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OF THE PATENT COOPERATION TREATY (PCT)

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LANGUAGE OF THE INTERNATIONAL APPLICATION AND TRANSLATIONS

Document prepared by the International Bureau

INTRODUCTION

1. At its first session, held from May 21 to 25, 2001, the Committee on Reform of the Patent Cooperation Treaty (PCT) agreed, *inter alia*, to recommend to the PCT Assembly that certain matters be referred to a working group for consideration and advice (see document PCT/R/1/26, paragraphs 67 and 68). The Assembly, at its thirtieth (13th ordinary) session, held from September 24 to October 3, 2001, unanimously approved the Committee's recommendations (see document PCT/A/30/7, paragraph 23).

2. The Director General accordingly convened the first session of the Working Group on Reform of the PCT, which was held from November 12 to 16, 2001, following which the second session of the Working Group was held from April 29 to May 3, 2002. As to the results of the work of the Working Group, see the summaries of the first and second sessions prepared by the Chair (documents PCT/R/WG/1/9 and PCT/R/WG/2/12, respectively) and document PCT/R/2/2, which reproduces the second session summary as an Annex.¹

¹ Working documents for sessions of the Assembly, the Committee and the Working Group are accessible via WIPO's Web site at <http://www.wipo.int/pct/en/meetings>.

Language of the international application: alignment with language-related filing date requirements of the Patent Law Treaty (PLT)

3. For the first session of the Working Group, the International Bureau prepared proposals for amendment of the Regulations under the PCT² with a view to aligning the language-related filing date requirements under the PCT with those under the PLT, as recommended by the Committee (see document PCT/R/26, paragraphs 72 to 74). Those proposals (see document PCT/R/WG/1/5, Annex II) would have had far-reaching consequences on aspects of the PCT procedure, beyond the filing date requirements, that concern receiving Office processing, international search, international publication and international preliminary examination. However, the proposals could not be discussed by the Working Group in the time available during its first session.
4. Some of the proposals would have resulted in much greater complexity of the PCT system, mainly for the reason that the proposals had to accommodate the fact that, under the PCT, several Offices and Authorities (and not just one national Office, as is the case under the PLT) are involved in the processing of the application during the international phase, and each PCT Office and Authority is entitled, within certain limits, to decide on its own working languages.
5. In view of this apparent contradiction to the objectives of PCT reform relating to simplification of both procedures and the wording of the Regulations, the International Bureau reconsidered the issue in substance and proposed to the second session of the Working Group (see document PCT/R/WG/2/5, paragraphs 1 to 7) not to proceed with changes to the Regulations concerning the language-related filing date requirements but rather to adopt a new approach for addressing the issue, as outlined in the following paragraphs.
6. The main difference between the language-related filing date requirements of the PLT and those of the PCT is that, *under the PLT*, only two elements of the application (“an express or implicit indication to the effect that the elements are intended to be an application” and “indications allowing the identity of the applicant to be established or allowing the applicant to be contacted by the Office”) must, for the purposes of the filing date, be in a language accepted by the Office, whereas the “part which on the face of it appears to be a description” may, for the purposes of according a filing date, be in any language (see PLT Article 5(2)). *Under the PCT*, both the “part which on the face of it appears to be a description” and the “part which on the face of it appears to be a claim or claims” must, for the purposes of according an international filing date, be in a language accepted by the receiving Office (see PCT Article 11(1)(ii) and PCT Rule 20.4(c)).
7. While, at first glance, there would appear to be a need to align the PCT language-related filing date requirements with those of the PLT, as originally proposed by the International

² References in this document to “Articles” and “Rules” are to those of the Patent Cooperation Treaty (PCT) and the Regulations under the PCT (“the Regulations”), or to such provisions as proposed to be amended or added, as the case may be (the current texts are available on WIPO’s Web site at http://www.wipo.int/pct/en/access/legal_text.htm). References to “national laws,” “national applications,” “the national phase,” etc., include reference to regional laws, regional applications, the regional phase, etc. References to “PLT Articles” and “PLT Rules” are to those of the Patent Law Treaty (PLT) and the Regulations under the PLT (see document PT/DC/47 on WIPO’s Web site at http://www.wipo.int/eng/document/pt_dc/index.htm).

Bureau in Annex II to document PCT/R/WG/1/5, upon further reflection, such approach overlooked the fact that an international application filed in any language with any receiving Office is in practice entitled, at present, to be accorded an international filing date (provided, of course, that all other filing date requirements are met). This arises because, pursuant to PCT Rule 19.4(a)(ii), if the international application³ is not in a language accepted (under PCT Rule 12.1(a)) by the receiving Office with which it was filed, it is considered to have been received by the receiving Office on behalf of the International Bureau as receiving Office and would be transmitted to the International Bureau, which accepts any language for the purposes of filing of the international application. Such an application would therefore be accorded an international filing date by the International Bureau as receiving Office (if all other filing date requirements are met).

