

**Australian Patent Office to Act as
International Searching Authority and
International Preliminary Examining Authority for
International Applications Received by the USPTO**

Effective November 1, 2008, the Australian Patent Office (IP Australia) will act as an International Searching Authority (ISA) under the Patent Cooperation Treaty for international applications filed with the United States Patent and Trademark Office (USPTO) as a receiving Office, provided that (1) the applications are submitted in the English language, (2) the applications do not contain one or more claims relating to mechanical engineering or analogous fields of technology as defined by certain International Patent Classification classes, and (3) IP Australia is chosen as a competent authority by the applicants of said applications. IP Australia will also act as an International Preliminary Examining Authority if these three requirements are met, and IP Australia acted as the ISA.

The USPTO will collect the search fees from the applicants, and will transmit the search fees to IP Australia. The search fee for IP Australia acting as an ISA for international applications received by the USPTO is \$ 1,514, effective November 1, 2008. Any other fees necessary for search or examination or incidental thereto will be paid by applicants directly to IP Australia.

With this addition, U.S. applicants will be able to elect the USPTO, the European Patent Office (EPO),¹ the Korean Intellectual Property Office or IP Australia as the ISA or IPEA.

The concluded agreement between the USPTO and IP Australia for the establishment of the IP Australia as an International Searching Authority and International Preliminary Examining Authority follows.

OCT 31 2008



JON W DUDAS

Under Secretary of Commerce for
Intellectual Property and Director of the
United States Patent and Trademark Office

¹ The use of the EPO is restricted, see PCT Applicant's Guide, Annexes D(EP), E(EP), PCT Gazette No. 07/2005, page 4432 and No. 38/2006, page 19070), the EPO will not act as an ISA/IPEA for US/RO applications with one or more claims to a business method.

**Arrangement between IP Australia and the
United States Patent and Trademark Office
Concerning Action of the Australian Patent Office
as an International Searching Authority
and Preliminary Examining Authority
under the Patent Cooperation International Treaty
for Certain International Applications Received by
the United States Patent and Trademark Office**

In the light of the facts that:

An Agreement exists between the Government of Australia and the International Bureau of the World Intellectual Property Organization (hereinafter called "International Bureau") in relation to the functioning of the Australian Patent Office (hereinafter called "IP AUSTRALIA") as an International Searching and International Preliminary Examining Authority under the Patent Cooperation Treaty (hereinafter called "the Agreement").

The United States Patent and Trademark Office (hereinafter "USPTO") is desirous to have IP AUSTRALIA carry out the tasks as one of the International Searching Authorities and International Preliminary Examining Authorities under the Patent Cooperation Treaty, and IP AUSTRALIA is willing to do so,

1. IP AUSTRALIA and the USPTO (hereinafter also called "both parties" or "the parties") have reached understandings about the following mutual arrangements: (1) IP AUSTRALIA will act as an International Searching Authority and International Preliminary Examining Authority under the Patent Cooperation Treaty for international applications filed with the USPTO as Receiving Office insofar as the following conditions are met

- (i) the applications are submitted in the English language
and

- (ii) the applications do not contain one or more claims relating to mechanical engineering or analogous fields of technology as defined by the International Patent Classification classes indicated in Annex A

and

(iii) insofar as IP AUSTRALIA is chosen as a competent authority, where applicable, by the applicants of said applications

(2) Pursuant to paragraph (1) IP Australia will act as an International Preliminary Examining Authority only where IP Australia had functioned as the International Searching Authority.

(3) The USPTO will inform the International Bureau, pursuant to PCT Rules 35 and 59 that IP Australia is competent for the searching and international preliminary examination of the certain kinds of international application specified under this arrangement in paragraphs (1) and (2).

2. IP AUSTRALIA will conduct the international search and international preliminary examination pursuant to the provisions of the Agreement between IP AUSTRALIA and the International Bureau, and will promptly notify the USPTO of any relevant amendment to said Agreement.
3. The language of correspondence between IP AUSTRALIA and the USPTO or the applicants will be English.
4. Conduct of technical and procedural matters including transfer of fees and exchange of documents will be as specified in the Technical document, Annex B.
5. IP AUSTRALIA, upon request and on payment, will furnish the applicants with copies of the documents cited in the international search reports and the international preliminary examination reports.
6. (1) The fees and charges which IP AUSTRALIA is entitled to make in relation to its function will be those set out in Annex C of the Agreement between IP AUSTRALIA and the International Bureau, depending on the version of the Agreement in force, as represented by Annex D of the PCT Applicant's Guide.

(2) The USPTO will collect the search fees from the applicants in the U.S. dollar amount specified in Annex D of the PCT Applicant's Guide and will transfer said amount in US Dollars (USD) to IP Australia Official Departmental Account at the National Australia Bank in AUSTRALIA, which has been communicated for this use.

(3) The USPTO will transfer the search fee to said bank account

in Australia, by the end of the next month following the month in which the search fee is received, and will promptly notify IP AUSTRALIA of the international filing date, the international application number, and the date on which the search fee was received.

