

# WIPO



PCT/A/I/7

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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. Annex I to this document contains the draft of the Agreement between the Federal Minister for Trade, Commerce and Industry of Austria and the International Bureau of the World Intellectual Property Organization in relation to the establishment and functioning of the Austrian Patent Office 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 Federal Minister for Trade, Commerce and Industry of Austria and the International Bureau of the World Intellectual Property Organization in relation to the establishment and functioning of the Austrian Patent Office as an International Searching and International Preliminary Examining Authority under the Patent Cooperation Treaty (PCT). Both draft Agreements have been initialed by both parties on March 30, 1978, and April 3, 1978, and April 4 and 6, 1978, respectively. The draft Agreement contained in Annex I is submitted to the Assembly

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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)

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

3. Austria has not yet deposited its instrument of ratification for the PCT. The internal procedures for the preparation of approval of ratification and for the adoption of the necessary implementing legislation are, however, far advanced, and it is expected that they will be so timely concluded as to permit a deposit of the instrument of notification by Austria during the period between the first and the second sessions of the Assembly (scheduled for September 25, 1978). On the basis of this expectation, the President of the Austrian Patent Office has suggested to the Director General of WIPO that at the Assembly be requested, in its first session, to appoint the Austrian Patent Office 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 Austrian Patent Office to begin its PCT activity immediately upon entry into force of the Treaty for Austria 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 Austrian Patent Office 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 Austria 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 Austrian Patent Office 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 (b) .

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 Austrian Patent Office 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 follows]

PCT/A/I/7

ANNEX I

Agreement between the  
Federal Minister for Trade, Commerce and Industry of Austria  
and the International Bureau of the  
World Intellectual Property Organization  
in relation to the establishment and functioning  
of the Austrian Patent Office  
as an International Searching and International  
Preliminary Examining Authority under the  
Patent Cooperation Treaty

Agreement between the Federal  
Minister for Trade, Commerce and Industry of Austria and the  
International Bureau of the World Intellectual Property Organization  
in relation to the establishment and functioning of the  
Austrian Patent Office 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 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 an 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 with the International Bureau;

AND WHEREAS it is recognized that the participation of the Austrian Patent Office 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 Federal Minister for Trade, Commerce and Industry of Austria, the superior authority of the Austrian Patent Office, acting for that Office, 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 II" 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; “Authority” means the Austrian Patent Office.

(2) All other terms and expressions used in this Agreement 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 6 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 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 Treaty. The Authority undertakes to apply and observe all the common rules (Article 16(3) (b)) 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) The Authority undertakes to act as an International Searching Authority for the international applications filed with the receiving Offices of, or acting for, the Contracting States indicated in Annex A of this Agreement 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) The Authority undertakes to act as an International Preliminary Examining Authority for the international applications filed with the receiving Offices of, or acting for, the Contracting States indicated in Annex A of this Agreement 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. In respect of international applications filed in the languages specified in Annex AI the Authority shall carry out examination without requiring translations of such applications.

Article 4

Provision of Personnel

(1) The Authority shall make available for the purposes of carrying out international search and international preliminary examination, respectively, all members of its staff having duties within the Authority relevant to such search or such examination and having sufficient technical qualifications to carry out such search or such examination. The numbers of such staff shall be maintained at levels meeting the minimum requirements 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, for the purposes of this Agreement, maintain and 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

Subject Matter Not Required  
to be Searched or Examined

The Authority will not search, by virtue of Article 17(2) (a)(i), or 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 39.1 or Rule 67.1, as the case may be, with the exception of the subject matter specified in Annex B.

Article 7

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 C of this Agreement.

(2) The Authority shall, to the extent and under the conditions set out in Annex C 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 or international-type search made by the Authority (Rules 16.3 and 41.1).

## Article 8

### Review Board

The Authority shall provide that the Appeal Department of the Austrian Patent Office (Beschwerdeabteilung des Österreichischen Patentamtes) shall examine protests in respect of additional fees where the international application is found not to comply with the requirement of unity of invention (Rule 40.2(c) or Rule 68.3(c)).

## Article 9

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

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

## Article 10

### Classification

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

## Article 11

### 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, specified in Annex A, which is the language of the international application.



Article 12

International-Type Search

(1) The Authority shall make an international-type search on any national application filed in any Contracting State which has specified the Authority as mentioned in Article 3 (1) of this Agreement:

- (i) as far as such is permitted by the law of, and is requested by, such State i
- (ii) where the national 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 in a language which the Authority has undertaken to accept for international applications under Article 3 of this Agreement.

Article 13

Information Service 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 of the Authority and may be agreed. The provision of search or examination work for developing countries under preferential conditions shall be the subject of a special agreement.

Article 14

Entry into Force of the Agreement

This Agreement shall enter into force upon approval, x) 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.

x) 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 Austria.

