

# WIPO



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## WORLD INTELLECTUAL PROPERTY ORGANIZATION GENEVA

### PATENT COOPERATION TREATY

#### INTERIM ADVISORY COMMITTEE FOR ADMINISTRATIVE QUESTIONS

Eighth Session

Geneva, October 10 to 18, 1977

#### PROGRESS REPORT ON NEGOTIATIONS WITH PROSPECTIVE INTERNATIONAL SEARCHING AND PRELIMINARY EXAMINING AUTHORITIES

prepared by the International Bureau

1. At its seventh session held in Geneva from November 1 to 8, 1976, the PCT Interim Advisory Committee for Administrative Questions (hereinafter referred to as "the Interim Committee") included on its program for the year 1977 (see the report of the said seventh session, document PCT/AAQ/VII/19, paragraph 170(v)) the negotiation of individual agreements between the International Bureau and the prospective International Searching Authorities on the basis of the Draft Model Agreement as contained in document PCT/AAQ/VII/5 and in the light of the advice provided by the Interim Committee during the discussion of the Draft Model Agreement (see the said report, document PCT/AAQ/VII/19, paragraphs 118 to 136).

2. This document reports on the action that has been taken to the present time by the International Bureau with respect to the negotiation of individual agreements with prospective International Searching Authorities as well as, in view of the likelihood of early implementation of Chapter II of the PCT, with prospective International Preliminary Examining Authorities and makes proposals which will facilitate the further negotiations with such Authorities.

3. Following consideration of the question of future activities of the European Patent Office under the PCT by the Interim Committee of the European Patent Organisation (EPO), a first round of discussions took place at Geneva in June 1977 between representatives of the EPO Interim Committee and of the International Bureau. The discussions took place as far as international search was concerned, on the basis of the Model Agreement as contained in document PCT/AAQ/VII/5 and the advice received thereon by the Interim Committee, and as far as international preliminary examination was concerned, on the basis of an adaptation of that Model Agreement, prepared by the International Bureau, which would serve as the basis for negotiations with prospective International Preliminary Examining Authorities (the adapted Model Agreement is annexed to this document for the purpose of information). The discussions thus constituted a first exchange of views on the envisaged conclusion of an agreement between the International Bureau and the European Patent Office as an International Searching and Preliminary Examining Authority. It was agreed that the discussions would be continued later in the year taking into account, in particular, the fact that the final authority, from the viewpoint of the conclusion of an agreement by the European Patent Office, would be the Administrative Council of the EPO which would only start to function after the entry into force of the European Patent Convention on October 7, 1977.

4. In the June/July 1977 (second) session of the Preparatory Intergovernmental Committee on the Revision of the Paris Convention for the Protection of Industrial Property, the Delegation of the United States of America made a declaration to the effect that its country was willing to offer the services of its Office acting as International Searching Authority to all nationals of countries of the Western hemisphere party to the PCT on the same conditions as to its own nationals and that in the event, currently under study, of the United States of America lifting the reservation it had made in relation to Chapter II of the PCT when ratifying that Treaty, the United States of America would be ready to make a similar offer as regards its Office acting as International Preliminary Examining Authority (paragraph 88 of document PR/PIC/II/13). Referring to that declaration, the Director General wrote to the US Commissioner of Patents and Trademarks, indicating that the International Bureau was at his disposal to start negotiations with the United States Patent and Trademark Office for the conclusion of an agreement with that Office as an International Searching Authority and, assuming the lifting of the reservation concerning Chapter II, also as an International Preliminary Examining Authority.

5. The President of the Austrian Patent Office has communicated to the Director General by a letter of July 28, 1977, the intention of the Austrian Authorities, on the basis of a recent decision of the EPO Interim Committee during its 9th session in June 1977, to have the Austrian Patent Office undertake an activity as International Searching Authority and as International Preliminary Examining Authority under the PCT in favor of developing countries. The relevant part of the decision of the EPO Interim Committee to which the said letter refers reads as follows:

"The European Patent Office, acting as an International Searching Authority and as an International Preliminary Examining Authority under the Patent Cooperation Treaty, shall cooperate with the Austrian and Swedish Patent Offices by transferring to them such work, to be carried out independently, in relation to requests for searching and preliminary examination in favour of developing countries, as is covered by agreements concluded by Austria or Sweden with these countries."

