

# WIPO



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**WORLD INTELLECTUAL PROPERTY ORGANIZATION**

GENEVA

**INTERNATIONAL PATENT COOPERATION UNION  
(PCT UNION)**

**MEETING OF INTERNATIONAL AUTHORITIES  
UNDER THE PATENT COOPERATION TREATY (PCT)**

**Fourteenth Session  
Geneva, February 5 to 7, 2007**

**RENEWAL OF AGREEMENTS BETWEEN  
THE INTERNATIONAL AUTHORITIES AND THE INTERNATIONAL BUREAU**

*Document prepared by the Secretariat*

## SUMMARY

1. The agreements between the International Bureau and the International Searching and Preliminary Examining Authorities all expire on December 31, 2007. New agreements will need to be approved by the PCT Assembly when it meets in September–October, 2007. International Authorities are invited to discuss a new draft model agreement, on which the individual agreements would then be based.

## BACKGROUND

2. The desirability of a consistent approach to agreements in relation to operation as an International Authority has long been recognized. Consequently, the PCT Assembly, at its 24th session in September–October 1997 approved the new texts of agreements lasting for a period of 10 years, from January 1, 1998, to December 31, 2007; those agreements which have subsequently been approved have been in a similar form, ending on the same date.

3. All of the Offices which have been appointed by the Assembly as an International Authority have been invited to begin negotiations to renew their respective agreements, beginning with a discussion of common issues by this Meeting, with the aim of establishing a common model agreement on which to base individual agreements.

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4. Negotiations of individual agreements will need to be completed by the end of July 2007 to enable the final draft agreements to be submitted for approval by the PCT Assembly in September–October 2007. In accordance with PCT Articles 16(3)(e) and 32(3), the PCT Committee for Technical Cooperation will be convened during the same period to give its advice to the Assembly on the extension of the appointments of the International Authorities.

#### MODEL AGREEMENT

5. The appendix contains a draft model agreement between an International Authority and the International Bureau. The proposed contents of the new model agreement are very similar to the existing agreements. The main changes are:

(a) the Preamble is restricted to a single recital noting that the appropriate appointment and approval processes have been completed by the Assembly;

(b) Article 2(3) contains a specific reference to the need for quality management systems to reflect the importance of the matter, reflecting a similar change to Rules 36 and 63 which will enter into force on April 1, 2007;

(c) to update terminology and references reflecting the amendments of the Rules since the previous agreements were concluded and the replacement of the separate PCT International Search Guidelines and PCT International Preliminary Examination Guidelines by the (combined) PCT International Search and Preliminary Examination Guidelines; and

(d) to adopt consistent terminology in cases where minor differences exist at present without any apparent difference in intention or meaning.

6. The Meeting may wish to consider the need for a common model for provisions relating to the temporary limitation of competence or contracting out of work to other Offices, such as that which currently appears in Article 3(4) in the agreement between the International Bureau and the European Patent Office. That provision is therefore included in the Appendix in square brackets, though clearly it would require significant revision if it were to be adopted as an optional part of the common model.

7. The greatest differences between the current agreements naturally lie in their Annexes, which permit the setting by Authorities of their specific fees, competence and the like. They all follow the same basic structure and it is not proposed to attempt to further align their contents at this time. However, it should be noted that Part II of Annex C will need to be modified in the case of some agreements, which refer to specific cases where a demand is considered as if it had not been submitted, to take account of the subsequent amendment of the relevant Rules.

8. *The Meeting is invited to comment on the draft model agreement contained in the Appendix.*

[Appendix follows]

APPENDIX

DRAFT MODEL AGREEMENT BETWEEN  
AN INTERNATIONAL AUTHORITY  
AND THE INTERNATIONAL BUREAU<sup>1</sup>

Agreement

between the PARTY

and the International Bureau of the World Intellectual Property Organization

in relation to the functioning of the OFFICE

as an International Searching Authority

and International Preliminary Examining Authority

under the Patent Cooperation Treaty

*Preamble*

The PARTY and the International Bureau of the World Intellectual Property Organization,

~~[Considering that the Agreement of DATE under Articles 16(3)(b) and 32(3) of the Patent Cooperation Treaty in relation to the functioning of OFFICE as an International Searching Authority and International Preliminary Examining Authority under the Patent Cooperation Treaty was concluded for a period of 10 years from DATE to DATE],~~

~~*Desirous to continue the functioning of OFFICE as an International Searching Authority and International Preliminary Examining Authority under the Patent Cooperation Treaty,*~~

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<sup>1</sup> Proposed additions and deletions compared to the contents of a typical current agreement are indicated, respectively, by underlining and striking through the text concerned.

