

International Patent Cooperation Union (PCT Union)

Assembly

Forty-Seventh (20th Ordinary) Session Geneva, October 5 to 14, 2015

AMENDMENT OF THE AGREEMENT CONCERNING THE FUNCTIONING OF THE STATE INTELLECTUAL PROPERTY SERVICE OF UKRAINE AS AN INTERNATIONAL SEARCHING AUTHORITY AND INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY UNDER THE PCT

Document prepared by the International Bureau

BACKGROUND

1. At its forty-fourth session, held in Geneva from September 23 to October 2, 2013, the Assembly appointed the State Intellectual Property Service of Ukraine (“the State Service”) as an International Searching Authority and International Preliminary Examining Authority under the PCT, and approved the text of a draft agreement between the State Intellectual Property Service of Ukraine and the International Bureau (documents PCT/A/44/4 Rev. and document PCT/A/44/5, paragraphs 31 to 36). The agreement was signed September 30, 2013.
2. Since then, the part of the Service responsible for administration of patent processing has become a separate unit titled “State Enterprise ‘Ukrainian Institute of Intellectual Property’” (“the State Enterprise”) (the official title in Ukrainian is “*Державне підприємство ‘Український інститут інтелектуальної власності’*”). The State Enterprise is independent of the State Service, but the State Service remains responsible for policy and oversight.
3. The State Enterprise retains all the examiners, search facilities, IT systems and other facilities and expertise described in document PCT/A/44/4 Rev. and is substantively the body which was appointed by the Assembly.

AMENDMENT OF AGREEMENT

4. The State Enterprise is almost ready to begin operation as an International Searching and Preliminary Examining Authority, but the State Service wishes to amend the agreement to reflect the current titles and relationships between the bodies concerned. The agreement will remain between the Service and the International Bureau, but the State Enterprise will act as the International Authority itself. Article 11(1) of the agreement indicates that amendments to the main body of the agreement are subject to the approval of the Assembly.

5. The proposed amendments are set out in the Annex to this document.

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

(i) to note the contents of document PCT/A/47/7; and

(ii) to approve the amendments to the agreement between the State Intellectual Property Service of Ukraine and the International Bureau as set out in the Annex to document PCT/A/47/7.

[Annex follows]

DRAFT AMENDMENTS TO THE AGREEMENT
BETWEEN THE STATE INTELLECTUAL PROPERTY SERVICE OF UKRAINE
AND THE INTERNATIONAL BUREAU
OF THE WORLD INTELLECTUAL PROPERTY ORGANIZATION

Agreement

between the State Intellectual Property Service of Ukraine
and the International Bureau of the World Intellectual Property Organization

in relation to the functioning of the ~~State Intellectual Property Service of Ukraine~~ State Enterprise “Ukrainian Institute of Intellectual Property”
as an International Searching Authority
and International Preliminary Examining Authority
under the Patent Cooperation Treaty

Preamble

The State Intellectual Property Service of Ukraine and the International Bureau of the World Intellectual Property Organization,

Considering that the PCT Assembly, having heard the advice of the PCT Committee for Technical Cooperation, has appointed the State Intellectual Property Service of Ukraine as an International Searching and Preliminary Examining Authority under the Patent Cooperation Treaty and approved this Agreement in accordance with Articles 16(3) and 32(3),

Considering that the State Enterprise “Ukrainian Institute of Intellectual Property” is responsible for patent processing activities on behalf of the State Intellectual Property Service of Ukraine.

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 ~~State Intellectual Property Service of Ukraine~~ State Enterprise “Ukrainian Institute of Intellectual Property”;

(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.

(2) 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 International Search and Preliminary Examination Guidelines.

(3) The Authority shall maintain a quality management system in compliance with the requirements set out in the PCT International Search and Preliminary Examination Guidelines.

(4) 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 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) The Authority shall conduct supplementary international searches in accordance with Rule 45*bis*, covering at least the documentation referred to in Annex E to this Agreement, subject to any limitations and conditions set out in that Annex.

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 (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 shall enter into force one month after the date on which the [Authority State Intellectual Property Service of Ukraine](#) notifies the Director General of the World Intellectual Property Organization through diplomatic channels that ~~it~~ [the Authority](#) is prepared to start functioning as an International Searching Authority and an International Preliminary Examining Authority.

Article 10
Duration and Renewability

This Agreement shall remain in force until December 31, 2017. The parties to this Agreement shall, no later than July 2016, 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 State Intellectual Property Service of Ukraine](#); and, notwithstanding paragraph (4), they shall take effect on the date agreed upon by them.

(3) The [Authority State Intellectual Property Service of Ukraine](#) 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;
- (iv) amend the indications and information concerning supplementary international searches contained in Annex E to this Agreement.

(4) Any amendment notified under paragraph (3) shall take effect on the date specified in the notification, provided that, for any change in the currency or amount of fees or charges contained in Annex C, for any addition of new fees or charges, and for any change in the conditions for and the extent of refunds or reductions of fees contained in Annex C, that date is at least two months 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, 2017:

(i) if the [Authority State Intellectual Property Service of Ukraine](#) gives the Director General of the World Intellectual Property Organization written notice, through diplomatic channels, to terminate this Agreement; or

(ii) if the Director General of the World Intellectual Property Organization gives the ~~Authority~~ [State Intellectual Property Service of Ukraine](#) written notice, through diplomatic channels, to terminate this Agreement.

(2) The termination of this Agreement under paragraph (1) shall take effect one year after receipt, through diplomatic channels, 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.

[Annexes to the agreement not reproduced here]

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