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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

ASSEMBLY

First Session (1st 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

Agreement with the European Patent Organisation

1. The present document is an addendum to document PCT/A/I/3.
2. Annex I to this document contains the draft of the Agreement between the International Bureau of the World Intellectual Property Organization and the European Patent Organisation in relation to the establishment and functioning of the European Patent Office as an International Searching and International Preliminary Examining Authority under the Patent Cooperation Treaty. The said draft Agreement has been initialed by both parties on March 31, 1978, and April 3, 1978, respectively. The draft Agreement is submitted to the Assembly for approval.

* "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"

3. Attention is drawn to Article 16 (2), containing two alternative versions which are both placed within square brackets. Alternative I of that paragraph contains proposals by the European Patent Office (EPO) concerning the right to use and to reproduce free of charge the PCT publications prepared by the International Bureau (pamphlet of the international application, Gazette, and other PCT publications of general interest). The International Bureau could not agree with those proposals. Alternative II contains the version proposed by the International Bureau with respect to the question of reproduction of PCT publications, a proposal with which the EPO could not agree. Since the question of copyright in PCT publications is dealt with under item 13 of the agenda of the first session of the Assembly (document PCT/A/I/1.Rev.), it was agreed among the parties to defer further consideration of the question raised in Article 16 (2) until after a decision has been reached by the Assembly with respect to the question of copyright in PCT publications. An agreed text of Article 16 (2) will be submitted as soon as possible during the first session and in any event before the question of approval of the said draft Agreement is considered by the Assembly.

4. The draft Agreement contained in Annex I reflects the consent of the EPO to be appointed as International Searching and International Preliminary Examining Authority which is one of the conditions of appointment under Articles 16 (3) (b) and 32(3).

5. *The Assembly is invited*

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

(ii) *to appoint, after signature of the Agreement contained in Annex I, the EPO as an International Searching and International Preliminary Examining Authority for a period of ten years from the date of the entry into force of the Agreement.*

Gradual Application of International Preliminary Examination as far as the European Patent Office International is concerned

6. It is expected that the Assembly will fix the date, from which demands for international examination may be submitted, at June 1, 1978 (see paragraph 8 of document PCT/A/I/2). However, the Agreement proposed to be concluded with the European Patent Organisation and contained in Annex I will provide for the exclusion, during a limited initial period, from international preliminary examination, of all or certain categories of international applications." Since it is the EPO which will be competent for the international preliminary examination of international applications of nationals or residents of the Federal Republic of Germany who, as applicants under the PCT, would otherwise made use of Chapter II of the PCT, the Government of the Federal Republic of Germany has addressed to the Director General of WIPO the notification contained in Annex II which was received on March 16, 1978. In that notification, the Government of the Federal Republic of Germany, referring to the applicability of Chapter II for its country as of March 29, 1978, proposes that the Assembly adopt the necessary measures for the gradual application of the Treaty and the Regulations, as far as the application of Chapter II for demands submitted by residents or nationals of the Federal Republic of Germany is concerned, in accordance with Article 65 (1).

7. However, the measures in question are needed not only for residents and nationals of the Federal Republic of Germany but also of any other State bound by Chapter II of the PCT concerning which the competent receiving Office will specify the EPO, and the EPO alone, as the International Preliminary Examining Authority competent for the preliminary examination for international applications filed with that receiving Office and concerning which the applicant demands international preliminary examination.

8. Consequently, it is proposed that the Assembly take the following decision:

“The Assembly of the International Patent Cooperation (PCT) Union,

“Considering the Agreement concluded between the International Bureau of the World Intellectual Property Organization and the European Patent Organization in as far as it concerns international preliminary examination,

“Considering Article 65(1) of the Patent Cooperation Treaty,

“Notes that in respect of international applications for which the European Patent Office would be the only competent International Preliminary Examining Authority, demands for international preliminary examination will be accepted by the European Patent Office as from the dates which result from the application of the provisions of the said agreement.”*

9. *The Assembly is invited*

(i) *to note the information contained in paragraphs 6 and 7, in particular the notification by the Government of the Federal Republic of Germany contained in Annex II;*

(ii) *to take the decision referred to in paragraph 8.*

[Annexes I and II follow]

* See Article 6 of the draft Agreement contained in Annex I, according to which the EPO starts to perform international preliminary examination only as of June 1, 1979, and, thereafter, limits, as a transitory measure and for a maximum period of five years from the entry into force of the Agreement, the kinds of international applications for which it performs international preliminary examination to certain technical fields, the limitations being the same as those provided for European patent applications. Those limitations will be communicated to the International Bureau and will be published in the Gazette.