Considering that the PCT Assembly, having heard the advice of the PCT Committee for Technical Cooperation, has appointed the Authority as an International Searching and Preliminary Examining Authority under the Patent Cooperation Treaty and approved this Agreement in accordance with Articles 16(3) and 32(3):

[COMMENT: Most of the agreements concluded in 1997 have recitals approximately the same as those shown in ~~strikeout~~, above. Those agreements concluded most recently have no recitals. The recitals containing details of previous agreements have caused slight confusion and been treated inconsistently when the agreements have subsequently been amended. Consequently, it is proposed that the only common recital should be an indication that the appropriate appointment and approval has taken place within the PCT Assembly.]

Hereby agree as follows:

*Article 1*

*Terms and Expressions*

- (1) For the purposes of this Agreement:
  - (a) “Treaty” means the Patent Cooperation Treaty;
  - (b) “Regulations” means the Regulations under the Treaty;
  - (c) “Administrative Instructions” means the Administrative Instructions under the Treaty;
  - (d) “Article” (except where a specific reference is made to an Article of this Agreement) means an Article of the Treaty;
  - (e) “Rule” means a Rule of the Regulations;
  - (f) “Contracting State” means a State party to the Treaty;

(g) “the Authority” means the OFFICE;

(h) “the International Bureau” means the International Bureau of the World

Intellectual Property Organization.

[COMMENT: The agreement between the International Bureau and the European Patent Office also defines “Convention” as meaning the European Patent Convention since this is used elsewhere in that agreement. Clearly, this is not relevant to other Authorities.]

(2) All other terms and expressions used in this Agreement which are also used in the Treaty, the Regulations or the Administrative Instructions have, for the purposes of this Agreement, the same meaning as in the Treaty, the Regulations and the Administrative Instructions.

## *Article 2*

### *Basic Obligations*

(1) The Authority shall carry out international search and international preliminary examination in accordance with, and perform such other functions of an International Searching Authority and International Preliminary Examining Authority as are provided under, the Treaty, the Regulations, the Administrative Instructions and this Agreement.

(2) In carrying out international search and international preliminary examination, the Authority shall apply and observe all the common rules of international search and of international preliminary examination and, in particular, shall be guided by the PCT [International Search Guidelines](#) and ~~the PCT~~ Preliminary Examination Guidelines.

[COMMENT: The change simply reflects the introduction of the new combined Guidelines replacing the old separate search and examination Guidelines.]

(3) The Authority shall maintain a quality management system in compliance with the requirements set out in the PCT International Search and Preliminary Examination Guidelines.

[COMMENT: In view of the amendments adopted by the PCT Assembly to Rules 36 and 63, it seems desirable to have a specific reference to quality management systems.]

(24) The Authority and the International Bureau shall, having regard to their respective functions under the Treaty, the Regulations, the Administrative Instructions and this Agreement, render, to the extent considered to be appropriate by both the Authority and the International Bureau, mutual assistance in the performance of their functions thereunder.

### *Article 3*

#### *Competence of Authority*

(1) The Authority shall act as International Searching Authority for any international application filed with the receiving Office of, or acting for, any Contracting State [specified in Annex A to this Agreement], provided that the receiving Office specifies the Authority for that purpose, that such application, or a translation thereof furnished for the purposes of international search, is in the language or one of the languages specified in Annex A to this Agreement and, where applicable, that the Authority has been chosen by the applicant.

[COMMENT: The words in square brackets are omitted in the case of Authorities which are willing to act as International Searching Authority for applications filed with any receiving Office.]

