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INTERNATIONAL SEARCH AND INTERNATIONAL PRELIMINARY EXAMINATION
OF INTERNATIONAL APPLICATIONS FILED IN SPANISH

Memorandum prepared by the International Bureau

This document (PCT/A/XX/2 Rev.) is a revised version of document PCT/A/XX/2 which was issued by the International Bureau on July 17, 1992. The revisions, which were made in response to comments provided to the International Bureau by the Japanese Patent Office and the Netherlands Patent Office, are indicated by vertical lines in the margin adjacent to revised passages of the document.

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Introduction

1. Since the entry into force of Rule 12.1(c) and (d) of the Regulations under the Patent Cooperation Treaty (PCT), it is possible to have international search reports prepared on the basis of a translation of the international applications. The translation must be made under the responsibility of the receiving Office and must be in a language accepted by the competent International Searching Authority. No such possibility, however, exists in the case of international preliminary examination since the Rules relating to Chapter II (International Preliminary Examination) of the PCT do not contain provisions similar to Rule 12.1(c) and (d).
2. The lack of such a possibility causes no problems for the present PCT Contracting States since for each present Contracting State bound by the provisions of Chapter II there is at least one International Preliminary Examining Authority which examines international applications in the language in which they are published.
3. However, this situation is expected to change soon. Several Spanish-speaking countries in Latin America have expressed interest in accession to the PCT, and there is no International Preliminary Examining Authority that carries out international preliminary examination of international applications in Spanish. Spain, a party to the PCT, may wish to withdraw its reservation in respect of Chapter II. In order to allow applicants from any Spanish-speaking country to file international applications in Spanish and to obtain not only an international search (if required, on the basis of a translation prepared under the responsibility of the receiving Office according to Rule 12.1(c)) but also an international preliminary examination, provision would need to be made for the possibility of obtaining international preliminary examination on the basis of a translation.

Proposed amendments to the PCT Regulations

4. The language of proceedings for international preliminary examination is, pursuant to PCT Rule 55.1, the language in which the international application is published. International applications filed in Spanish are published in that language. Therefore, the language in which international preliminary examination would have to be carried out under the present Regulations would also be Spanish.
5. In order to overcome the consequences of the fact that at present none of the International Preliminary Examining Authorities is prepared to carry out international preliminary examination in Spanish, a solution similar to the solution provided by Rule 12.1(c) and (d) in respect of international search (see paragraph 1, above) is proposed in this memorandum in relation to the Rules relating to Chapter II, that is, in relation to international preliminary examination.
6. It is proposed to amend the Regulations to provide for a procedure under which, for the purposes of international preliminary examination, applicants may be required by an International Preliminary Examining Authority to furnish a translation into the language, or one of the languages, which that Authority is prepared to use for international preliminary examination. In cases where a translation has already been transmitted to the International Searching

Authority under Rule 12.1(c) and where the International Preliminary Examining Authority is part of the same national Office or intergovernmental organization as the International Searching Authority, the applicant would not need to furnish the translation again; in such a case (unless the applicant wishes to furnish and furnishes a (new) translation with the demand), the International Preliminary Examining Authority would make use of the translation already furnished to the International Searching Authority.

7. Consequential amendments are required to clarify the language in which amendments must be filed as well as the language for correspondence with an Authority requiring a translation.

8. As to amendments, where international preliminary examination is carried out on the basis of a translation, the amendments which will be annexed to the international preliminary examination report would be in the language of the translation. Where an elected Office does not require a translation of the international application as published (because the international application was published in an official language used by the elected Office), that Office could require a translation (into the language of publication of the international application) of any annex to the international preliminary examination report which is not in the said language of publication (see proposed Rule 74.1(b)). For example, if the international application was filed and published in Spanish but examined on the basis of an English translation and amendments submitted (in English) in the course of the international preliminary examination, the annex to the international preliminary examination report would have to be translated into Spanish by the applicant when he entered the national phase before a national Office whose official language was Spanish. On the other hand, in the case of an elected Office which requires a translation of such an international application into English, the annex to the international preliminary examination report would already be in English, so that no translation of that annex would need to be furnished to that elected Office (see the amendment of proposed Rule 74.1(a)).

