

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

Thirtieth Session
Geneva, November 1 to 3, 2023

EXTENSION OF APPOINTMENT OF INTERNATIONAL SEARCHING AND PRELIMINARY EXAMINING AUTHORITIES

Document prepared by the International Bureau

SUMMARY

1. The appointments of all International Authorities expire on December 31, 2027. Extensions of the appointments will require the advice of the PCT Committee for Technical Cooperation (PCT/CTC), including evaluation of each Office or organization in terms of meeting the revised minimum requirements for appointment that will enter into force on January 1, 2026 with the amendment of the definition of the PCT minimum documentation. The PCT Union Assembly will also need to approve both the extension of appointments and the new agreements with the International Bureau before the appointments expire. It is proposed to begin informal consultations on the process and the requirements for new agreements in order to ensure that sufficient time is available for consideration before proposals need to be put to the PCT/CTC and PCT Union Assembly.

REQUIRED PROCESSES

2. PCT Article 16(3) states:

(3)(a) International Searching Authorities shall be appointed by the Assembly. Any national Office and any intergovernmental organization satisfying the requirements referred to in subparagraph (c) may be appointed as International Searching Authority.

(b) Appointment shall be conditional on the consent of the national Office or intergovernmental organization to be appointed and the conclusion of an agreement, subject to approval by the Assembly, between such Office or organization and the

International Bureau. The agreement shall specify the rights and obligations of the parties, in particular, the formal undertaking by the said Office or organization to apply and observe all the common rules of international search.

(c) The Regulations prescribe the minimum requirements, particularly as to manpower and documentation, which any Office or organization must satisfy before it can be appointed and must continue to satisfy while it remains appointed.

(d) Appointment shall be for a fixed period of time and may be extended for further periods.

(e) Before the Assembly makes a decision on the appointment of any national Office or intergovernmental organization, or on the extension of its appointment, or before it allows any such appointment to lapse, the Assembly shall hear the interested Office or organization and seek the advice of the Committee for Technical Cooperation referred to in Article 56 once that Committee has been established.

3. Under PCT Article 32(3), the same requirements apply, *mutatis mutandis*, to the extension of appointment of International Preliminary Examining Authorities.

4. Consequently, the extension of appointments will require:

(a) the PCT/CTC to give its advice;

(b) the PCT Assembly to approve agreements between the Offices and the International Bureau;

(c) the PCT Assembly to extend the appointments; and

(d) the Offices to complete any national formalities required in order to sign their new agreements by December 31, 2027.

ISSUES

REVIEW BY THE PCT/CTC

5. All International Authorities have been appointed based on their compliance with the minimum requirements set out in PCT Rules 36 and 63. They provide annual reports on continued compliance through their quality reports under Chapter 21 of the PCT International Search and Preliminary Examination Guidelines. The minimum requirements will be updated with effect from January 1, 2026, as a result of the amendment of PCT Rules 34, 36 and 63 as approved by the PCT Union Assembly at its fifty-fifth session in July 2023 (see document PCT/A/55/2) and corresponding modifications to the PCT Administrative Instructions.

6. For the sake of efficiency for both International Authorities and Contracting States, it is proposed that the session of the PCT/CTC giving advice to the Assembly should focus on compliance with the changes to the minimum requirements. While Contracting States should be free to review compliance in general, the general documentation should be provided by the International Authorities' annual quality reports, which are published on the WIPO website. Unless there are specific other points that they wish to bring to Contracting States' attention relating to their particular circumstances, the International Authorities should only be required to provide documentation specifically for the PCT/CTC covering their implementation of the new requirements – making available their patent document collections to other International Authorities and ensuring that they are able to search the complete minimum documentation under the amended Rules.

7. If International Authorities agree with this approach, it will be formally proposed to the PCT Contracting States at a future session of the PCT Working Group, or at the PCT/CTC if it has reason to meet for any other purpose prior to the session to be convened to consider the extensions of appointments.

NATIONAL PROCEDURAL ISSUES FOR APPROVAL OF AGREEMENTS

8. In October 2017, the forty-ninth session of the PCT Union Assembly extended the appointment of the 22 International Authorities then appointed until December 31, 2027 (document PCT/A/49/2). All International Authorities appointed during the same session or subsequently were appointed with effect until the same date. Agreements under PCT Article 16(3)(b) were approved, each of which states in Article 10 “The parties to this Agreement shall, no later than July 2026, start negotiations for its renewal.”

9. However, even at that time it was noted that several of the International Authorities would have difficulties in concluding the domestic formalities of signing the agreements before the end of the year. The Canadian Intellectual Property Office in particular sought an extension of the previous agreement (document PCT/A/49/2 Corr.), which it was able to approve with reduced formalities pending domestic approval of the main new agreement.

10. Consequently, it is proposed to begin informal discussion of the required process immediately, with a view to more clearly identifying what needs to be achieved and what timetables Contracting States will find practical.

REVISION TO THE MODEL AGREEMENT

11. All the current agreements between the International Bureau and International Authorities are based on a model agreement approved by the twenty-fourth session of the Meeting of International Authorities under the PCT (see document PCT/MIA/24/2 and paragraphs 30 and 31 of document PCT/MIA/24/15). This means that the main bodies of the agreements vary only as necessary to refer to the different Offices appointed and parties to the agreement (typically the Office, Head of Office, Ministry or Minister). All differences of substance are set out in Annexes to the agreements.

12. The International Bureau strongly wishes to preserve the consistency of this arrangement, giving the same general rights and obligations to each International Authority and maintaining the same procedures and timings for making changes to the International Authorities’ competence (in terms of States and languages), fees, classification arrangements and other services.

13. However, it may be desirable to make changes to the agreements to simplify general administration activities. By way of example, some International Authorities have difficulties with the national processes involved in amending the annexes to their agreement, just as with signing the main agreement in the first place. To address this, content in the annexes to the agreements that is typically amended while the agreement is in force such as fee amounts might be removed. Instead, modification of the relevant matter would be the subject of notifications to the International Bureau, subject to the same timings and safeguards as in Article 11 of the current agreements but being published as notices in the PCT Gazette (and consolidated information being available in the PCT Applicant’s Guide), rather than amending the agreement. The content removed from the annexes would be deemed to have been notified to the International Bureau as a starting arrangement, in the absence of any other notifications prior to entry into force of the new agreements. Amendments would also be required to the PCT Regulations where they refer to any content that will be removed from the agreements, entering into force on January 1, 2028, when the new agreements take effect.

14. The International Bureau welcomes any other suggestions for changes to the agreements that may streamline processes. Possible implementations of such suggestions may be discussed through the quality subgroup wiki and at the next session of the Meeting.

15. The Meeting is invited to comment on:

(i) the appropriate nature of review by the PCT/CTC; and

(ii) issues to be considered in relation to the form and content of agreements between International Authorities and the International Bureau

in relation to the extension of the appointments of International Authorities after December 31, 2027.

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