PCT/A/I/5

ANNEX I

March 30, 1978

Agreement between the International Bureau of the
World Intellectual Property Organization and the
European Patent Organisation in relation to the
establishment and functioning of the
European Patent Office as an International Searching and
International Preliminary Examining Authority
under the Patent Cooperation Treaty

The INTERNATIONAL BUREAU OF THE WORLD INTELLECTUAL PROPERTY ORGANIZATION, hereinafter referred to as “the International Bureau”

and

the EUROPEAN PATENT ORGANISATION, hereinafter referred to as “the Organisation”,

CONSIDERING that 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,

CONSIDERING that Articles 16 (3) (b) and 32 (3) of the Patent Cooperation Treaty provide, inter alia, that the appointment of an intergovernmental organization as an International Searching and International Preliminary Examining Authority by the Assembly of the International Patent Cooperation Union shall be subject to the conclusion of an Agreement between the intergovernmental organization and the International Bureau,

CONSIDERING that by virtue of Article 4 of the Convention on the Grant of European Patents, done at Munich on October 5, 1973, the European Patent Office has been constituted as an Organ of the Organization which is an intergovernmental organization established by the said Convention, and that, by virtue of the Protocol on Centralization annexed to the said Convention, the International Patent Institute mentioned in Article 16 of the Patent Cooperation Treaty as a prospective International Searching Authority was integrated into the European Patent Office on January 1, 1978, which Office, on that date, assumed the tasks incumbent upon the said Institute,

CONSIDERING that Articles 154 and 155 of the said Convention provide, inter alia, that subject to the conclusion of an agreement between the Organisation and the International Bureau, the European Patent Office shall act as an International Searching and International Examining Authority International under the Patent Cooperation Treaty,

AND CONSIDERING that it is recognized that the participation of the European Patent Office as an International Searching and International Preliminary Examining Authority will contribute to the successful implementation of the Patent Cooperation Treaty,

HEREBY AGREE 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 otherwise specified, means an Article of the Treaty; “Rule” means a Rule of the Regulations; “Assembly” means the Assembly as defined in Article 2(xvii); “International Bureau” means the International Bureau as defined in Article 2 (xix) ; “Contracting State” refers to a Contracting State to the Treaty; “Convention” means the Convention on the Grant of European Patents done at Munich on October 5, 1973 as well as the Implementing Regulations which are an integral part of the Convention; “Authority” means the European Patent Office established under Article 4 of the Convention; and “Administrative Council” means the Administrative Council of the Organisation.

(2) All other terms and expressions used in this Agreement and 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 which, pursuant to Article 7 of this Agreement, the Authority is not required to search or to examine, carry out international search and international preliminary examination in accordance with, and perform such other functions of an International Searching 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 the Guidelines for International Search and 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 search and of international preliminary examination.

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

Article 3

Competence of Authority

(1) Subject to paragraph (3), the Authority undertakes to act as an International Searching Authority for all international applications filed with the receiving Offices of, or acting for, all Contracting States provided that the receiving Office specifies the Authority for that purpose and that such applications are in one of the languages specified in Annex A of this Agreement.

(2) Subject to paragraphs (3), the Authority undertakes to act as an International Preliminary Examining Authority for all international applications filed with the receiving Offices of, or acting for, all Contracting States provided the receiving Office specifies the Authority for that purpose. In respect of international applications filed in the languages specified in Annex A, the Authority shall carry out examination without requiring translations of such applications.

