

Meeting of International Authorities Under the Patent Cooperation Treaty (PCT)

Twenty-Fourth Session
Reykjavík, February 8 to 10, 2017

EXTENSION OF APPOINTMENT OF INTERNATIONAL AUTHORITIES

Document prepared by the International Bureau

SUMMARY

1. All of the Offices currently appointed as International Searching and Preliminary Examining Authorities under the PCT (“International Authorities”) are seeking extension of their appointment. Applications for extension will need to be prepared and presented effectively to ensure an efficient and useful session of the Committee for Technical Cooperation (PCT/CTC).
2. International Authorities are invited to give further feedback on a further revised draft model agreement between the International Bureau and an International Authority which takes into account comments received by International Authorities in reply to Circular C. PCT 1479, before specific draft agreements for each International Authority are prepared.

BACKGROUND

3. Each of the existing International Authorities was appointed by the Assembly for a period ending on December 31, 2017. In 2017, the Assembly will therefore need to make a decision on the extension of the appointment of each existing International Authority that wishes to seek an extension of its appointment, having first sought the advice of the PCT/CTC (see PCT Articles 16(3)(e) and 32(3)).
4. The following timetable for the procedure was agreed by the PCT Working Group at its ninth session in May 2016 (see paragraph 8 of document PCT/WG/9/14, and paragraph 72 of the Summary by the Chair of the session, document PCT/WG/9/27):

- (a) Before the end of June 2016: issuance by the International Bureau of a Circular to all existing International Authorities, formally commencing the extension process [see Circular C. PCT 1479, dated June 24, 2016].
- (b) By the end of September 2016: feedback by existing International Authorities on whether they intend to seek extension of their appointment and on any other issue raised in the Circular [all Authorities have indicated their intention to seek extension].
- (c) Before the end of November 2016: preparation of a working document for the twenty-fourth session of the Meeting of International Authorities (PCT/MIA), envisaged to take place in January/February 2017, taking into account the feedback received from Authorities in response to the Circular, setting out the draft model agreement which will form the basis for the new agreements to be concluded between the International Bureau and each Authority seeking extension of its appointment [this document].
- (d) Preferably by March 1, 2017, and in any case no later than two months prior to the convening of the thirtieth session of the PCT/CTC (to be held back-to-back with the tenth session of the PCT Working Group, envisaged to take place in May/June 2017 [now provisionally scheduled to take place from May 8 to 12, 2017]): submission by any International Authority seeking extension of its appointment of the official request for extension of its appointment and of any supporting documentation to the Director General.
- (e) May/June 2017: thirtieth session of the PCT/CTC, to be held back-to-back with the tenth session of the PCT Working Group; consideration by the PCT/CTC of all requests for extension of appointments by existing International Authorities and of the draft model agreement, with a view to giving advice to the PCT Assembly.
- (f) September/October 2017: forty-ninth session of the PCT Assembly; decision by the PCT Assembly on the extension of existing appointments of International Authorities, taking into account the advice of the PCT/CTC; approval of the text of each of the agreements between the International Bureau and the Authorities whose appointment is to be extended.
- (g) January 1, 2018: entry into force of the new agreements between the International Bureau and each of the Authorities whose appointment has been extended, for a period of 10 years, to end on December 31, 2027.

APPLICATIONS FOR EXTENSION OF APPOINTMENT

5. With the submission of the present document to the PCT/MIA, steps (a) to (c) in the procedure leading up to the reappointment of International Authorities as set out in paragraph 4, above, have been completed. The next formal step in the process of extension of appointments is for all Authorities to submit the necessary documentation to the Director General. This should preferably be done before March 1, 2017, but should, in any case, be done by March 8, 2017 (two months before the intended date of opening of the thirtieth session of the PCT/CTC).
6. While the Understanding of the PCT Assembly concerning the appointment of International Authorities, adopted at its forty-sixth session, held in September 2014, applies only to the appointment of new Authorities, the PCT Working Group, at its ninth session, further agreed that the procedures should follow the spirit of that Understanding (see paragraph 72 of the Summary by the Chair of the session, document PCT/WG/9/27).
7. In accordance with this agreement, the documentation to be provided to the PCT/CTC should provide details as to the extent to which the Authority meets the minimum requirements for the extension of its appointment, as well as other information relevant to the request for extension, along the same lines as those expected to be provided by an Office seeking

(original) appointment. However, as far as the requirement that the Office must have in place a quality management system and internal review arrangements in accordance with the common rules of international search, it shall be sufficient that an Authority seeking extension of its appointment simply refers to the most recent report on its existing quality management system submitted to the International Bureau in accordance with Chapter 21 of the PCT International Search and Preliminary Examination Guidelines. These reports are normally published shortly after the Meeting of International Authorities and so will be available before the deadline for submitting the applications.