The President of the Austrian Patent Office has proposed in his letter that consultations between representatives of the International Bureau and of the Austrian Patent Office concerning the future activity of the Austrian Patent Office as a PCT authority should start as soon as possible and that a first round of discussions should take place in Vienna in September 1977. The Director General has replied favorably to this proposal.

6. It is consequently anticipated that, in the autumn of 1977, negotiations will either continue or be taken up with the prospective Authorities mentioned above.

7. The International Bureau is ready to open negotiations with the Offices of, or acting for, other countries which have ratified or acceded to the PCT, or are about to do so, and intend to become an International Searching and/or International Preliminary Examining Authority. To this end, any member of the Interim Committee wishing to commence negotiations is invited to indicate, and if it has expressed such wish in writing to the International Bureau before the forthcoming session, to confirm, such interest during the forthcoming session of the Interim Committee.

8. The Interim Committee is invited to note the contents of this document; its interested members are invited to make or confirm the indication mentioned in paragraph 7.

[Annex follows]

DRAFT MODEL AGREEMENT BETWEEN AN INTERNATIONAL PRELIMINARY  
EXAMINING AUTHORITY AND THE INTERNATIONAL BUREAU

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Agreement between .....(\*) and the International Bureau of the World Intellectual Property Organization in relation to the functioning of .....(\*) in the capacity of an International Preliminary Examining Authority appointed 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 it is recognized that the participation of the .....(\*) as an International Preliminary Examining Authority in matters affecting international preliminary examination will contribute to the successful implementation of the Patent Cooperation Treaty;

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

IT IS HEREBY AGREED between the .....(\*), hereinafter called the "Authority," and the International Bureau of the World Intellectual Property Organization, hereinafter called the "International Bureau," as follows:

#### Article 1

##### Terminology Used in the Agreement

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

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

#### Article 2

##### Basic Obligation

(1) The Authority shall, except in respect of subject matter on which, pursuant to Article 7 of this Agreement, the Authority is not required to carry out international preliminary examination, carry out international preliminary examination in accordance with, and perform such other functions of an International Preliminary Examining Authority as are provided under the Treaty, the Regulations, the Administrative Instructions and this Agreement. In carrying out international preliminary examination, the Authority shall be guided by the Guidelines for Carrying Out International Preliminary Examination under the Patent Cooperation Treaty. The Authority undertakes to apply and observe all the common rules of international preliminary examination.

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(\*) Reference will be made to a national Office or intergovernmental Organization.

(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 and Languages of International Preliminary Examining Authority<sup>1</sup>

(1) Subject to Article 6 of this Agreement, the Authority undertakes to act as an International Preliminary Examining Authority [for all international applications] [for international applications of the kinds specified in Annex A of this Agreement] filed with the receiving Offices of, or acting for, [all States] [the States specified in Annex A of this Agreement].

(2) The Authority shall carry out international preliminary examination on international applications filed in the languages specified in Annex A without requiring translations of such applications.

### Article 4

#### Minimum Personnel Requirements

(1) The Authority shall maintain a staff of at least ... fulltime employees with sufficient technical qualifications to carry out international preliminary examination under the Treaty.

(2) The Authority shall maintain a staff which is capable of conducting international preliminary examination in the required technical fields and which has language facilities to understand the following languages: .....<sup>2</sup>

### Article 5

#### Documentation Facilities

(1) The Authority shall maintain for the purposes of international preliminary examination, in addition to the minimum documentation facilities properly arranged for examination purposes specified in the Regulations (Rules 34 and 63.1(ii)), the following documentation facilities:<sup>3</sup> (cite groups of documents outside Rule 34 as to time or as to country coverage).

