

## **Patent Cooperation Treaty (PCT) Working Group**

**Sixteenth Session**  
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### **MIXED-LANGUAGE INTERNATIONAL APPLICATIONS**

*Document submitted by the European Patent Office*

#### **SUMMARY**

1. As introduced at the fifteenth session of the PCT Working Group, the European Patent Office (EPO) proposes to add a paragraph to Rule 26.3<sup>ter</sup> 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.

2. The purpose of the proposed rule change is to ensure that the international filing date is unaffected between the scenario of an international application containing more than one language where all languages are accepted by the competent receiving Office, and the scenario of an international application containing languages that are not accepted by the competent receiving Office. This would prevent discriminating between applicants depending on the said scenarios and would be particularly useful for receiving Offices accepting several filing languages.

#### **BACKGROUND**

3. 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).

4. At the European Patent Office (EPO), when the description and/or the claims of an international application (or any part thereof) are in more than one language, and all of these languages are filing languages accepted by the EPO as receiving Office, the EPO would like to accord as international filing date the date of receipt of the international application and to invite the applicant to file a translation with the aim of ensuring compliance with Article 3(4)(i). However, unfortunately, the PCT does not provide a clear legal basis to request such a translation from applicants.

5. For this reason, the EPO initiated a discussion on this point of practice in the electronic forum of the PCT Quality Subgroup (wiki) in December 2021. The exchange showed that there is indeed a lack of clarity as to the procedure to be followed and consequently no harmonized approach amongst Offices. Therefore, clarification on the procedure to be followed is necessary to ensure a uniform treatment of these cases. A clear legal basis for requesting the necessary translation would increase legal certainty for both receiving Offices and users. Consequently, the EPO presented its proposal of a new Rule 26.3*ter(e)* at the fifteenth session of the PCT Working Group in October 2022. Based on the comments received both during that session and afterwards, the EPO is submitting the present revised version.

## PROPOSAL

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

6. It is proposed that when an international application contains text in more than one language, all such languages being accepted by the receiving Office, an international filing date can be accorded, supposing that all non-language related requirements are otherwise met. For international applications containing text in more than one language including a language not accepted by the receiving Office, the current practice of forwarding the application to the International Bureau under Rule 19.4(a)(ii) would remain unchanged.

7. Under the proposed rule, an initial time limit of one month and a second one-month time limit would apply for the applicant to provide a translation of the relevant (parts of) the claims and description into a single language that is already present in the application as filed, and which ought to be a language accepted by the International Searching Authority and would be the language in which the international application is to be published. This would ensure that the application is not translated into an entirely different, third language. For instance, when an international application is filed with the EPO as receiving Office containing all claims in French while the description is partially in French and partially in English, the applicant will have to furnish a translation of both the relevant parts of the claims and description into French or into English. As a result, the receiving Office will have at its disposal the entire claims and description in a single language that it accepts for filing.

8. This single language will be considered the language of the application as filed. In the example above, if an applicant chooses to file a translation of the entire claims and the respective parts of the description into English, the language of the application will be English. Consequently, missing or erroneously filed elements or parts (Rule 12.1*bis*), amendments to the international application (Rule 12.2(a)) and any rectification of an obvious mistake (Rule 12.2(b)) only need to be filed in this single language.

### PROCEDURE

9. Where the required translation is not received within one month of the date of receipt of the international application by the receiving Office, the procedure under Rule 12.3(c) to (e) will be applicable *mutatis mutandis*. If the applicant fails to furnish the translation of both the

relevant (parts of the) claims and/or description into a single language, the receiving Office will invite them to do so, preferably at the same time as it accords the international filing date and application number. Initially, a time limit of one month from the date of receipt of the international application by the receiving Office applies (proposed Rule 26.3ter(e)). If the translation is not submitted within this time limit, a second one-month time limit or a time limit of two months from the receipt of the international application, whichever expires later, will apply (Rule 12.3(c) *mutatis mutandis*). The applicant will be required to pay a late furnishing fee to the receiving Office, depending on the receiving Office's choice of introducing such a fee (Rule 12.3(e) *mutatis mutandis*).

10. Any translation and any payment received by the receiving Office before that Office declares the international application to be considered withdrawn and before the expiration of 15 months from the priority date will be considered to have been received on time (Rule 12.3(d) *mutatis mutandis*). If the translation is not supplied before this time, the international application will be considered withdrawn by the receiving Office.

11. Regarding the abstract and text matter of drawings, the language-related rules remain unchanged. In the vast majority of cases, the applicant will choose a single language of the claims and description that is the same as the language of the abstract and text matter of drawings originally filed. In this scenario, no translation of the abstract and text matter of the drawings will be necessary under Rule 26.3ter(a)(ii) as the single language of the claims and description corresponds to “*the language in which the international application is to be published*” (Rule 26.3ter(e)(iii)). In the rare cases where an applicant furnishes the translation of the mixed-language claims and description into a single language that is not the same language as the abstract and/or text matter of the drawings, Rule 26.3ter(a) would apply. Accordingly, the receiving Office invites the applicant to file a translation of the abstract and/or text matter of the drawings into this single language. This will ensure that the entire international application is available to the receiving Office in a single language, also for the purpose of search and publication.