8. Since there was not yet agreement on a standard application form for appointment (see paragraphs 52 to 56 of Annex II to document PCT/MIA/23/14), the format of the documentation to submit to the PCT/CTC is up to each individual International Authority. However, a number of International Authorities have indicated that they find various features of the draft form to be useful and that they will be basing their applications on that general format.

9. It is not envisaged that there will be any expectation that Offices seeking extension of their appointment as an International Authority will have sought the assistance of other International Authorities, as recommended to Offices seeking initial appointment in paragraph (a) of the Understanding referred to in paragraph 6, above. All such Offices have either been acting as International Authorities for some time or else have been the subject of such assistance in the context of their recent appointment. However, the International Bureau would observe that exchanges of information and suggestions concerning good practice between International Authorities are useful ongoing activities. It might therefore be appropriate to mention any such exchanges in the applications for extension of appointment.

ENSURING AN EFFICIENT AND USEFUL SESSION OF THE CTC

10. The International Bureau observes that, with applications for reappointment from 22 Offices to be considered during the same week as the tenth session of the PCT Working Group, it will be essential that the session of the PCT/CTC is run efficiently, while still ensuring that the Committee is able to review and give meaningful advice on each of the applications. Consequently, the International Bureau suggests the following measures to assist the process:

- (a) International Authorities are encouraged to send draft copies of applications to the International Bureau at an early stage (preferably before this session of the PCT/MIA) for an informal review of whether all required issues appear to have been covered.
- (b) Each application should indicate an official who can be contacted by other members of the PCT/CTC with questions in advance of the session, with a view to providing any further information requested. If an Authority does not wish to name an official in the documentation, an alternative would be to indicate that such a name has been given to the Secretariat, which will pass it on to other members of the PCT/CTC on request.
- (c) Authorities should seek to assist one another by reviewing the other applications as soon as they are published and providing early feedback on any areas which might cause concern during the session. The International Bureau will publish "Add" documents if an Authority discovers that the information on a significant issue is unclear or insufficient and the Authority wishes to provide useful clarifications in advance of the session.
- (d) Authorities should assume that delegations at the PCT/CTC have reviewed the documentation in advance of the meeting. Introductions by Authorities during the session should therefore seek to be brief (five minutes at the most) and focus primarily on the overall benefit which the extension of appointment of the Office will bring to the PCT System, together with any further information which may be useful to bring to the Committee's attention in view of discussions with other Offices.

MODEL AGREEMENT BETWEEN THE INTERNATIONAL BUREAU AND AN INTERNATIONAL AUTHORITY

11. The Annex to this document sets out a revised draft model agreement between the International Bureau and an International Authority, taking into account the comments received by Authorities in response to Circular C. PCT 1479. Differences between the model and a “typical” current agreement are set out using underline and strikethrough, noting that a number of further minor variations exist between current agreements and that it will remain necessary to keep certain variations, particularly with regard to the parties eligible under the relevant national laws to sign and modify the agreement. Yellow highlighted text shows areas where changes have been made compared to the draft in Circular C. PCT 1479. The naming of Annexes reflects the letters used in the current agreements, using *Abis* and *Cbis* to indicate the order of items which fall between existing Annexes; the final version would be updated to be Annexes A, B, C, D, etc.

Issues Raised in Response to the Circular

12. In the responses to Circular C. PCT 1479, a number of Authorities expressed concern over the proposal to move the definitive statements of whether certain procedures (specifically supplementary search and national classification) were offered by a particular International Authority from the main body of the Agreement (Articles 3(4) and 6) into the Annexes (Annexes *Abis* and *Cbis*). The aim of this was not to imply that there was an obligation to move towards providing these procedures, but to assist flexibility and transparency so that:

- (a) any changes which the Authority wished to make in the relevant areas could be done without further reference to the PCT Assembly (noting that the services in question are ones to which the Assembly has already given its general approval); and
- (b) people interested in the scope of services offered by International Authorities would be able to find a definitive list simply by checking the Annexes, since the articles would (in substance) be common to all Authorities, while the Annexes would explicitly set out the areas where differences lay.

