

# **External Regulations to the Agreement on the establishing of the Nordic Patent Institute (NPI)**

## **Part 1 General Provisions**

### **Rule 1. Definitions**

For the purpose of these Regulations

- (i) "Agreement" means Agreement on the Establishing of the Nordic Patent Institute;
- (ii) "Article" means an Article of the Agreement;
- (iii) "Rule" means a Rule of the Regulations;
- (iv) "Regulations" means the Regulations to the Agreement (Internal and External);
- (v) "Contracting Parties" means the governments of Denmark, Iceland and Norway;
- (vi) "NPO" means the Patent Offices of Denmark, Iceland and Norway;
- (vii) "PCT System" includes the Articles, Rules, Administrative Instructions and the PCT International Search and Preliminary Examination Guidelines under the Patent Cooperation Treaty (PCT), done at Washington on June 19, 1970 as revised, amended and modified;
- (viii) "Examiner" means the examiner working for or on behalf of the Nordic Patent Institute;
- (ix) "Search" means an international search according to the PCT System;
- (x) "Examination" means an international preliminary examination according to the PCT System;
- (xi) The "Board" means the Board of Directors of the Nordic Patent Institute;
- (xii) The "Head" means the Head of the Nordic Patent Institute;
- (xiii) "ISA" means International Searching Authority under the PCT;
- (xiv) "IPEA" means International Preliminary Examining Authority under the PCT; and
- (xv) "IPRP" means International Preliminary Examination Reports according to PCT Chapter II.
- (xvi) "SIS" means supplementary international search according to PCT Rule 45bis.
- (xvii) "SSR" means supplementary international search report according to PCT Rule 45bis.

### **Rule 2. Languages**

(1) Communications to the Nordic Patent Institute pertaining to PCT-work shall be in Danish, English, Icelandic, Norwegian or Swedish.

(2) Communications to the Nordic Patent Institute pertaining to contractual work or commercial services shall be in Danish, English, Norwegian or Swedish.

### **Rule 3. Communications with Nordic Patent Institute**

(1) The Nordic Patent Institute shall accept communications on paper and in electronic form. The Nordic Patent Institute may specify in which electronic form communications will be accepted.

(2) The Nordic Patent Institute may specify under which conditions it will accept communications through the use of video conference-equipment or by other media.

(3) The means of communication between the Nordic Patent Institute and WIPO shall be decided as per agreement between the Nordic Patent Institute and WIPO.

#### **Rule 4. The date of receipt of communications**

(1) Unless otherwise stated in the PCT System, a communication shall be deemed to be received when the communication has arrived at the Nordic Patent Institute's headquarters.

(2) Communication on paper shall be given a date of receipt. Communication delivered after regular office hours on a business day or during days of closing shall be deemed to be received on the date of delivery, if such communication has been delivered in the mailbox at the Nordic Patent Institute's headquarters.

(3) Communication in electronic form is deemed to be received when logged into the Nordic Patent Institute's computer system. Communication submitted by facsimile shall be deemed to be received on the date of the receipt of the complete facsimile.

(4) Communication meant for the Nordic Patent Institute, but wrongly submitted to a NPO, shall be forwarded by that NPO to the Nordic Patent Institute. The date of receipt of that communication will be regulated by paragraphs 2 or 3 above. Communication meant for a NPO, but wrongly submitted to the Nordic Patent Institute, shall be forwarded by the Nordic Patent Institute to the NPO for which it originally was intended. The applicant will receive information that the communication is forwarded.

#### **Rule 5. Time limits for communications**

(1) The time limits for responding to communications to the Nordic Patent Institute shall follow the PCT System. Time limits not covered by the PCT System shall be determined by the Nordic Patent Institute in each instance.

(2) Provided that the time limit for communication to be submitted to the Nordic Patent Institute expires on a Saturday, Sunday or a national Danish public holiday, the expiry of the time limit shall be postponed until the following business day.

#### **Rule 6. The date of receipt of payments**

(1) Unless otherwise stated in the PCT System, a payment shall be deemed to be received at the Nordic Patent Institute's headquarters when registered in the bank account of the Nordic Patent Institute.

### **Part 2 PCT work**

#### **Rule 7. The Nordic Patent Institute as an International Authority (ISA and IPEA)**

(1) The Nordic Patent Institute shall act as an International Searching Authority and International Preliminary Examining Authority, and shall carry out all its obligations under the PCT System with respect to international patent applications filed in accordance with the PCT System. In addition, the search work shall be in accordance with an ISO-certified quality system.

(2) The Nordic Patent Institute shall act as an International Searching Authority and International Preliminary Examining Authority in accordance with the PCT System for the nationals and residents of the Nordic Patent Institute's Contracting Parties, those being Denmark, Iceland and Norway.

(3) In case of a conflict between the provisions of these Regulations and the PCT System pertaining to the Nordic Patent Institute's obligations as International Searching Authority

and International Preliminary Examining Authority, the provisions of the PCT System shall prevail.