(4) Any fee for copies of documents cited in the international search report, additional international search fee, international preliminary examination fee, additional preliminary examination fee, or any necessary fee for search or preliminary examination will be paid by the applicant to IP AUSTRALIA in the amount in the currency set out in Annex D or E of the PCT Applicant's Guide.

7. (1) This Arrangement will come into effect on **November 1, 2008**.

(2) The period of the validity of this Arrangement will end upon expiry of the Agreement between IP AUSTRALIA and the International Bureau, and will be extended with any renewal of the said Agreement between IP AUSTRALIA and the International Bureau.

8. This Arrangement may be amended with the written consent of both parties.

9. (1) This Arrangement may be terminated by either party by written notice addressed to the other party.

(2) The termination under the preceding paragraph will take effect six months after receipt of the notice by the other party.

(3) IP AUSTRALIA will act as the competent International Searching Authority and the International Preliminary Examining Authority in accordance with this Arrangement upon international applications insofar as these applications are received by the USPTO within six months after the receipt of the notice under the preceding paragraph.

10. (1) Provisions under the Patent Cooperation Treaty, and the Regulations and the Administrative Instructions under the Treaty, where relevant, will apply to matters which are not provided for in this Arrangement.


(2) This Arrangement is not governed by international law. Any differences which arise between IP Australia and the USPTO about this arrangement will be resolved peacefully by consultations and negotiations between IP AUSTRALIA and the USPTO.


Signed in Geneva, Switzerland on behalf of the parties in two originals in English, each text being equally authentic.

Signed in Geneva, Switzerland,

on

September 24, 2008


Jon W. Dudas
Under Secretary of Commerce
for Intellectual Property and
Director of the USPTO


Philip Noonan
Director General
IP Australia

ANNEX A

Subject matter for which the Australian Patent Office is **NOT** a competent International Search Authority or International Preliminary Examination Authority for international applications filed with the RO/US by International Patent Classification (8th edition):

A01-AGRICULTURE; FORESTRY; ANIMAL HUSBANDRY; HUNTING; TRAPPING; FISHING, all classes except:

A01H, A01N, A01P (i.e. new plants or processes of obtaining them thereof, Preservation of human, animals bodies or plants, biocidal, pest repellent, pest attractant or plant growth regulatory activity of chemical compounds or preparations)

A21-BAKING; EQUIPMENT FOR MAKING OR PROCESSING DOUGHS; DOUGHS FOR BAKING all classes except:

A21D, (i.e. Treatment of flour or dough for baking)

A22-BUTCHERING; MEAT TREATMENT; PROCESSING POULTRY OR FISH

A23N – MACHINES OR APPARATUS FOR TREATING HARVESTED FRUIT, VEGETABLES OR FLOWER BULBS IN BULK

A23P-SHAPING OR WORKING OF FOODSTUFFS

A24- TOBACCO; CIGARS; CIGARETTES

A41-47 PERSONAL AND DOMESTIC ARTICLES (eg. headgear (A42), footwear(A43), haberdashery (A44))

A61-MEDICAL OR VETERINARY SCIENCE, all classes except:

A61K, A61L, A61P and A61Q (i.e. preparations for medical, dental or toilet purposes, methods, apparatus for sterilising materials or objects, chemical aspects of bandages, dressings, absorbent pads, or surgical articles, therapeutic activity of chemical compounds, use of cosmetics or similar toilet preparations)

A62- LIFE-SAVING all classes except:

A62D (i.e. chemical means for extinguishing fires, processes for making harmful chemical substances harmless, or less harmful, by effecting a chemical change, composition of materials for coverings or clothing for protecting against harmful chemical agents; composition of materials for transparent parts of gas-masks, respirators, breathing bags or helmets; composition of chemical materials for use in breathing apparatus)

A63- SPORTS; GAMES; AMUSEMENTS

B06- GENERATING OR TRANSMITTING MECHANICAL VIBRATIONS IN GENERAL

B21, B23-B27 all except:

B23K (i.e. soldering or unsoldering; welding; cladding or plating by soldering or welding; cutting by applying heat locally, e.g. flame cutting; working by laser beam)

B31- MAKING PAPER ARTICLE WORKING PAPER

B60-B68 all except:

B60L, B60M and B60Q (i.e. electric equipment or propulsion of electrically-propelled vehicles; magnetic suspension or levitation for vehicles; electrodynamic brake systems for

vehicles, in general, power supply lines, or devices along rails, for electrically-propelled vehicles, arrangement of signalling or lighting devices, the mounting or supporting thereof or circuits therefor, for vehicles in general)

D01-D07 Textiles all except:

D06L, D06M, D06N, D06P, D06Q (i.e. bleaching, treatment of fabrics, dyeing or printing textiles, decorating textiles)

E01- E06 FIXED CONSTRUCTION

E21- EARTH OR ROCK DRILLING; MINING

F01-F04 MACHINES

F15-F17 ENGINEERING ELEMENTS, ACTUATORS, STORAGE OR DISTRIBUTION OF GASES OR LIQUIDS

F41-F42 WEAPONS, AMMUNITION

G04-HOROLOGY

G06-COMPUTING; Calculating; Counting

G10-MUSICAL INSTRUMENTS

G11-INFORMATION STORAGE