

No. 19642

AUSTRALIA
and
WORLD INTELLECTUAL PROPERTY
ORGANIZATION

Agreement in relation to the establishment and functioning of the Patent Office of the Government of Australia as an international searching and international preliminary examining authority under the Patent Cooperation Treaty (with annexes). Signed at Geneva on 29 February 1980

Authentic text: English.

Registered by Australia on 11 March 1981.

AUSTRALIE
et
ORGANISATION MONDIALE
DE LA PROPRIÉTÉ INTELLECTUELLE

Accord relatif à la création et au fonctionnement de l'Office des brevets du Gouvernement australien comme administration chargée de la recherche et de l'examen préliminaire international en vertu du Traité de coopération en matière de brevets (avec annexes). Signé à Genève le 29 février 1980

Texte authentique : anglais.

Enregistré par l'Australie le 11 mars 1981.

AGREEMENT¹ BETWEEN THE PATENT OFFICE OF THE GOVERNMENT OF AUSTRALIA AND THE INTERNATIONAL BUREAU OF THE WORLD INTELLECTUAL PROPERTY ORGANIZATION IN RELATION TO THE ESTABLISHMENT AND FUNCTIONING OF THE PATENT OFFICE OF THE GOVERNMENT OF AUSTRALIA AS AN INTERNATIONAL SEARCHING AND INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY UNDER THE PATENT COOPERATION TREATY²

PREAMBLE

Whereas the States party to the Patent Cooperation Treaty, done at Washington on June 19, 1970,² constitute a Union for cooperation in the filing, searching and examination of applications for the protection of inventions, and for rendering special technical services, the said Union being known as the International Patent Cooperation Union;

And whereas articles 16(3)(b) and 32(3) of the Patent Cooperation Treaty provide, *inter alia*, that the appointment of an Office as an International Searching and International Preliminary Examining Authority by the Assembly of the International Patent Cooperation Union shall be subject to the conclusion of an Agreement with the International Bureau;

And whereas it is recognized that the participation of the Patent Office of the Government of Australia as an International Searching and International Preliminary Examining Authority in matters affecting international search and international preliminary examination will contribute to the successful implementation of the Patent Cooperation Treaty;

It is hereby agreed between the Patent Office of the Government of Australia and the International Bureau of the World Intellectual Property Organization, hereinafter called the "International Bureau," as follows:

Article 1. TERMINOLOGY USED IN THE AGREEMENT

(1) For the purpose of this Agreement, "Treaty" means the Patent Cooperation Treaty done at Washington on June 19, 1970; "Regulations" means the Regulations under the Treaty; "Administrative Instructions" means the Administrative Instructions under the Treaty; "article," except where otherwise specified, means an Article of the Treaty; "Rule" means a Rule of the Regulations; "Assembly" means the Assembly as defined in article 2(xvii); "International Bureau" means the International Bureau as defined in article 2(xix); "Contracting State" refers to a Contracting State to the Treaty; "Authority" means the Patent Office of the Government of Australia.

(2) All other terms and expressions used in this Agreement are to be understood in the same sense as that in which they are used in the Treaty.

¹ Came into force on 29 February 1980 by signature after approval by the Assembly of the International Patent Cooperation Union, in accordance with article 14.

² United Nations, *Treaty Series*, vol. 1160, p. 231.

Article 2. BASIC OBLIGATION

(1) The Authority shall, except in respect of subject matter which, pursuant to article 6 of this Agreement, the Authority is not required to search or to examine, carry out international search and international preliminary examination in accordance with, and perform such other functions of an International Searching 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 be guided by the Guidelines for International Search and for International Preliminary Examination to be carried out under the Treaty. The Authority undertakes to apply and observe all the common rules of international search and of international preliminary examination.

(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, each render, to the extent possible, assistance to the other in relation to the performance, by the other, of its functions thereunder.

Article 3. COMPETENCE OF AUTHORITY

(1) The Authority undertakes to act as an International Searching Authority for the international applications filed with the receiving Offices of, or acting for, the Contracting States indicated in annex A of this Agreement provided that the receiving Office specifies the Authority for that purpose and that such applications are in one of the languages specified in annex A of this Agreement.