(2) The Authority shall act as International Preliminary Examining Authority for any international application filed with the receiving Office of, or acting for, any Contracting State [specified in Annex A to this Agreement], provided that the receiving Office specifies the Authority for that purpose, [that such application, or a translation thereof furnished for the purposes of international preliminary examination, is in the language or one of the languages specified in Annex A to this Agreement] and, where applicable, that the Authority has been chosen by the applicant [and that any other requirements regarding such application as specified in Annex A to this Agreement have been met].

[COMMENT: The words in the first square brackets are omitted in the case of Authorities which are willing to act as International Preliminary Examining Authority for applications filed with any receiving Office. The European Patent Office replaces the words in the second square brackets with a limitation on competence to those international applications for which the international search was performed either that Office or an Office of a State party to the European Patent Convention. Other Authorities which limit their competence to international applications on which they performed the international search do so by including the words in the final set square brackets and stating this limitation within Annex A.]

(3) Where an international application is filed with the International Bureau as receiving Office under Rule 19.1(a)(iii), paragraphs (1) and (2) apply as if that application had been filed with a receiving Office which would have been competent under Rule 19.1(a)(i) or (ii), (b) or (c) or Rule 19.2(i).

[(4)(a) Notwithstanding paragraphs (1) and (2), if the work load of the Authority reaches such a level that, because of its then existing facilities, it cannot perform the tasks assumed by it under this Agreement without risks for its proper functioning under the Convention, the Authority may

(i) entrust any industrial property Office of a State party to the Convention with work in respect of international search or international preliminary examination to be carried out under the responsibility of the Authority;

(ii) notify the International Bureau either that it will not carry out international search or international preliminary examination or both in respect of international applications filed with any receiving Office of or acting for a State whose nationals or residents may choose that Office acting as an International Searching and/or International Preliminary Examining Authority or that it will carry out international search or international preliminary examination or both in respect of such international applications but only for a given number of applications each year or only in respect of certain fields of technology.

(b) Any limitation under subparagraph (a)(ii) shall take effect on the date agreed upon between the receiving Office and the Authority and specified in the notification, provided that that date is at least one month later than the date on which the notification is received by the International Bureau. If such a date is not agreed upon by the receiving Office and the Authority, the limitation shall take effect three months from the date of receipt of the notification by the Authority to the International Bureau. The International Bureau shall promptly publish in the Gazette any notification under this subparagraph.

(c) The initial duration of any limitation under subparagraph (a)(ii) shall not exceed a period of three years and may be extended one or more times for a period not exceeding two years provided that notice of three months is given prior to the expiration of the preceding period.]

[COMMENT: The European Patent Office's agreement includes the above Article 3(4) whereby, if the work load of the Authority reaches a level where it cannot perform the tasks assumed by it under the agreement without risks for the proper functioning of the Office under the European Patent Convention, the Office may either entrust work to other IP Offices party to the European Convention or limit its competence as an International Authority in various ways. The Meeting may wish to consider whether a common format for this type of clause may be useful if other Offices wish to allow for such possibilities. See paragraph 6 of the main body of this document.]



*Article 4*

*Subject Matter Not Required to Be Searched or Examined*

The Authority shall not be obliged to search, by virtue of Article 17(2)(a)(i), or examine, by virtue of Article 34(4)(a)(i), any international application to the extent that it considers that such application relates to subject matter set forth in Rule 39.1 or 67.1, as the case may be, with the exception of the subject matter specified in Annex B to this Agreement.

*Article 5*

*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 functions as an International Searching Authority and International Preliminary Examining Authority, is set out in Annex C to this Agreement.

[COMMENT: Some current agreements say “function” rather than “functions”. The latter would appear to be preferable.]

(2) The Authority shall, under the conditions and to the extent set out in Annex C to this Agreement:

(i) refund the whole or part of the search fee paid, or waive or reduce the search fee, where the international search report can be wholly or partly based on the results of an earlier search made by the Authority (Rules 16.3 and 41.1);

[COMMENT: This provision would need to be modified if the relevant Rules were amended to permit searches made by Offices other than the Authority to be taken into account, as suggested in document PCT/MIA/14/5.]

