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WORKING GROUP ON REFORM OF THE PATENT
COOPERATION TREATY (PCT)

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CHANGES RELATED TO THE PATENT LAW TREATY (PLT):

LANGUAGE OF THE INTERNATIONAL APPLICATION AND TRANSLATIONS

Document prepared by the International Bureau

BACKGROUND

Language of the international application: alignment with language-related filing date requirements of the PLT

1. At its first session, the Working Group on Reform of the Patent Cooperation Treaty (PCT) discussed proposals designed to align the PCT with the requirements of the Patent Law Treaty (PLT), based on document PCT/R/WG/1/5.¹ While certain PLT related matters (including the issues of right of priority and priority claims, missed time limit for entering the national phase, international applications filed without claims and “reference filings”) were discussed in detail, there was not enough time to discuss all proposed changes related to the PLT as set out in document PCT/R/WG/1/5. Among the issues that were not discussed during the first session was the issue of the language of the international application and translations. This document² contains revised proposals in relation to that issue.

¹ See WIPO’s Internet site at http://www.wipo.int/pct/en/meetings/reform_wg/index_1.htm.

² This and other working documents for the present session are available on WIPO’s Internet site at http://www.wipo.int/pct/en/meetings/reform_wg/reform_wg2.htm.

2. Annex II to document PCT/R/WG/1/5 set out specific proposals to align the language-related filing date requirements under the PCT with those under the PLT, with far reaching consequences on certain non-filing date related provisions dealing with the language of the international application for receiving Office processing, international search, international publication and international preliminary examination. Some of those 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.

3. In view of this apparent contradiction to one of the objectives of PCT reform, namely, to simplify, clarify and, where possible, shorten the wording of the provisions of the Regulations, the International Bureau has reconsidered the issue in substance and now proposes a new approach for addressing the issue of the language of the international application, as outlined in the following paragraphs.

4. 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)).³ *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)).

5. 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 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 application⁴ 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

³ References in this document to “Articles,” “Rules” and “Sections” are, respectively, to those of the Patent Cooperation Treaty (PCT), of the Regulations under the PCT (“the Regulations”) and of the Administrative Instructions under the PCT (“the Administrative Instructions”), or to such provisions as proposed to be amended or added, as the case may be. The current texts are available on WIPO’s Internet site at <http://www.wipo.int/eng/pct/texts/index.htm>. References to “national law,” “national applications,” “national Offices,” etc., include reference to regional law, regional applications, regional Offices, etc. The current texts are available on WIPO’s web site at <http://www.wipo.int/pct/eng/texts/index.htm>. References to “PLT Articles” and “PLT Rules” are to those of the Patent Law Treaty (PLT) concluded on June 2, 2000 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).

⁴ 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*.

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).

6. 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.

7. The International Bureau therefore proposes not to proceed with changes to the current PCT Rules concerning the language-related filing date requirements nor any related provisions dealing with the language of the international application for receiving Office processing, international search, international publication and international preliminary examination, with the following exception.

Translation of the international application for the purposes of international search

8. 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 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)).⁵ In practice, it is normally the applicant who in practice 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.

⁵ At present, this is the case: (i) where the international application is filed in Dutch with the Netherlands Industrial Property Office or the Belgium Industrial Property Office and ISA/EP 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 ISA/SE carries out 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 ISA/KR carries out international search in Korean.

9. The Annex to this document contains proposals to amend the PCT Regulations⁶ 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. The proposals are in line with earlier proposals submitted by the Republic of Korea during the first session of the Working Group (see document PCT/R/WG/1/8) and 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.

10. The Working Group is invited to consider the proposals contained in the Annex to this document.

[Annex follows]

⁶ 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.

ANNEX

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:

LANGUAGE OF THE INTERNATIONAL APPLICATION AND TRANSLATIONS

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Rule 12

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

12.1 [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 (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. Rule 12.3(b) shall apply *mutatis mutandis*.

[COMMENT: See paragraphs 8 and 9 in the “Background” section of 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.

(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.

[Rule 12.4, continued]

(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 basic fee.

[COMMENT: With regard to the proposal to add new Rule 12.4, see paragraphs 8 and 9 in the “Background” section of this document. See also Rule 48.3(b), which is proposed to be deleted, 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 Comment on Rule 12.4, above).]

(c) [No change]

48.4 to 48.6 [No change]

[End of Annex and of document]