(3) Where the activities of the Authority under paragraphs (1) and (2), after approval of the Administrative Council, are extended

(a) to acting as an International Searching Authority in respect of an international application filed pursuant to a decision of the Assembly under Article 9 (2), or

(b) to acting as an International Preliminary Examining Authority in respect of an international application in respect of which a demand for international preliminary examination is submitted pursuant to a decision of the Assembly under Article 31(2)(b), the Authority shall communicate the decision to extend its activities to the International Bureau, together with the date at which the decision takes effect, and the latter shall publish that communication in the Gazette.

Article 4

Personnel

(1) The Authority shall use the staff at its disposal, having sufficient technical qualifications to carry out search or examination, to the extent required by the workload to be undertaken by it under this Agreement. In any event, the minimum requirements concerning staff as set out in Rules 36.1(i) and 63.1(i) shall be respected.

(2) The Authority shall maintain a staff which is capable of searching in all technical fields for which search is required and capable of examining in all technical fields for which examination is required. That staff shall have the necessary 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

The Authority shall, for the purposes of this Agreement, use all documentation facilities at its disposal. In any event, the minimum requirements concerning documentation as set out in Rules 36.1 (ii) and 63.1 (ii) shall be respected.

Article 6

Transitory Measures Concerning
International Preliminary Examination

The Authority shall perform international preliminary examination as of June 1, 1979. As a transitory measure and for a maximum period of five years from the entry into force of this Agreement, the Authority shall limit the kinds of international applications for which it performs international preliminary examination to certain technical fields. The limitations shall be the same as those provided for the examination of European patent applications pursuant to Article 162 of the Convention which are published by the Authority in the European Patent Bulletin and are established with reference to the International Patent Classification. The said limitations shall be communicated by the Authority to the International Bureau and shall be published in the Gazette.

Article 7

Subject Matter not required to be Searched or Examined

The Authority shall not search, by virtue of Article 17(2) (a) (i), or shall 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 39.1 or Rule 67.1, as the case may be, it being understood that the Authority is not equipped to search or to examine computer programs.

Article 8

Fees and other 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 and International Preliminary Examining Authority is set out in Annex B of this Agreement.

(2) The Authority shall, to the extent and under the conditions set out in Annex B of this Agreement, refund the whole or part of the international search fee paid where an international search report can be wholly or partially based on the results of an earlier international or international-type search made by the Authority.

Article 9

Competence in Case of Protest

The Boards of Appeal, which are responsible under Articles 154(3) and 155(3) of the Convention for deciding on a protest made under Rules 49.2(c) and 68.3(c) respectively by the applicant against the fixing of additional fees where such additional fees are paid under protest, are composed of two technically qualified members and one legally qualified member.

Article 10

Time Limits

(1) The Authority shall, within the time limits specified in the first two sentences of Rule 42.1, establish international search reports, or declarations under Article 17(2) (a). However, during a transitory period of three years from the entry into force of the Treaty and after notification of the International Bureau, these time limits may be extended under the conditions provided for in Rule 42.1, last sentence,

(2) The Authority shall, within the maximum periods specified in Rule 69.1(a) (i) and (ii), establish international preliminary examination reports.

Article 11

Classification

For the purposes of Rules 43.3(a) and 70.5(b), the Authority shall indicate solely the International Patent Classification.

Article 12

Limitation of Processing of International Applications

(1) (a) If the workload of the Authority reaches such a level that because of its 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 notify the International Bureau in writing that, as from a date not earlier than 9 months from the date of the notification, it will limit the acceptance of international applications, either for international search or for international preliminary examination, to not more than a given number each year or to certain fields of technology. Any of the said limitations may be exercised singly or in combination with another limitation or with all the other limitations.

(b) The initial duration of any limitation shall not exceed a period of two years. The said duration may be extended one or more times in respect of one or more limitations for a period of not more than two years each, provided that in each case notice of four months is given prior to the expiration of the initial or any subsequent period.

(c) The Authority shall enter into consultations with the International Bureau before giving the written notification referred to in subparagraph (a) or the notice of extension referred to in subparagraph (b).

