

# WIPO



PCT/R/1/5

ORIGINAL: English

DATE: March 23, 2001

WORLD INTELLECTUAL PROPERTY ORGANIZATION

GENEVA

INTERNATIONAL PATENT COOPERATION UNION  
(PCT UNION)

COMMITTEE ON REFORM  
OF THE PATENT COOPERATION TREATY (PCT)

First Session  
Geneva, May 21 to 25, 2001

REFORM OF THE PCT:  
PROPOSALS BY THE REPUBLIC OF KOREA

*Document prepared by the International Bureau*

1. The proposals appearing on the following pages were made by the Republic of Korea in a submission to the International Bureau received on January 31, 2001. Background information appears in document PCT/R/1/2.<sup>1</sup>

2. *The Committee is invited to consider the proposals contained in this document.*

---

<sup>1</sup> The working documents for the Committee's session are available on WIPO's web site at the following address: [http://www.wipo.int/pct/en/reform/index\\_1.htm](http://www.wipo.int/pct/en/reform/index_1.htm)

KOREAN INTELLECTUAL PROPERTY OFFICE  
REPUBLIC OF KOREA

KIPO PROPOSAL FOR PCT REVISION

I. INTRODUCTION

A PCT applicant who files in a non-publication language, shall submit a translation in a publication language for international publication. (Article 21) Due to the inconsistency of the current PCT provisions with regard to responsibility for preparing and submitting the translation, international filings prepared in a non-search language are treated more favorably than those prepared in a search language are, even though both filings are based in a non-publication language.

For a PCT application filed in a non-publication and non-search language, the applicant by herself assumes full responsibility for preparing and submitting the necessary translation for international publication. (Rule 12.3) The applicant has to prepare and submit the translation within a specified time limit. Also, the recipient office for the translation is the Receiving Office at which the PCT application is originally filed. Where the applicant fails to prepare and submit the translation and, if applicable, any late fee in due course, her PCT application shall be regarded as withdrawn and the Receiving Office shall take an action of declaring the PCT application as withdrawn.

However, when a PCT applicant files her PCT application in a non-publication, yet a search language (a language accepted by an International Searching Authority which carries out international search for the application), totally different set of standards are applied. (Rule 48.3) In such a case, the International Searching Authority instead of the PCT applicant shall take final responsibility to prepare and submit the translation for international publication. Therefore, although the applicant does neither prepare and submit the translation nor pay for an applicable translation fee, her PCT application may proceed and complete the international phase of the PCT system since a third party, the International Searching Authority, should finally bear the cost and the time to prepare and submit the translation on behalf of the PCT applicant's benefit. Although the International Searching Authority may invite the PCT applicant to pay for the translation fee, the applicant may easily ignore such invitation because she is not penalized nor disadvantaged by doing so.

Such PCT provisions may induce PCT applicants to go through international filing procedures without due diligence. The operation of the translation-related provisions is based upon voluntary and good faith compliance of a PCT applicant since the PCT rules do not contain any penalty provision against non-compliance. In addition, the International Searching Authority's invitation to make a translation fee payment is not backed by any enforcement power to collect the translation fee from a PCT applicant. Therefore, if a PCT applicant would intend to take advantage of the provisions, the applicant would become unjustly enriched by savings of time and translation costs without any disadvantage.

In addition, under the above provisions, the International Searching Authority is wrongfully burdened with the execution of an extra task of which the beneficiary is not the Authority itself but a negligent or a bad faith PCT applicant. Where an International Searching Authority carries out international searches in a non-publication language, the Authority has the good will in improving the convenience of PCT applicants and promoting international filings through the PCT system. Despite such good will, the International Search Authority has to absorb the final responsibility for the translation preparation and submission which should have been allocated to PCT applicants. Where a PCT applicant who filed in a non-publication, yet a search language, would negligently or intentionally not prepare and submit the necessary translation, the International Searching Authority can only invite the applicant to pay translation fees for the translation. If the applicant ignores or does not respond to such an invitation, the International Searching Authority does not have any resolution or remedial method to redress its own costs and time for the preparation and submission of the translation.

