

## **Patent Cooperation Treaty (PCT) Working Group**

**Ninth Session  
Geneva, May 17 to 20, 2016**

### **EXTENSION OF APPOINTMENT OF INTERNATIONAL SEARCHING AND PRELIMINARY EXAMINING AUTHORITIES**

*Document prepared by the International Bureau*

#### **SUMMARY**

1. The purpose of the present document is to set out the proposed process for the extension of the appointment of existing International Authorities that wish to seek an extension of their appointment for a further 10 year period, with effect from January 1, 2018, to end December 31, 2027.

#### **BACKGROUND**

2. 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 Committee for Technical Cooperation (PCT/CTC) (see PCT Articles 16(3)(e) and 32(3)).

3. The minimum requirements which an International Authority must satisfy before it can be appointed and which it must continue to satisfy while it remains appointed, and which it thus must also satisfy when seeking the extension of its appointment, are set out in PCT Rules 36 and 63. Appointment and thus the extension of an appointment is also conditional on the conclusion of an agreement between the International Bureau and the relevant Office, which must be approved by the Assembly.

4. All agreements between the International Bureau and existing International Authorities follow a common general format. Other than matters such as the name of the Office, the main bodies of the agreements differ from one another only in respect of certain different requirements, such as those relating to the extent of competence or the date of entry into force, among others.

5. Article 10 of each of the existing agreements specifies that “[t]he parties to this Agreement shall, no later than July 2016, start negotiations for its renewal”. The International Bureau thus intends to formally commence the extension process referred to in paragraph 2, above, by issuing a Circular to all existing International Authorities before the end of June 2016, inviting each Authority to indicate whether it intends to seek the extension of its appointment by a further period of 10 years, to end December 31, 2027. The Circular will further invite each Authority that wishes to seek such an extension to comment on a draft model agreement which will form the basis of the new agreement to be concluded between the Authority and the International Bureau and to discuss any special provisions which may need to apply to the Office.

#### **PROPOSED PROCESS AND TIMETABLE**

6. As far as the procedures for the extension of appointment of International Authorities is concerned, it is recalled that the Assembly, at its forty-sixth session, held in September 2014, adopted an Understanding with regard to the procedures for the appointment of International Authorities (see paragraph 25 of document PCT/A/46/6). For ease of reference, the text of the Understanding is reproduced in the Annex to the present document.

7. While, strictly speaking, the Understanding only applies to the original appointment of an Office as an International Authority, the International Bureau nevertheless proposes that the “spirit” of that Understanding should also apply to the procedures for the extension of the appointment of existing International Authorities, so as to allow the PCT/CTC to meet as a true expert body well in advance of the consideration by the PCT Assembly of the requests for extension.

8. In line with the spirit of the Understanding, it is thus proposed that the procedure for extension of existing appointments should follow the following time table:

(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, as outlined in paragraph 5, above.

(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.

(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.

(d) Preferably by March 1, 2017, and in any case no later than two month 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): 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.

9. In line with the spirit of the Understanding, it is further proposed that any request for an extension of appointment should be made on the understanding that the Authority seeking extension of its appointment must meet all substantive criteria for appointment at the time of the decision on the extension by the Assembly.

10. With regard to the documentation to be submitted by an Authority in support of its request for extension of its appointment, it is further proposed that such documentation 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, provided that, 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.

11. Finally, should the Working Group agree with the proposals set out in paragraphs 8 to 10, above, it is proposed that the process for the extension of existing appointments of International Authorities in the run-up to the 2017 session of the PCT/CTC should be governed by what is set out in those paragraphs, without the need for a formal decision by the PCT Assembly to that effect.

#### **DISCUSSION BY THE MEETING OF INTERNATIONAL AUTHORITIES**

12. The Meeting of International Authorities, at its twenty-third session, held in January 2016, discussed a document on the extension of appointments (document PCT/MIA/23/9). This document invited comments from International Authorities concerning:

- (a) changes which may be desirable to the model agreements between the International Bureau and International Authorities; and
- (b) the documentation which International Authorities should be required to supply to the PCT/CTC as part of the extension process.

13. The discussion by the Meeting of International Authorities is outlined in paragraphs 14 to 19 of the Summary by the Chair (see document PCT/MIA/23/14, reproduced in the Annex to document PCT/WG/9/2). Paragraphs 15 to 18 of the Summary are reproduced below:

“15. One Authority indicated that it was essential for an Authority to show to the PCT Committee for Technical Cooperation (PCT/CTC) that it met the minimum requirements for appointment by providing details along the same lines as had been proposed in the application form discussed by the Quality Subgroup.

“16. One Authority suggested clarifying the wording of Article 4 of the model agreement covering subject matter not searched by the International Authority.

“17. One Authority suggested that there could be a peer review process under which the documentation submitted for reappointment by one Authority was reviewed by one or more other Authorities to verify compliance with the minimum documentation requirements under Rule 36.1(ii).

“18. One Authority suggested that the re-appointment process should be processed according to the requirements of the existing rules and avoid increasing the workload of existing International Authorities.”

*14. The Working Group is invited to comment on the proposed process for the extension of appointment of International Searching and Preliminary Examining Authorities set out in paragraphs 8 to 11, above.*

[Annex follows]

UNDERSTANDING WITH REGARD TO  
THE PROCEDURES FOR APPOINTMENT OF INTERNATIONAL AUTHORITIES

*(adopted by the PCT Assembly at its forty-sixth session,  
held in September 2014 (see paragraph 25 of document PCT/A/46/6))*

“Procedures for Appointment of International Authorities:

“(a) A national Office or an intergovernmental organization (“Office”) seeking appointment is strongly recommended to obtain the assistance of one or more existing International Authorities to help in the assessment of the extent to which it meets the criteria, prior to making the application.

“(b) Any application for appointment of an Office as an International Authority is to be made well in advance of its consideration by the PCT Assembly so as to allow time for an adequate review by the Committee for Technical Cooperation (PCT/CTC). The PCT/CTC should meet as a true expert body at least three months in advance of the PCT Assembly, if possible back-to-back with a session of the PCT Working Group (usually convened around May/June of any given year), with a view to giving its expert advice on the application to the PCT Assembly.

“(c) Consequently, a written request to the Director General to convene the PCT/CTC is to be sent by the Office preferably by March 1 of the year in which the application is to be considered by the PCT Assembly and in any case in time to allow the Director General to send out letters of convocation of the PCT/CTC not less than two months prior to the opening of the session.

“(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.

“(e) Any document by the Office in support of its application for consideration by the PCT/CTC should be submitted to the Director General at the latest two months prior to the opening of the session of the PCT/CTC.

“(f) Any such application is then to be submitted to the PCT Assembly (usually convened around September/October of any given year), together with any advice given by the PCT/CTC, with a view to deciding on the application.”

[End of Annex and of document]