

Notice Concerning the Australian Patent Office's  
Action as an International Searching Authority and  
International Preliminary Examining Authority for  
International Applications Received by the  
United States Patent and Trademark Office

The conditions under which the Australian Patent Office (IP Australia) will act as an International Searching Authority (ISA) and an International Preliminary Examining Authority (IPEA) under the Patent Cooperation Treaty (PCT) for international applications filed with the United States Patent and Trademark Office (USPTO) as a Receiving Office (RO/US) have changed effective September 24, 2014. The condition that IP Australia would not act as an ISA for applications with one or more claims directed to the fields of business methods or mechanical engineering or analogous fields of technology as defined by specified areas of the International Patent Classification System has been removed. A new condition that IP Australia has not received more than 250 international applications from the USPTO during the relevant fiscal quarter has been added.

This change is the result of a new "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 Application Received by the United States Patent and Trademark Office" signed on September 24, 2014, and effective on that date.

Under the new Arrangement, IP Australia may act as an ISA under the PCT for international applications filed with the RO/US provided that: (1) the applications are submitted in the English language; (2) IP Australia has not received more than 250 international applications from the USPTO during the relevant fiscal quarter; and (3) IP Australia is chosen as a competent authority by the applicants of said applications. IP Australia also will act as an IPEA if these three requirements are met, and IP Australia acted as the ISA.

The USPTO will continue to 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 \$1,972 (USD) effective May 1, 2014. Any other fees necessary for search or examination or incidental thereto will continue to be paid by applicants directly to IP Australia.

The newly concluded Arrangement between the USPTO and IP Australia follows.

12/5/14  
Date



Michelle K. Lee  
Deputy Under Secretary of Commerce for Intellectual  
Property and Deputy Director of the United States Patent  
and Trademark Office

**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:

The United States Patent and Trademark Office (hereinafter called "USPTO") and the Australian Patent Office (hereinafter called "IP Australia") desire to replace the "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" signed at Geneva on September 24, 2008 (USPTO No. 2008-010-087), including its Annexes;

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 "IP Australia" as an International Searching and International Preliminary Examining Authority under the Patent Cooperation Treaty (hereinafter called "the Agreement"); and

USPTO desires 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,

IP Australia and the USPTO (hereinafter also called "the participants") have reached the following understandings:

1. (1) IP Australia intends to 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) IP Australia has not received more than 250 international applications from the USPTO during the current fiscal quarter; and
- (iii) IP Australia is chosen as a competent authority by the applicants of said applications.

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

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

2. IP Australia intends to conduct the international search and international preliminary examination pursuant to the provisions of the Agreement between IP Australia and the International Bureau, and intends to 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 is English.
4. Conduct of technical and procedural matters including transfer of fees and exchange of documents is as specified in the Technical document, Annex A of this arrangement.
5. IP Australia, upon request and on payment, intends to 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 are intended to 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 intends to collect the search fees from the applicants in the U.S. Dollar (USD) amount specified in Annex D

of the PCT Applicant's Guide and intends to transfer said amount in USD to IP Australia Official Departmental Account at the National Australia Bank in Australia, which has been communicated for this use.

(3) The USPTO intends to 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 intends to 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 is expected to be paid by the applicant to IP Australia in the amount and in the currency set out in Annex D or E of the PCT Applicant's Guide.

7. (1) This Arrangement comes into effect upon the date of last signature.

(2) The period of the validity of this Arrangement ends on December 31, 2017 or upon the termination of the Agreement between IP Australia and the International Bureau if such termination is earlier. USPTO and IP Australia intend to extend this Arrangement by written modification upon any renewal of the said Agreement between IP Australia and the International Bureau.

8. This Arrangement may be modified with the written consent of both USPTO and IP Australia.

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

(2) A participant should endeavour to inform the other participant six months before providing the written notice referred to in the preceding paragraph.

(3) IP Australia intends to 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) The participants intend, where relevant, to apply the provisions under the Patent Cooperation Treaty, and the Regulations and the Administrative Instructions under the

Treaty, to matters which are not provided for in this Arrangement.

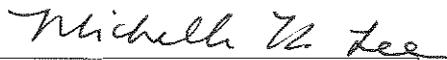
(2) This Arrangement does not give rise to legal obligations under international or domestic law. IP Australia and USPTO intend to resolve any differences which arise regarding this arrangement amicably through consultations and negotiations.

11. Annex A forms part of this arrangement.
12. The participants understand that if there is a change regarding the information in Section 1 (Contact Details) of Annex A, the participant making the change intends to notify the other participant.
13. This Arrangement replaces the "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", signed at Geneva September 24, 2008, including its Annexes.

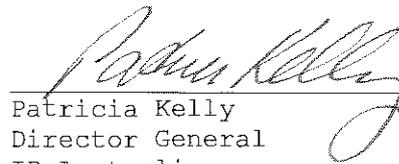
Signed on behalf of the participants in two originals in English.