(2) Where the International Bureau conducts negotiations with the Contracting States to the Convention with a view to finding solutions to the problems caused by the limitation or limitations fixed pursuant to paragraph 1, particularly through the allocation of the work, not to be performed by the Authority, to other International Searching or International Preliminary Examining Authorities, the Authority shall cooperate in order to facilitate arriving at such solutions.

Article 13

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 English, French or German language, depending on the language of the international application or its translation.

Article 14

International-Type Search

(1) Subject to Article 7 of this Agreement and paragraph (3) of this Article, the Authority shall make an international-type search on any national application filed in any Contracting State, the receiving Office of which has specified the Authority, as mentioned in Article 3(1) of this Agreement

- (a) as far as such is permitted by the law of, and is requested by, such State;
- (b) where the law of such State so permits and the applicant so requests.

(2) Where the national application is not in a language in which the Authority has undertaken to search international applications under Article 3 of this Agreement, the international-type search shall be carried out on a translation, transmitted by the applicant, in a language which the Authority has undertaken to accept for international applications under Article 3 of this Agreement.

(3) Pursuant to Article 65(1), the Authority, during a maximum period of 5 years, reserves the right to limit the international-type searches which it performs under paragraph (1) to a number which shall not be less than 5,000 per year. Article 12 of this Agreement shall apply to international-type searches.

Article 15

Information Service and Technical Assistance

The Authority shall participate in the information services and shall contribute to the technical assistance program under Chapter IV of the Treaty within the limits of its possibilities and under conditions to be established in agreement with the International Bureau.

Article 16

Publications

(1) The International Bureau shall furnish to the Authority free of charge four copies of each published international application, of the Gazette and of each other publication of general interest published by the International Bureau in relation to the Treaty or the Regulations.

Alternative I [(2) The Authority shall have the right to use and to reproduce the documents mentioned in paragraph (1) in the framework of its operations as a Patent Office.]

Alternative II [(2) The Authority shall have the right to reproduce the documents referred to in paragraph (1) exclusively for the use of its own staff].

Article 17

Entry into Force of the Agreement

This Agreement shall enter into force on the date of its signature and after approval by the Administrative Council and thereafter by the Assembly. The Agreement shall be published by the International Bureau in the Gazette and by the Authority in the Official Journal of the European Patent Office. The date of entry into force shall be indicated in the said publications.

Article 18

Duration and Renewability of the Agreement

This Agreement shall retain in force for a period of 10 years. It shall be renewable for a period of 10 years subject to the approval of the Administrative Council and the approval of, and the extension of the appointment of the Authority for that period by, the Assembly.

Article 19

Amendment

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

(2) Without prejudice to the provisions of paragraph (3), amendments may be made to the Annexes of this Agreement by agreement between the International Bureau and the Authority. Amendments shall take effect upon publication in the Gazette or, if a later date is specified in the amendments, on that later date.

(3) The Authority may, by notice in writing given to the International Bureau:

(a) add to the languages Listed in Annex A of this Agreement;

(b) subject to paragraph (4), amend the schedule of fees and other charges contained in Annex B of this Agreement.

(4) Normally, the schedule of 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 of the schedule. Any amendment of the schedule 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 that later date.

(5) The International Bureau shall publish promptly in the Gazette any amendment of this Agreement under paragraph (1), any amendment of this Agreement agreed between the International Bureau and the Authority under paragraph (2), and any notification received by it under paragraph (3). The said amendments and notifications shall also be published in the Official Journal of the European Patent Office.

Article 20

Termination of the Agreement

(1) This Agreement shall terminate:

(a) 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; or

(b) if the Organisation gives the Director General of the World Intellectual Property Organization 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.

IN WITNESS WHEREOF the parties hereto have executed this Agreement.

DONE at Geneva, this day of April 1978, in two originals in the English, French and German languages, each text being equally authentic.

For the International Bureau:

For the Organisation:

Arpad Bogsch
Director General

J.B. van Benthem
President
European Patent Office

ANNEX A

Languages specified for the purposes of Article 3 (1) and (2) of the Agreement

1. For the purposes of Article 3(1) of the Agreement, applications shall be filed in one of the following languages:

English,
French,
German.