### **Rule 8. Tasks of the Nordic Patent Institute being an International Searching Authority (ISA)**

(1) The applicant may request that the Nordic Patent Institute be the International Searching Authority. The international application must be in a language accepted by the Nordic Patent Institute as the International Searching Authority.

(2) An international search includes a search for earlier disclosures relevant to the novelty and inventive step of the claimed invention and the establishment of an international search report and a written opinion.

(3) At the same time as establishing the international search report, the examiner establishes a written opinion as to whether the claimed invention appears to be novel, involves an inventive step, is industrially applicable and meets the other requirements of the PCT System which are checked by the International Searching Authority.

(4) The Nordic Patent Institute shall submit the international search report and the written opinion to the International Bureau and the applicant.

### **Rule 9. Tasks of the Nordic Patent Institute carrying out International-Type Searches (ITS)**

(1) An applicant may request in the national application that the Nordic Patent Institute carry out an international-type search.

(2) An international-type search includes a search for earlier disclosures relevant to the novelty and inventive step of the claimed invention and the establishment of an international search report. No written opinion is established for such searches.

(3) The Nordic Patent Institute shall submit the international-type search report to the applicant.

### **Rule 10. Tasks of the Nordic Patent Institute carrying out Supplementary International Searches (SIS)**

(1) The applicant may, before the expiration of a time limit of 19 months from the priority date, request that the Nordic Patent Institute conduct a supplementary international search.

(2) The Nordic Patent Institute shall conduct the supplementary international search in accordance with PCT Rule 45bis.

(3) The supplementary international search shall, in addition to the PCT minimum documentation, cover at least the documents in Danish, Icelandic, Norwegian and Swedish held in the search collection of the Nordic Patent Institute.

(4) The Nordic Patent Institute shall submit the supplementary international search report (SSR) to the International Bureau and the applicant.

### **Rule 10bis. Limitation concerning requests for Supplementary International Searches**

(1) Any limitations and conditions concerning supplementary international searches shall be published on the NPI's website ([www.npi.int](http://www.npi.int)).

### **Rule 11. Tasks of the Nordic Patent Institute being an International Preliminary Examining Authority (IPEA)**

(1) The applicant may demand that the Nordic Patent Institute as an International Preliminary Examining Authority conduct an international preliminary examination.

(2) In the international preliminary examination, the examiner will consider further the issues of novelty, inventive step and industrial applicability, taking into account any comments or amendments from the applicant relating to the international search report, in accordance with the PCT System.

(3) The Nordic Patent Institute shall submit the international preliminary report on patentability to the International Bureau and the applicant.

### **Rule 12. Time limits for establishing International Reports**

(1) The Nordic Patent Institute shall establish international search reports, written opinions, international-type search reports, supplementary international search reports and International Preliminary Examination Reports (IPRP) within the time limits mentioned in the PCT System.

(2) According to PCT Rule 42.1, the time limit for establishing the international search report shall be three months from the receipt of the search copy by the Nordic Patent Institute, or nine months from the priority date, whichever time limit expires later.

(3) The Nordic Patent Institute shall establish written opinions according to PCT Rule 43bis.1.

(4) According to PCT Article 15.5, an international-type search is considered similar to an international search. The time limit for establishing an international-type search report shall follow PCT Rule 42.1 as stated above.

(5) The Nordic Patent Institute shall establish the supplementary international search report (SSR) within 28 months from the priority date.

(6) According to PCT Rule 69.2, the time limit for establishing the International Preliminary Examination Report (IPRP) shall be 28 months from the priority date, or six months from the time provided under PCT Rule 69.1, or six months from the date of the Nordic Patent Institute being in receipt of any translation furnished under PCT Rule 55.2, whichever expires last.

(7) The Nordic Patent Institute will publish its current time limits on its website.

### **Rule 13. Request for copies of documents cited in a search report**

(1) Any applicant or designated Office is entitled to request copies of the documents cited in the search report at any time within seven years of the international filing date of the international application.

(2) If such a request is received, the Nordic Patent Institute shall prepare documents and submit the documents to the applicant or the designated Office making the request. The stipulated fee shall be paid.

#### **Rule 14. Payments to the Nordic Patent Institute for PCT-work**

(1) For PCT-work, the fees to be paid are specified in the Schedule of Fees annexed to these Regulations.

(2) The Nordic Patent Institute determines, where applicable, whether the prescribed fees have been paid and it notifies the applicant of any underpayment or overpayment, according to the PCT System.

(3) If no fees are paid, or the amount paid is insufficient, the Nordic Patent Institute invites the applicant to pay the missing amount, together with, where applicable, a late payment fee according to the PCT System.

(4) The handling fee and the preliminary examination fee are payable within one month from the date on which the demand was submitted or 22 months from the priority date, whichever time limit expires later. Where the demand was transmitted to the Nordic Patent Institute as International Preliminary Examining Authority, the fees are payable within one month from the date of actual receipt of the demand by the Nordic Patent Institute or 22 months from the priority date, whichever time limit expires later.

