

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

Thirty-First Session
Beijing, October 16 and 17, 2024

MODEL AGREEMENT BETWEEN AN OFFICE OR ORGANIZATION AND THE
INTERNATIONAL BUREAU IN RELATION TO ITS FUNCTIONING AS AN
INTERNATIONAL SEARCHING AND PRELIMINARY EXAMINING AUTHORITY

Document prepared by the International Bureau

SUMMARY

1. This document invites comments on a draft model Agreement that would be used for preparing the individual agreements under Articles 16(3) and 32(3) that the International Bureau will conclude with each Office or organization that will act as an International Searching and Preliminary Authority from January 1, 2028.

BACKGROUND

2. At its thirtieth session in November 2023, the Meeting discussed the extension of appointment of International Searching and Preliminary Examining Authorities beyond December 31, 2027, when all appointments are due to expire (see document PCT/MIA/30/4, and paragraphs 42 to 46 of the Summary by the Chair of the Meeting, document PCT/MIA/30/10). Paragraph 46 of the Summary sets out the follow up agreed by the Meeting:

“46. The Meeting invited the International Bureau, taking into account the comments made:

(a) to give further consideration to how the review of applications for extension of appointment of the International Authorities can be conducted efficiently; and

(b) to begin informal discussions with International Authorities on improving the agreements between the International Bureau and International Authorities, particularly with regard to streamlining the process of making changes to fees and the competence of the Authority.”

3. The Assembly of the PCT Union (“the Assembly”) will be required to approve the extension of appointment of each Office or organization wishing to continue operations from January 1, 2028. For each extension of appointment, the Assembly must approve an agreement under Articles 16(3)(b) and 32(3) relating to the functioning of the Office or organization as an International Searching and Preliminary Examining Authority (“Agreement”). Further details of this process are set out in paragraphs 2 to 4 of document PCT/MIA/30/4.

4. Annex I to this document sets out a draft model Agreement based on an earlier draft that has been discussed informally over the PCT Quality Subgroup electronic forum. Like previous extensions of appointment, the International Bureau intends to base individual draft agreements on a model Agreement that is common to all Authorities, thereby giving the same general rights and obligations to each Authority. The International Bureau will therefore invite the Committee for Technical Cooperation to comment on the draft model Agreement when it provides its advice on the extension of appointments under Article 16(3)(e), as took place when the Committee provided its advice on extensions of appointment at its thirtieth session in May 2017 (see document PCT/CTC/30/5).

DRAFT MODEL AGREEMENT

5. The draft model Agreement removes all Annexes compared to the existing Agreements. The content of these Annexes relates to the competence of the Authority in terms of States and languages of the international application and operational arrangements such as fees, classification arrangements and languages of correspondence. This information is also included in the *PCT Applicant's Guide*. By removing the Annexes, duplication of this information will be avoided, removing the possibility of inconsistencies. Moreover, the *PCT Applicant's Guide* has been fully electronic since December 2022, increasing the efficiency of processing data and providing users with enhanced functions and a better navigation experience compared to the PDF format of the Agreements.

6. In place of amending the Annexes, the Authority would notify the International Bureau of a modification, which the International Bureau would publish in the *PCT Gazette* and incorporate into the *PCT Applicant's Guide* when the modification takes effect. For International Authorities in States where amending the Annexes of the Agreement can be a protracted process, it is hoped that a notification procedure will facilitate standard operational changes such as fee amounts or extending the competency of an Authority to additional States and languages.

7. While publication of a notification in the *PCT Gazette* will replace amendment of Annexes in the draft model Agreement, the model draft Agreement does not intend to change the practical requirements in terms of the operational details that require agreement between the Director General and the Authority before a change can take effect, and those that an Authority can change by a unilateral notification to the International Bureau. For example, in Article 3, an Authority will be able to add to the States for which it will act as International Searching Authority or International Preliminary Examining Authority and the languages it will accept for international application by notifying the International Bureau. However, reducing the number of States or removing a language accepted for international applications will continue to require agreement of the Director General.