(2) The Authority undertakes to act as an International Preliminary Examining Authority for the international applications filed with the receiving Offices of, or acting for, the Contracting States indicated in Annex A of this Agreement provided that the receiving Office specifies the Authority for that purpose and that such applications are in one of the languages specified in annex A of this Agreement. In respect of international applications filed in the languages specified in annex A, the Authority shall carry out examination without requiring translations of such applications.

Article 4. PROVISION OF PERSONNEL

(1) The Authority shall, for the purposes of carrying out international search and international preliminary examination, respectively, make available the staff at its disposal, to the extent required by the workload, having sufficient technical qualifications to carry out such search or such examination. The staff of the Authority shall be maintained at a level meeting the minimum requirement as set out in Rules 36.1(i) and 63.1(i).

(2) The Authority shall maintain a staff which is capable of searching and examining in all technical fields and which has language facilities to understand at least those languages in which the minimum documentation referred to in Rule 34 is written or is translated.

Article 5. DOCUMENTATION FACILITIES

The Authority shall, for the purposes of this Agreement, use all documentation facilities at its disposal. In any event, the minimum requirements concerning documentation as set out in Rules 36.1(ii) and 63.1(ii) shall be respected.

Article 6. SUBJECT MATTER NOT REQUIRED TO BE SEARCHED OR EXAMINED

The Authority will not search, by virtue of article 17(2)(a)(i), or will not examine, by virtue of article 34(4)(a)(i), any international application to the extent that it considers that the international application relates to subject matter set forth in Rule 39.1 or Rule 67.1, as the case may be, with the exception of the subject matter specified in annex B.

Article 7. 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 function as an International Searching and International Preliminary Examining Authority, is set out in annex C of this Agreement.

(2) The Authority shall, to the extent and under the conditions set out in annex C of this Agreement, refund the whole or part of the search fee paid where a search report can be wholly or partially based on the results of an earlier international or international-type search made by the Authority (Rules 16.3 and 41.1).

Article 8. REVIEW BOARD

The Authority shall provide, in accordance with Rules 40.2(c) and 68.3(c) and (d), a special instance to examine protests in respect of additional fees where the international application is found not to comply with the requirement of unity of invention. The said special instance shall be the Commissioner of Patents or any officer exercising his powers under Australian law.

Article 9. TIME LIMIT FOR PREPARATION OF INTERNATIONAL SEARCH REPORTS OR DECLARATIONS AND INTERNATIONAL PRELIMINARY EXAMINATION REPORTS

The Authority shall, within the time limits specified in the first two sentences of Rule 42.1, establish international search reports, or declarations under article 17(2) (a) and, within the maximum periods specified in Rule 69.1(a) (i) and (ii), establish international preliminary examination reports.

Article 10. CLASSIFICATION

For the purposes of Rules 43.3(a) and 70.5(b), the Authority shall indicate solely the International Patent Classification.

Article 11. LANGUAGES OF CORRESPONDENCE USED BY THE AUTHORITY

For the purposes of correspondence, including forms, the Authority shall use the English language.

Article 12. INTERNATIONAL-TYPE SEARCH

(1) The Authority shall make an international-type search on any national application filed in any Contracting State which has specified the Authority as mentioned in article 3(1) of this Agreement:

- (i) As far as such is permitted by the law of, and is requested by, such State;
- (ii) Where the national law of such State so permits and the applicant so requests.

(2) Where the national application is not in a language in which the Authority has undertaken to search international applications under article 3 of this Agreement, the international-type search shall be carried out on a translation in a

language which the Authority has undertaken to accept for international applications under article 3 of this Agreement.

Article 13. INFORMATION SERVICE AND TECHNICAL ASSISTANCE

The Authority shall supply the International Bureau with such information services and such other contributions to the technical assistance program under chapter IV of the Treaty as are practicable within the existing facilities of the Authority and may be agreed. The provision of search or examination work for developing countries under preferential conditions shall be the subject of a special agreement.

Article 14. ENTRY INTO FORCE OF THE AGREEMENT

This Agreement shall enter into force once all the following conditions are fulfilled:

- (i) It is approved by the Assembly;
- (ii) It is signed by the Authority and the International Bureau; and
- (iii) The Treaty has entered into force for Australia.

The Agreement together with an indication of the date of its entry into force shall be published in the *Gazette* by the International Bureau.

Article 15. DURATION AND RENEWABILITY OF THE AGREEMENT

This Agreement shall remain in force for a period of 10 years. It shall be renewable for a period of 10 years subject to the approval of, and the extension of the appointment of the Authority for that period by, the Assembly.