(ii) refund the search fee where the international application is withdrawn or considered withdrawn before the start of the international search.

(3) The Authority shall, under the conditions and to the extent set out in Annex C to this Agreement, refund the whole or part of the preliminary examination fee paid where the demand is considered as if it had not been submitted (Rule 58.3) or where the demand or the international application is withdrawn by the applicant before the start of the international preliminary examination.

### *Article 6*

#### *Classification*

[For the purposes of Rules 43.3(a) and 70.5(b), the Authority shall indicate solely the International Patent Classification.][The Authority shall indicate the International Patent Classification for the purposes of Rules 43.3(a) and 70.5(b) and may also apply the *relevant national classification system*.]

[COMMENT: All Authorities except the United States Patent and Trademark Office presently use the first option. Consequently the words “relevant national classification system” in practice refer to the “United States Patent Classification”.]

### *Article 7*

#### *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 or one of the languages indicated, having regard to the language or languages indicated in Annex A and to the language or languages whose use is authorized by the Authority under Rule 92.2(b), in Annex D.

*Article 8*

*International-Type Search*

The Authority shall carry out international-type searches to the extent decided by it.

*Article 9*

*Entry into Force*

This Agreement shall enter into force on January 1, ~~1998~~ 2008.

[COMMENT: The existing agreements in fact contain a variety of provisions in this Article, due to the fact that some Offices were commencing operation as an Authority for the first time at a date which was to be decided in different ways, or else relating to entry into force of amendments. These differences are not relevant to the renewal of existing agreements.]

*Article 10*

*Duration and Renewability*

This Agreement shall remain in force until December 31, ~~2007~~ 2017. The parties to this Agreement shall, no later than January ~~2007~~ 2017, start negotiations for its renewal.

[COMMENT: It is suggested that, as for those agreements adopted in 1997, the new agreements should last for a period of 10 years, and that any new agreements or amendments concluded subsequently should last until the end of 2017 so as to expire at the same time.]

*Article 11*

*Amendment*

(1) Without prejudice to paragraphs (2) and (3), amendments may, subject to approval by the Assembly of the International Patent Cooperation Union, be made to this Agreement by agreement between the parties hereto; they shall take effect on the date agreed upon by them.

(2) Without prejudice to paragraph (3), amendments may be made to the Annexes to this Agreement by agreement between the Director General of the World Intellectual Property Organization and the **PARTY Authority**; they shall take effect on the date agreed upon by them.

[COMMENT: At present, any changes to the Annexes need to be agreed or notified (in the case of paragraph (3), below) by the party to the Agreement. In cases where this is the minister, rather than the Office, this can add an apparently unnecessary burden and delay to the process of amending the Annexes.]

(3) The **PARTY Authority** may, by a notification to the Director General of the World Intellectual Property Organization:

(i) add to the indications of [States and] languages contained in Annex A to this Agreement;

[COMMENT: The inclusion of the words in square brackets depends on whether Article 3 allows for limitations of competence by State.]

(ii) amend the schedule of fees and charges contained in Annex C to this Agreement;

(iii) amend the indications of languages of correspondence contained in Annex D to this Agreement.

(4) Any amendment notified under paragraph (3) shall take effect on the date specified in the notification, provided that, for any increase of fees or charges contained in Annex C, that date is at least one month later than the date on which the notification is received by the International Bureau.

## *Article 12*

### *Termination*

(1) This Agreement shall terminate before December 31, 2007:

(i) if the PARTY 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 gives the PARTY 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, unless a longer period is specified in such notice or unless both parties agree on a shorter period.

In witness whereof the parties hereto have executed this Agreement.

Done at GENEVA, this DATE, in two originals in the LANGUAGE language[s, each text being equally authentic].

For the PARTY by:

For the International Bureau by:

NAME

NAME

SIGNATORY

Director General

World Intellectual Property Organization

*Annex A*

*[States and] Languages*

Under Article 3 of the Agreement, the Authority specifies[:

(i) the following States:

...

(ii) the following language[s]:

...

