

International Patent Cooperation Union (PCT Union)

Assembly

Forty-Ninth (21st Ordinary) Session Geneva, October 2 to 11, 2017

EXTENSION OF APPOINTMENT OF THE INTERNATIONAL SEARCHING AND PRELIMINARY EXAMINING AUTHORITIES UNDER THE PCT

Document prepared by the International Bureau

1. The Canadian Commissioner of Patents has informed the International Bureau that it will not be possible to complete the relevant national processes for approval of the new agreement set out in Annex IV to document PCT/A/49/2 before December 31, 2017.
2. Consequently, it is proposed to take the same approach as that which has already been proposed in relation to the Australian Patent Office in document PCT/A/49/2, specifically:
 - (a) to maintain the extension of the appointment of the Canadian Commissioner of Patents as an International Searching and Preliminary Examining Authority until December 31, 2027, as proposed in paragraph 10(iii) of document PCT/A/49/2;
 - (b) to approve a draft agreement between the International Bureau and the Canadian Commissioner of Patents identical to the one proposed in document PCT/A/49/2 save that the date in Article 9 (Entry into Force) is replaced by a date to be determined at a later date; and
 - (c) to approve, in addition, the extension of the existing agreement between the International Bureau and the Canadian Commissioner for Patents for a period of up to one year pending the ratification of the new agreement, with the existing agreement ceasing automatically on entry into force of the new agreement.

3. Consequently, document PCT/A/49/2 is amended as follows:

(i) Paragraphs 8 and 9: references to the Canadian Commissioner of Patents are added so that these two paragraphs would read as follows:

“8. It is proposed that all agreements, ~~except that between the Australian Patent Office and the International Bureau, and that between the Canadian Commissioner of Patents and the International Bureau,~~ enter in force on January 1, 2018, following the expiration of the existing agreements.

“9. In the case of the Australian Patent Office ~~and the Canadian Commissioner of Patents,~~ it will not be possible for the ~~respective~~ Governments to complete the necessary domestic ratification procedures before the expiration of the existing agreements on December 31, 2017. Consequently, it is proposed to extend the existing agreements pending the ratification of the new agreements, with the existing agreements ceasing automatically on entry into force of the new agreements. Annexes II and IV to this document contains both the extension agreement and the new agreement with, ~~respectively,~~ the Australian Patent Office ~~and the Canadian Commissioner of Patents.~~”

[Note: the changes to both paragraphs are shown using underline and strikeout, but do not constitute part of the final text.]

(ii) Annex IV (Draft Agreement between the Canadian Commissioner of Patents and the International Bureau) is replaced by the Annex to this document, containing both the new draft extension agreement and the modified main draft agreement, as described in paragraph 2(b), above.

[Annex follows (replacing PCT/A/49/2 Annex IV)]

Amendment to the Agreement

between the Canadian Commissioner of Patents
and the International Bureau of the World Intellectual Property Organization

in relation to the functioning of the Canadian Commissioner of Patents
as an International Searching Authority
and International Preliminary Examining Authority
under the Patent Cooperation Treaty

Preamble

The Canadian Commissioner of Patents and the International Bureau of the World Intellectual Property Organization,

Considering that the Agreement between the Canadian Commissioner of Patents and the International Bureau of WIPO in relation to the functioning of the Canadian Commissioner of Patents as an International Searching Authority and International Preliminary Examining Authority under the Patent Cooperation Treaty (PCT) of December 13, 2007 (the Agreement), made under PCT Articles 16(3)(b) and 32(3), was concluded for a period of 10 years from January 1, 2008 to December 31, 2017,

Considering that the said Agreement has been amended in 2010, these amendments having been published in the PCT Gazette on July 22, 2010,

Considering that the Canadian Commissioner of Patents and the International Bureau of WIPO have already started negotiations for a new Agreement as provided under Article 10 therein,

Recognizing that the Canadian Commissioner of Patents will not be able to complete the necessary domestic procedures to ratify a new Agreement in relation to the functioning of the Canadian Commissioner of Patents as an International Searching Authority and International Preliminary Examining Authority under the Patent Cooperation Treaty, prior to the expiration of the Agreement on December 31, 2017;

Hereby agree as follows:

Article 1
Extension of the Agreement

(1) The Agreement between the Canadian Commissioner of Patents and the International Bureau of WIPO signed on December 13, 2007, including its amendments and Annexes, is hereby extended until December 31, 2018 or until the day before the entry into force of a new Agreement on the same subject matter in accordance with PCT Articles 16(3)(b) and 32(3) and with the domestic legal and constitutional procedures of Canada, whichever is sooner.

(2) Consequently, references made to "December 31, 2017" under Articles 10 and 12 of the Agreement are amended to "December 31, 2018", accordingly.

Article 2
Approval and entry into force

(1) In accordance with Article 11(1) of the Agreement, this amendment shall be subject to the approval of the Assembly of the International Patent Cooperation Union.

(2) Subject to paragraph 1 of this Article, this amendment shall take effect on December 31, 2017.

In witness whereof the parties hereto have executed this Agreement.

Done at *[city]*, this *[date]*, in two originals in the English and French languages, each text being equally authentic.