Article 15

Duration and Renewability of the 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 Federal Minister for Trade, Commerce and Industry may, by notice in writing given to the Director General of the World Intellectual Property Organization:

(i) add to the States and languages listed in Annex A of this Agreement,

(ii) subject to paragraph (4), amend the schedule of fees and other charges contained in Annex C 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 Federal Minister for Trade, Commerce and Industry, on the date specified by the Federal Minister.

(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 Federal Minister of Trade, Commerce and Industry 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 Federal Minister of Trade, Commerce and Industry 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 ..... this ..... day of ..... 1978, in two originals each in the English and German languages, both texts being equally authentic.

For the Federal Minister for Trade  
Commerce and Industry of Austria:

For the International Bureau  
by:

ANNEX A

States and Languages Specified for the Purposes  
of Article 3 of the Agreement

1. The States specified for the purposes of Article 3 (1) of the Agreement are the States regarded as a developing country in conformity with the established practice of the General Assembly of the United Nations.

2. The languages specified for the purposes of Article 3 (1) of the Agreement are:

English  
French  
German

3. The States specified for the purposes of Article 3 (2) of the Agreement are the States regarded as a developing country in conformity with the established practice of the General Assembly of the United Nations.

4. The languages specified for the purposes of Article 3 (2) of the Agreement are:

English  
French  
German

ANNEX B

Subject Matter Specified Under Article 6  
of the Agreement

The subject matter set forth in Rule 39.1 or Rule 67.1, which, under Article 6 of the Agreement, is not excluded from search or examination, is the following:

Diagnostic methods which are not practiced on the human body.

ANNEX C

Schedule of Fees and Charges of the Authority  
and Extent and Conditions of Refunds of the  
Search Fee for the Purposes of Article 7 of the Agreement

(a) Schedule of fees and charges

<u>Fee</u>	<u>Amount in Austrian Schillings</u>
Search fee (Rule 16.1(a))	4000.-
Additional fee (Rule 40.2(a))	4000.-
Preparing copies of cited documents (Rule 44.3(b))	6. - per page
Preliminary examination fee (Rule 58.1(b))	4000.-
Addition fee (Rule 68.3(a))	4000.-
Preparing copies of cited documents (Rule 71.2(b))	6.- per page

(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 or international-type search (Rule 16.3 and 41.1)

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

The amount of any refund of the search fee shall be 75% if the Authority benefits from the prior search report to the full extent or a substantially prevailing portion.

[Annex II follows]

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ANNEX II

Protocol of Agreement concerning the Agreement between the  
Federal Minister for Trade, Commerce and Industry of Austria  
and the International Bureau of the  
World Intellectual Property Organization  
in relation to the establishment and functioning  
of the Austrian Patent Office  
as an International Searching and International  
Preliminary Examining Authority under the  
Patent Cooperation Treaty (PCT)

Protocol of Agreement concerning the Agreement between the Federal Minister for Trade, Commerce and Industry of Austria and the International Bureau of the World Intellectual Property Organization in relation to the establishment and functioning of the Austrian Patent Office as an International Searching and International Preliminary Examining Authority under the Patent Cooperation Treaty (PCT)

The FEDERAL MINISTER FOR TRADE t COMMERCE AND INDUSTRY OF AUSTRIA and the INTERNATIONAL BUREAU OF THE WORLD INTELLECTUAL PROPERTY ORGANIZATION,

Having regard to the procedure in the National Assembly of Austria for the approval of the ratification by Austria of the Patent Cooperation Treaty, (PCT) and for the enactment of legislation for the purposes of implementing the PCT and of enabling the Austrian Patent Office 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 Federal Minister for Trade t Commerce and Industry of Austria and the International Bureau of the World Intellectual Property Organization in relation to the establishment and functioning of the Austrian Patent Office 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 t is in conformity with the Bill for the said legislation to be approved by the National Assembly of Austria,

Considering, further, that the Agreement should not be signed until the National Assembly of Austria has approved the ratification of the PCT by Austria and has passed the said Bill,

HAVE AGREED as follows:

#### Article 1

The Federal Minister for Trade, Commerce end Industry of Austria 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 Federal Minister for Trade, Commerce and Industry of Austria and the International Bureau promptly after the approval, by the National Assembly of Austria, of the ratification of the PCT by Austria and the passing of the legislation implementing the PCT and enabling the Austrian Patent Office to act as an International Searching and International Preliminary Examining Authority.

Article 3

No change shall be made to the text of the Agreement annexed hereto before signature except in the event that the National Assembly of Austria makes amendments to the Bill for the legislation referred to in Article 2 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 Federal Minister for Trade, Commerce and Industry of Austria 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 and German languages, each text being equally authentic.

For the Federal Minister for  
Trade, Commerce and Industry of  
Austria by:

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

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[End of Annexes]  
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