

WIPO



PCT/A/I/6

ORIGINAL: English

DATE: April 10, 1978

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

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 Patent Office of Japan and the International Bureau of the World Intellectual Property Organization in relation to the establishment and functioning of the Patent Office of Japan as an International Searching and International Preliminary Examining Authority under the Patent Cooperation Treaty. Annex II to this document contains a draft Protocol of Agreement concerning the Agreement between the Patent Office of Japan and the International Bureau of the World Intellectual Property Organization in relation to the establishment and functioning of the Patent Office of Japan as an International Searching and International Preliminary Examining Authority under the Patent Cooperation Treaty (PCT). Both drafts have been initialed by both (PCT) parties on March 30, 1978, and April 9, 1978, respectively. The draft Agreement

* *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

contained in Annex I is submitted to the Assembly for approval and the draft Agreement in Annex II is communicated to the Assembly for information.

3. Japan has not yet deposited its instrument of ratification for the PCT. At the time of writing this document, the Japanese Diet and the House of Councilors have, however, already approved the Bill consenting to the ratification of the Treaty. The legislative process concerning the adoption of the legislation implementing the PCT and enabling the Patent Office of Japan to act as an International Searching and International Preliminary Examining Authority is far advanced. It is consequently expected that the internal procedures for the approval of ratification and the adoption of the necessary implementing legislation will be so timely concluded as to permit a deposit of the instrument of ratification by Japan during the period between the first and the second sessions of the Assembly (scheduled for September 25, 1978). It is furthermore expected that the Treaty will enter into force for Japan during that period. On the basis of these expectations, the Director General of the Patent Office of Japan has suggested to the Director General of WIPO that the Assembly be requested, in its first session, to appoint the Patent Office of Japan as an International Searching and International Preliminary Examining Authority despite the fact that the ratification procedure will not have been completed by the time the decision would be taken, this in order to enable the Patent Office of Japan to begin its PCT activity immediately upon entry into force of the Treaty for Japan without having to wait for a decision by the Assembly in a subsequent session.

4. In view of the situation, it is suggested that the Assembly approve the draft Agreement contained in Annex I and appoint the Patent Office of Japan as an International Searching and International Preliminary Examining Authority under the PCT, it being understood that such appointment will take effect when both of the following two conditions are fulfilled:

(i) the draft Agreement contained in Annex I is signed with the text approved by the Assembly without further modification, according to the intention of both parties reflected in the draft Protocol of Agreement contained in Annex II and subject only to the exception referred to in Article 3 of that Protocol;

(ii) the Government of Japan deposits its instrument of ratification of the PCT during the period between the first and second sessions of the Assembly.

5. The Protocol of Agreement, the draft of which is contained in Annex II, is envisaged to be signed by both parties during the first session of the Assembly after approval by the Assembly of the draft Agreement contained in Annex I and before the proposed appointment.

6. The draft Agreement contained in Annex I reflects the consent of the Patent Office of Japan 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).

7. *The Assembly is invited*

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

(ii) *to appoint, after signature of the Protocol of Agreement contained in Annex II and subject to the conditions referred to in paragraph 4 above, the Patent Office of Japan as an International Searching and International Preliminary Examining Authority for a period of ten years from the date of entry into force of the Agreement contained in Annex I.*

[Annexes I and II follow]

PCT/A/I/6

ANNEX I

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

Agreement between the Patent Office of
Japan and the International Bureau of the
World Intellectual Property Organization in relation
to the establishment and functioning of the
Patent Office of Japan as an International Searching and
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 examining 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 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 national Office and the International Bureau;

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

IT IS HEREBY AGREED between the Patent Office of Japan, hereinafter called the Authority, II 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, "Treaty" means the Patent Cooperation Treaty done at Washington on June 19, 1970; "Regulations" means the Regulations under the Treaty; "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) of the Treaty; "International Bureau" means the International Bureau as defined in Article 2 (xix) of the Treaty; "Contracting State" refers to a Contracting State to 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 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 be guided by 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 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

(1) Subject to Article 7 of this Agreement, the Authority undertakes to act as an International Searching Authority for all international applications filed with receiving Offices of, or acting for, the Contracting States specified in Annex A of this Agreement, provided that the receiving Office of the State concerned 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 Articles 6 and 7 of this Agreement, the Authority undertakes to act as an International Preliminary Examining Authority for all international applications filed with the receiving Offices of, or acting for, the Contracting States referred to in paragraph (1) provided that the receiving Office of the State concerned specifies the Authority for that purpose. In respect of the international applications filed in the languages specified in Annex A of this Agreement, the Authority shall carry out examination without requiring translations of such applications.

Article 4

Personnel Requirements

(1) The Authority shall, for the purposes of carrying out international search and international preliminary examination, respectively, make available the staff at its disposal, to the extent required by the workload, having sufficient technical qualifications to carry out such search or such examination. The staff of the Authority shall be maintained at a level meeting the minimum requirement as set out in Rules 36.1(i) and 63.1(i)

(2) The Authority shall maintain a staff which is capable of searching and 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 use for search and for examination purposes all documentation facilities ordinarily at the disposal of the staff referred to in Article 4 of this Agreement and shall maintain and use for the said purposes at least the minimum documentation referred to in the Regulations properly arranged for search or for examination purposes (Rules 36.1(ii) and 63.1(ii)).