13. To this end, the general relationship between the Articles and Annexes remains unchanged from the proposals in Circular C. PCT 1479. However, minor changes are proposed to the wording of the Articles to make clear that it is acceptable for the relevant Annex to indicate that the Authority does not perform supplementary international search or provide national classifications at all. It is further proposed, following a suggestion by one International Authority, that an equivalent arrangement should apply to international-type searches, specifying the extent, if any, to which an Authority provides such searches in the Annexes to the Agreement (Article 8 and Annex E).

14. A number of Authorities expressed concerns over the following proposals in the text of Article 3 and Annex A:

- (a) the need to indicate within the Annex any conditions or limitations which may apply; and
- (b) the proposed timetable for becoming competent as an International Authority following the request of a receiving Office.

15. These proposals were made by the International Bureau to deal with two issues which have surfaced on numerous occasions over the past 10 years, as follows.

16. *Transparency*: It is sometimes difficult to determine the potential scope of competence for a particular International Authority. Because, in accordance with Rule 35, the situation is also dependent on receiving Offices, the exact competence will always require some further investigation. It is nevertheless desirable to be as clear as possible in at least two respects:

(a) References which exist in several agreements to “any country that the Authority will specify” leaves a suggestion that there might be countries for which the Authority has agreed to act but which are not (directly or by category) indicated in list of countries set out in the Annex. Noting that an addition to the list can be made purely by notification, which needs to be made in any case to ensure that the information is included in the PCT Gazette, the Applicant’s Guide and reference data for various IT systems, there appears to be no need for such an option.

(b) Some Authorities have limitations on their competence based on numbers of international applications or technical fields of international applications received from certain receiving Offices. At present, it is not always clear that any such limitation exists, as such limitations may be defined in documents (such as bilateral agreements between the Authority and a receiving Office concerned) which are difficult to obtain. While there may in some cases be a need to define such limitations by reference to another document, there should always be a reference in the agreement of the Authority with the International Bureau which is at least sufficient to allow interested parties to find and access that document.

17. *Procedure and timing for starting work for a particular receiving Office*: Many International Authorities indicate their willingness to provide services for a wide range of States, typically defined by a general geographic region. However, it is not always clear to receiving Offices what they need to do in order to make the relevant Authority competent. In the absence of any specific procedure, it could readily be argued that, in these circumstances, the International Authority should be competent from the moment that the relevant receiving Office informs the International Bureau in accordance with Rule 35. In practice, it is expected that an exchange of letters occurs, agreeing a start date. The International Bureau would like to provide assistance to receiving Offices by setting out details of what they need to do. The proposal which was included in Circular C. PCT 1479 to indicate a specific timetable has been removed, since too many factors may be involved. It is hoped, nevertheless, that receiving Offices and International Authorities will strive to keep the process as short as possible.

18. *The Meeting is invited*:

(i) *to comment on the issues concerning documents to be submitted to, and procedures for, the forthcoming session of the PCT Committee for Technical Cooperation; and*

(ii) *to comment on the revised draft model Agreement set out in the Annex to document PCT/MIA/24/2.*

[Annex follows]

ANNEX

DRAFT MODEL AGREEMENT BETWEEN AN INTERNATIONAL AUTHORITY
AND THE INTERNATIONAL BUREAU¹

Agreement

between the PARTY
and the International Bureau of the World Intellectual Property Organization

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

¹ Proposed additions and deletions compared to the contents of a typical current agreement are indicated, respectively, by underlining and striking through the text concerned. Yellow highlighted text shows areas where changes have been made compared to the draft in Circular C. PCT 1479.

Preamble

The PARTY 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 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 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~~[, that such application is not an application of a kind 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~~[, that such application is not an application of a kind 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~~]~~.

[COMMENT 1: The reference in square brackets to “kinds of application” in Articles 3(1) and (2) only currently exists in the Agreement with the European Patent Office. As of January 1, 2015, the European Patent Office has removed the exclusion of certain applications in the area of business methods from the kinds of application for which it will not act as International Searching Authority and International Preliminary Examining Authority. It is therefore proposed to remove the reference to “kinds of application”. It is nevertheless proposed to include a provision “and that any other requirements regarding such application as specified in Annex A to this Agreement have been met” in paragraph (1), equivalent to that which appears in paragraph (2). While the main use in relation to international preliminary examination is to limit competence to international applications where the Office had also acted as ISA, this provision could, if necessary, also cover numerical or subject matter-related limitations such as those

which are applied by some Authorities. Where limitations of this type are imposed, it is highly desirable that they be set out in the Annexes of the Agreements for transparency.]