8. Compared to existing Agreements, the draft model Agreement does change the timing for any modification to take effect except for when a receiving Office specifies an International Authority to become competent for international search and preliminary examination. To provide adequate time to set up appropriate data and fee transfer processes, set equivalent

amounts to fees, and update legal publications, the International Bureau proposes that a minimum period of two months is required from the date that the International Bureau receives the notification to the date that the International Authority becomes competent for international applications filed at that receiving Office.

9. To transition to the new format of Agreements based on notifications, the draft model Agreement requires the International Bureau to publish in the *PCT Gazette* the provisions that apply when the Agreements enter into force where this is essential for the operation as an International Searching and Preliminary Examining Authority. These requirements are in Article 3(3) relating to the States for which the Authority will act, and the languages accepted for international applications, Article 5(1) relating to the fees and charges of the Authority, and Article 7(1) regarding the languages of correspondence used by the Authority. In the case of carrying out supplementary international searches, a previous notification will remain in effect when the new Agreements enter into force. This will also apply for the exceptions of subject matter excluded from search or examination referred to in Article 4 and additional patent classifications used in reports and opinions referred to in Article 6. Before the transition, the International Bureau will contact each International Authority to invite them to confirm the details that are in the current Annexes to the Agreements or notify any changes. The International Bureau will then publish in the *PCT Gazette* the provisions to apply when the new Agreements enter into force.

AMENDMENTS TO THE REGULATIONS UNDER THE PCT

10. Where the PCT Regulations refer to the Agreement and the relevant provisions are set out in the current Annexes, the relevant Rules could be amended with effect from January 1, 2028, to account for removal of the Annexes, as set out in Annex II to this document. The need to amend the Rules could be discussed during the session of the PCT Working Group that takes place when the Committee for Technical Cooperation meets to provide its advice on extensions of appointment with a view to considering submitting the proposed amendments to the Assembly when it extends the appointment of International Authorities and approves new draft Agreements.

11. *The Meeting is invited to comment on the draft model Agreement set out in Annex I and on the draft amendments to the PCT Regulations set out in Annex II to this document.*

[Annex I follows]

Draft 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

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 of the Contracting States for which the Authority will act, 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 that the Authority will accept and any other requirements regarding international applications published under this Article have been met, 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 of the Contracting States for which the Authority will act, 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 that the Authority will accept and any other requirements regarding international applications published under this Article have been met, and, where applicable, that the Authority has been chosen by the applicant.

(3) The International Bureau shall publish in the Gazette the Contracting States for which the Authority will act as International Searching Authority and International Preliminary Examining Authority, the languages that the Authority will accept, and any other requirements regarding international applications determining the competence of the Authority to act as International Searching Authority and International Preliminary Examining Authority, applicable at the date of entry into force of this Agreement.

(4) Without prejudice to paragraph (5), modifications may be made to the Contracting States for which the Authority will act as International Searching Authority or International Preliminary Examining Authority, the languages that the Authority will accept and other requirements regarding international applications determining the competence of the Authority to act as International Searching Authority and International Preliminary Examining Authority, 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.

(5) The Authority may, by a notification to the International Bureau, add to the States for which the Authority will act as International Searching Authority or International Preliminary Examining Authority and the languages that the Authority will accept for international applications; any addition shall take effect on the date specified in the notification.

(6) Where a receiving Office specifies the Authority under paragraphs (1) and (2), the Authority shall become competent for international applications filed at that receiving Office from a date to be agreed by the receiving Office and the Authority and to be notified to the International Bureau, that date being at least two months later than the date on which the notification is received by the International Bureau.

(7) 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).

(8) The Authority shall be competent to carry out supplementary international searches in accordance with Rule 45*bis* if it has notified the International Bureau of its preparedness to do so, specifying the documentation that the supplementary international search will cover and any limitations and conditions on the competency of the Authority. The Authority may, at any time, notify the International Bureau that it wishes to modify the documentation and the limitations and conditions, or notify that the Authority is no longer prepared to be competent to carry out supplementary international searches; any modification shall take effect from the date specified in the notification, provided that, in the case that the Authority is no longer prepared to be competent to carry out supplementary international searches, that date is at least six months later than the date on which the notification is received by the International Bureau.