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<sup>1</sup> A Contracting State has the option to consider only one International Preliminary Examining Authority or several such Authorities as competent to examine international applications filed with its national Office and must inform the International Bureau of its choice. Where it considers several Authorities as competent, it must identify in its communication to the International Bureau each such Authority. In the latter situation, the identification may indicate either that all such Authorities are competent for the same kinds of international applications, leaving the choice to the applicant, or that certain of such Authorities are competent for one kind of international application and certain others are competent for other kinds of international applications (Article 32(2) and PCT Rules 35.2 and 59.1).

<sup>2</sup> Both of the language facilities required under Rule 63.1(iii) and any further language facilities should be referred to here.

<sup>3</sup> The Authority may wish to, and even should, maintain and use such documentation outside Rule 34, but no significant changes should be made without informing the International Bureau.



(2) Where a patent document is republished once or more than once, as such or as a granted patent, the Authority shall keep, in accordance with Rule 34.1(d), the following versions of such patent documents in its minimum documentation: ..... (Examples: Offenlegungsschrift of the Federal Republic of Germany, Tokkyo Kokaikoho of Japan (as far as the English language abstracts are generally available) and the Première Publication of France).<sup>4</sup>

#### Article 6

##### Number or Kinds of International Applications Processed

The limitations which, in accordance with Article 65(1), the Authority will apply, for a transitional period of .... years, on the number or kinds<sup>5</sup> of international applications it will accept for international preliminary examination are specified in Annex B.

#### Article 7

##### Subject Matter not Required to be Examined

The subject matter<sup>6</sup> specified in Rule 67.1 on which the Authority will not carry out international preliminary examination by virtue of Article 34(4)(a)(i) is specified in Annex C of this Agreement.

#### Article 8

##### Fees and Charges

(1) A schedule of all fees of the Authority, and any other charges which the Authority is entitled to make, in relation to its function as an International Preliminary Examining Authority, is set out in Annex D of this Agreement.

(2) The currencies in which the Authority will receive handling fees are set out in Annex D of this Agreement.

(3) The Authority shall transfer all handling fees received by it to the International Bureau in Swiss currency or such other currency convertible into Swiss currency as may be agreed.

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<sup>4</sup> The Regulations give the Authority the faculty of providing for substitution by a kind of document other than those specified herein (see Rule 34.1(d)).

<sup>5</sup> The Authority may provide in its Agreement with the International Bureau, transitionally, for limitations on the number and kinds of international applications that such Authority will undertake to process. In such cases, the Assembly of the International Patent Cooperation Union shall adopt the procedures necessary for the gradual application of the Treaty in respect to the number or kinds of international applications to be processed. Alternatively, another International Preliminary Examining Authority may undertake to perform the remaining work for the Contracting State(s) concerned.

<sup>6</sup> The Treaty gives the Authority the faculty of excluding certain subject matter (e.g., plant varieties, computer programs, etc.) from international preliminary examination (Article 34(2)(a)(i) and Rule 67). Such subject matter should be listed in the Annex.

Article 9

Review Board

The Authority shall provide, in accordance with Rule 68.3(c) and (d), a ..... [three-member board or special instance or competent higher authority] 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 or competent higher authority] is designated in Annex E of this Agreement.

Article 10

Time Limit for Preparation of International Preliminary  
Examination Reports

The Authority shall establish international preliminary examination reports within the time limits specified in Rule 69.1(a) and (c).

Article 11

Classification

Any other classification<sup>7</sup> of the subject matter which the Authority will apply in international preliminary examination reports, in addition to the International Patent Classification, is indicated in Annex F of this Agreement.

Article 12

Information Service and Technical Assistance<sup>8</sup>

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 as may be agreed.

Article 13

Entry into Force of the Agreement

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

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<sup>7</sup> Since the normal indication of classification is according to the International Patent Classification (see Rule 70.5(b)), such indication of symbols of another classification system constitutes the exception.

<sup>8</sup> This Article provides the basis for negotiating with the Authority its participation in patent information services to be established and technical assistance to developing countries to be provided under Chapter IV of the PCT.

Article 14

Duration and Renewability of the Agreement

This Agreement shall remain in force for a period of ..... years<sup>9</sup>. It shall be renewable for a period of ..... years subject to the approval of, and the extension of the appointment of the Authority for that period by, the Assembly.