(5) The Nordic Patent Institute shall transfer the handling fees collected during the preceding month to the International Bureau according to the PCT System.

(6) Where the NPO as a Receiving Office has received a payment of fees according to the PCT System, on behalf of the Nordic Patent Institute, the NPO shall forward the payment to the Nordic Patent Institute in the currency in which the payment was received.

### **Part 3 Contractual work and Commercial services**

#### **Rule 15. Contractual Work for Patent Offices**

(1) The Nordic Patent Institute may enter into agreements with Patent Authorities pertaining to search, examination and other types of work within the area of patents.

(2) The Nordic Patent Institute will provide information as to the types of services which may be delivered to Patent Authorities.

(3) Such agreements shall include elements, such as:

- (i) The types of services to be delivered;
- (ii) Delivery; time and means; and
- (iii) Terms of payment.

#### **Rule 16. Commercial Services relating to private legal entities**

(1) The Nordic Patent Institute may enter into agreements with private legal entities not having their residence or principal place of business in any of the Contracting Parties, pertaining to search, examination and other types of work within the area of patents.

(2) The Nordic Patent Institute will provide information as to the types of services which may be delivered to private legal entities.

- (3) Such agreements shall include elements, such as:
- (i) The types of services to be delivered;
  - (ii) Delivery; time and means; and
  - (iii) Terms of payment.

### **Rule 17. Payments to the Nordic Patent Institute for Contractual Work and Commercial Services**

(1) For contractual work and commercial services, the terms of payments will be specified in the individual agreement.

(2) Payments to the Nordic Patent Institute shall be made in DKK, unless payment in another currency is agreed upon.

(3) The Nordic Patent Institute will issue an invoice for the payment as specified in the individual agreement.

(4) The time limit for the payment is one month, unless otherwise specified in the individual agreement.

(5) If the time limit for payment expires on a Saturday, Sunday or a national Danish public holiday, the expiry of the time limit shall be postponed until the following business day.

## **Part 4 Administrative matters**

### **Rule 18. Keeping of files**

(1) The Nordic Patent Institute shall keep the file of each international application it receives for at least 10 years from the international filing date, as set out in PCT Rule 93.

### **Rule 19. Revisions and Amendments**

(1) The Board may amend the Regulations. The Board may also amend the Schedule of Fees to the extent these are not set by WIPO.

(2) The Head and any member of the Board may submit proposals for amending the Regulations to the Board.

These Regulations were approved by the Board on 20 November 2008.

Signed on behalf of the Board

9 December 2008

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Jørgen Smith  
Chairman of the Board

## Schedule of fees

(Revised 1 April 2010)

### ISA Fees

International search fee	Rule 16.1(a)	DKK 13,290 <sup>1</sup> ISK 317,000 <sup>1</sup> NOK 14,590 <sup>1</sup>
Search fee refund If earlier International Search Report or ITS can be used:	Rule 16.3	50%
International search or ITS If earlier national search report from another Patent Office can be used	Rule 41	25%
Fee for each additional independent invention	Rule 40.2	DKK 13,290 <sup>2</sup>
Protest fee	Rule 40.2	DKK 8,000
Fee for copies of cited documents (cited in ISR)	Rule 44.3	DKK 50 per document

<sup>1</sup> DKK / ISK / NOK equivalent of the Euro amount of the search fee (Rule 16.1(a)) payable to the European Patent Office as International Searching Authority, as modified from time to time in accordance with the directives under PCT Rule 16.1(d). The amounts shown in the table are the amounts which are presently in force.

<sup>2</sup> Same DKK amount as the search fee under Rule 16.1(a)).

### ITS Fees

Basic fee (if requested in national application in DK, IS, NO)	Article 15	DKK 4,500 ISK 180,000 NOK 5,125
Basic fee if requested in other national applications)		DKK 7,000
Fee for each additional independent invention	Article 15	DKK 7,000
Fee for each claim in excess of 10 (except for ITS requested in a DK or NO national application)	Article 15	DKK 200 ISK 8,000 NOK 250

### IPEA Fees

Preliminary examination fee	Rule 58	DKK 5,000
Fee for each additional independent invention	Rule 68.3(a)	DKK 5,000
Protest fee	Rule 68.3(e)	DKK 8,000
Fee for late payment of handling fee or preliminary examination fee	Rule 58bis.2	25% of unpaid amount, but 1) min. handling fee and 2) max. double handling fee
Fee for copies of cited documents in IPER	Rule 71.2	DKK 50 per document
Fee for copies from IPEA file	Rule 94.2	DKK 3.25 per page

## SIS Fees

Supplementary international search fee	Rule 45bis.3(a)	DKK 13,290
Supplementary international search fee will be re-funded if, the supplementary search request is considered not to have been submitted before the Nordic Patent Institute has started the supplementary international search	Rule 45bis.5(a)	
Review fee	Rule 45bis.6(c)	DKK 8,000