

WIPO



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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

ASSEMBLY

Twenty-First Session (9th Ordinary)*
Geneva, September 20 to 29, 1993

MATTERS CONCERNING THE PCT UNION
(SECOND ADDENDUM)

Memorandum prepared by the International Bureau

* *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

APPOINTMENT OF THE SPANISH PATENT AND TRADEMARK OFFICE
AS
INTERNATIONAL SEARCHING AUTHORITY

1. The Spanish Government has requested that, under Article 16 of the PCT, the Spanish Patent and Trademark Office be appointed as an International Searching Authority in the twenty-first session of the Assembly of the PCT Union, to take place in September 1993.
2. Article 16 of the PCT provides that "International Searching Authorities shall be appointed by the Assembly [of the PCT Union]" (paragraph (3) (a)), that "Any national Office... satisfying the requirements referred to in subparagraph (c) may be appointed as International Searching Authority" (ibidem) , that "Appointment shall be conditional on the consent of the national Office...to be appointed and the conclusion of an agreement, subject to approval by the Assembly, between such Office...and the International Bureau" (paragraph (3)(b)). The draft of the agreement is contained in the Annex.
3. Article 16 of the PCT also provides that "Before the Assembly makes a decision on the appointment of any national Office [as an International Searching Authority]..., the Assembly shall hear the interested Office...and seek the advice of the Committee for Technical Cooperation..." (paragraph (3)(e)). The said Committee has been convened for September 21 and 22, 1993; it will be seized of the present document, and its advice will be communicated to the Assembly when it meets from September 21 to 29, 1993. (This item will not be considered by the Assembly before the said Committee gives its advice.)
4. The said draft agreement is similar to those in force between WIPO and the presently existing International Searching Authorities and International Preliminary Examining Authorities, except on the points described in paragraph 5, below.
5. The Spanish Patent and Trademark Office will not function as an International Preliminary Examining Authority in view of the fact that Spain maintains a reservation under Article 64(1) (a) of the PCT to the effect that it is not bound by Chapter II. The minimum requirements set out in PCT Rule 36.1(ii) and (iii) for International Searching Authorities are complied with. The minimum requirements set out in PCT Rule 36.1(i) will be met within three years from the entry into force of the agreement; a corresponding undertaking of the Spanish Patent and Trademark Office is contained in Article 2(3) of the draft agreement set out in the Annex to this document. The agreement will enter into force upon approval by the Assembly of the PCT Union and subsequent signature and will remain in force until December 31, 1997. The date of termination of the agreement of December 31, 1997, would coincide with the termination dates of all other existing agreements between WIPO and the International Searching and Preliminary Examining Authorities.

6. The willingness of the Spanish Patent and Trademark Office to serve as an International Searching Authority is particularly welcome since there has not been up to now any International Searching Authority which has declared itself prepared to carry out international searches in respect of international applications filed in Spanish without the need for a translation.

7. The Assembly of the PCT Union is invited

(i) to hear the representative of the Spanish Patent and Trademark Office as required in Article 16(3) (e) of the PCT,

(ii) to approve the draft agreement between the Spanish Patent and Trademark Office and WIPO as set out in the Annex, and

(iii) to appoint the Spanish Patent and Trademark Office as an International Searching Authority with effect from the entry into force of the said agreement.

[Annex follows]

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ANNEX

AGREEMENT

between

the SPANISH PATENT AND TRADEMARK OFFICE

and the WORLD INTELLECTUAL PROPERTY ORGANIZATION

in relation to the functioning of

the SPANISH PATENT AND TRADEMARK OFFICE as

an International Searching Authority

under the Patent Cooperation Treaty

The Spanish Patent and Trademark Office and the World Intellectual Property Organization

hereby agree as follows:

Article 1

Terms and Expressions Used in the Agreement

- (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) “Authority” means the Spanish Patent and Trademark Office;

(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 in accordance with, and perform such other functions of an International Searching Authority as are provided under the Treaty, the Regulations, the Administrative Instructions and this Agreement. In carrying out international search, the Authority shall be guided by the Guidelines for International Search to Be Carried Out under the Patent Cooperation Treaty. The Authority shall apply and observe all the common rules of international search.

(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 possible, mutual assistance in the performance of their functions thereunder.

(3) The Authority undertakes to comply with the conditions laid down in Rule 36.1(i) within three years from the entry into force of this Agreement.

Article 3

Competence of Authority

The Authority shall act as an International Searching Authority for all international applications filed in the Spanish language with the receiving Office of, or acting for, any Contracting State where that Office has specified the Authority for that purpose.

Article 4

Subject Matter Not Required to Be Searched

The Authority shall not be obliged to search, by virtue of Article 17(2) (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, with the exception of the subject matter specified in Annex A of 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 function as an International Searching Authority, is set out in Annex B of this Agreement.

(2) The Authority shall, under the conditions and to the extent set out in Annex B of this Agreement, refund the whole or part of the search fee paid where an 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) or where the international application is withdrawn or considered withdrawn before the start of the international search.

Article 6

Classification

For the purposes of Rule 43.3(a), 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 Spanish language.

Article 8

International-Type Search

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

Article 9

Entry into Force of the Agreement

This Agreement shall enter into force upon approval by the Assembly of the International Patent Cooperation Union and subsequent signature.

Article 10

Duration and Renewability of the Agreement

This Agreement shall remain in force until December 31, 1997. Latest in January 1997, the parties to this Agreement shall 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 of 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 notice in writing given to the Director General of the World Intellectual Property Organization, amend the schedule of fees and other charges contained in Annex B of this Agreement.

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

Article 12

Termination of the Agreement

(1) This Agreement shall terminate before December 31, 1997:

(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, thisth day of, 1993 in two originals in the English and Spanish languages, each text being equally authentic.

For the Authority by:

For the World Intellectual Property
Organization by:

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ANNEX A

SUBJECT MATTER NOT EXCLUDED
FROM SEARCH

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

None.