2. For the purposes of Article 3(2) of the Agreement, applications shall be filed in one of the following languages:

English,
French,
German.

ANNEX B

I. Schedule of fees and other charges referred to in Article 8(1) of the Agreement

	PCT		EPC	AMOUNT DM
	Article	Rule		
1. Fees and other charges levied by the EPO as an International Searching Authority under the PCT				
1.1. Search fee*		16		1,700
1.2. Additional fee	17(3) (a)	40	154(3)	1,700
1.3. Cost of preparing copies of cited documents**	20(3)	44.3(b)	R.104a	1/page
2. Fees and other charges levied by the EPO as an International Preliminary Examining Authority				
2.1. Handling fee		57.1-57.3		OMPI/WIPO
2.2. Preliminary examination fee				1,000
2.3. Additional fee	34(3) a	68.3	155(3) R.104a	1,000
2.4. Cost of preparing copies** of additional cited documents	20(3) 36(4)	71.2(b)		1/page
2.5. Cost of copies of documents** in the file of the International application		94		1/page

* This fee will apply for international-type searches pursuant to Article 14(1)(a) of the Agreement unless otherwise agreed between the Organisation and the State in question.

** The amount given for these costs does not include any royalties to be paid by the Authority.

II. Refund of the fees for the international search report pursuant to Article 8(2) of the Agreement

1. The search fee will be refunded fully or in part if the international search report drawn up on an international application is based on an earlier international search report or an international-type search report already prepared by the Authority on an application whose priority is claimed for the international application. For the purposes of Article 8(2) of the Agreement, all search reports drawn up by the Authority on a national or European patent application will be considered international-type search reports.

2. The amount of any refund will be 25, 50, 75 or 100 per cent of the search fee depending upon the extent to which the Authority benefits from the earlier search report.

[Annex II follows]

Notification of the Federal Republic of Germany

1. The Patent Cooperation Treaty (PCT) entered into force for the Federal Republic of Germany on January 24, 1978, and Chapter II of the said Treaty became applicable for it on March 29, 1978, as Germany did not avail itself of the possibility provided for in Article 64 paragraph 1 lit. a of the Treaty.

2. With regard to the provisions concerning the international search and the international Preliminary examination the Federal Republic of Germany - on the basis of the Protocol on the Centralisation of the European Patent System and its Introduction, which is part of the Convention on the Grant of European Patents - has renounced on behalf of its central industrial property office in favour of the European Patent Office

- any activities as International Searching Authority

- any activities as International Preliminary Examining Authority

under the Treaty.

3. In accordance with these obligations under international law the competent receiving Office of the Federal Republic of Germany will specify the European Patent Office for the searching of international applications filed with this receiving Office and for the international preliminary examination (Article 16 paragraph 2 and Article 32 paragraph 2 of the Treaty).

4. The Federal Republic of Germany refers to Article 65 paragraph 1 of the Treaty and the Agreement to be concluded between the International Bureau of the World Intellectual Property Organization and the European Patent Organisation in relation to the establishment and functioning of the European Patent Office as an International Searching and International Preliminary Examining Authority under the Patent Cooperation Treaty. The draft of the Agreement will be submitted to the PCT Assembly for approval. In this Agreement provision will be made by a special Article for transitory measures concerning the International Preliminary Examination, saying that the European Patent Office shall limit the kinds of international applications for which it performs the international preliminary examination to certain technical fields. The limitations shall be the same as those provided for the examination of European Patent applications pursuant to Article 162 of the Convention on the Grant of European Patents which are published by the European Patent Office in the European Patent Bulletin and are established with reference to the International Patent Classification.

5. The Federal Republic of Germany therefore proposes that the Assembly adopt the measures necessary for the gradual application of the Treaty and the Regulations in respect of the corresponding categories of international applications, in accordance with Article 65 paragraph 1 of the Treaty and on the basis of the aforementioned Agreement.

[End of Annexes]

[End of document]