

# WIPO



PCT/A/III/6

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WORLD INTELLECTUAL PROPERTY ORGANIZATION  
GENEVA

INTERNATIONAL PATENT COOPERATION UNION  
(PCT UNION)

ASSEMBLY

Third Session (2<sup>nd</sup> Extraordinary)\*  
Geneva, April 25 to May 1, 1979

APPOINTMENT OF THE AUSTRALIAN PATENT OFFICE AS INTERNATIONAL  
SEARCHING AND PRELIMINARY EXAMINING AUTHORITY AND APPROVAL OF  
DRAFT AGREEMENT BETWEEN THAT OFFICE AND THE INTERNATIONAL  
BUREAU

*Note prepared by the International Bureau*

## BACKGROUND

1. According to Articles 16(3) and 32(3), the International Searching Authorities and the International Preliminary Examining Authorities shall be appointed by the Assembly of the International Patent Cooperation Union (hereinafter referred to as “the Assembly”). Any national Office and any intergovernmental Organization satisfying the minimum requirements, particularly as to manpower and documentation, prescribed by the Regulations (see Rules 36.1 and 63.1) may be appointed as International Searching Authority and/or International Preliminary Examining Authority. Appointment shall be conditional on the consent of the national Office or intergovernmental Organization to be appointed and the conclusion of an agreement, subject to approval by the Assembly, between such Office or Organization and the International Bureau. The appointment shall be for a fixed period of time and may be extended for further periods.

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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)

2. The following Offices are, after their appointment by the Assembly in its first session, at present acting as:

- (i) International Searching and International Preliminary Examining Authority:
  - (a) the Patent Office of Japan;
  - (b) the USSR State Committee for Inventions and Discoveries;
  - (c) the Royal Patent and Registration Office of Sweden;
  - (d) the European Patent Office;
- (ii) International Searching Authority:
  - (e) the United States Patent and Trademark Office;
- (iii) International Preliminary Examining Authority:
  - (f) the Patent Office of the United Kingdom.

#### REQUEST BY THE AUSTRALIAN PATENT OFFICE

3. On January 30, 1979, the Permanent Representative of Australia in Geneva communicated to the International Bureau the decision of the Government of Australia to adhere to the PCT and to seek appointment of the Australian Patent Office as an International Searching and Preliminary Examining Authority at the third session of the PCT Assembly. On February 2, 1979, the said decision was announced publicly in Australia.

4. Australia has not yet deposited its instrument of accession to the PCT. According to the information received, the Government of Australia has taken a decision to become a party to the Treaty, but the deposit of an instrument of accession will only follow the passing of legislation for the implementation of the PCT by the Federal Parliament. Having regard to the time expected to be required for consideration of the said legislation by the Parliament, the Government of Australia expects to deposit the instrument of accession at a time which would cause entry into force of the Treaty for Australia by January 1, 1980. At the same time, the Australian Patent Office intends to take up its function as a PCT Authority. The intention is to have that Office act as an International Searching and Preliminary Examining Authority not only for Australia, but for all developing countries with particular emphasis on the Asian region. The Australian Patent Office fulfills the minimum requirements prescribed in Rule 36 of the PCT.

5. In view of its firm expectation of being in a position to deposit an instrument of accession later this year, the Government of Australia, through its Permanent Representative in Geneva, has suggested to the Director General of WIPO that the Assembly be requested, at its third session, to appoint the Australian Patent Office as an International Searching and Preliminary Examining Authority despite the fact that the parliamentary procedure will not have been completed by the time the decision would be taken. A similar procedure had been applied by the Assembly in its first session, when appointing the Patent Offices of Austria and

Japan as PCT Authorities. The reasons for this request of the Australian Authorities are mainly:

(i) that an early decision would facilitate and accelerate the accession process and the preparation of the implementation of the Treaty on the legislative and administrative level, taking into account the functions which the Australian Patent Office would undertake as a PCT Authority,

(ii) that an early decision would enable the Australian Patent Office without any further lead period to assume its functions as an International Searching and Preliminary Examining Authority immediately upon entry into force of the Treaty and without having to wait for a decision of the Assembly after accession which could not be implemented immediately in view of the further necessary legislative and administrative preparations.