[COMMENT 2: At present, the words in square brackets “specified in Annex A to this Agreement” in the second and third line of Article 3(1) and Article 3(2), respectively, are not included in existing Agreements where an Authority is competent for the receiving Office of any Contracting State. In order to have more consistent wording in the main body of the Agreement for all Authorities, where an Authority is willing to act as International Searching Authority and/or International Preliminary Examining Authority for applications filed with the receiving Office of, or acting for, any Contracting State, it is proposed that Articles 3(1) and (2) nevertheless make reference to Annex A. Annex A will then specify that the Authority can act for any Contracting State (see Option A in Annex A). This will enable any such Authority to limit the Contracting States for which it is competent during the term of its agreement without the need for a formal amendment of Articles 3(1) and/or (2).]

[COMMENT 3: At present, the words in square brackets “and that any other requirements regarding such application as specified in Annex A to this Agreement have been met” at the end of Article 3(2) are not included in agreements where the Authority does have any such additional requirements in place. In order to have more consistent wording in the main body of the Agreement for all Authorities, it is proposed to include the reference to “any other requirements regarding such application as specified in Annex A to the Agreement” in all agreements, whether or not the Authority includes any such requirements on its competence to act as an International Preliminary Examining Authority. This will enable any Authority not including such requirements to add them without the need for a formal amendment of Article 3(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) 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 45bis to the extent decided by it, as set out in Annex Abis to this Agreement.

[COMMENT: Articles 3(4) and 11(3)(~~v~~ii) as well as Annex Abis (current Annex E), which all relate to supplementary international search, are only included in the agreements of Authorities currently offering this service. It is proposed that these provisions be included in the agreements of all Authorities, with Annex Abis stating whether or not the Authority carries out supplementary international searches. This will achieve greater consistency between the agreements, and also enable an Authority offering supplementary international search to cease to offer the service without the need to amend the Articles of the Agreement, which would require approval by the PCT Assembly].

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 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 that Annex to the extent decided by it as set out in Annex Cbis to this Agreement.

[COMMENT: It is proposed to amend Article 6 to allow for the indication of classification symbols in addition to the International Patent Classification if the Authority specifies the classification in a new Annex Cbis to the Agreement. With the exception of the agreement with one Authority, which allows for the indication of classification symbols under its national patent classification system in addition to those under the International Patent Classification, all current agreements indicate sole use of the International Patent Classification. In this regard, it should be noted that the current Article 6 would be incompatible with the proposal submitted to the PCT Working Group in document PCT/WG/9/26.]

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 as set out in Annex E to this Agreement.

Article 9
Entry into Force

This Agreement shall enter into force on January 1, ~~2008~~ 2018.

Article 10
Duration and Renewability

This Agreement shall remain in force until December 31, ~~2017~~ 2027. The parties to this Agreement shall, no later than July ~~2016~~ 2026, start negotiations for its renewal.

[COMMENT: As had been the practice in case of previous renewals, it is proposed that the new agreements should last for 10 years, and that any new agreements concluded with an Office which will be appointed to act as an International Authority during the 2017 session of the PCT Assembly or at any time thereafter during the 10 year period should equally remain in force until the end of 2027, so as to expire at the same time as all other agreements.]

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][PARTY]; and, notwithstanding paragraph (4), they shall take effect on the date agreed upon by them.

(3) The [Authority][PARTY] 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;

(~~iv~~) amend the indications and information concerning on supplementary international searches contained in Annex ~~E~~ Abis to this Agreement;

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

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

(~~iv~~) amend the indications of on languages of correspondence contained in Annex D to this Agreement;

(vi) amend the indications on international-type 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:

(i) for an amendment to Annex A bis 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 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.

[COMMENT 1: The words “Authority” and “PARTY” have been put in square brackets since, under the current agreements, the power to amend the Annexes by way of an agreement with the International Bureau or unilaterally by notifying the International Bureau, as provided for under Article 11(2) and (3), rests either with the Authority (in the case of all agreements except for one) or with the Party who has concluded the agreement (in the case of one agreement).]

[COMMENT 2: It is proposed to provide for the possibility for an Authority to amend Annex A bis by way of a notification to the International Bureau to the effect that that the Authority shall cease to offer supplementary international searches as of a particular date, that date being at least six months after the date on which the Director General has received such notification.]