8. In other words, the PCT is already, in practice, “PLT-compliant” in relation to language-related filing date requirements, since an international application will be entitled to an international filing date no matter in which language and with which Office it was filed. In a sense, the PCT is even more applicant-friendly than the PLT in this respect since it does not require, as does the PLT, that at least two elements of the application (“an express or implicit indication to the effect that the elements are intended to be an application” and “indications allowing the identity of the applicant to be established or allowing the applicant to be contacted by the Office”) must, for the purposes of the filing date, be in a language accepted by the Office. For the purposes of according an international filing date, the International Bureau as receiving Office accepts any element of the international application in any language.

9. At its second session, the Working Group discussed the proposed new approach for addressing the issue of the language of the international application as outlined in paragraphs 7 and 8, above, and agreed to it. The Working Group’s discussions are outlined in paragraph 27 of the summary of the session prepared by the Chair (document PCT/R/WG/2/12):

“27. It was agreed that no change was needed to the existing PCT Regulations in order to give effect to the language-related filing date requirements of the PLT, noting that PCT Rule 19.4(a)(ii) already provided for transmission to the International Bureau as receiving Office, without loss of filing date, of an international application which was not in a language accepted by the receiving Office with which it was filed, and noting that the International Bureau accepted any language for the purposes of filing of international applications. The PCT was thus already “PLT-compliant” in relation to language-related filing date requirements.”

10. It is thus proposed, recognizing that the PCT is already, in practice, consistent with the language-related filing date requirements of the PLT, not to proceed with changes to the PCT Regulations concerning the language-related filing date requirements.

Translation of the international application for the purposes of international publication

11. At present, where the international application is filed in a language which is accepted by the receiving Office and by the International Searching Authority that is to carry out the

³ More precisely, the description and/or the claims; language defects in the request, the abstract or any text matter in the drawings are considered formal defects under PCT Rule 26.3*ter*.

international search but is not a language of publication, it is the International Searching Authority which is responsible for the establishment of a translation of the international application into English (see present Rule 48.3(b)).⁴ In practice, it is normally the applicant who prepares the translation and furnishes it to the International Searching Authority. However, if the applicant does not do so, the International Searching Authority must prepare the translation itself. Although the Authority may charge a fee for preparing the translation (see present Rule 48.3(b), second sentence), this creates extra work for the Authority. In addition, in some cases the Authority is unable to recover the cost of preparing the translation, since there is no sanction if the applicant fails to pay the fee for the translation. The preparation of a translation appears to be a matter which should properly be the responsibility of the applicant.

12. During the first session of the Working Group, the Republic of Korea submitted a proposal for amendment of the PCT Regulations so as to require the applicant, rather than the International Searching Authority, to furnish the required translation and to introduce a sanction if the applicant fails to do so (see document PCT/R/WG/1/8), in line with earlier proposals submitted by the Korean Industrial Property Office, the Netherlands Industrial Property Office, the Swedish Patent and Registration Office and the European Patent Office, which were discussed in 1997 by an ad hoc advisory group on proposed amendments of the PCT Regulations. However, Working Group was unable to discuss the proposal in the time available during its first session.

13. At its the second session, the Working Group discussed proposals for amendment of the PCT Regulations, based on document PCT/R/WG/2/5, prepared by the International Bureau along the lines of the earlier proposal in document PCT/R/WG/1/8 submitted by the Republic of Korea. The Republic of Korea also submitted further proposals to the second session in document PCT/R/WG/2/5 Add.1. As outlined in the summary of the session prepared by the Chair (see document PCT/R/WG/2/12, paragraphs 28 to 30):

“28. The proposals contained in the Annex to document PCT/R/WG/2/5 were agreed, subject to the further modifications proposed in document PCT/R/WG/2/5 Add.1, subject to the matters raised in the following paragraphs.

“29. It was agreed that further consideration should be given to the basis for calculation of the late furnishing fee contemplated in Rules 12.3(e) and 12.4(e), depending on the amount which might be fixed for the proposed new “flat” international filing fee under item 1 of the Schedule of Fees (see paragraphs 20 to 22, above).

