

WIPO



PCT/A/31/3
ORIGINAL:English
DATE:July24,2002

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

ASSEMBLY

Thirty-First (18th Extraordinary) Session
Geneva, September 23 to October 1, 2002

MATTERS CONCERNING THE PCT UNION:
AMENDMENT OF THE AGREEMENT BETWEEN THE JAPAN PATENT OFFICE AND
THE INTERNATIONAL BUREAU OF WIPO
IN RELATION TO THE FUNCTIONING OF THE JAPAN PATENT OFFICE AS AN
INTERNATIONAL SEARCHING AUTHORITY AND
PRELIMINARY EXAMINING AUTHORITY UNDER THE PCT

Document prepared by the International Bureau

1. In a letter addressed to the Director General dated June 12, 2002, the Commissioner of the Japan Patent Office has proposed modifications to the definition of its competence as an International Searching Authority and as an International Preliminary Examining Authority as set out in the Agreement between the Japan Patent Office and the International Bureau of WIPO in relation to the functioning of the Japan Patent Office as an International Searching Authority and Preliminary Examining Authority under the PCT. The Japan Patent Office has also proposed to update the name of the Office in the Agreement from "Japanese Patent Office" to "Japan Patent Office." A copy of such letter is reproduced in Appendix I to this document.¹

¹ Working documents for the session of the Assembly are accessible via WIPO's Website at <http://www.wipo.int/pct/en/meetings>.

2. Subject to approval of the proposed amended Agreement by the Assembly, and pursuant to Article 11(3)(i) of the Agreement, Annex A (States and Languages) to the Agreement would be modified as indicated, for the purposes of information, in Appendix II to this document.

3. Reference is made to Article 11(1) of the existing Agreement which provides that “[...] 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.”

4. The Japan Patent Office and the International Bureau have agreed on the required amendments to the existing Agreement, the draft text of which appears in Appendix II to this document (text proposed to be added is underlined and text proposed to be deleted is struck through) and propose that the Agreement, as amended, enter into force upon approval by the Assembly and subsequent signature.

5. The Assembly of the PCT Union is invited to approve the text of the amended Agreement between the Japan Patent Office and the International Bureau, as appearing in Appendix II to this document.

[Appendices follow]



JAPAN PATENT OFFICE
MINISTRY OF ECONOMY, TRADE AND INDUSTRY
GOVERNMENT OF JAPAN

3-4-3Kasumigaseki,Chiyoda -ku,Tokyo100 -8915,JAPAN
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June 12, 2002

Dr.KamilIdris
DirectorGeneral
WorldIntellectualPropertyOrganization
34chemindesColombettes
1211Geneva20
Switzerland

DearDr.Idris:

TheJapanPatentOffice(JPO) availsitselfofthisopportunityto express its gratitude forthe cooperationthattheInternationalBureauhasbeenextendingtousforourservices as an International Searching Authority (IS A) and International Preliminary Examining Authority (IPEA) under the “Agreement between the Japanese Patent Office and the International Bureau of the World Intellectual Property Organization in relation to the functioning of the Japanese Patent Office as an International Searching Authority and InternationalPreliminaryExaminingAuthorityunderthePatentCooperationTreaty.”

Asyou areaware ,theJPOhasbeen acting sinceApril2,2001asanISAwhere an international applicationis writtenin English and filedwiththeJPOorthereceivingOffice of,oractingfor,anyContractingStatethattheAuthority willspecify .Ofsuch applications, meanwhile,theJPOhasbeencarryingoutinternationalpreliminaryexaminationsasanIPEA , pursuant to the relev ant Japanese law, only for those for which the JPO has prepared the International SearchReport(ISR) .

It is desirablethat the same authority should prepare an ISR and an International Preliminary Examination Report (IPER) for the same international appl ication.This point is in line with the direction of discussions within the framework of the PCT reform: simplificationandstreamliningofthesystem. However,thisconditionis notclearlystipulated intheaboveagreement despitethatit is provided in the relevant Japaneselaw.

TheJPOproposes,therefore,that Articles3and11aswellasAnnexAoftheabove agreementbe changed as per the attachment hereto in accordance with Article 11(1)of the sameagreement.