Article 12 Termination

(1) This Agreement shall terminate before December 31, ~~2017~~ 2027:

(i) if the PARTY 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 PARTY 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.

[COMMENT: In a number of the current agreements, the signatory party is the same as the Authority and the term “Authority” is used in Article 12 in place of the name of the signatory party. For reasons of consistency, it is proposed to refer, in the new agreements, to the name of the party in all cases.]

In witness whereof the parties hereto have executed this Agreement.

Done at GENEVA, this DATE, in XX originals in the ... language(s).

For the PARTY by:

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

Francis Gurry
Director General
World Intellectual Property Organization

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: ...

[subject to the following conditions: ...]

so far as Article 3(2) is concerned: [where the Authority [or an industrial property Office of a State party to the European Patent Convention] has prepared the international search report,] ...

[subject to the following conditions: ...]

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.

[COMMENT 1: As at present, the text in square brackets at the beginning of the reference to Article 3(2) allows an Authority to limit its competence as an International Preliminary Examining Authority to international applications in respect of which the Authority (or, in the case of the European Patent Office, the Authority itself or an IP Office of an EPC Contracting State) has prepared the international search report].

[COMMENT 2: The text in square brackets adding further conditions would be used where an Office has applied further limitations, such as those relating to maximum numbers or certain subject matter, for example, the agreements concerning the Israel Patent Office and Japan Patent Office in their capacities as an International Searching Authority and International Preliminary Examining Authority with respect to applications filed at the receiving Office of the United States Patent Trademark Office - see <http://www.uspto.gov/about-us/news-updates/uspto-and-jpo-announce-patent-cooperation-treaty-agreement> and http://www.uspto.gov/sites/default/files/patents/law/notices/ilpo_isa-ipea.pdf].

[COMMENT 3: For specifying States for which the Authority is competent, the following options could be used:

OPTION A: “any Contracting State”.

(Option A should be chosen by an Authority that is willing to act as International Searching Authority and/or International Preliminary Examining Authority for applications filed with any receiving Office of, or acting for, any PCT Contracting State. The proposed text differs from the present text of the agreements for these Authorities, which does not specify any States in Annex A – see text enclosed in square brackets indicated by strikethrough).

OPTION B: “any Contracting State in accordance with the obligations of ... within the framework of the European Patent Organisation”.

(Option B should be chosen by most Authorities of States party to the European Patent Convention. For these Authorities, it is proposed not to specify names of any particular States that fall within the broader proposed definition.)

OPTION C: “[*indication of an exhaustive list of States by name and/or definition*]”.

(For option C, a definition could relate to the geographical location (e.g. “any State of the Latin American and Caribbean region”) or to the classification of a State as a developing or least developed country (e.g., “any State being regarded as a developing country in accordance with ...[a defined established practice]”).)

[COMMENT 4: It is proposed to clarify the procedure for a receiving Office of, or acting for, a State specified in this Annex as being competent by an Authority, to specify the Authority to act as an International Searching Authority and/or International Preliminary Examining Authority.]

[COMMENT 5: In specifying States, it is proposed to avoid wording such as “and any State that the Authority will specify”, “by arrangement” or “provided an agreement between the State has been concluded”. Such wording lacks clarity as it implies that the Authority could act as an International Searching and/or Preliminary Examining Authority for States other than those defined in Annex A. It is also not clear to state that an agreement needs to be made between the receiving Office and the Authority, since this could allow an Authority to decide not to conclude such an agreement with a receiving Office of a State that is specified in this Annex (whether specified individually or as part of a collective definition).]

(ii) the following language[s] which it will accept:

...

[COMMENT: As at present, an Authority would continue to be able to specify the languages in which it will accept international applications, including different languages depending on the receiving Office with which the international application was filed].

{Annex ~~E~~Abis
Supplementary International Search:
Documentation Covered; Limitations and Conditions}

[The Authority does not conduct supplementary international searches.]

[The Authority conducts supplementary international searches as follows:

...]

[COMMENT: An Authority would specify whether or not it conducts supplementary international searches. This would be followed by the documentation and limitations and conditions for those Authorities offering supplementary international searches, similar to the contents at present in Annex E. Authorities offering supplementary international search have different text in that Annex. However, it is not proposed to align the provisions more closely at this time.]