Article 16. AMENDMENT

(1) Without prejudice to paragraphs (2) and (3), amendments may be made to this Agreement by agreement between the parties hereto and shall take effect upon approval of those amendments by the Assembly, or, if a later date is specified in the amendments, on that date.

(2) Without prejudice to the provisions of paragraph (3), amendments may be made to the annexes of this Agreement by agreement between the parties hereto and shall take effect upon notification in the *Gazette* or, if a later date is specified in the amendments, on that date.

(3) The Authority may, by notice in writing given to the Director General of the World Intellectual Property Organization:

- (i) Add to the States and languages listed in annex A of this Agreement;
- (ii) Subject to paragraph (4), amend the schedule of fees and other charges contained in annex C of this Agreement.

(4) Normally, the schedule of fees and other charges shall not be amended during the first year after the entry into force of this Agreement or thereafter at an interval of less than one year from a previous amendment of the schedule. Any amendment of the schedule shall take effect one month after publication of the notification of the amendment in the *Gazette* pursuant to paragraph (5), or, if a later date has been specified by the Authority, on the date specified by the Authority.

(5) The International Bureau shall publish promptly in the *Gazette* any amendment of this Agreement agreed between the parties and approved by the Assembly under paragraph (1), any amendment of this Agreement agreed between the parties under paragraph (2), and any notification received by it under paragraph (3).

Article 17. TERMINATION OF THE AGREEMENT

(1) This Agreement shall terminate:

- (a) If the Authority gives the Director General of the World Intellectual Property Organization written notice to terminate this Agreement; or
- (b) If the Director General of the World Intellectual Property Organization, with the approval of the Assembly, gives the Authority 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.

IN WITNESS WHEREOF the parties hereto have executed this Agreement.

DONE at Geneva, this twenty ninth day of February. One thousand nine hundred and eighty, in two originals, in the English language.

For the Patent Office
of the Government of Australia:

[Signed — Signé]¹

For the International Bureau:

[Signed — Signé]²

ANNEX A

STATES AND LANGUAGES SPECIFIED FOR THE PURPOSES
OF ARTICLE 3 OF THE AGREEMENT

1. The States specified for the purposes of article 3(1) of the Agreement are:
Australia and the States regarded as a developing country in conformity with the established practice of the General Assembly of the United Nations.
2. The languages specified for the purposes of article 3(1) of the Agreement are:
English.
3. The States specified for the purposes of article 3(2) of the Agreement are:
Australia and the States regarded as a developing country in conformity with the established practice of the General Assembly of the United Nations.
4. The languages specified for the purposes of article 3(2) of the Agreement are:
English.

ANNEX B

SUBJECT MATTER SPECIFIED UNDER ARTICLE 6 OF THE AGREEMENT

The subject matter set forth in Rule 39.1 or Rule 67.1, which, under article 6 of the Agreement, is not excluded from search or examination, is the following:

None.

¹ Signed by L. D. Thompson — Signé par L. D. Thompson.

² Signed by A. Bogsch — Signé par A. Bogsch.

ANNEX C

SCHEDULE OF FEES AND CHARGES OF THE AUTHORITY AND EXTENT AND CONDITIONS OF REFUNDS OF THE SEARCH FEE FOR THE PURPOSES OF ARTICLE 7 OF THE AGREEMENT

(a) *Schedule of fees and charges*

<i>Fee</i>	<i>Amount in Australian Dollars</i>
Search fee (Rule 16.1(a))	300.00
Additional fee (Rule 40.2(a))	250.00
Preparing copies of cited documents (Rule 44.3(b))	5.00 (per document)
Preliminary examination fee (Rule 58.1(b))	100.00
Additional fee (Rule 68.3(a))	100.00
Preparing copies of cited documents (Rule 71.2(b))	5.00 (per document)

(b) *Conditions and extent of refunds of the search fee where the search report can be wholly or partially based on the results of an earlier international or international-type search (Rule 16.3 and 41.1)*

The conditions and extent of refunds of the search fee in cases where the search report can be wholly or partially based on the results of an earlier international or international-type search are the following:

The amount of any refund of the search fee shall be 75% if the Authority benefits from the prior search report to the full extent or a substantially prevailing portion.