

Patent Cooperation Treaty (PCT) Working Group

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MIXED-LANGUAGE INTERNATIONAL APPLICATIONS

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SUMMARY

1. The European Patent Office (EPO) proposes to amend Rule 26.3~~ter~~ with the aim of clarifying and harmonizing the procedure to be followed by receiving Offices in cases where:
 - (a) the description of an international application is filed in a different language from the language of the claims, or parts of the description/claims are filed in a different language from the remainder of the element; and
 - (b) all such languages are accepted by the competent receiving Office.

BACKGROUND

2. According to Article 3(4)(i), an international application (request, description, claim(s), drawings and abstract) must be in a prescribed language. However, to be accorded an international filing date, it is sufficient that the description and the claim(s) of an international application be in any language accepted by the competent receiving Office in line with Article 11(1)(ii) and Rules 12.1(a) and 20.1(c).
3. On that basis, when the description and/or the claims of an international application (or any part thereof) are in differing languages, and all of these languages are official languages of the EPO, the EPO as receiving Office accords as international filing date the date of receipt of the international application, and invites the applicant to file a translation with the aim of ensuring compliance with Article 3(4)(i). In the English authentic version of the Treaty, Article 3(4)(i) requires the international application to be “in a prescribed language”; in the French authentic version, the text explicitly states that the international application needs to be

in one single language (“dans une des langues prescrites ...”)¹. The EPO has, however, noticed that the PCT does not provide a clear legal basis to rely on for such request for translation.

4. For this reason, in December 2021, the EPO initiated a discussion on this point of practice in the electronic forum of the PCT Quality Subgroup (wiki) with the aim of gathering feedback on the practice adopted by other receiving Offices in similar situations.

5. The consultation showed that there is indeed a lack of clarity as to the procedure to be followed and consequently no harmonized approach. Two Offices stated that, in such a situation, they would seek the International Bureau's advice. Another Office would accord the international filing date and then invite the applicant to file a translation under Rule 12.3. However, a further Office would not accord the international filing date, but rather advise the applicant to file a request to correct the international application under Article 11, with the consequence that the international filing date would be shifted to the date on which the correction is received.

6. The International Bureau was also consulted. Its practice as receiving Office in such cases is to accord the international filing date and request a translation for the purpose of the international search under Rule 12.3.

7. It follows from the above that clarification on the procedure to be followed is necessary to ensure a harmonized treatment of these cases. A clear legal basis for requesting the necessary translation would increase legal certainty for both the receiving Offices and the users.

ASSESSMENT OF THE VARIOUS OPTIONS AND PROPOSAL

NON-ACCORDANCE OF THE INTERNATIONAL FILING DATE

8. It is recalled that if the description of an international application is filed in a different language from the language of the claims, or parts of the description/claims are filed in different languages, including languages not accepted by the receiving Office under Rule 12.1(a), the international application is transmitted to the International Bureau as receiving Office (paragraph 56 of the Receiving Office Guidelines). The International Bureau then accords as international filing date, if all requirements under Article 11 are fulfilled, the date on which the international application was originally received by the receiving Office (Rule 19.4).

9. International applications containing a description in a different language from the language of the claims or containing parts of the description/claims in a different language, where all of the languages are accepted by the receiving Office, might be considered not compliant with Article 11. It follows that such applications would be treated differently from those described in paragraph 8, above. Applicants would thus suffer a great disadvantage considering the impact the invitation under Article 11 has on the international filing date.

TRANSMITTAL TO THE INTERNATIONAL BUREAU

10. A possible solution to the problem of the accordance of the international filing date would be the transmittal of the international application to the International Bureau as receiving Office, in line with the practice followed when the entire description and/or claims (or any part thereof) include languages not accepted by the receiving Office (see paragraph 9, above).

11. This solution would, however, increase the administrative burden on both receiving Offices (e.g. fees would have to be refunded) and inevitably lead to a delay in the processing of the file. This does not seem to be necessary considering that, for the purpose of the

¹ Article 67(1)(a) states that both the English language text and the French language text of the Treaty are equally authentic.

accordance of the international filing date, the terms “any language” accepted by the receiving Office under Rule 12.1 could be interpreted as covering the case where the description and/or the claims are in multiple languages, where all are accepted by the receiving Office.

ACCORDANCE OF THE INTERNATIONAL FILING DATE AND INVITATION TO FILE A TRANSLATION

12. Some Offices are of the opinion that the international filing date should be accorded in such situations and that then the applicant should be invited to file a translation for the purposes of the international search under Rule 12.3.

13. Although this solution may be applicable to cases where the description and/or claims (or any part thereof) are filed in different languages and where all such languages are accepted by the receiving Office concerned but not by the International Searching Authority selected, it does not cover the case where such languages are accepted by both the receiving Office and the International Searching Authority. In the latter case, the receiving Office lacks a clear legal basis to invite the applicant to provide a translation for the purposes of the translation under Rule 12.3, and this is indeed the situation in which the EPO as receiving Office finds itself whenever such a case arises.

