

WIPO



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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

**INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)**

ASSEMBLY

**Twenty-Fourth Session (11th Ordinary)
Geneva, September 16 to October 1, 1997**

**MATTERS CONCERNING THE PCT UNION:
APPOINTMENT OF THE KOREAN INDUSTRIAL PROPERTY OFFICE AS
INTERNATIONAL SEARCHING AUTHORITY AND
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY**

Document prepared by the International Bureau

1. In a letter dated April 4, 1997, the Korean Industrial Property Office (KIPO) expressed the wish to be appointed as an International Searching Authority (ISA) and as an International Preliminary Examining Authority (IPEA) under the Patent Cooperation Treaty (PCT). The letter from KIPO is reproduced as Appendix I to this document.
2. Article 16(3)(e) of the PCT provides: "Before the Assembly [of the PCT Union] makes a decision on the appointment of any national Office [as an ISA] ..., the Assembly shall ... seek the advice of the Committee for Technical Cooperation ..." (hereinafter referred to as the PCT/CTC).
3. According to Article 32(3) of the PCT, the provisions of Article 16(3) shall apply, *mutatis mutandis*, in respect of the appointment of an IPEA.

4. The PCT/CTC, at its nineteenth session in Geneva from May 26 to 30, 1997, agreed to recommend to the Assembly of the PCT Union that it appoint KIPO as an ISA and IPEA, provided that the appointment should take effect upon the entry into force of the Agreement between KIPO and the International Bureau in relation to the functioning of KIPO as an ISA and IPEA, and that such entry into force should be one month after the date on which KIPO notified the Director General of WIPO that it had in its possession the PCT minimum documentation referred to in PCT Rule 34, properly arranged for search purposes, including both:

(a) the complete collection of patent documents referred to in PCT Rule 34.1(b)(i) and (ii), including the missing documents indicated in document PCT/CTC/XIX/3, and

(b) the non-patent literature as published in the PCT List of Periodicals to Be Used for Search and Examination according to PCT Rule 34.1(b)(iii), including all missing items.

5. The PCT/CTC noted that its advice, as set out in paragraph 4, above, would be submitted, together with the request by KIPO and a draft Agreement between KIPO and the International Bureau in respect of KIPO's functioning as an ISA and IPEA, to the Assembly of the PCT Union for consideration at its September/October 1997 session.

6. *The Assembly of the PCT Union is invited*

(i) *to hear the representative of the Korean Industrial Property Office as required by PCT Article 16(3)(e),*

(ii) *to approve the text of the draft Agreement between the Korean Industrial Property Office and the International Bureau as set out in Appendix II, and*

(iii) *to appoint the Korean Industrial Property Office as an International Searching Authority and an International Preliminary Examining Authority with effect from the entry into force of the said Agreement until December 31, 2007.*

[Appendices follow]

APPENDIX I

Text of letter dated April 4, 1997,

from: Korean Industrial Property Office (KIPO)
Ministry of Trade, Industry and Energy
823-1 Yeoksam-dong
Kangnam-ku
Seoul 135-784
Republic of Korea

to: Dr. Arpad Bogsch
Director General of WIPO

Dear Dr. Bogsch,

I would like to take this opportunity to express my sincere gratitude to you for your kind support and assistance extended to the Korean Industrial Property Office (KIPO) with reference to KIPO's wish to be appointed as an International Searching Authority (ISA) and as an International Preliminary Examining Authority (IPEA).

As you were informed, the patent system in Korea has developed remarkably during the past decade with KIPO's continuous efforts, for the enhancement of patent protection through amendments of the Patent Act. The number of patent applications has tremendously increased from 12,759 in 1986 to 90,326 in 1996. International applications under the PCT have also followed the increasing trend of patent applications along with the increase from 13 in 1989 to 281 in 1996. I anticipate the patent applications as well as PCT applications shall rapidly increase in the years to come.