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:

[any subject matter which is searched or examined under the patent grant procedure in accordance with the provisions of [name of national patent law and of country] [European Patent Convention]] [none]].

[COMMENT: Notwithstanding the exclusions in Rules 39.1 and 67.1, almost all Authorities search or examine subject matter in international patent applications that they would search or examine in national or regional patent applications. Where this is the case, it is proposed to use the above standardized text, inserting the names of the applicable national laws and country/countries or "European Patent Convention", as appropriate. If there is no subject matter set forth in Rules 39.1 and 67.1 that will be searched or examined by an International Authority, the Authority should simply indicate "none".]

Annex C
Fees and Charges

Part I. Schedule of Fees and Charges

Kind of fee or charge	Amount (currency)
Search fee (Rule 16.1(a))	...
Additional fee (Rule 40.2(a))	...
[Supplementary search fee(s) (Rule 45bis.3(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)	...]

[COMMENT: Fees in square brackets are optional and are not charged by all Authorities. Footnotes are used where reductions are offered for applicants from certain countries, notably developing and/or least developed countries. Two current agreements also include footnotes to indicate that the amount of the search fee is fixed in the form of an equivalent amount of the euro amount of the search fee payable to the European Patent Office as an International Searching Authority, as modified from time to time in accordance with the Directives under Rule 16.1(d).]

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 [already made by the Authority on an application whose priority is claimed for the international application], ... % of the amount of the search fee paid shall be refunded [on request of the applicant], [depending on the extent to which an Authority benefits from that earlier search].

[COMMENT: There is considerable variation in the current agreements in the wording of the provisions relating to refunding the search fee where the Authority benefits from the results of an earlier search; the agreement of one Authority does not include such a provision. While an Authority may determine the amount of any refund and the conditions for any such refund, Authorities may wish to consider the possibilities to achieve greater consistency in the wording of this provision between the different agreements. The text above is based on the more commonly-used wording in the existing agreements, with optional parts indicated in square brackets.]

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

[COMMENT: The current agreements of most Authorities include this general provision to cover the case where the demand for international preliminary examination has been considered as if it had not been submitted. The agreement of one Authority provides a full refund, but lists the relevant provisions (Rules 54.4, 54bis.1(b), 58bis.1(b) and 60.1(c)). The agreements of two Authorities offer a full refund except for Rule 60.1(c), where a full refund is given less the amount of the transmittal fee.]

(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.

[COMMENT: Most Authorities provide a full refund of the preliminary examination fee where the international application or the demand is withdrawn before the start of international preliminary examination. Two Authorities offer a 75% refund of the preliminary examination fee. One Authority offers a full refund less a processing fee equivalent to the transmittal fee under Rule 14.1(b).]

[(6) The Authority shall refund the supplementary search fee if, before it has started the supplementary international search in accordance with Rule 45bis.5(a), the supplementary search request is considered not to have been submitted under Rule 45bis.5(g).]

[COMMENT: All but one Authority offering supplementary international search provides for this refund.]

[(7) The Authority shall refund the supplementary search fee if, after receipt of the documents specified in Rule 45bis.4(e)(i) to (iv), but before it has started the supplementary international search in accordance with Rule 45bis.5(a), it is notified of the withdrawal of the international application or the supplementary search request.]

[COMMENT 1: Three Authorities offering supplementary international search provide for this refund.]

[COMMENT 2: The agreement of one Authority also includes a provision permitting it to abstain from refunding the search fee and the preliminary examination fee in certain situations where such a refund is not compatible with the applicable national law.]

Annex Cbis Classification

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

[COMMENT: Authorities wishing to use a national patent classification in addition to the International Patent Classification would specify the classification system in this Annex.]

Annex D Languages of Correspondence

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

...

[noting that the language of correspondence shall be the language in which the international application is filed or translated, as the case may be.]

[depending on the language in which the international application is filed or translated.]

[COMMENT: For those Authorities processing international applications in more than one language, the agreements contain a number of variations, generally to the effect of one of the two options in square brackets above. In most cases, the language is required to be the same as that in which the international application was filed, or, where applicable, translated. Some Authorities also offer the option of correspondence in the “main” language(s) of the Authority, irrespective of the language of filing or translation. Other options might include that a response to an individual item of correspondence shall be in the language of that correspondence (assuming that it is one of the listed options) irrespective of the language of the international application.].

Annex E
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.]

[The Authority conducts international-type searches as follows:

...]

[End of Annex and of document]