6. In view of this request, the International Bureau has immediately started negotiations with the Australian Patent Office concerning the Agreement to be concluded between that Office and the International Bureau under Articles 26(3) and 32(3) of the PCT. These negotiations have resulted in the texts attached to this document. Annex I to this document contains the draft of the Agreement between the Patent Office of the Government of Australia and the International Bureau of the World Intellectual Property Organization in relation to the establishment and functioning of the Patent Office of the Government of Australia as an International Searching and International Preliminary Examining Authority under the Patent Cooperation Treaty. Annex II to this document contains an Exchange of Notes between the Australian Permanent Mission in Geneva and the Director General of WIPO concerning the Agreement between the Patent Office of the Government of Australia and the International Bureau of the World Intellectual Property Organization in relation to the establishment and functioning of the Patent Office of the Government of Australia as an International Searching and International Preliminary Examining Authority under the Patent Cooperation Treaty. The draft Agreement was initialed by both parties on April 2, 1979.

7. The draft Agreement contained in Annex I is submitted to the Assembly for approval and the Exchange of Notes in Annex II is communicated to the Assembly for information.

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

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

(ii) the Government of Australia deposits its instrument of accession to the PCT during this year.

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

*10. The Assembly is invited:*

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

*(ii) to appoint, subject to the conditions referred to in paragraph 8 above, the Australian Patent Office as an International Searching and 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/III/6  
ANNEX I

AGREEMENT BETWEEN THE PATENT OFFICE OF THE GOVERNMENT OF AUSTRALIA AND THE INTERNATIONAL BUREAU OF THE WORLD INTELLECTUAL PROPERTY ORGANIZATION IN RELATION TO THE ESTABLISHMENT AND FUNCTIONING OF THE PATENT OFFICE OF THE GOVERNMENT OF AUSTRALIA AS AN INTERNATIONAL SEARCHING AND INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY UNDER THE PATENT COOPERATION TREATY

Agreement between the PATENT OFFICE OF  
THE GOVERNMENT OF AUSTRALIA AND THE  
INTERNATIONAL BUREAU OF THE WORLD  
INTELLECTUAL PROPERTY ORGANIZATION in  
relation to the establishment and  
functioning of the Patent Office of  
the Government of Australia as an  
International Searching and Interna-  
tional 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 Patent Office of the Government of Australia 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;

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IT IS HEREBY AGREED between the Patent Office of the Government of Australia, 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); "International Bureau" means the International Bureau as defined in Article 2(xix); "Contracting State" refers to a Contracting State to the Treaty; "Authority" means the Patent Office of the Government of Australia.

(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

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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 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) 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,

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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 A, the Authority shall carry out examination without requiring translations of such applications.

Article 4

Provision of Personnel

(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, for the purposes of this Agreement, use all documentation facilities at its disposal.

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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).

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Article 8

Review Board

The Authority shall provide, in accordance with Rules 40.2(c) and 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 Commissioner of Patents or any officer exercising his powers under Australian law.

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.

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Article 11

Languages of Correspondence Used by the Authority

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

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;

(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

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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 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 Australia.

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

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.

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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 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 Authority, on the date specified by the Authority.

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(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:

(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.

IN WITNESS WHEREOF the parties hereto have executed this Agreement.

DONE at Geneva, this .... day of ....., 1979,  
in two originals in the English language.

For the Patent Office of the  
Government of Australia:

For the International Bureau:

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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:

Australia and 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

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

Australia and 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

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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:

None.

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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

Fee	Amount in Australian Dollars
Search fee (Rule 16.1(a)) .....	300.00
Additional fee (Rule 40.2(a)) .....	250.00
Preparing copies of cited documents (Rule 44.3(b))..	5.00 [per document]
Preliminary examination fee (Rule 58.1(b)).....	100.00
Additional fee (Rule 68.3(a)) .....	100.00
Preparing copies of cited documents (Rule 71.2(b))..	5.00 [per document]

(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 (Rules 16.3 and 41.1)

The conditions and 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.

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NOTE No P280/79  
226/7/2/2

The Australian Permanent Mission presents its compliments to the Director General of the World Intellectual Property Organisation and has the honour to refer to the proposal before the Assembly of the International Patent Cooperation Union to appoint the Patent Office of the Government of Australia as an International Searching Authority and an International Preliminary Examining Authority under the Patent Cooperation Treaty concluded at Washington on 19 June 1970.

The Permanent Mission has been instructed to inform the International Bureau that the Government of Australia has taken a decision to become a party to the Patent Cooperation Treaty for and on behalf of Australia and to seek to have the Patent Office of the Government of Australia appointed an International Searching Authority and an International Preliminary Examining Authority under that Treaty.