As a means of facilitating PCT applications, dealing with the growth of applications in a more efficient manner and enhancing the quality of patent search and examination together with contributing towards the development of the PCT system, the Korean Industrial Property Office is determined to apply for appointment as an ISA and an IPEA.

I, thereupon, take the pleasure of addressing a formal request to have the Korean Industrial Property Office be appointed as an ISA and as an IPEA in accordance with Article 16(3) and Article 32(3) of the PCT.

I would like you to put this matter before the PCT/CTC in order to obtain the advice of the Committee as referred to in PCT Article 16(3)(e), and I look forward to your favourable consideration and co-operation.

Sincerely yours,

Hong-Geon Choe
Commissioner

Statement for the Appointment of a PCT/ISA and an IPEA

< Background >

The importance of industrial property rights in Korea has been growing remarkably during the past decade with a tremendous increase in industrial property rights applications. Taking the number of patent applications (including utility models) for instance, it has jumped from 42,728 in 1988 to 157,480 in 1996, which has placed us fifth in the world.

International applications under the PCT have also followed the increasing trend of patent applications. With these promising trends, the necessity for upgrading the quality of patent search and examination in the Korean Industrial Property Office (KIPO) became one of our main priorities. And KIPO is presently faced with demands from private companies which wish to use PCT procedures to call upon KIPO to devise a more user-friendly process for filing PCT applications. On top of that, we believe it is time for KIPO to assume an international role and responsibility corresponding to its status in the field of industrial property rights.

< Objectives >

We believe that KIPO's joining the PCT International Searching Authorities as well as the PCT International Preliminary Examining Authorities could serve to fulfill those purposes. That is, to:

- i) facilitate further our nationals' filing of PCT applications;
- ii) enhance the quality of patent search and examination; and
- iii) assume an international role and responsibility corresponding to its status in the area of industrial property rights.

< KIPO's Qualifications and Preparations >

Given this opportunity, I would like to illustrate KIPO's qualifications to be appointed an ISA as well as an IPEA focusing on the minimum requirements laid down in Article 16(3)(c) of the PCT.

KIPO has established a Task Force to push forward and systematically support our preparations to meet, at the earliest possible time, the minimum requirements for being appointed as one of the International Searching Authorities referred to in Article 16(3)(c) as well as in Rule 36.

A. *Patent Examination Personnel Requirement*

KIPO has continuously increased patent examiners by a large number in order to effectively cope with the remarkable increase of patent applications, despite the trend of strong control over the increase of the number of staff in other ministries or government offices under the "small government" policy. The Korean Industrial Property Office has about 400 patent examiners with sufficient technological qualifications to carry out international-type searches and examinations. Almost all examiners have a good knowledge of at least one foreign language. In particular, 41 examiners holding doctorate degrees were recently recruited to undertake examinations with respect to the newly emerging technologies including biotechnology and computer-related technology. Moreover, KIPO plans to further recruit over 200 examiners next year. It is anticipated that there will be over 800 patent examiners by the year 2000.

In addition to the increase in the number of patent examiners, KIPO has also strived to further enhance the quality of examination by way of a series of intensive training programs. Before becoming a patent examiner, the prospective examiner must undergo a series of intensive training courses to learn all the necessary professional knowledge and skills including patent law, patent classification, and the guidelines for patent search and examination. Even after becoming an examiner, he/she is required to undergo re-training courses in the third and the fifth year in order to keep informed of new information and knowledge in the related field of intellectual property as well as technology concerned. KIPO has also established and maintained the so-called "Examiner Evaluation System" to ensure the high quality of examination by conferring incentives to good examiners who obtain high points during examination evaluation.

While strengthening the examination staff, KIPO has made every effort to promote and update the computerization of patent search and examination with the aim of enhancing the total efficiency of the patent examination process.

Since the launch of the first comprehensive computerization plan in 1989 with the assistance of WIPO, KIPO's computerization status has been considerably improved. In spite of many difficulties stemming from the lack of experienced experts, funding, and facilities, concerted efforts have been made to further upgrade the computerization of patent search and related administration, and numerous computerized systems were developed and successfully employed in the area of administration processing, patent search and examination.