For United States Patent  
and Trademark Office

For IP Australia



Michelle Lee  
Deputy Under Secretary of Commerce  
for Intellectual Property and  
Deputy Director of the USPTO



Patricia Kelly  
Director General  
IP Australia

Date: September 24, 2014

Date: 24/9/14

**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  
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**Annex A**

**Outline of Technical and Procedural Matters**

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## 1 Contact details

1.1 Language of communication: English

1.2 Contact details for IP Australia's PCT Section ("IP Australia/PCT"):

Phone number: +61 2 6222 3626  
Fax number: +61 2 6283 7999 (discontinued from 4 June 2014)  
E-mail: [pct@ipaustralia.gov.au](mailto:pct@ipaustralia.gov.au)

Fax: From 5 June 2014, IP Australia intends to set up an Emergency Facsimile Service (EFS) to support customers when access to IP Australia's eServices is unavailable. Use of the EFS as an approved means of electronic communication with IP Australia is restricted to circumstances outlined at: [http://www.ipaustralia.gov.au/about-us/corporate/emergency\\_management/emergency-fax-service/](http://www.ipaustralia.gov.au/about-us/corporate/emergency_management/emergency-fax-service/)

1.3 Postal address for IP Australia/PCT:

PCT Team  
IP Australia  
PO Box 200  
Woden ACT 2606  
Australia

1.4 Street Address for IP Australia/PCT (required for courier delivery):

PCT Team  
IP Australia  
Ground Floor, Discovery House  
47 Bowes Street  
Phillip ACT 2606  
Australia

1.5 Postal address for the USPTO:

Director of the US Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
United States of America

1.6 Contact details for the receiving office of the USPTO:

Phone number: +1 703 756 1403  
Fax number: +1 571 273 3201  
E-mail: [Harvey.Phillips@uspto.gov](mailto:Harvey.Phillips@uspto.gov)

## 2 Payment procedure and fees for ISA/IPEA services

For the most up to date information on the amount of fees applicable for ISA service please refer to PCT Applicants Guide Annex D at [http://www.wipo.int/pct/guide/en/gdvol1/annexes/annexd/ax\\_d\\_au.pdf](http://www.wipo.int/pct/guide/en/gdvol1/annexes/annexd/ax_d_au.pdf) and for the IPEA information refer to PCT Applicants Guide Annex E at [http://www.wipo.int/pct/guide/en/gdvol1/annexes/annexe/ax\\_e\\_au.pdf](http://www.wipo.int/pct/guide/en/gdvol1/annexes/annexe/ax_e_au.pdf).

2.1 Classification of fees:

Search fee: AUD 2200 as converted to USD with reference to the PCT Applicant's Guide Annex D  
Preliminary examination fee: AUD 590  
Handling fee: AUD 234

These fees may be subject to change. Current fees can be found at:  
<http://www.wipo.int/pct/en/fees/index.html>

2.2 Procedure for remitting fees:

Search fee: US applicant ⇒ USPTO ⇒ IP Australia (wire transfer preferred)

\* International postal money orders are not recommended because of the pressure on IP Australia to start international search on time

Preliminary examination fee: US applicant ⇒ IP Australia  
Handling fee: US applicant ⇒ IP Australia  
Additional fees: US applicant ⇒ IP Australia  
Protest fee: US applicant ⇒ IP Australia

\* The preferred method for payment of fees by US applicants to IP Australia is via its online eServices portal using MasterCard or Visa. This is available via [www.ipaustralia.gov.au](http://www.ipaustralia.gov.au)

\*\* US applicants should indicate the PCT application number when making payment via eServices, and indicate what the payment is for in the instructions box.

2.3 Acceptable currency for fee payment:

USD for fee payment by USPTO to IP Australia  
AUD for fees paid to IP Australia by US applicant

2.4 IP Australia's bank account details for fee remittance:

Swift code: NATAAU3303M  
Name of bank: National Australia Bank,  
BSB: 082-926  
Account number: 868711229  
Name of beneficiary: IP Australia Official Departmental Account

\* An accompanying remittance file is to be sent to:  
[accounting.ops@ipaustralia.gov.au](mailto:accounting.ops@ipaustralia.gov.au)

\*\* Reference to be used with payment via EFT by the USPTO is to be in the following format: USPTO PCT Month (in words) Year (in numerals)

2.5 Responsibility for the cost of remitting fees or refunds:

Remittance fee:	sending party (US applicant or the USPTO)
Postal fee:	sending party (all postage must be prepaid)
Refund:	receiving party (US applicant or the USPTO)

2.6 Refund procedure

- i. IP Australia determines whether the paid fee exceeds the required amount.
- ii. If so, IP Australia notifies the US applicant or the USPTO.
- iii. a) If a refund is due to the US applicant, IP Australia remits the AUD denominated refund cheque to the US applicant.  
b) If a refund is due to the USPTO, the USPTO intends to deduct that amount from its next monthly payment to IP Australia. If the refund is not executed as intended, IP Australia intends to ask the USPTO for assistance.
- iv. Currency conversion fees for refunds are intended to be borne by the US applicant or the USPTO.