Article 6

Transitional Limitation on Number of
International Applications Accepted for
International Preliminary Examination

For a transitional period starting upon the entry into force of this Agreement and ending on a date to be agreed upon between the Authority and the International Bureau, the Authority shall apply the limitation on the number of international applications which the Authority will accept for international preliminary examination specified in Annex B of this Agreement.

Article 7

Subject Matter Not required
to be Searched or Examined

The Authority will not search I by virtue of Article 17(2) (a) (i), or will not examine I 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, with the exception of the subject matter specified in Annex C of this Agreement.

Article 8

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 and International Preliminary Examining Authority, is set out in Annex D of this Agreement.

(2) The Authority shall, to the extent and under the conditions set out in Annex D of this Agreement, refund the whole or part of the search fee paid where a search report can be wholly or partially based on the results of an earlier international search made by the Authority (Rule 16.3).

Article 9

Examination of Protest

The Authority shall provide, in accordance with Rules 40.2 (c) and (d) and 68.3 (c) and (d), a three-member board or 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 three-member board or special instance is designated in Annex E of this Agreement.

Article 10

Time Limit for Preparation of International
Search Reports or Declarations and International
Preliminary Examination Reports

(1) Subject to paragraph (2), 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) and I within the maximum periods specified in Rule 69.1 (a) (i) and (ii), establish international preliminary examination reports.

(2) During the period beginning on the date of the Authority's appointment and ending on January 24, 1981, the Authority may establish international search reports, in exceptional cases, within a time limit which exceeds that specified in paragraph (1) above by two months, provided that, in any given case, this extension does not go beyond the expiration of the 18th month after the priority date of an international application.

Article 11

Classification

Any other classification of the subject matter which the Authority will indicate for the purposes of Rules 43.3 (a) and (b) and 70.5 (a) and (b), in addition to the International Patent Classification, is specified in Annex F of this Agreement.

Article 12

Language of Correspondence Used
by the Authority

For the purposes of correspondence, including forms, other than with the International Bureau, the Authority shall use one of the languages specified in Annex G of this Agreement.

Article 13

Information Services and Technical Assistance

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

Article 14

Entry into Force of the Agreement

This Agreement shall enter into force once all the following conditions are fulfilled:

- (i) it is approved by the Assembly;
- (ii) it is signed by the Authority and the International Bureau; and
- (iii) the Treaty has entered into force for Japan.

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 15

Duration and Renewability of the Agreement

Subject to Article 17 of this Agreement, this Agreement shall remain in force for a period of 10 years. It shall be renewable for a period of 10 years subject to the approval of, and the extension of the appointment of the Authority for that period by, the Assembly.

Article 16

Amendment

(1) Without prejudice to paragraphs (2) and (3), amendments may be made to this Agreement by 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 Annexes of 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) The Authority may, by notice in writing given to the Director General of the World Intellectual Property Organization:

- (i) add to the Contracting States and languages listed in Annex A of this Agreement;
- (ii) increase the number of international applications to be processed as specified in Annex B of this Agreement;

- (iii) add to the subject matter listed in Annex C of this Agreement;
- (iv) subject to paragraph (4), amend the schedule of fees and other charges contained in Annex D of this Agreement;
- (v) delete any classification listed in Annex F 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 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 this Agreement agreed between the parties under paragraph (2), and any notification received by it under paragraph (3).

Article 17

Termination of the Agreement

- (1) This Agreement shall terminate:
 - (i) if the Director General of the Patent Office of Japan 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, with the approval of the Assembly, gives the Director General of the Patent Office of Japan 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 1978, in two originals in the English and Japanese languages, each text being equally authentic.

For the Patent Office of
Japan by:

For the International
Bureau by:

.....
Director General

.....
Director General

ANNEX A

CONTRACTING STATES AND LANGUAGES SPECIFIED FOR
THE PURPOSES OF ARTICLE 3 OF THE AGREEMENT

(a) Contracting States

Japan

(b) Languages

Japanese

ANNEX B

LIMITATION ON NUMBER OF INTERNATIONAL APPLICATIONS
PROCESSED SPECIFIED FOR THE PURPOSES OF
ARTICLE 6 OF THE AGREEMENT

The limitation on the number of international applications which the Authority will accept for international preliminary examination for the purposes of Article 6 of the Agreement is as follows:

6,000 international applications in each full calendar year during which the limitation applies.

