

Agreement with WIPO for the Australian Patent Office to function as an ISA and IPEA under the Patent Cooperation Treaty

Introduction

- 3.1 The proposed treaty action is definitive signature of the *Agreement between the Government of Australia and the International Bureau of the World Intellectual Property Organization (WIPO) in relation to the functioning of the Australian Patent Office as an International Searching Authority and International Preliminary Examining Authority under the Patent Cooperation Treaty*. The Agreement will extend an existing treaty, due to expire in December 2008, until 2017.¹
- 3.2 The Patent Cooperation Treaty facilitates the filing and assessment of a patent application in multiple jurisdictions and provides for the appointment of a national patent office as an International Searching Authority (ISA) and International Preliminary Examining Authority (IPEA).
- 3.3 The purpose of this Agreement is to continue the appointment of the Australian Patent Office as an ISA and IPEA, therefore allowing IP Australia to continue as a competent search and examination authority for international patent applications filed in Australia.²

1 National Interest Analysis (NIA), para 2.

2 NIA, para 4.

Reasons for Australia to take treaty action

- 3.4 The Patent Cooperation Treaty (PCT) simplifies and streamlines the process of filing for patent protection in a number of countries through a single international patent application. IP Australia informed the Committee that the 139 member states of the PCT are:
- ... the bigger economic targets for Australian applicants wishing to export – places such as Japan, Continental Europe, America et cetera are all members of the PCT.³
- 3.5 Using the provisions of the PCT therefore provides significant time and cost savings for patent applicants by allowing them to make a single application rather than separate applications in each country they are seeking patent protection in.⁴
- 3.6 An integral part of this process is the appointment of ISAs and IPEAs to conduct the international search and examination required for each application. Appointment of the Australian Patent Office as an ISA and IPEA provides additional cost savings for Australian applicants by also eliminating unnecessary repetition of search and examination across countries.⁵
- 3.7 The Australian Patent Office has been an international authority since 1980 and is one of only 13 patent offices appointed world wide under the PCT.⁶ There is international prestige attached to this appointment and Australia has a high standing in the intellectual property community.⁷ As an international authority:
- IP Australia can continue to influence development of the international IP system from a position of operational credibility.⁸
- 3.8 As part of IP Australia, the Australian Patent Office operates on a full cost recovery basis and its activities are revenue neutral to Government. The Office issues reports on about 3000 international searches each year and has bilateral agreements with other countries,

3 Mr Victor Portelli, *Transcript of Evidence*, 13 October 2008, p. 10.

4 NIA, para 6.

5 NIA, para 6.

6 Mr Victor Portelli, *Transcript of Evidence*, 13 October 2008, p. 7.

7 NIA, para 9.

8 Mr Victor Portelli, *Transcript of Evidence*, 13 October 2008, p. 8.

including New Zealand, Thailand and Singapore, to perform searches for those countries.⁹

- 3.9 The appointment of the Australian Patent Office also provides considerable benefits for local business and industry, which are able to access and use the large skills and knowledge base conveniently available through the Office.¹⁰

Obligations

- 3.10 Article 2 of the treaty provides that the Australian Patent Office shall carry out an international search and international preliminary examination in accordance with the Patent Cooperation Treaty (including its Regulations and Administrative Instructions) and this Agreement to evaluate the originality of an invention and its industrial applicability.
- 3.11 In doing so, the Australian Patent Office is obliged to apply established search and examination rules (Article 2(2)), manage a quality management system (Article 2(3)), and render mutual assistance with the International Bureau of WIPO (Article 2(4)).¹¹
- 3.12 Annexes to the Agreement specify which countries the Australian Patent Office will act as an ISA and IPEA for, the language used by the Office, subject matter not excluded from search or examination, and fees and charges (Annex A to D).

Implementation

- 3.13 No additional action is required to implement this Agreement as it largely continues arrangements already in place under the existing agreement and implemented by the *Patents Act 1990*.

9 NIA, para 8.

10 Mr Victor Portelli, *Transcript of Evidence*, 13 October 2008, p. 8.

11 NIA, paras 11 to 14.

Costs

- 3.14 There will be no additional costs above Australia's existing annual membership contribution to WIPO of about \$750,000. The Committee was informed however that as IP Australia is the only ISA/IPEA Australian patent applicants can use, there would be costs to industry if the Agreement does not proceed.¹²

Consultation

- 3.15 The Australian Patent Office has received very positive support from industry and professional organisations for its role as an ISA/IPEA. Consultation undertaken specifically in relation to this Agreement indicated strong support from stakeholders for continuation of this role.¹³

Conclusion and recommendation

- 3.16 The Committee recognises the advantages to Australian business and industry arising from the appointment of the Australian Patent Office as an ISA and IPEA, as well as the contribution that this appointment makes to Australia's international standing in intellectual property fora. The Committee therefore supports binding treaty action being taken.

Recommendation 2

The Committee supports the Agreement between the Government of Australia and the International Bureau of the World Intellectual Property Organization (WIPO) in relation to the functioning of the Australian Patent Office as an International Searching Authority and International Preliminary Examining Authority under the Patent Cooperation Treaty and recommends that binding treaty action be taken.

12 NIA, para 17.

13 NIA, Consultation attachment.