⁴ At present, this is the case, in practice: (i) where the international application is filed in Dutch with the Netherlands Industrial Property Office or the Belgium Industrial Property Office and the European Patent Office as International Searching Authority carries out international search (in Dutch); (ii) where the international application is filed with the Danish Patent and Trademark Office in Danish, Norwegian or Swedish, with the Finnish National Board of Patents in Finnish or Swedish, the Icelandic Patent Office in Danish, Norwegian or Swedish, the Norwegian Patent Office in Norwegian, or the Swedish Patent Office in Danish, Finnish, Norwegian or Swedish, and the Swedish Patent Office as International Searching Authority carries out the international search (in Danish, Finnish, Norwegian or Swedish); and (iii) where the international application is filed with the Korean Intellectual Property Office in Korean and that Office as International Searching Authority carries out international search (in Korean).

“30. It was noted that the combined effect of the existing provisions of PCT Rules 12.1(c), 12.3(b) and 26.3ter(c), and proposed new Rule 12.4(b), is such as to prevent a receiving Office from requiring a translation of the request if it is filed in any language of publication under the PCT, even if that language is not accepted by the receiving Office. Consideration should be given to further amendments which would enable the receiving Office to require a translation of the request into a language which is both a language of publication and a language accepted by the receiving Office.”

14. The Annex to the present document contains a redraft of the proposals contained in documents PCT/R/WG/1/8, PCT/R/WG/2/5 and PCT/R/WG/2/5 Add.1, taking into account the views expressed, and agreement reached, at the second session of the Working Group.

Language of the request

15. As requested by the Working Group (see document PCT/R/WG/2/12, paragraph 30), the International Bureau has considered a possible amendment of the PCT Regulations so as to allow a receiving Office to require a translation of the *request* part of an international application for the purposes of processing by it, even though it may be prepared to accept, for the purposes of according an international filing date, the filing of an *international application*⁵ in any language.

16. Present Rule 12.1(c) requires that the request be in a language which is both a language accepted by the receiving Office for the purposes of filing international applications and a language of publication. If the request meets that requirement, the receiving Office is not entitled, having regard to Rules 12.3(b) and 26.3ter(c), to require a translation of it, even though a translation of the remainder of the application may be required under Rule 12.3(a). This restriction may limit the capacity of some receiving Offices to adopt a more flexible approach in relation to the languages which it is prepared to accept for the purposes of Rule 12.1(a).

17. The Annex to this document thus contains a proposal to amend Rule 12.1(c) so as to enable a receiving Office to specify any language of publication which it accepts for the purposes of filing the request. This would enable receiving Offices to accept, for the purposes of according the international filing date, the filing of the international application⁵ in any language while, at the same time, enabling it to limit the languages that it is prepared to accept for the purposes of filing of the request, and to require a translation of the request if not in such a language.

18. The Committee is invited to consider the proposals contained in paragraph 10, above, and in the Annex.

[Annex follows]

⁵ More precisely, the description and the claims; language defects in the request, the abstract and any text matter in the drawings are considered formal defects under PCT Rule 26.3ter.

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:¹

LANGUAGE OF THE INTERNATIONAL APPLICATION AND TRANSLATIONS

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¹ Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned. Certain provisions that are not proposed to be amended may be included for ease of reference.

Rule 12

**Language of the International Application and Translation
for the Purposes of International Search and International Publication**

12.1 *Languages Accepted for the Filing of International Applications*

(a) and (b) [No change]

(c) Notwithstanding paragraph (a), the request shall be filed in any ~~a~~ language of publication which ~~is both a language accepted by~~ the receiving Office accepts for that purpose under that paragraph and a language of publication.

[COMMENT: See paragraphs 15 and 17 in the Introduction to this document.]

(d) [No change]

12.2 *Language of Changes in the International Application*

(a) [No change]

(b) Any rectification under Rule 91.1 of an obvious error in the international application shall be in the language in which the application is filed, provided that:

(i) where a translation of the international application is required under Rule 12.3(a), [12.4\(a\)](#) ~~48.3(b)~~ or 55.2(a), rectifications referred to in Rule 91.1(e)(ii) and (iii) shall be filed in both the language of the application and the language of that translation;

[COMMENT: The proposed amendment of item (i) is consequential on the proposed addition of new Rule 12.4 and deletion of Rule 48.3(b) (see below).]

(ii) [No change]

12.3 [No change]

12.4 Translation for the Purposes of International Publication

(a) Where the language in which the international application is filed is not a language of publication and no translation is required under Rule 12.3(a), the applicant shall, within 14 months from the priority date, furnish to the receiving Office a translation of the international application into English.

[COMMENT: See paragraphs 11 to 13 in the Introduction to this document. As at present (see present Rule 48.3(b), which is proposed to be deleted), the international application would be translated into, and published in, English.]