PROPOSAL: ACCORDANCE OF THE INTERNATIONAL FILING DATE AND INVITATION TO FILE A TRANSLATION UNDER NEW RULE 26.3ter(e)

14. The proposed new Rule 26.3ter(e) would provide receiving Offices, once the international filing date has been accorded, with a clear legal basis to request a translation of the description and/or the claims (or any part thereof) into one single language in compliance with Article 3(4)(i). In case of doubt as to whether Article 3(4)(i) is the appropriate legal basis in the PCT for such a new provision, reference is made to the authentic French version of Article 3(4)(i), which confirms that the international application must be in one single language (“dans une des langues prescrites ...”). It is repeated that this additional provision is relevant only in cases where the application contains wording in two or more languages accepted by the receiving Office.

15. The single language referred to in proposed new Rule 26.3ter(e) is a language meeting the following requirements: it is a language accepted by the International Searching Authority that is to carry out the international search, a language of publication and a language accepted by the receiving Office under Rule 12.1(a). These requirements mirror the requirements of Rule 12.3(a) applicable to translations for the purpose of search.

16. If the required translation has not been filed before the notification of the application number and international filing date to the applicant (Rule 20.2(c)), that applicant will be invited to do so within one month of the date of receipt of the international application.

17. Where the translation is not received within that time limit, the procedure under Rule 12.3(c) to (e) will be applicable *mutatis mutandis*: the applicant is invited to file the required translation and pay a late furnishing fee within one month of the date of the invitation or two months of the date of receipt of the international application, whichever expires later. Translations and payments received before the expiration of the time limit of 15 months from the priority date will be considered as received on time. Otherwise, the application is considered withdrawn and Rule 29.1 applies accordingly.

18. The alternative approach of first requiring a translation of (the parts of) the claims or description filed in a differing language into the language of the remainder of the claims and description is more burdensome. First, the time limit under Rule 12.3(a) for translation of the entire application into a language accepted for search by the International Searching Authority is too short, i.e. within one month of receipt of the international application by the receiving Office. This leaves no possibility for acting in a sequential manner. Second, from a user

perspective, it is more efficient when the receiving Office requires only one translation into a single language that is also fit for both the international search and publication. Third, from an operational perspective, inviting the applicant to file two different translations and checking compliance with these two steps would create an unnecessary burden for receiving Offices instead of requiring just one single translation for the whole procedure.

19. The Working Group is invited to comment on the proposal contained in paragraphs 14 to 18, and on the proposed amendments to Rule 26.3ter contained in the Annex to this document.

[Annex follows]

INDICATIVE DRAFT AMENDMENTS TO THE PCT REGULATIONS

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Rule 26

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

26.1 to 26.2bis [No change]

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

(a) Where the international application is filed in a language of publication, the receiving Office shall check:

(i) the international application for compliance with the physical requirements referred to in Rule 11 only to the extent that compliance therewith is necessary for the purpose of reasonably uniform international publication;

(ii) any translation furnished under Rule 12.3 or 26.3ter for compliance with the physical requirements referred to in Rule 11 to the extent that compliance therewith is necessary for the purpose of satisfactory reproduction.

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

(i) the international application for compliance with the physical requirements referred to in Rule 11 only to the extent that compliance therewith is necessary for the purpose of satisfactory reproduction;

(ii) any translation furnished under Rule 12.3, ~~or~~ 12.4 or 26.3ter 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.

26.3bis [No change]

26.3ter *Invitation to Correct Defects under Article 3(4)(i)*

(a) to (d) [No change]

(e) Where the description of an international application is filed in a language which is different from the language of the claims, or parts of the description or parts of the claims are filed in a language which is different from the language of the remainder of this element, and

where all such languages are accepted by the receiving Office under Rule 12.1(a), the receiving Office shall invite the applicant to furnish, within one month of the date of receipt of the international application by the receiving Office, a translation of the description of the claims, or any part thereof, into a single language which is all of the following:

(i) a language accepted by the International Searching Authority that is to carry out the international search,

(ii) a language of publication, and

(iii) a language accepted by the receiving Office under Rule 12.1(a).

Rule 12.3(c) to (e) shall apply *mutatis mutandis*.

26.4 and 26.5 [No change]

Rule 29
International Applications Considered Withdrawn

29.1 *Finding by Receiving Office*

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 Rule 12.3(d), ~~or~~ 12.4(d) or 26.3ter (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:

(i) the receiving Office shall transmit the record copy (unless already transmitted), and any correction offered by the applicant, to the International Bureau;

(ii) the receiving Office shall promptly notify both the applicant and the International Bureau of the said declaration, and the International Bureau shall in turn notify each designated Office which has already been notified of its designation;

(iii) the receiving Office shall not transmit the search copy as provided in Rule 23, or, if such copy has already been transmitted, it shall notify the International Searching Authority of the said declaration;

(iv) the International Bureau shall not be required to notify the applicant of the receipt of the record copy;

(v) no international publication of the international application shall be effected if the notification of the said declaration transmitted by the receiving Office reaches the International Bureau before the technical preparations for international publication have been completed.

29.2 to 29.4 *[No change]*

[End of Annex and of document]