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 that the Authority has notified to the International Bureau; any changes to the exceptions of the subject matter shall take effect on the date specified in the notification.

Article 5

Fees and Charges

(1) The International Bureau shall publish in the Gazette, the 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, and, where applicable, as an Authority specified for supplementary search, and any conditions for and the extent of refunds and reductions in fees, as applicable on the date of entry into force of this Agreement.

(2) The Authority may, by a notification to the International Bureau, change the currencies or amounts of the fees of the Authority or of the charges which the Authority is entitled to make, in relation to its functions as an International Searching Authority and International Preliminary Examining Authority, add or remove any fees or charges that may be required by the Authority, add or remove any late fees for which payment may be subjected by the Authority, and make changes in the conditions for and the extent of refunds or reductions of fees permitted under the Treaty and Regulations, provided that any amount paid by mistake, without cause, or in excess of the amount due, for fees shall be refunded. Any notification under this paragraph shall specify the date that the changes shall take effect, provided that that date is at least two months later than the date on which the notification is received by the International Bureau.

Article 6 Classification

For the purposes of Rules 43.3(a) and 70.5(b), the Authority shall indicate the classification of the subject matter according to the International Patent Classification. The Authority may, in addition, in accordance with Rules 43.3 and 70.5, indicate the classification of the subject matter according to any other patent classification that it has notified to the International Bureau to the extent decided by it as set out in that notification; any changes to the other patent classifications shall take effect on the date specified in the notification.

Article 7 Languages of Correspondence Used by the Authority

(1) The International Bureau shall publish in the Gazette the language or languages that the Authority may use for the purposes of correspondence, including forms, other than with the International Bureau, and, where more than one language may be used, any conditions relating to the use of a language.

(2) The Authority may, by a notification to the International Bureau, amend the languages that the Authority may use for the purposes of correspondence other than with the International Bureau, and any conditions relating to the use of a language; any amendment shall take effect on the date specified in the notification.

(3) Where more than one language has been indicated under this Article, the Authority shall give regard to the language or languages specified under Article 3 of this Agreement and to the language or languages whose use is authorized by the Authority under Rule 92.2(b).

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 on January 1, 2028.

Article 10
Duration and Renewability

This Agreement shall remain in force until December 31, 2037. The parties to this Agreement shall, no later than July 2036, start negotiations for its renewal.

Article 11
Amendment

(1) 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) The International Bureau shall publish any amendments or notifications provided for under this Agreement in the Gazette.

Article 12
Termination

(1) This Agreement shall terminate before December 31, 2037:

(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.

In witness whereof the parties hereto have executed this Agreement.

Done at CITY, this DATE, in XX originals in the LANGUAGES language(s) [each text being equally authentic].

For the PARTY by:

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

[Annex II follows]

PROPOSED AMENDMENTS TO THE PCT REGULATIONS¹

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¹ Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned.

Rule 16
The Search Fee

16.1 and 16.2 *[No change]*

16.3 *Partial Refund*

Where the International Searching Authority takes into account, under Rule 41.1, the results of an earlier search in carrying out the international search, that Authority shall refund the search fee paid in connection with the international application to the extent and under the conditions ~~provided for~~ [published in the Gazette under the procedure](#) in the agreement under Article 16(3)(b).

Rule 44
Transmittal of the International
Search Report, Written Opinion, Etc.

44.1 and 44.2 *[No change]*

44.3 *Copies of Cited Documents*

(a) [No change] The request referred to in Article 20(3) may be presented any time during seven years from the international filing date of the international application to which the international search report relates.

(b) The International Searching Authority may require that the party (applicant or designated Office) presenting the request pay to it the cost of preparing and mailing the copies. The level of the cost of preparing copies shall be ~~provided for~~ [notified to the International Bureau under the procedure](#) in the agreements referred to in Article 16(3)(b) between the International Searching Authorities and the International Bureau.