Before depositing its Instrument of Accession the Government of Australia will await the passing of legislation for the purpose of implementing the Treaty and of enabling the Patent Office of the Government of Australia to act as an International Searching Authority and an International Preliminary Examining

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Authority in accordance with the provisions of an agreement to be concluded between the Australian Patent Office and the International Bureau, a draft of which agreement is attached to this Note. It is the intention that this legislation be in effect in time to enable Australia to accede to the Treaty and bring it into force for Australia by 1 January 1980.

It is the understanding of the Government of Australia that, promptly after the deposit on behalf of Australia of the Instrument of Accession to the Treaty, representatives of the Patent Office of the Government of Australia and the International Bureau will sign the agreement referred to in the preceding paragraph and that the text of the agreement will be the same as that set out in the attachment to this Note apart from necessary amendments having regard to the legislation passed by the Parliament of the Commonwealth of Australia.

It is also the understanding of the Government of Australia that any such amendments to the agreement will require the approval of the Assembly of the International Patent Cooperation Union.

The Permanent Mission would be grateful to receive the confirmation of the International Bureau that the foregoing is acceptable to the International Bureau and in particular that the preceding two paragraphs also represent the understanding of the International Bureau on the matter.

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The Australian Permanent Mission avails itself of this opportunity to renew to the Director General of the World Intellectual Property Organisation the assurances of its highest consideration.

GENEVA  
2 April 1979



The agreement attached to the Note is not reproduced here since it consists of the draft Agreement reproduced in Annex I.



WORLD INTELLECTUAL PROPERTY ORGANIZATION  
ORGANISATION MONDIALE DE LA PROPRIÉTÉ INTELLECTUELLE

The Director General of the World Intellectual Property Organization (WIPO) has the honor to acknowledge receipt of the Note of the Australian Permanent Mission of April 2, 1979, which concerns the proposal to appoint the Patent Office of the Government of Australia as an International Searching Authority and an International Preliminary Examining Authority under the Patent Cooperation Treaty and which reads, as follows:

"The Australian Permanent Mission presents its compliments to the Director General of the World Intellectual Property Organisation and has the honour to refer to the proposal before the Assembly of the International Patent Cooperation Union to appoint the Patent Office of the Government of Australia as an International Searching Authority and an International Preliminary Examining Authority under the Patent Cooperation Treaty concluded at Washington on 19 June 1970.

"The Permanent Mission has been instructed to inform the International Bureau that the Government of Australia has taken a decision to become a party to the Patent Cooperation Treaty for and on behalf of Australia and to seek to have the Patent Office of the Government of Australia appointed an International Searching Authority and an International Preliminary Examining Authority under that Treaty.

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"Before depositing its Instrument of Accession the Government of Australia will await the passing of legislation for the purpose of implementing the Treaty and of enabling the Patent Office of the Government of Australia to act as an International Searching Authority and an International Preliminary Examining Authority in accordance with the provisions of an agreement to be concluded between the Australian Patent Office and the International Bureau, a draft of which agreement is attached to this Note. It is the intention that this legislation be in effect in time to enable Australia to accede to the Treaty and bring it into force for Australia by 1 January 1980.

"It is the understanding of the Government of Australia that, promptly after the deposit on behalf of Australia of the Instrument of Accession to the Treaty, representatives of the Patent Office of the Government of Australia and the International Bureau will sign the agreement referred to in the preceding paragraph and that the text of the agreement will be the same as that set out in the attachment to this Note apart from necessary amendments having regard to the legislation passed by the Parliament of the Commonwealth of Australia.

"It is also the understanding of the Government of Australia that any such amendments to the agreement will require the approval of the Assembly of the International Patent Cooperation Union.

"The Permanent Mission would be grateful to receive the confirmation of the International Bureau that the foregoing is acceptable to the International Bureau and in particular that the preceding two paragraphs also represent the understanding of the International Bureau on the matter."

The Director General of WIPO has the honor to state that the procedure outlined in the said Note is acceptable to the International Bureau and to confirm the understandings mentioned in the fourth and fifth paragraphs quoted above, it being understood, as far as the said fourth paragraph is concerned, that the Assembly of the PCT Union will have previously approved the agreement referred to therein and will have previously appointed the Patent Office of the Government of Australia as an International Searching Authority and an International Preliminary Examining Authority.

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April 2, 1979

[End of Annex II  
and of document]