2.7 The USPTO's bank account details are as follows:

Payments or refunds may be remitted via wire to the USPTO at:

Name of Bank:	Treas. NYC (Treasury New York City)
Swift Code:	FRNYUS33FX1
Bank ABA routing number:	021030004
Agency Locator Code:	13100001 (US Patent & Trademark Office)
OBI:	IP Australia refund

Payment or refunds may be remitted via check to:

Attn: Matthew Lee  
Mail Stop 16  
US Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
United States of America

Please be sure to include the agency locator code with wire actions. Please include a description/purpose with the payment or refund.

Contact: Matthew Lee on 01-571-272-6343 with any questions related to the above.

### **3 Procedure for transmitting documents between the USPTO and IP Australia**

#### **3.1 Transmission of search copy:**

Transmission frequency: once a week or as soon as possible after the receiving office completes its formality examination.

Transmission method: Federal Express or DHL.

Street address (required for courier delivery): at paragraph 1.4 of Annex A.

USPTO and IP Australia intend to allow the International Bureau (IB) to prepare and transmit search copies electronically ('eSearchCopy') to IP Australia on behalf of USPTO once the IB, USPTO and IP Australia are ready to do so. Upon commencement of transmittal of the eSearchCopy from the IB to IP Australia, the USPTO intends to cease the transfer of the paper search copy from its office to IP Australia.

#### **3.2 Notice of the receipt of search copy:**

IP Australia/PCT notifies the USPTO on paper via postal service, private carrier or facsimile within two weeks of receiving the search copy. For facsimile transmission of ONLY the Notification of Receipt of Search Copy, use the USPTO Central Fax number which is +1(571) 273 8300.

3.3 Notification of excess requests:

IP Australia/PCT notifies the USPTO on paper via postal service, private carrier or facsimile that the search will not be conducted by IP Australia because more than 250 requests have been received in the current fiscal quarter. For facsimile transmission use the USPTO Central Fax number which is +1(571) 273 8300.

IP Australia/PCT may retain up to 25 excess requests received in the current fiscal quarter; the excess requests contributing to the total number of requests received in the next fiscal quarter.

IP Australia/PCT intends to notify the USPTO within two weeks of receiving any search copy that exceeds the quarterly limit and for which IP Australia/PCT does not intend to perform the international search using form PCT ISA 224.

IP Australia/PCT intends to dispose securely of the search file if no response is received within 1 month of notifying the USPTO.

USPTO does not intend to forward the search fee for applications where IP Australia/PCT has provided notification of excess requests to the USPTO. Should the USPTO have already sent the search fee, then the USPTO intends to withhold an amount equivalent to the search fee from a subsequent payment due to IP Australia.

## **4 Direct contact between US applicants and IP Australia**

4.1 Submission procedure and method of making a demand:

Applicants that register for ePCT private services may submit the demand to IP Australia using the 'Submit Chapter II Demand' Action. IP Australia's preferred method for receiving a demand is through ePCT.

Method of transmitting documents: for paper-based demands - postal service, or for electronic submissions, these can be completed through IP Australia's eServices portal. This is available via the website at [www.ipaustralia.gov.au](http://www.ipaustralia.gov.au)

Postal address for IP Australia / PCT: as at paragraph 1.3 of Annex A.

Street Address for IP Australia / PCT (required for courier delivery): as at paragraph 1.4 of Annex A.

4.2 Procedure for notifying applicants that a demand has been received:

IP Australia/PCT notifies applicants within two weeks of receiving the demand.

4.3 Payment procedure for examination and handling fees:

Procedure: US applicant ⇒ IP Australia's bank account

The preferred method for payment of fees by US applicants to IP Australia is via its online eServices portal. This is available via the website at [www.ipaustralia.gov.au](http://www.ipaustralia.gov.au)

US applicants should indicate the PCT application number when making payment via eServices, and indicate what the payment is for in the instructions box.

Time limit: Payment must arrive at IP Australia's bank within one month of the submission date of the demand or 22 months from the priority date, whichever expired later.

Currency: AUD

## **5 Procedure for transmitting documents between US applicants and IP Australia**

### **5.1 Transmission of various notices and invitations from IP Australia to US applicants:**

To be sent via the postal service to the postal address specified in the demand. Where feasible and appropriate, communication is to be via ePCT.

### **5.2 Response of US applicants to IP Australia's invitations:**

US applicants are expected to respond via ePCT, eServices or postal service (but not by telephone, fax or e-mail) within the period specified in the invitation.

Time frame for responding to an invitation: normally one month from the mailing date.

Time frame for responding to written opinions (of an international preliminary examination): normally two months from the mailing date (time limits can be extended at the examiner's discretion as long as the due date for an international preliminary examination report is not affected, or shortened at the examiner's discretion if the due date is affected).

### **5.3 Method of communication between IP Australia and US applicants during an international preliminary examination**

Language: English  
Method: postal service, telephone, etc.