Article 15

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 International Bureau:

(a) add to the kinds of applications and the languages listed in Annex A of this Agreement and to the documentation facilities listed in Article 5 of this Agreement;

(b) amend the limitations, specified in Article 6 of this Agreement, on the number or kinds of international applications it will accept for international preliminary examination but only so as to increase the number or kinds of applications it will so accept;

(c) subject to paragraph (4), amend the schedule of fees and other charges contained in Annex D of this Agreement;<sup>10</sup> and

(d) amend Annex F of this Agreement by omitting classifications specified therein or adding classifications thereto.

(4) 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).

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<sup>9</sup> The period specified and the period of appointment as an International Preliminary Examining Authority should be identical.

<sup>10</sup> The question could be further studied whether substantial increases in the amounts specified in the schedule should not be subject to the agreement of the parties or even to approval by the Assembly.



Article 16

Termination of the Agreement<sup>11</sup>

(1) This Agreement shall terminate:

(a) if the Authority gives the Director General of the International Bureau written notice to terminate this Agreement; or

(b) if the Director General of the International Bureau, with the approval of the Assembly, gives the Authority written notice to terminate this Agreement.

(2) The termination of this Agreement under paragraph (1) shall take effect one year after receipt of the notice by the other party.

(3) Notwithstanding paragraph (2), if:

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

(b) at the same time [the country of the Authority denounces] [all such countries as are both member States of the Authority and Contracting States under the Treaty, and have not previously denounced the Treaty, denounce] the Treaty under Article 66,

the notice to terminate this Agreement shall take effect [at the same time as the denunciation of the Treaty takes effect] [at such time as the denunciation of the Treaty becomes effective for all such countries].

IN WITNESS WHEREOF the parties hereto have executed this Agreement.

DONE in duplicate at ....., this ..... day of ....., in originals in the ..... and ..... languages, each text being equally authentic.

For the Authority by:

For the International Bureau by:

[Listing of PCT provisions relevant  
to Articles of the Agreement follows]

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<sup>11</sup> Since the existence of the Agreement is a condition of the appointment of an International Preliminary Examining Authority, the termination of the Agreement can only be expected to be considered on the basis that the termination of the appointment of an International Preliminary Examining Authority by the Assembly was also desired.

LISTING OF PCT PROVISIONS RELEVANT TO ARTICLES OF THE AGREEMENT

General	The Agreement	PCT Articles 32(3) and 16(3)(b) PCT Article 34(1) (Procedural Matters) Rule 89.1(b)
Article 1	Terminology Used in the Agreement	PCT Article 2
Article 2	Basic Obligation	
Article 3	Competence and Languages of International Preliminary Examining Authority	PCT Articles 32(2) and (3) and 16(3)(b) Rules 55.2(a), 59 and 35.2
Article 4	Minimum Personnel Requirements	PCT Rule 63.1(i) and (iii)
Article 5	Documentation Facilities Minimum Documentation	PCT Article 16(3)(c), Rule 34, Rule 36.1(ii)
Article 6	Number or Kinds of International Applications Processed	PCT Article 65(1)
Article 7	Subject Matter not Required to be Examined	PCT Article 34(4)(a)(i) Rule 67.1(i) to (vi)
Article 8	Fees and Charges (1) Preliminary Examination Fee (2) Translation (3) Charge for Copies	PCT Article 31(5) Rule 58.1 PCT Rule 48.3(b) PCT Rule 71.2(b)
Article 9	Review Board	PCT Rule 68.3(c) and (d)
Article 10	Time Limit for Preparation of International Preliminary Examination Reports	PCT Rule 69.1(a) and (c)
Article 11	Classification	PCT Rule 70.5(b)
Article 13	Information Service and Technical Assistance	PCT Articles 50 and 51
Article 14	Entry into Force of the Agreement	PCT Articles 32(3) and 16(3)(e)
Article 15	Duration and Renewability of the Agreement	PCT Articles 32(3) and 16(3)(e)
Article 16	Amendment	
Article 17	Termination of the Agreement	PCT Articles 32(3) and 16(3)(e)