[COMMENT: For Authorities which do not provide for any limitation with respect to State in Article 3, only the item on languages is relevant. For some States, the list of States is separated into lists relating to Articles 3(1) and 3(2), differing by the additional requirement in relation to Article 3(2) that the Authority will only be competent as International Preliminary Examining Authority for applications for which it acted as International Searching Authority.]

*Annex B*

*Subject Matter Not Excluded from Search or Examination*

The subject matter set forth in Rule 39.1 or 67.1 which, under Article 4 of the Agreement, is not excluded from search or examination, is the following:

all subject matter searched or examined *[in national grants by the Office or under national patent law administered by the Office]*.

[COMMENT: The specific text at the end of this paragraph varies depending on the particular legal basis of patent processing by that Office.]

*Annex C*

*Fees and Charges*

*Part I. Schedule of Fees and Charges*

<i>Kind of fee or charge</i>	<i>Amount</i>
	<i>(Currency)</i>
Search fee (Rule 16.1(a))	...
Additional fee (Rule 40.2(a))	...
Preliminary examination fee (Rule 58.1(b))	...
<a href="#">[Late payment fee for preliminary examination</a>	<a href="#">amount as set out in Rule 58bis.2]</a>
Additional fee (Rule 68.3(a))	...
[Protest fee (Rules 40.2(e) and 68.3(e))	...]
[Late furnishing fee for sequence listings (Rule 13ter.1(c))	...]
Cost of copies (Rules 44.3(b), 71.2(b) and 94.1)	...

[COMMENT: Not all of the Authorities charge all of the fees. The amount of any late payment fee under Rule 58bis.2 is set in that Rule and is not a fixed amount. Nevertheless, in view of Article 5(1), it would seem that a reference is required in this Annex for any Authority which wishes to charge such a fee. For some Authorities, the cost of copies is set at different levels depending on the type of documents involved and may be charged either per document or per page. Fee reductions for applicants from developing countries are generally dealt with by footnotes to the amounts listed within this part, rather than by provisions within Part II, below.]



*Part II. Conditions for and Extent of Refunds or Reductions of Fees*

[COMMENT: This is the section within which there is currently the greatest variation between the various agreements. It is not proposed to align provisions on refunds and reductions of fees at this time. For information, most of the agreements include the following elements.]

(1) *[in all agreements]* Any amount paid by mistake, without cause, or in excess of the amount due, for fees indicated in Part I shall be refunded.

(2) *[in most agreements, but in once case combined with the case of item (5), below and making special further provisions]* Where the international application is withdrawn or considered withdrawn, under Article 14(1), (3) or (4), before the start of the international search, the amount of the search fee paid shall be fully refunded.

(3) *[A provision relating to the Authority benefiting from an earlier search, providing for refunds of a specified amount or of proportions between 25% and 50% of the international search fee]*

(4) *[A provision relating to refund of international preliminary examination fees under Rule 58.3. Some agreements make different provisions depending on the basis on which a demand has been considered not to have been submitted and refer to Rules 54.4(a), 57.4(c), 58.2(c) and 60.1(c). In view of the amendments to the Rules since the agreements were adopted, these will need revision. The relevant provisions are now Rules 54.4, 54bis.1(b), 58bis.1(b) and 60.1(c).]*

(5) *[A provision relating to refund of preliminary examination fees where the international application or the demand is withdrawn before the start of international preliminary examination, providing for refunds of the whole fee, 75% of the fee or the amount of the fee paid, less a processing fee. The European Patent Office's agreement also allows for it to lay down further refunds of this fee under its own conditions.]*

*Annex D*

*Languages of Correspondence*

Under Article 7 of the Agreement, the Authority specifies the following language[s]:

...

[noting that the language of correspondence shall be the language in which the international application is filed or translated, as the case may be.][depending on the language in which the international application is filed or translated, or, at the applicant's choice, ... .]

[COMMENT: For those Authorities processing international applications in more than one language, the agreements contain a number of variations, generally to the effect of one of the two options shown in square brackets above. In most cases, the language is required to be the same as that in which the international application was filed or, where applicable, translated. Some Authorities also offer the option of correspondence in the "main" language(s) of the Authority irrespective of the language of filing or translation.]

[End of appendix and of document]