

Meeting of International Authorities under the Patent Cooperation Treaty (PCT)

**Twenty-Sixth Session
Cairo, February 13 to 14, 2019**

**APPOINTMENT AS AN INTERNATIONAL SEARCHING AND PRELIMINARY
EXAMINING AUTHORITY (ISA/IPEA) AND DECLARATION BY RECEIVING OFFICES
AS COMPETENT ISA/IPEA**

Document prepared by the Indian Patent Office

BACKGROUND

PROCEDURE FOR APPOINTMENT OF INTERNATIONAL AUTHORITIES UNDER THE PCT

1. The appointment of International Searching Authorities (ISAs) and International Preliminary Examining Authorities (IPEAs) under the Patent Cooperation Treaty (PCT) is a matter for the PCT Assembly and is governed by Articles 16(3) and 32(3) of the PCT. It follows from Rules 36.1(iv) and 63.1(iv) of the Regulations under the PCT that any appointment will be as both an ISA and an IPEA. The requirements to be met for appointment as International Authority are common for all Member States.
2. The candidate Office indicates that it wishes to seek appointment by the PCT Assembly as an ISA/IPEA and submits the application along with supporting documents. In conformity with Articles 16(3)(e) and 32(3) of the PCT, the PCT Committee for Technical Cooperation (PCT/CTC) gives its advice on the appointment of the candidate Office as an ISA and IPEA. Under Articles 16(3)(b) and 32(3) of the PCT, the appointment of an ISA and IPEA is conditional on the conclusion of a standard Agreement, subject to approval by the Assembly, between the Office or organization concerned and the International Bureau.
3. The Assembly hears the representative of the candidate Office, takes into account the recommendations of the PCT Committee for Technical Cooperation (PCT/CTC), approves the draft of the Agreement between the Office and the International Bureau and appoints the Office as an International Searching Authority and International Preliminary Examining Authority.

AGREEMENT WITH THE INTERNATIONAL BUREAU AND DECLARATION AS COMPETENT ISA/IPEA BY RECEIVING OFFICES

4. As per Rule 19 of the Regulations under the PCT, the international application can be filed:

- with the national Offices of or acting for the Contracting State of which the applicant is a resident or a national, or
- irrespective of the Contracting State of which the applicant is a resident or national, with the International Bureau.

5. Thus, each receiving Office (RO) specifies the International Searching and Preliminary Examining Authorities competent for the search and examination of international applications filed with such Office. This is applicable to the international applications filed with the International Bureau as RO by its nationals/residents. This is based on the Agreement by each International Authority with the International Bureau wherein the Authority too states which of the Contracting States for which it will act. Thus the applicant can choose only those ISAs and IPEAs that are declared competent by the receiving Offices of the country of the applicant's nationality/residence.

6. Annex A of the Agreement between an International Authority and WIPO states:

“Where a receiving Office specifies the International Authority under Articles 3(1) and (2) [competent ISA and IPEA], the International Authority shall become competent for international applications filed at that receiving Office from a date to be agreed by the receiving Office and International Authority and to be notified to the International Bureau.”

7. Thus even when an International Authority is ready to act as ISA/IPEA for applications filed by the nationals/residents of other Member States, the applicants can choose the International Authority only if the receiving Office of such Member State has declared the International Authority as competent for its applicants.

PROPOSAL

8. According to the existing mechanism, once the PCT Assembly appoints an Office as an International Authority, practically the applicants who are nationals/residents of any of the Member States of the PCT are not able to choose the Authority as ISA or IPEA for their International Applications. The step of “declaring as competent ISA/IPEA” by the receiving Offices of each Member State adds a further step of bilateral recognition by each of the Member States. This has an overriding effect on the recognition/appointment already secured following the due process in which all Member States were already part of the decision-making.

9. In today's world, research and production are widely spread across many countries involving a great level of collaboration among countries. The businesses are also transnational with multiple partners for research, production, marketing etc. The need for patenting and the choice of Authority are decided by the applicants based on various factors. In case of multiple applicants from different countries, the applicants have more choice since selection of an ISA/IPEA is possible if at least one of the applicants is eligible to choose the Office as ISA/IPEA. Such a choice is not uniformly available to all applicants and there exists a need to shape the rules for the changing world.

10. In view of the above, the Indian Patent Office proposes that all Authorities may consider changes in the existing mechanism so that the International Authorities may act for all the States and the step of declaration as competent ISA/IPEA by the receiving Offices of each of the Member States of the PCT could be ultimately done away with so that the applicants who are nationals/residents of any of the Member States of the PCT may choose any of the

International Authorities as ISA for their international applications. As far as choice of IPEA is concerned, this choice may be based on which Authority was chosen as ISA for the application, if such condition applies for the IPEA. This change would make available more options to the applicants for better utilization of the PCT System. The cooperation among the International Authorities and among the Member States would be more meaningful as the Authorities recognize the services offered by other Authorities.

11. Certain technical hurdles that are foreseen in implementing this proposal would be the arrangements by receiving Offices for the transmittal of search fees and search copies to the ISAs. Until such arrangements are in place, either directly between Offices or through the International Bureau, it is proposed that to start with, the applicants filing international applications through the International Bureau as receiving Office (RO/IB) may be allowed the choice of any of the International Authorities as ISA/IPEA. Once the Authorities agree in principle to the proposal, such detailed modalities could be worked out.

12. The Indian Patent Office would like to invite all the Authorities to consider the above proposal and to present their views on its practical implementation.

13. The Meeting is invited to comment on the contents of the present document.

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