

WIPO



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WORLD INTELLECTUAL PROPERTY ORGANIZATION

GENEVA

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

ASSEMBLY

**Thirtieth (13th Ordinary) Session
Geneva, September 24 to October 3, 2001**

APPOINTMENT OF THE SPANISH PATENT AND TRADEMARK OFFICE AS
AN INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY; AMENDMENT
OF THE AGREEMENT BETWEEN THE SPANISH PATENT AND TRADEMARK
OFFICE AND THE INTERNATIONAL BUREAU OF WIPO

Document prepared by the International Bureau

1. In a letter addressed to the Director General dated June 4, 2001, the Director General of the Spanish Patent and Trademark Office expressed the wish that the Spanish Patent and Trademark Office be appointed as an International Preliminary Examining Authority (IPEA) under the Patent Cooperation Treaty (PCT). An English translation (prepared by the International Bureau) of such letter is reproduced as Annex I to this document.
2. The Spanish Patent and Trademark Office had been appointed as an International Searching Authority (ISA) with effect from September 22, 1993.
3. PCT Article 32(3) extends, *mutatis mutandis*, to the appointment of International Preliminary Examining Authorities the provisions laid down by PCT Article 16(3) in relation to the appointment of International Searching Authorities. PCT Article 16(3)(b) provides that "Appointment shall be conditional on the consent of the national Office or intergovernmental organization to be appointed and the conclusion of an agreement, subject to approval by the Assembly, between such Office or organization and the International Bureau." The appointment of the Spanish Patent and Trademark Office as IPEA would therefore also require amendments to the existing Agreement between that Office and the International Bureau in order to include in its scope the functions of the Spanish Patent and Trademark Office as IPEA, in addition to those as ISA. Reference is also 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 Spanish Patent and Trademark Office and the International Bureau have agreed on the required amendments to the existing Agreement, the draft text of which appears as Annex II to this document (text proposed to be added is underlined and text proposed to be deleted is struck through). Noting that the Spanish Patent and Trademark Office does not intend to start functioning as an IPEA until some time in 2002, the Office and the International Bureau propose that the Agreement, as amended, enter into force, and, consequently, that the appointment of the Office as IPEA have effect, one month after the date on which the Office will notify the Director General that it is ready to start functioning as an IPEA.

5. *The Assembly of the PCT Union is invited:*

- (i) *to appoint the Spanish Patent and Trademark Office as International Preliminary Examining Authority, with effect as indicated in paragraph 4, above;*
- (ii) *to approve the text of the amended Agreement between the Spanish Patent and Trademark Office and the International Bureau, as appearing in Annex II to this document.*

[Annexes follow]

PCT/A/30/5
ANNEX I

[Original: Spanish; English translation by
the International Bureau of WIPO]

Spanish Patent and Trademark Office
Madrid - Spain

June 4, 2001

Dr. Kamil Idris
Director General
World Intellectual Property Organization

As you well know, the Spanish Patent and Trademark Office (SPTO) has been an International Searching Authority under the Patent Cooperation Treaty since 1993.

Thanks to the important efforts carried out during the last eight years, as well as during the previous preparatory years, the SPTO has earned great international prestige as an International Searching Authority for Spanish language applications. Its outstanding performance has been internationally acknowledged by the Iberoamerican PCT Contracting States, the World Intellectual Property Organization itself and the European Patent Office. A cooperation agreement on international searches was signed with the latter and the Swedish Patent and Registration Office in 1999.

In view of these results in the field of international searches, the Spanish Authorities consider that the time is ripe for the SPTO to request the status of International Preliminary Examining Authority in the framework of the Patent Cooperation Treaty; and the role of the SPTO in the PCT system would be complete. The introduction of substantive examination in the national patent granting procedure and compliance with all PCT requirements for becoming an International Preliminary Examining Authority are two factors that fully enable us to become such an Authority.

This interest has been expressed by the Spanish Authorities more than once and, specifically, on the occasion of your important visit to Spain early this year.