ANNEX C

SUBJECT MATTER SPECIFIED UNDER ARTICLE 7
OF THE AGREEMENT

The subject matter set forth in Rule 39.1 or Rule 67.1, which, under Article 7, is not excluded from search or examination, is the following:

None

ANNEX D

SCHEDULE OF FEES AND CHARGES OF THE AUTHORITY
AND EXTENT AND CONDITIONS OF REFUNDS OF THE
SEARCH FEE FOR THE PURPOSES OF ARTICLE 8
OF THE AGREEMENT

(a) Schedule of fees and charges*

<u>Fee</u>	<u>Amount</u> Japanese Yen
Search fee (Rule 16.1(a))	45,000
Additional fee (Rule 40.2(a))	35,000
Preparing copies of cited documents (Rule 44.3(b))	100 per page
Preliminary examination fee (Rule 58.1(b))	15,000
Additional fee (Rule 68.3(a))	10,000
Preparing copies of cited documents (Rule 71.2(b))	100 per page
Preparing copies of requested documents (Rule 94.1)	100 per page

* The Authority reserves the right to make adjustments, prior to the entry into force of the PCT for Japan, in the indicated fees and charges where such adjustment is required having regard to the Cabinet Order to be made in relation to such fees and charges.

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(b) Conditions and extent of refunds of the search fee where the search report can be wholly or partially based on the results of an earlier international search (Rule 16.3)**

The conditions and extent of refunds of the search fee in cases where the search reports can be wholly or partially based on the results of an earlier international search are the following:

The amount of any refund of the search fee shall be 30% or 55% of the search fee depending upon the extent to which the Authority benefits from the prior search report.

** The Authority reserves the right to make adjustments, prior to the entry into force of the PCT for Japan, in the extent and conditions of refunds of the search fee where such adjustment is required having regard to the Administrative Order of the Ministry of International Trade and Industry to be made in relation to this matter.

ANNEX E

DESIGNATION FOR THE PURPOSES OF ARTICLE 9
OF THE AGREEMENT

For the purposes of Article 9, a three-member board, appointed by the Director General of the Authority to that effect, is designated.

ANNEX F

CLASSIFICATION SPECIFIED FOR THE PURPOSES OF
ARTICLE 11 OF THE AGREEMENT

The classification specified for the purposes of Article 11 of the Agreement is:

Japanese Patent Classification

ANNEX G

LANGUAGES SPECIFIED FOR THE PURPOSES OF
ARTICLE 12 OF THE AGREEMENT

The languages specified for the purposes of Article 12 of the Agreement are:

Japanese

[Annex II follows]

Protocol of Agreement concerning the Agreement
between the Patent Office of Japan and the
International Bureau of the World Intellectual
Property Organization in relation to the
establishment and functioning of the Patent Office of
Japan as an International Searching and
International Preliminary Examining Authority
under the Patent Cooperation Treaty (PCT)

Protocol of Agreement concerning the
Agreement between the Patent Office of Japan and the
International Bureau of the World Intellectual Property Organization
in relation to the establishment and functioning of the
Patent Office of Japan as an International Searching and
International Preliminary Examining Authority
under the Patent Cooperation Treaty (PCT)

The PATENT OFFICE OF JAPAN and the INTERNATIONAL BUREAU OF THE
WORLD INTELLECTUAL PROPERTY ORGANIZATION,

Having regard to the procedure in the Diet of Japan for the approval of the ratification by Japan of the Patent Cooperation Treaty (PCT) and for the enactment of legislation for the purposes of implementing the PCT and of enabling the Patent Office of Japan to act as an International Searching and International Preliminary Examining Authority under the PCT,

Having regard also to the provisions of Articles 16 (3) (b) and 32 (3) of the PCT, Considering that the Agreement between the Patent Office of Japan and the International Bureau of the World Intellectual Property Organization in relation to the establishment and functioning of the Patent Office of Japan as an International Searching and International Preliminary Examining Authority under the Patent Cooperation Treaty, hereinafter referred to as "the Agreement," the text of which is annexed hereto, is in conformity with the Bill for the said legislation at present before the Diet of Japan,

Considering, further, that the Agreement should not be signed until the deposit of the instrument of ratification by the Government of Japan,

HAVE AGREED as follows:

Article 1

The Authority and the International Bureau will, subject to the provisions of this Protocol, enter into the Agreement the text of which is annexed hereto.

Article 2

The Agreement will be signed by the representatives of the Patent Office of Japan and the International Bureau promptly after the deposit of the instrument of ratification by the Government of Japan.

Article 3

No change shall be made to the text of the Agreement annexed hereto before signature except in the event that the Diet of Japan makes amendments to the Bill for the legislation referred to in the Preamble of this Protocol which necessitates an amendment of the Agreement. In this event, amendments will be made only to such parts of the Agreement as may require to be amended by reason of the amendments to the Bill and the Agreement as amended will, if any of its Articles is so amended, be submitted for the approval of the Assembly of the International Patent Cooperation (PCT) Union.

IN WITNESS WHEREOF, the Patent Office of Japan and the International Bureau of the World Intellectual Property Organization have executed this Protocol.

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

For the Patent Office of
Japan by:

For the International Bureau of the
World Intellectual Property Organization by:

.....
Director General

.....
Director General