

International Patent Cooperation Union (PCT Union)

Assembly

Fifty-Third (23rd Ordinary) Session
Geneva, October 4 to 8, 2021

**APPOINTMENT OF THE EURASIAN PATENT OFFICE AS AN INTERNATIONAL
SEARCHING AND PRELIMINARY EXAMINING AUTHORITY UNDER THE PCT**

Document prepared by the International Bureau

SUMMARY

1. The present document invites the Assembly to decide on the appointment of the Eurasian Patent Office (EAPO) as an International Searching and Preliminary Examining Authority under the Patent Cooperation Treaty (PCT), taking into account the advice by the PCT Committee for Technical Cooperation, which unanimously agreed to recommend to the Assembly that the Eurasian Patent Office be appointed. The Assembly is also invited to approve the text of the draft Agreement in relation to the functioning of the Eurasian Patent Office as an International Searching and Preliminary Examining Authority.

BACKGROUND

2. The appointment of International Searching Authorities (ISAs) and International Preliminary Examining Authorities (IPEAs) under the Patent Cooperation Treaty (PCT) is a matter for the Assembly and is governed by Articles 16(3) and 32(3) of the PCT. It follows from Rules 36.1(iv) and 63.1(iv) of the Regulations under the PCT that any appointment will be as both an ISA and an IPEA.

3. In a letter dated December 24, 2019, the President of EAPO, Ms. Saule Tlevlessova, requested the Director General of WIPO to convene a session of the Committee for Technical Cooperation (PCT/CTC) in order to give advice to the PCT Assembly concerning the appointment of EAPO as an International Searching Authority (ISA) and International Preliminary Examining Authority (IPEA) under the PCT, in conformity with the paragraph (c) of the procedures set out in the Understanding with regard to procedures for appointment of International Authorities, as modified by the Assembly at its fiftieth (29th extraordinary) session from September 24 to October 2, 2018. The International Bureau received the documentation in support of the application on March 3, 2020, in conformity with paragraph (e) of the procedures, noting that the Director General had convened the thirty-first session of the PCT/CTC to take place from May 26 to 29, 2020 in order to provide its advice on the application. Due to the COVID-19 pandemic, this session took place from October 5 to 8, 2020. This documentation is reproduced in the Annexes to the application for appointment presented to that session (document PCT/CTC/31/2 Rev).

ADVICE OF THE PCT COMMITTEE FOR TECHNICAL COOPERATION

4. In conformity with Articles 16(3)(e) and 32(3) of the PCT, the PCT Committee for Technical Cooperation gave its advice on the appointment of EAPO as an ISA and IPEA at its thirty-first session, held in Geneva from October 5 to 8, 2020. Paragraph 5 of document PCT/CTC/31/3 summarizes the advice by the Committee as follows:

“5. The Committee unanimously agreed to recommend to the Assembly of the PCT Union that the Eurasian Patent Office be appointed as an International Searching and Preliminary Examining Authority under the PCT.”

DRAFT AGREEMENT IN RELATION TO THE FUNCTIONING OF THE EURASIAN PATENT OFFICE AS AN INTERNATIONAL SEARCHING AND PRELIMINARY EXAMINING AUTHORITY

5. Under Articles 16(3)(b) and 32(3) of the PCT, the appointment of an ISA and IPEA is conditional on the conclusion of an Agreement, subject to approval by the Assembly, between the Office or organization concerned and the International Bureau. The text of a draft Agreement between the Eurasian Patent Organization and the International Bureau is set out in the Annex to this document.

6. If the Assembly agrees to the appointment, it would take effect upon entry into force of the Agreement between the Eurasian Patent Organization and the International Bureau. This would take place when EAPO is ready to begin operations as an International Authority. Paragraph (d) of the Understanding with regard to the procedures for appointment of International Authorities, as modified by the Assembly at its fiftieth (29th extraordinary) session from September 24 to October 2, 2018, provides details of this timing, as follows:

“(d) Any such application should be made on the understanding that the Office seeking appointment must meet all substantive criteria for appointment at the time of the appointment by the Assembly and is prepared to start operation as an International Authority as soon as reasonably possible following appointment, at the latest around 18 months following the appointment. With regard to the requirement that the Office seeking appointment must have in place a quality management system and internal review arrangements in accordance with the common rules of international search, where such system is not yet in place at the time of the appointment by the Assembly, it shall be sufficient that such system is fully planned and, preferably, that similar systems are already operational in respect of national search and examination work to demonstrate the appropriate experience.”

7. Under Article 10 of the draft Agreement, it would remain in force until December 31, 2027, which is the same date as all existing agreements between the International Bureau and Offices or organizations in relation to their functioning as an International Searching and Preliminary Examining Authority.

8. *The Assembly of the PCT Union is invited, in accordance with Articles 16(3) and 32(3) of the PCT:*

(i) to hear the Representative of the Eurasian Patent Office and take into account the advice of the PCT Committee for Technical Cooperation set out in paragraph 5 of document PCT/CTC/31/3;

(ii) to approve the text of the draft Agreement between the Eurasian Patent Organization and the International Bureau set out in the Annex to document PCT/A/53/1; and

(iii) to appoint the Eurasian Patent Office as an International Searching Authority and International Preliminary Examining Authority with effect from the entry into force of the Agreement until December 31, 2027.

[Annex follows]

Draft Agreement

between the Eurasian Patent Organization and the International Bureau of the World Intellectual Property Organization

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

Preamble

The Eurasian Patent Organization 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 Eurasian Patent Office 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 Eurasian Patent 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.

(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 a date to be notified to the Director General of the World Intellectual Property Organization by the Authority, that date being at least one month later than the date on which the notification is made.

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 Eurasian Patent Organization 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 Eurasian Patent Organization 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 Russian languages, each text being equally authentic.

For the Eurasian Patent Organization by:

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: any Contracting State;
- so far as Article 3(2) is concerned: any Contracting State.

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:
- Russian and English.

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 the Eurasian Patent Convention.

Annex D
Fees and Charges

Part I. Schedule of Fees and Charges

<i>Kind of fee or charge</i>	<i>Amount (Russian roubles)</i>
Search fee (Rule 16.1(a))	...
Additional fee (Rule 40.2(a))	...
Preliminary examination fee (Rule 58.1(b))	...
Late payment fee for preliminary examination	amount as set out in Rule 58bis.2
Additional fee (Rule 68.3(a))	...
Protest fee (Rules 40.2(e) and 68.3(e))	...
Late furnishing fee for sequence listings (Rules 13ter.1(c) and 13ter.2)	...
Cost of copies (Rules 44.3(b), 71.2(b) and 94.2)	...

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 to 75% 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) 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 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):

Russian and English, depending on the language in which the international application is filed or translated.

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]