For the Canadian Commissioner of Patents
by:

For the International Bureau of the World
Intellectual Property Organization by:

Draft Agreement

between the Canadian Commissioner of Patents
and the International Bureau of the World Intellectual Property Organization

in relation to the functioning of the Canadian Commissioner of Patents
as an International Searching Authority
and International Preliminary Examining Authority
under the Patent Cooperation Treaty

Preamble

The Canadian Commissioner of Patents 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 Canadian Commissioner of Patents 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),

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 Canadian Commissioner of Patents;
 - (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 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 and that any other requirements regarding such application as specified in Annex A to this Agreement have been met.

(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 requirements 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).

(4) The Authority shall conduct supplementary international searches in accordance with Rule 45*bis* to the extent decided by it, as set out in Annex B to this Agreement.

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 C 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 D to this Agreement.

(2) The Authority shall, under the conditions and to the extent set out in Annex D 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 D 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 the classification of the subject matter according to the International Patent Classification. The Authority may, in addition, in accordance with Rules 43.3 and 70.5, indicate the classification of the subject matter according to any other patent classification specified in Annex E to this Agreement to the extent decided by it as set out in that Annex.

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 F.

Article 8
International-Type Search

The Authority shall carry out international-type searches to the extent decided by it as set out in Annex G to this Agreement.

Article 9
Entry into Force

This Agreement shall enter into force on *[date]*.

Article 10
Duration and Renewability

This Agreement shall remain in force until December 31, 2027. The parties to this Agreement shall, no later than July 2026, 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; and, notwithstanding paragraph (4), 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 indications on supplementary international searches contained in Annex B to this Agreement;

(iii) amend the schedule of fees and charges contained in Annex D to this Agreement;

(iv) amend the indications on patent classification systems contained in Annex E to this Agreement;

(v) amend the indications on languages of correspondence contained in Annex F to this Agreement;

(vi) amend the indications on international-type searches contained in Annex G to this Agreement.

(4) Any amendment notified under paragraph (3) shall take effect on the date specified in the notification, provided that:

(i) for an amendment to Annex B to the effect that the Authority shall no longer conduct supplementary international searches, that date is at least six months later than the date on which the notification is received by the International Bureau, and

(ii) for any change in the currency or amount of fees or charges contained in Annex D, 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 D, 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, 2027:

(i) if the Canadian Commissioner of Patents 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 Canadian Commissioner of Patents 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 *[city]*, this *[date]*, in two originals in the English and French languages, each text being equally authentic.

The Canadian Commissioner of Patents:

For the International Bureau of the World
Intellectual Property Organization by:

Annex A
States and Languages

Under Article 3 of the Agreement, the Authority specifies:

- (i) the following States for which it will act:

so far as Article 3(1) is concerned:

Canada, and the States regarded as developing countries in conformity with the established practice of the General Assembly of the United Nations;

so far as Article 3(2) is concerned:

where the Authority has prepared the international search report, Canada, and the States regarded as developing countries in conformity with the established practice of the General Assembly of the United Nations.

Where a receiving Office specifies the International Authority under Articles 3(1) and (2), the International Authority shall become competent for international applications filed at that receiving Office from a date to be agreed by the receiving Office and International Authority and to be notified to the International Bureau.

- (ii) the following languages which it will accept:

English, French.

Annex B
Supplementary International Search:
Documentation Covered; Limitations and Conditions

The Authority does not conduct supplementary international searches.

Annex C
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:

any subject matter which is searched or examined under the patent grant procedure in accordance with the provisions of Canadian patent law.

Annex D
Fees and Charges

Part I. Schedule of Fees and Charges

Kind of fee or charge	Amount (Canadian dollars)
Search fee (Rule 16.1(a))	1,600
Additional fee (Rule 40.2(a))	1,600
Preliminary examination fee (Rule 58.1(b))	800
Additional fee (Rule 68.3(a))	800
Cost of copies (Rules 44.3(b), 71.2(b), 94.1 <i>ter</i> and 94.2) in electronic form	
(a) for the first 7 megabytes, plus	10 ¹
(b) for each additional 10 megabytes or part thereof exceeding the first 7 megabytes	10 ¹
Cost of copies (Rules 44.3(b), 71.2(b) 94.1 <i>ter</i> and 94.2), per page (paper)	1 ¹

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 the results of an earlier search 25% of the amount of the search fee paid shall be refunded, depending on the extent to which an Authority benefits from that earlier search.

(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, the amount of the preliminary examination fee paid shall be fully refunded.

¹ With respect to Rules 44.3(b) and 71.2(b), in its capacity as an International Searching Authority, the Authority provides applicants with a first copy of all non-patent literature documents cited in the international search report, free of charge. A first copy of each non-patent literature document cited is made available to designated or elected Offices upon request, free of charge. In its capacity as an International Preliminary Examining Authority, the Authority makes a first copy of all additional non-patent literature documents cited in the international preliminary examination report but not cited in the international search report available to applicants and elected Offices upon request, free of charge.

Annex E
Classification

Under Article 6 of the Agreement, the Authority specifies the following classification system(s) in addition to the International Patent Classification: none.

Annex F
Languages of Correspondence

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

English, French.

Annex G
International-Type Search

Under Article 8 of the Agreement, the Authority specifies the following extent of international-type searches:

The Authority does not conduct international-type searches.

[End of Annex and of document]