In order to meet the changes in users' demands, IPR systems, and technological developments, KIPO reviewed the computerization plan made in 1989 and complemented it in a more realistic and efficient manner.

The KIPO's current computerized system covers the entire process of patent administration from application to registration. The following is a list of systems developed by KIPO:

- application and examination processing system ('92)
- trial decision search system ('92)
- patent search system ('92-'95)
 - . IFD search system ('92)
 - . English literature search system ('93)
 - . Japanese literature search system ('94)
 - . domestic literature search system ('95)
 - . accumulation of search data: foreign ('93-'95), domestic ('95-'96)
- electronic application system ('94-'97)
- official gazette publication on CD-ROM system ('96)

In particular, I would like to illustrate in detail the computerized systems developed and put in operation in KIPO with respect to patent search and examination.

1) the Patent Search Database

Domestic and foreign information or materials is sorted, then keyed-in or scanned into the database. The computerization of this database is carried out on a step-by-step basis, giving priority to the industrial sectors in urgent need of prior art search, such as the automobile and semi-conductor industries. The system, which is already in partial operation, is expected to contribute toward the speeding up of the patent examination and information supply for interested parties. The creation of the database for past documents will be finished by 1998. Full texts and abstracts of all Korean patent/utility model applications filed since 1947 will be compiled through image scanning. The input process will be gradually carried out year by year until 1998 starting from applications related to key industrial sectors. In 1994, a total number of 78,695 cases was image-scanned into the database and necessary preparation for inputting the abstracts was completed.

2) the Patent Search System

A patent search system in Korean and Japanese languages was developed in 1994. This search system, developed for more efficient retrieval of prior art references is a database of patent information and material from many different countries permitting an on-line access to the stored data in various conditions. Completed in 1994 was a search system available in Korean and Japanese which was integrated into the existing English search system having been developed in 1993, and has been in operation since that time. The search system which underwent some database reconstruction (11 million items) resulting from continuous testing and changing of hardware of the IFD retrieval system, is now in full-fledged operation.

3) the Electronic Filing System

KIPO started to operate an electronic filing system in July 1996 and the plan was successfully carried out. Forty-two percent of the total patent applications were filed on floppy disks from the launch of the electronic filing system in July 1996 to the end of the year.

KIPO will endeavor to further improve computerization including the continuous up-dating of computer-aided search and examination systems.

B. Minimum Documentation

In relation to patent documentation the Korean Industrial Property Office has operated a documentation division since its inauguration in 1977 which is in charge of collecting patent documents and non-patent literature, classifying them into search files for patent examiners and providing information service to the public. In 1991, KIPO established the Information and Documentation Bureau with the aim of further facilitating the task of collecting, processing and utilizing patent information and documentation.

As the result of systematic and continuous efforts with reference to patent documentation, KIPO has now collected a wide range of information resources from Korea and from 35 other countries including the US, the UK, Germany, France and Japan and three international organizations including EPO and WIPO. As of March 1997, KIPO is in possession of more than 40 million patent documents in the form of paper, microfilm and other electronic media including CD-ROM, together with an almost complete set of the non-patent literature referred to in PCT Rule 34.1(b)(iii). The collected patent documents are classified according to the International Patent Classification into search files which are located in the examiners' room. The documents in the search files contain the full text of patent specifications of more than 36 million cases from 16 countries and three organizations including Australia, Austria, Canada, France, Germany, Japan, Russia, Switzerland, the UK, the US, EPO, WIPO and OAPI, together with the abstracts of 18 countries' patent documents.

In addition, KIPO has collected a large number of machine-readable documents in the form of microfilm as well as CD-ROM. Microfilm documents contain more than 6 million cases from nine countries and two organizations including Australia, Canada, Switzerland, France, the UK, Japan, the US, EPO and WIPO. There are also over five million cases in CD-ROM from 12 countries and three organizations including major developed countries as well as EPO and WIPO.