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

(c) Where the applicant has not, within the time limit referred to in paragraph (a), furnished a translation required under that paragraph, the receiving Office shall invite the applicant to furnish the required translation, and to pay, where applicable, the late furnishing fee required under paragraph (e), within 16 months from the priority date. Any translation received by the receiving Office before that Office sends the invitation under the previous sentence shall be considered to have been received before the expiration of the time limit under paragraph (a).

[Rule 12.4, continued]

(d) Where the applicant has not, within the 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 17 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 equal to [50%] of the international filing fee.

[COMMENT: The Working Group, at its second session, was of the view that further consideration should be given to the basis for calculation of the late furnishing fee contemplated in Rules 12.3(e) and 12.4(e), depending on the amount which might be fixed for the proposed new “flat” international filing fee under item 1 of the Schedule of Fees (see document PCT/R/WG/2/12, paragraph 29). The figure of 50% is therefore placed in square brackets. With regard to the proposal to add new Rule 12.4, see paragraphs 11 to 13 in the Introduction to this document. See also Rule 48.3(b), which is proposed to be deleted (see below).]

Rule 22

Transmittal of the Record Copy and Translation

22.1 *Procedure*

(a) to (g) [No change]

(h) Where the international application is to be published in the language of a translation furnished under Rule 12.3 [or 12.4](#), that translation shall be transmitted by the receiving Office to the International Bureau together with the record copy under paragraph (a) or, if the receiving Office has already transmitted the record copy to the International Bureau under that paragraph, promptly after receipt of the translation.

[COMMENT: The proposed amendment of paragraph (h) is consequential on the proposed addition of new Rule 12.4 (see above).]

22.2 [*Remains deleted*]

22.3 [No change]

Rule 26

**Checking by, and Correcting Before, the Receiving Office of
Certain Elements of the International Application**

26.1 and 26.2 [No change]

26.3 *Checking of Physical Requirements Under Article 14(1)(a)(v)*

(a) [No change]

(b) Where the international application is filed in a language which is not a language of publication, the receiving Office shall check:

(i) [No change]

(ii) any translation furnished under Rule 12.3 [or 12.4](#) and the drawings for compliance with the physical requirements referred to in Rule 11 to the extent that compliance therewith is necessary for the purpose of reasonably uniform international publication.

[COMMENT: The proposed amendment of item (ii) is consequential on the proposed addition of new Rule 12.4 (see above).]

26.3*bis* to 26.6 [No change]

Rule 29

International Applications or Designations Considered Withdrawn

29.1 *Finding by Receiving Office*

(a) If the receiving Office declares, under Article 14(1)(b) and Rule 26.5 (failure to correct certain defects), or under Article 14(3)(a) (failure to pay the prescribed fees under Rule 27.1(a)), or under Article 14(4) (later finding of non-compliance with the requirements listed in items (i) to (iii) of Article 11(1)), or under Rules 12.3(d) [or 12.4\(d\)](#) (failure to furnish a required translation or, where applicable, to pay a late furnishing fee), or under Rule 92.4(g)(i) (failure to furnish the original of a document), that the international application is considered withdrawn:

[COMMENT: The proposed amendment of paragraph (a) is consequential on the proposed addition of new Rule 12.4 (see above).]

(i) to (iv) [No change]

Rule 48

International Publication

48.1 and 48.2 [No change]

48.3 *Languages of Publication*

(a) [No change]

(a-*bis*) If the international application is not filed in a language of publication and a translation into a language of publication has been furnished under Rule 12.3 [or 12.4](#), that application shall be published in the language of that translation.

[COMMENT: The proposed amendment of paragraph (a-*bis*) is consequential on the proposed addition of new Rule 12.4 (see above).]

(b) ~~[Deleted] 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. The translation shall be prepared under the responsibility of the International Searching Authority, which shall be obliged to have it ready in time to permit international publication by the prescribed date, or, where Article 64(3)(b) applies, to permit the communication under Article 20 by the end of the 19th month after the priority date. Notwithstanding Rule 16.1(a), the International Searching Authority may charge a fee for the translation to the applicant. The International Searching Authority shall give the applicant an opportunity to comment on the draft translation. The International Searching Authority shall fix a time limit reasonable under the~~

[Rule 48.3(b), continued]

~~circumstances of the case for such comments. If there is no time to take the comments of the applicant into account before the translation is communicated or if there is a difference of opinion between the applicant and the said Authority as to the correct translation, the applicant may send a copy of his comments, or what remains of them, to the International Bureau and each designated Office to which the translation was communicated. The International Bureau shall publish the relevant portions of the comments together with the translation of the International Searching Authority or subsequently to the publication of such translation.~~

[COMMENT: The proposed deletion of paragraph (b) is consequential on the proposed addition of new Rule 12.4 (see above).]

(c) [No change]

48.4 to 48.6 [No change]

[End of Annex and of document]