IT IS HEREBY AGREED between the Patent Office of the United Kingdom, hereinafter called the "Authority," and the International Bureau of the World Intellectual Property Organization, hereinafter called the "International Bureau," as follows:

Article 1

Terminology Used in the Agreement

(1) For the purpose of this Agreement, the "Treaty" means the Patent Cooperation Treaty done at Washington on June 19, 1970; the "Regulations" means the Regulations under the Treaty; the "Administrative Instructions" means the Administrative Instructions under the Treaty; "Article" (except where a specific reference is made to an Article of this Agreement) means an Article of the Treaty; "Rule" means a Rule of the Regulations; "International Bureau" means the International Bureau as defined in Article 2 (xix) of the Treaty;

(2) All other terms and expressions used in this Agreement which are also used in the Treaty, are to be understood in the same sense as that in which they are used in the Treaty.

## Article 2

### Basic Obligation

(1) The Authority shall, except in respect of subject matter on which, pursuant to Article 6 of this Agreement, the Authority is not required to carry out international preliminary examination, carry out international preliminary examination in accordance with, and perform such other functions of an International Preliminary Examining Authority as are provided under the Treaty, the Regulations, the Administrative Instructions and this Agreement. In carrying out international preliminary examination, the Authority shall be guided by the Guidelines for International Preliminary Examination to be carried out under the Patent Cooperation Treaty. The Authority undertakes to apply and observe all the common rules of international preliminary examination.

(2) The Authority and the International Bureau shall, having regard to their respective functions under the Treaty, the Regulations, the Administrative Instructions and this Agreement, each render, to the extent possible, assistance to the other in relation to the performance, by the other, of its functions thereunder.

## Article 3

### Competence of Authority

The Authority undertakes to act as an International Preliminary Examining Authority for all international applications published or to be published in the English language and filed with the receiving Office of, or acting for, any Contracting State where that Office has specified the Authority for that purpose. Where any such application is not filed in the English language, the Authority will require a translation into that language.

## Article 4

### Provision of Personnel

(1) The Authority shall make available, to the extent required for the purposes of carrying out international preliminary examination, staff having duties within the Authority relevant to such examination and having sufficient technical qualifications to carry out such examination. The staff of the Authority shall be maintained at a level meeting the minimum requirements as set out in Rule 63.1(i).

(2) The Authority shall maintain a staff which is capable of examining in all technical fields and which has language facilities to understand at least those languages in which the minimum documentation referred to in Rule 34 is written or is translated.

#### Article 5

##### Documentation Facilities

The Authority shall comply with the requirements of Rule 63.1(ii).

#### Article 6

##### Subject Matter Not Required to be Examined

The Authority will not examine, by virtue of Article 34(4) (a) (i), any international application to the extent that it considers that the international application relates to subject matter set forth in Rule 67.1.

#### Article 7

##### Fees and Charges

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 Preliminary Examining Authority, is set out in the Annex to this Agreement.

#### Article 8

##### Competence for Protests in Case of Additional Fees

The Authority shall provide, in accordance with Rule 68.3(c) and (d), a special instance to examine protests in respect of additional fees where the international application is found not to comply with the requirement of unity of invention. The said special instance shall be the Comptroller General of the Patent Office of the United Kingdom or any officer exercising his powers under United Kingdom law.

Article 9

Time Limit for Preparation of International  
Preliminary Examination Reports

The Authority shall establish international preliminary examination reports within the applicable time limit specified in Rule 69.1(a)

Article 10

Classification

For the purposes of Rule 70.5, the Authority will indicate solely the International Patent Classification.

Article 11

Language of Correspondence Used by the Authority

For the purposes of correspondence, including forms, the Authority shall use the English language,

Article 12

Technical Assistance

The Authority shall supply the International Bureau with such contributions to the technical assistance program under Chapter IV of the Treaty as are practicable within the existing facilities of the Authority and as may be agreed.

Article 13

Entry into Force of the Agreement

This Agreement shall enter into force upon approval by the Assembly and subsequent signature. The Agreement together with an indication of the date of its entry into force shall be published in the Gazette by the International Bureau.

Article 14

Duration of the Agreement

This Agreement shall remain in force for a period of 15 years from June 1, 1978.

Article 15

Amendment

(1) Without prejudice to paragraphs (2) and (3), amendments may be made to this Agreement between the parties hereto and shall take effect upon approval of those amendments by the Assembly, or, if a later date is specified in the amendments, on that date.

(2) Without prejudice to the provisions of paragraph (3), amendments may be made to the Annex to this Agreement by agreement between the parties hereto and shall take effect upon notification in the Gazette or, if a later date is specified in the amendments, on that date.

(3) Subject to paragraph (4), the Authority may, by notice in writing given to the International Bureau, amend the fees and other charges contained in the Annex to this Agreement.

(4) Normally, the fees and other charges shall not be amended during the first year after the entry into force of this Agreement or thereafter at an interval of less than one year from a previous amendment. Any amendment of the fees and other charges shall take effect one month after publication of the notification of the amendment in the Gazette pursuant to paragraph (5), or, if a later date has been specified by the Authority, on the date specified by the Authority.

(5) The International Bureau shall publish promptly in the Gazette any amendment of this Agreement agreed between the parties and approved by the Assembly under paragraph (1), any amendment of the Annex to this Agreement agreed between the parties under paragraph (2), and any notification received by it under paragraph (3).

Article 16

Termination of the Agreement

(1) This Agreement shall terminate:

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

(b) if the Director General of the World Intellectual Property Organization, with the approval of the Assembly, 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.

(3) Notwithstanding paragraph (2), if

(i) notice to terminate this Agreement is given by the Authority under paragraph (1), and

(ii) at the same time all Contracting States, the receiving Offices of, or acting for which have specified the Authority under Article 32(2), not having previously denounced the Treaty under Article 66, denounce this Treaty under Article 66, the notice to terminate this Agreement shall take effect at such time as the denunciation of the Treaty becomes effective for all such countries,

IN WITNESS WHEREOF the parties hereto have executed this Agreement.

Done at Geneva, this ..... day of April 1978 in two originals in the English language.

For the Patent Office  
of the United Kingdom

For the International Bureau

.....  
Comptroller General

.....  
Director General



SCHEDULE OF FEES AND CHARGES OF THE AUTHORITY  
FOR THE PURPOSES OF ARTICLE 7 OF THE AGREEMENT

Fee	Amount
	<u>Pound Sterling</u>
1. Preliminary Examination Fee (Rule 58.1)	
(a) where an international search report has been established for the invention	£25.00
(b) where no international search report has been established for the invention	£25.00 plus the Sterling equivalent of the current EPO search fee
2. Additional fee referred to in Rule 68.3	for each invention this will exceed the relevant fee stated under 1.
3. Copies of documents cited under Article 36(4) (see Rule 71.2(a) and (b))	Current rate for preparing photocopy plus postage
4. Copies of documents requested pursuant to Rule 94	Current rate for preparing Photocopy plus postage

[End of the Annex and of document]