Furthermore, KIPO has now 56 CD-ROM workstations, together with 386 personal computers in which a CD-ROM drive can be installed. All patent examiners will have a PC with a CD-ROM drive by the end of this year, with which they can access to patent documentation arranged for search purposes on CD-ROM or other electronic media.

KIPO also has established the WPI and FPDB databases and a retrieval system in order for patent examiners to utilize the data published by the Derwent Information Ltd. and EPO. The WPI database contains more than six million cases from 35 countries and two organizations dated back to 1963, the contents of which are bibliographic data, drawings and abstracts in English, and FPDB stores patent documents covering EPO, Japan and the US.

In addition, the patent examiners of KIPO can access, through the Internet, non-patent literature including a large number of periodicals on science and technology, which also introduce recently developed technologies.

KIPO has entered into consultation with several foreign patent offices with a view to obtaining the missing documents listed in the attached Annex. While hoping these offices will grant assistance by donating or selling to KIPO the missing parts of the minimum documentation they published, I anticipate that we will be able to complete the collection of those documents by the date on which the Agreement between WIPO and KIPO will enter into force.

In conclusion, I am confident that KIPO has already established a strong examining force and a rich collection of documentation, to almost meet the minimum requirements to be a qualified PCT ISA and IPEA. The remainder of the minimum documentation will be secured in the shortest period of time.

We promise to make every endeavors to complete the necessary requirements as soon as possible.

[Appendix II follows]

APPENDIX II

DRAFT

Agreement

between the Korean Industrial Property Office
and the International Bureau of the World Intellectual Property Organization

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

Preamble

The Korean Industrial Property Office and the International Bureau of the World Intellectual Property Organization,

Considering Articles 16(3)(b) and 32(3) of the Patent Cooperation Treaty in relation to the functioning of national Offices and intergovernmental organizations as International Searching Authorities and International Preliminary Examining Authorities under the Patent Cooperation Treaty,

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 Korean Industrial Property 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. 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 Search Guidelines and the PCT Preliminary Examination Guidelines.

(2) 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.

(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.

(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).

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 made by the Authority (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 International Patent Classification.

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.

Article 9

Entry into Force

This Agreement shall enter into force one month after the date on which the Authority notifies the Director General of the World Intellectual Property Organization that it has in its possession the minimum documentation referred to in Rule 34, properly arranged for search purposes, including both patent documents and non-patent literature.

Article 10

Duration and Renewability

This Agreement shall remain in force until December 31, 2007. The parties to this Agreement shall, no later than January 2007, 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; 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 schedule of fees and charges contained in Annex C to this Agreement;
- (iii) amend the indications of languages of correspondence contained in Annex D to this Agreement.

(4) Any amendment notified under paragraph (3) shall take effect on the date specified in the notification, provided that, for any increase of fees or charges contained in Annex C, that date is at least one month 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, 2007:
- (i) if the Korean Industrial Property Office 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 Korean Industrial Property Office 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 Korean languages, each text being equally authentic.

For the Korean Industrial Property Office
by:

For the International Bureau
by:

(signature)
(function)

(signature)
Director General of the World Intellectual
Property Organization

Annex A
States and Languages

Under Article 3 of the Agreement, the Authority specifies:

(i) the following States:

Republic of Korea;
any developing country that the Authority will specify;

(ii) the following languages:

Korean, English.

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:

none.

Annex C
Fees and Charges

Part I. Schedule of Fees and Charges

Kind of fee or charge	Amount (Korean won)
Search fee (Rule 16.1(a))	150,000
Additional fee (Rule 40.2(a))	150,000
Preliminary examination fee (Rule 58.1(b))	150,000
Additional fee (Rule 68.3(a))	150,000
Cost of copies (Rules 44.3(b), 71.2(b) and 94.1), per page	200

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 an earlier search, 75% of the search fee paid shall be refunded.

(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.

Annex D Languages of Correspondence

Under Article 7 of the Agreement, the Authority specifies the following languages:

Korean, English.

[End of Appendix and of document]