For all these reasons, Director General, let me confirm our interest and desire that the SPTO be appointed as a PCT International Preliminary Examining Authority and ask you to initiate the procedure to submit, as early as possible, the corresponding Agreement between the International Bureau and the SPTO to the PCT Assembly.

Let me express once more my highest regard for you.

(signed)

José López Calvo
Director General
Spanish Patent and Trademark Office

[Annex II follows]

DRAFT

Amended Agreement

between the Spanish Patent and Trademark Office
and the International Bureau of the World Intellectual Property Organization

in relation to the functioning of the Spanish Patent and Trademark Office
as an International Searching Authority and
International Preliminary Examining Authority
under the Patent Cooperation Treaty

Preamble

The Spanish Patent and Trademark Office and the International Bureau of the World Intellectual Property Organization,

Considering that the Agreement of ~~September 22, 1993~~ October 1, 1997, under Article 16(3)(b) of the Patent Cooperation Treaty in relation to the functioning of the Spanish Patent and Trademark Office as an International Searching Authority under the Patent Cooperation Treaty entered into force on ~~September 22, 1993~~ October 1, 1998, and will remain into force until ~~December 31, 1997~~ December 31, 2007,

Considering Article 32(3) of the Patent Cooperation Treaty in relation to the functioning of national Offices and intergovernmental organizations as International Preliminary Examining Authorities under the Patent Cooperation Treaty,

Desirous to continue the functioning of the Spanish Patent and Trademark Office as an International Searching Authority and to start its functioning as an International Preliminary Examining Authority, under the Patent Cooperation Treaty,

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 Spanish Patent and Trademark 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 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 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, that, where applicable, 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.

~~(2)~~(3) Where an international application is filed with the International Bureau as receiving Office under Rule 19.1(a)(iii), paragraphs (1) and (2) applies 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 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 function 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 on January 1, 1998 one month after the date on which the Authority notifies the Director General of the World Intellectual Property Organization that it is ready to start functioning as an International Preliminary Examining Authority.

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 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 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 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 third day of October 2001, in two originals in the English and Spanish languages, each text being equally authentic.

For the Spanish Patent and
Trademark Office by:

José López Calvo
Director General
Spanish Patent and Trademark Office

For the International Bureau by:

Kamil Idris
Director General
World Intellectual Property Organization

**Annex A
Languages**

Under Article 3 of the Agreement, the Authority specifies the following language:

Spanish.

**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:

~~none~~ all subject matter searched or examined in Spanish national applications.

**Annex C
Fees and Charges**

Part I. Schedule of Fees and Charges

Kind of fee or charge	Amount (Spanish pesetas)	Amount (Euros)
Search fee (Rule 16.1(a))	157,235 ¹	945 ¹
Additional fee (Rule 40.2(a))	157,235 ¹	945 ¹
<u>Preliminary examination fee (Rule 58.1(b))</u>	<u>78,860</u>	<u>473.96</u>
<u>Additional fee (Rule 68.3(a))</u>	<u>78,860</u>	<u>473.96</u>
Cost of copies (Rules 44.3(b) and 71.2(b))		
– national documents, per document	610	3.67
– foreign documents, per document	859	5.16
<u>Cost of copies (Rule 94.2) per document</u>	<u>37</u>	<u>0.22</u>

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 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) Where the Authority benefits from an earlier search, 25%, 50%, 75% or 100% of the search fee paid shall be refunded, depending upon the extent to which the Authority benefits from that earlier search.

¹ This fee is reduced by 75% where the applicant or, if there are two or more applicants, each applicant is a natural person and is a national of and resides in a State not party to the European Patent Convention, which fulfils the requirements for the corresponding reduction of certain PCT fees as specified in the Schedule of Fees annexed to the PCT Regulations (see also corresponding footnote to the Annex C(IB) and PCT *Gazette* No. 50/1995, pages 19233 and 19234), and in accordance with the decision of the EPO's Administrative Council of October 11, 2000 (OJ EPO 2000, 446).

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

(5) When the international application or the demand is withdrawn before the start of the international preliminary examination, the amount of the preliminary examination fee paid shall be fully refunded.

Annex D
Languages of Correspondence

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

Spanish.

[End of Annexes and of document]