Furthermore, when a PCT applicant would intentionally pursue a course to take advantage of the translation-related provisions, a serious unfairness issue can be raised among PCT applicants. Among those who file in a non-publication, but a search language, preparation cost for the translation would usually account for the single largest cost factor in the international filing procedure. If one who does not bear the translation cost would be guaranteed under the PCT system to enjoy the same benefit as others who bear the translation cost, the PCT system would not be regarded as impartial and equitable.

The PCT system needs to be operated on the basis of fairness and equity. The one who does benefit must bear the cost of the benefit. The ultimate beneficiary of a PCT application is a PCT applicant herself since this whole PCT procedure is for her to obtain intellectual property rights called patent or utility model, etc in various countries. Therefore, the responsibility of preparing and submitting the translation for international publication needs to be assigned to the PCT applicant herself, not to an International Searching Authority which carries out international search in a non-publication language in favor of the PCT applicants as well as the PCT system as a whole. When the PCT applicant fails to fulfill her responsibility, she should bear the consequences. By doing so, the PCT system will enhance its consistency, improve its fairness and equity, and reduce unwarranted burden of an International Searching Authority.

## II. REVISION PROPOSAL

1. The PCT rules are revised to apply the same principle to both a PCT applicant who files in a non-publication and non-search language and a PCT applicant who files in a non-publication, but a search language. Regardless of the language of international filing, a PCT applicant will be responsible for preparing and submitting the translation for international publication. The only advantage for a PCT applicant who files in a non-publication, but a search language is that due to submit the translation is not a month from the international filing date, but 14 months from its priority date.

2. If a PCT applicant fails to prepare and submit the translation within the due time, she may be given one-month grace period to prepare and submit the translation, subject to, if applicable, a late submission fee.

3. Under the revised PCT rules, the recipient of the translation is a Receiving Office, not an International Searching Authority. Therefore, when the Receiving Office receives any translation for international publication, it shall transmit the translation to the International Bureau for international publication.

4. Where a PCT applicant fails to prepare and submit the translation and to pay any applicable late submission fee even after the one-month grace period, her PCT application shall be regarded as withdrawn and declared so by the Receiving Office.

### III. DRAFT PROVISIONS OF PROPOSED REVISION

1. Change of title of Rule 12 from “Language of the International Application and Translation for the Purposes of International Search” to “Language of the International Application and Translation for the Purposes of International Search and Publication”

2. New insertion of Rule 12.4 as follows:

#### *12.4 Translation for the Purpose of Publication*

(a) Where the language in which the international application is filed is not the language of publication, but accepted by the International Searching Authority that is to carry out the international search, the applicant shall, within 14 months from the priority date, furnish to the Receiving Office a translation of the application into the language prescribed under Rule 48.3(b).

(b) Paragraph (a) shall not apply to the request nor to any sequence listing part of the description.

(c) Where, by the time 14 months have lapsed since the priority date, the applicant has not furnished a translation required under paragraph (a), the Receiving Office shall invite the applicant to furnish the required translation and to pay, where applicable, the late furnishing fee referred to in paragraph (e), within one month from the date of the invitation.

(d) Where the Receiving Office has sent to the applicant an invitation under paragraph (c) and the applicant has not, within the applicable time limit under paragraph (c), furnished the required translation and paid any required late furnishing fee, the international application shall be considered withdrawn and the Receiving Office shall so declare. Any translation and any payment received by the Receiving Office before that Office makes the declaration under the previous sentence and before the expiration of 15 months from the priority date shall be considered to have been received before the expiration of that time limit.

(e) The furnishing of a translation after the expiration of the time limit under paragraph (a) may be subjected by the Receiving Office to the payment to it, for its own benefit, of a late furnishing fee up to 50% of the basic fee.

3. Deletion of the unnecessary part and streamlining of Rule 48.3(b) as follows:

Rule 48.3 *Languages of Publication*

(b) If the international application is filed in a language which is not a language of publication and no translation into a language of publication is required under Rule 12.3(a), that application shall be published in English translation.

[End of document]