Ourproposalaimstobringintothea boveagreementtheconformitywiththecurrent Japaneselaw which provides that the JPO should act as an IPEA only for those applications

for which the JPO has prepared the ISR. Since the JPO has been acting in accordance with this particular provision of the Japanese law, our services to applicants will not be practically changed even if our proposed amendment is added to the agreement.

The JPO will make continuous efforts as an ISA and IPEA to enhance the quality of international search and international preliminary examination and for the development of the PCT system.

Sincerely yours,

(signed)

Kouzo Oikawa
Commissioner

[Appendix II follows]

Amended Agreement

between the ~~Japan Japanese~~ Patent Office and the International Bureau of the World Intellectual Property Organization

in relation to the functioning of the ~~Japan Japanese~~ Patent Office as an International Searching Authority and International Preliminary Examining Authority under the Patent Cooperation Treaty

Preamble

The ~~Japan Japanese~~ Patent Office and the International Bureau of the World Intellectual Property Organization,

Considering that the Agreement of ~~October 1, 1997~~ ~~September 28, 1987~~, under Articles 16(3)(b) and 32(3) of the Patent Cooperation Treaty in relation to the functioning of the ~~Japan Japanese~~ Patent 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 January 1, ~~1998~~ ~~1988~~, to December 31, ~~2007~~ ~~1997~~,

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

Hereby agrees 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 ~~Japan Japanese~~ Patent Office;
- (h) "the International Bureau" means the International Bureau of the World Intellectual Property Organization.

(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. 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 Search Guidelines and the PCT Preliminary Examination Guidelines.

(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, 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.

(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 requirement regarding such application as specified in Annex A to this Agreement have been met.

(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).

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 matters specified in Annex B to this Agreement.

Article 5
Fees and Charges

(1) As scheduled, 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.

(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);
- (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.

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, as amended, shall enter into force upon approval by the Assembly of the International Patent Cooperation Union and subsequent signature on January 1, 1998.

Article 10 Duration and Renewability

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

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 Authority; they shall take effect on the date agreed upon by them.

(3) The 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;
- (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 dates 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 Authority 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 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, 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 _____, in two originals in the English and Japanese languages, each text being equally authentic.

For the Japan Patent Office by:

For the International Bureau by:

(signature)
(name)
(function)
Japan Patent Office

(signature)
Kamil Idris
Director General
World Intellectual Property Organization

Annex A
States and Languages

Under Article 3 of the Agreement, the Authority specifies ~~the following languages:~~

- (i) ~~the following States, so far as Article 3(1) is concerned:
Japan and any State that the Authority will specify;~~
- (ii) ~~the following States, so far as Article 3(2) is concerned:
Where the Authority has prepared the international search report, Japan and
any State the Authority will specify;~~
- (iii) ~~the following languages:
Japanese and, where the international application is filed with the Japanese
Patent Office or the receiving Office of, or acting for, any Contracting State
that the Authority will specify, English.~~

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:

subject matter which is searched or examined in Japanese national applications.

Annex C
Fees and Charges

Part I. Schedule of Fees and Charges

Kind of fee or charge	Amount (Japanese yen)
Search fee (Rule 16.1(a))	72,000
Additional fee (Rule 40.2(a))	63,000
Preliminary examination fee (Rule 58.1(b))	28,000
Additional fee (Rule 68.3(a))	18,000
Cost of copies (Rules 44.3(b), 71.2(b) and 94.1), per document	1,400

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

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

(2) Where the Authority benefits from an earlier search to a considerable extent, the amount of 29,000 Japanese yen shall be refunded, upon request.

(3) In the cases provided for under Rule 58.3, the amount of the preliminary examination fee paid shall be fully refunded.

(4) As long as there is a refund of the search fee (in the case where the international application is withdrawn or considered withdrawn, under Article 14(1), (3) or (4), before the start of the international search) and there is a refund of the preliminary examination fee (in the case where the international application or the demand is withdrawn before the start of the international preliminary examination) continues not to be compatible with the national law applicable to the Authority, the Authority may abstain from refunding those fees.

Annex D **Languages of Correspondence**

Under Article 7 of the Agreement, the Authority specifies the following languages:
Japanese, English.

[End of Appendix II and of document]