12. With the wording “*the receiving Office shall, as appropriate, invite the applicant to furnish...a translation*”, the scope of the proposed new rule does not extend to cases where more than one language is required for the proper understanding of the claimed invention (e.g. a translation device). This also applies to cases where the International Bureau acts as receiving Office and no text in a language of publication is included in the international application. In this case, the International Bureau invites the applicant to specify a language of publication into which the applicant will supply a translation of the entire claims and description. Further detailed explanations are set out in the draft Receiving Office Guidelines (see final paragraph of Annex II).

13. The draft Receiving Office Guidelines included in Annex II are intended to provide guidance for the implementation of the proposed new rule. Annex II is included for information and feedback only as the drafting of these Guidelines remains within the remit of the International Bureau following the entry into force of any amendment to the PCT Regulations.

14. *The Working Group is invited to consider the proposed amendments to the Regulations in Annex I to this document.*

[Annexes follow]

PROPOSED AMENDMENTS TO THE PCT REGULATIONS<sup>1</sup>

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<sup>1</sup> Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned.

## 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) Where the abstract or any text matter of the drawings is filed in a language which is different from the language, subject to Rules 12.1bis and 26.3ter(e), of the description and the claims, the receiving Office shall, unless

(i) a translation of the international application is required under Rule 12.3(a), or

- (ii) the abstract or the text matter of the drawings is in the language in which the international application is to be published,

invite the applicant to furnish a translation of the abstract or the text matter of the drawings into the language in which the international application is to be published. Rules 26.1, 26.2, 26.3, 26.3bis, 26.5 and 29.1 shall apply *mutatis mutandis*.

(b) 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, as appropriate, 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 or the claims, or any part thereof, such that the description and claims are in a single language which is all of the following:

(i) one of the languages contained in the description or claims as filed;

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

(iii) the language in which the international application is to be published.

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]*

[Annex II follows]

## DRAFT RECEIVING OFFICE GUIDELINES REGARDING RULE 26.3ter(e)

If the receiving Office accepts more than one language for the filing of international applications, when part of the description or part of the claims is filed in an accepted language that differs from the language of the remainder of this element but both languages are accepted, a time limit of one month as of the date of receipt of the application applies for the applicant to provide a translation of this part of the description or part of the claims. The translation has to be provided into a single language chosen by the applicant that is contained in the description or claims as filed, accepted for the purpose of the search by the competent International Searching Authority and is the language in which the application is to be published.

The same principle applies to cases where all of the claims are filed in a different language from the description, both languages being accepted by the receiving Office, i.e. a translation of the the entire description or of the entire set of claims needs to be furnished into one single language chosen by the applicant that is at the same time a language contained in the description or claims as filed, accepted for search by the competent International Searching Authority and is the language in which the application is to be published.

If the applicant fails to furnish the translation of both the relevant (parts of the) claims and/or description into a single language, the receiving Office will invite them to do so, preferably at the same time as it accords the international filing date and application number. If no translation of (part of) the description and/or the claims into a single language has been received within the initial time limit of one month as of receipt of the application, the receiving Office will invite the applicant using Form PCT/RO/132 to furnish the translation within a second one-month time limit from the date of the invitation or within two months from the date of receipt of the application by the receiving Office, whichever expires later, and to pay, where applicable, a late furnishing fee.

In cases where the abstract and/or text matter of the drawings of the application have been filed in a language different from the single language chosen by the applicant and where no translation of the abstract and/or text matter of drawings into this single language has been received one month after the receipt of the application, the receiving Office will also invite the applicant via Form PCT/RO/106 (Annex A, box 3.b. and/or c.) to furnish a translation of the abstract and/or text matter of the drawings under Rule 26.3ter(a). Preferably, this notification will be sent in parallel to issuing the invitation under Rule 26.3ter(e) via Form/RO/132 and both notifications will make reference to each another. The single language chosen by the applicant under Rule 26.3ter(e) is also considered the language of the description and the claims as well as the language in which the application is to be published referred to in Rule 26.3ter(a)(ii). A time limit of two months from the invitation to furnish a translation of the abstract and/or text matter applies (Rule 26.2).

In particular in two instances, the words “*as appropriate*” contained in Rule 26.3ter(e) provide some flexibility for the receiving Office

(i) in cases where the submission of an application containing multiple languages is required for a proper understanding of the claimed invention (e.g. a translation device), to decide not to invite the applicant to submit a translation into a single language under Rule 26.3ter(e); and

(ii) in cases where the International Bureau acting as receiving Office receives a mixed-language application where no text in a language of publication is included, to decide to invite the applicant to specify a language of publication accepted by the competent International Searching Authority into which the applicant will supply a translation of the claims and description.

[End of Annex II and of document]