

WIPO



PCT/A/30/6

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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**

AMENDMENT OF THE AGREEMENT BETWEEN THE EUROPEAN PATENT
ORGANISATION AND THE INTERNATIONAL BUREAU OF WIPO
RELATING TO THE FUNCTIONING OF THE EUROPEAN PATENT OFFICE AS AN
INTERNATIONAL SEARCHING AND
PRELIMINARY EXAMINING AUTHORITY UNDER THE PCT

Document prepared by the International Bureau

1. In a letter addressed to the Director General dated July 10, 2001, the President of the European Patent Office (EPO) has proposed that the competence of the EPO as International Searching Authority (ISA) and International Preliminary Examining Authority (IPEA), which is currently universal, should be restricted; the relevant excerpts of the letter are reproduced below:

“[T]he EPO currently handles the majority of international applications as ISA and IPEA and is no longer in a position to deal with the ever increasing workload in international search and preliminary examination within the prescribed time limits. In some technical fields the backlog has already reached such an extent that urgent measures have had to be taken.

“In order to alleviate this situation, which is critical not only for the applicants concerned but for the integrity of the PCT system as a whole, a more balanced distribution of work amongst the PCT Authorities is a core issue.

“Currently the EPO accepts a universal competence as ISA and IPEA under Article 3 of the PCT Agreement whereas [...] other Authorities limit their competence to specific

contracting states. The continuing viability of the EPO as an international Authority under the PCT demands the inclusion of a clause enabling the EPO to restrict its competence in similar terms as the need arises.

“In this context, I would emphasize that the EPO does not intend in any way to alter its competence as regards:

- the EPO member states, for which the competence of the Office follows from Articles 154 and 155 EPC,
- PCT contracting states which do not have an international Authority of their own (developing countries in particular).

“We feel it is not essential to the proper functioning of the PCT however that applicants who have the option of filing at their “home” receiving Office which is also an ISA and IPEA should additionally be entitled to select the EPO in this capacity. I therefore propose pursuant to Article 11(1) of the Agreement that Article 3 be amended as follows: [...].

“It goes without saying that the EPO is willing to continue its fruitful cooperation with WIPO under the PCT. However, in order to do so the Office must preserve its proper functioning as a PCT Authority as well as the Office responsible for granting European patents. The proposed amendment will be an important step in that direction.”

2. 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.”

3. The European Patent Organisation and the International Bureau have agreed on the required amendments to the existing Agreement, the draft text of which appears in the Annex 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 on November 1, 2001).

4. The Assembly of the PCT Union is invited to approve the text of the amended Agreement between the European Patent Organisation and the International Bureau, as appearing in the Annex to this document.

[Annex follows]

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ANNEX

DRAFT

Amended Agreement

between the European Patent Organisation
and the International Bureau of the World Intellectual Property Organization

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

Preamble

The European Patent Organisation and the International Bureau of the World Intellectual Property Organization,

Considering that the Agreement of [January 1, 1998](#), ~~October 7, 1987~~, under Articles 16(3)(b) and 32(3) of the Patent Cooperation Treaty, as well as Articles 154 and 155 of the European Patent Convention, [as amended on November 1, 2001](#), in relation to the functioning of the European 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, 1988, to December 31, 1997~~, [January 1, 1998, to December 31, 2007](#),

Desirous to continue the functioning of the European Patent Office as an International Searching Authority and 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 European Patent Office;
 - (h) “the International Bureau” means the International Bureau of the World Intellectual Property Organization;
 - (i) “Convention” means the Convention on the Grant of European Patents (European Patent Convention).
- (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, for such application, the international search is or has been performed by the Authority or the industrial property Office of a State party to the Convention and, where applicable, that the Authority has been chosen by the applicant.

(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.

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.

(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~~ November 1, 2001.

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 President of the European Patent Office; they shall take effect on the date agreed upon by them.

(3) The President of the European Patent Office 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 European Patent Organisation 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 European Patent Organisation 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, French and German languages, each text being equally authentic.

For the European Patent Organisation by:

For the International Bureau by:

Ingo Kober
President
European Patent Office

Kamil Idris
Director General
World Intellectual Property Organization

**Annex A
Languages**

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

English, French, German, and, where the receiving Office is the industrial property Office of Belgium or the Netherlands, Dutch.

**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 under the European patent grant procedure in application of the equivalent provisions of the Convention.

**Annex C
Fees and Charges**

Part I. Schedule of Fees and Charges

Kind of fee or charge	Amount (Euro)
Search fee (Rule 16.1(a))	945 ¹
Additional fee (Rule 40.2(a))	945 ¹
Preliminary examination fee (Rule 58.1(b))	1,533 ¹
Additional fee (Rule 68.3(a))	1,533 ¹
Protest fee (Rules 40.2(e) and 68.3(e))	1,022
Cost of copies (Rules 44.3(b), 71.2(b) and 94.1), per page	0.60

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, upon request, be fully refunded.

(3) Where the Authority benefits from an earlier search (including a privately commissioned "standard" search) already made by the Authority on an application whose priority is claimed for the international application, the following refund of the search fee shall be made:

- (i) no supplementary search performed: refund of 100%;

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).

- (ii) supplementary search performed in the documentation relating to one or more subdivisions consulted in the earlier search or extended to one or more subdivisions not yet consulted: refund of 75%;
 - (iii) supplementary search performed in the documentation relating to one or more subdivisions already consulted and extended to one or more subdivisions not yet consulted: refund of 50%;
 - (iv) supplementary search performed in the documentation relating to subdivisions concerning a new aspect of the invention claimed (for instance, cases where the international application is based on several earlier applications only one of which was the subject of an earlier search report): refund of 25%.
- (4) In the cases provided for under Rule 58.3, the amount of the preliminary examination fee paid shall be fully refunded.
- (5) Where the international application or the demand is withdrawn before the start of the international preliminary examination, 75% of the preliminary examination fee paid shall be refunded.

Annex D **Languages of Correspondence**

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

English, French or German, depending on the language in which the international application is filed or translated.

[End of Annex and of document]