(c) [Remains deleted]

(d) [No change] Any International Searching Authority may perform the obligations referred to in paragraphs (a) and (b) through another agency responsible to it

Rule 45bis
Supplementary International Searches

45bis.1 Supplementary Search Request

(a) [No change] The applicant may, at any time prior to the expiration of 22 months from the priority date, request that a supplementary international search be carried out in respect of the international application by an International Searching Authority that is competent to do so under Rule 45bis.9. Such requests may be made in respect of more than one such Authority.

(b) to (d) [No change]

(e) The supplementary search request shall be considered not to have been submitted, and the International Bureau shall so declare:

(i) if it is received after the expiration of the time limit referred to in paragraph (a); or

(ii) if the Authority specified for supplementary search has not ~~stated, in the applicable agreement under Article 16(3)(b),~~ notified the International Bureau of its preparedness to carry out such searches or is not competent to do so under Rule 45bis.9(b).

45bis.2 [No change]

45bis.3 Supplementary Search Fee

(a) to (c) [No change]

(d) [No change] The International Bureau shall refund the supplementary search fee to the applicant if, before the documents referred to in Rule 45bis.4(e)(i) to (iv) are transmitted to the Authority specified for supplementary search, the international application is withdrawn or considered withdrawn, or the supplementary search request is withdrawn or is considered not to have been submitted under Rules 45bis.1(e) or 45bis.4(d).

(e) The Authority specified for supplementary search shall, to the extent and under the conditions ~~provided for~~ published in the Gazette under the procedure in the applicable agreement under Article 16(3)(b), 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).

45bis.4 [No change]

45bis.5 *Start, Basis and Scope of Supplementary International Search*

(a) to (e) [No change]

(f) The supplementary international search shall cover at least the documentation [that the Authority has notified to the International Bureau](#) for that purpose ~~in the applicable agreement under Article 16(3)(b)~~.

(g) [No change] If the Authority specified for supplementary search finds that carrying out the search is entirely excluded by a limitation or condition referred to in Rule 45bis.9(a), other than a limitation under Article 17(2) as applicable by virtue of Rule 45bis.5(c), the supplementary search request shall be considered not to have been submitted, and the Authority shall so declare and shall promptly notify the applicant and the International Bureau accordingly.

(h) [No change]

45bis.6 to 45bis.8 [No change]

45bis.9 *International Searching Authorities Competent to Carry Out Supplementary International Search*

(a) An International Searching Authority shall be competent to carry out supplementary international searches if [it has notified the International Bureau of](#) its preparedness to do so, ~~is stated in the applicable agreement under Article 16(3)(b)~~, subject to any limitations and conditions to the extent set out in that ~~agreement~~ [notification](#).

(b) [No change] The International Searching Authority carrying out the international search under Article 16(1) in respect of an international application shall not be competent to carry out a supplementary international search in respect of that application.

(c) [No change] The limitations referred to in paragraph (a) may, for example, include limitations as to the subject matter for which supplementary international searches will be carried out, other than limitations under Article 17(2) as applicable by virtue of Rule 45*bis*.5(c), limitations as to the total number of supplementary international searches which will be carried out in a given period, and limitations to the effect that the supplementary international searches will not extend to any claim beyond a certain number of claims.

Rule 71
Transmittal of the International Preliminary Examination Report
and Related Documents

71.1 *[No change]*

71.2 *Copies of Cited Documents*

(a) [No change] The request under Article 36(4) may be presented any time during seven years from the international filing date of the international application to which the report relates.

(b) The International Preliminary Examining Authority may require that the party (applicant or elected Office) presenting the request pay to it the cost of preparing and mailing the copies. The level of the cost of preparing copies shall be ~~provided for~~ [notified to the International Bureau under the procedure](#) in the agreements referred to in Article 32(2) between the International Preliminary Examining Authorities and the International Bureau.

(c) [Remains deleted]

(d) [No change] Any International Preliminary Examining Authority may perform the obligations referred to in paragraphs (a) and (b) through another agency responsible to it.

[End of Annex II and of document]