9. The PCT Rules which would have to be amended in order to implement the above proposals are Rules 55, 60.1, 61.1, 66.9, 70.17 and 74.1.

10. The amendment of Rule 66.9, in providing for an invitation procedure to deal with cases where an amendment is not filed in the required language, would apply equally to the case covered by present Rule 66.9, namely, where the international application was filed in a language other than the language in which it is published.

11. As to the language of correspondence, it is proposed to amend Rule 92.2.

12. The texts of the provisions as proposed to be amended are contained in the Annex to this document.

13. The proposed amendments should facilitate the accession of Spanish-speaking countries to the PCT and would make it possible that they accept Chapter II.

14. The proposed amendments are so drafted that they would not be limited in their operation to international applications filed in Spanish. They could apply equally to any international application for which neither the language of filing nor the language of publication is accepted for international preliminary examination. In practice, however, the amendments would at present concern only international applications filed in Spanish.

15. The opportunity is also taken to clarify the operation of PCT Rules 37.2, 38.2 and 43.4 in cases where an International Searching Authority undertakes a search on the basis of a translation transmitted under Rule 12.1(c). Under the present Rules, the title, the abstract and the international search report (or the declaration under PCT Article 17(2)(a)) must be established in the language in which the international application is published. That language is not a working language of the International Searching Authority if the latter requires a translation under Rule 12.1(c). The amendments proposed to those provisions in the Annex to this document would entitle an International Searching Authority, if it so wished, to establish a title or an abstract (in circumstances set out in Rules 37.2 and 38.2, respectively) and the international search report (or the said declaration) in the language of the translation. Whenever the International Searching Authority establishes the title, the abstract and the international search report (or the said declaration) in the language of the translation, the International Bureau would, under Rule 48.3(c), prepare translations into the language of publication and, where the language of the translation transmitted under Rule 12.1(c) was not English, also into English.

Entry into force

16. It is proposed that the amendments to the Regulations under the PCT set out in this document, when adopted by the Assembly, enter into force on January 1, 1993.

17. The Assembly is invited

(i) to adopt the amendments to the Regulations under the PCT which are proposed in the Annex to the present document, and

(ii) to decide that those amendments will enter into force on January 1, 1993.

[Annex follows]

ANNEX

TEXT OF THE PROPOSED AMENDMENTS

Rule 37

Missing or Defective Title

37.1 [No change]

37.2 Establishment of Title

If the international application does not contain a title and the International Searching Authority has not received a notification from the receiving Office to the effect that the applicant has been invited to furnish a title, or if the said Authority finds that the title does not comply with Rule 4.3, it shall itself establish a title. Such title shall be established in the language in which the international application is published or, if a translation was transmitted under Rule 12.1(c) and the International Searching Authority so wishes, in the language of that translation.

Rule 38

Missing or Defective Abstract

38.1 [No change]

38.2 Establishment of Abstract

(a) If the international application does not contain an abstract and the International Searching Authority has not received a notification from the receiving Office to the effect that the applicant has been invited to furnish an abstract, or if the said Authority finds that the abstract does not comply with Rule 8, it shall itself establish an abstract. Such abstract shall be established in the language in which the international application is published or, if a translation was transmitted under Rule 12.1(c) and the International Searching Authority so wishes, in the language of that translation.

(b) [No change]

Rule 43

The International Search Report

43.1 to 43.3 [No change]

43.4 Language

Every international search report and any declaration made under Article 17(2)(a) shall be in the language in which the international application to which it relates is published or, if a translation was transmitted under Rule 12.1(c) and the International Searching Authority so wishes, in the language of that translation.

43.5 to 43.10 [No change]

Rule 55

Languages (International Preliminary Examination)

55.1 Language of Demand*

The demand shall be in the language of the international application or, if the international application has been filed in a language other than the language in which it is published, in the language of publication. However, if a translation of the international application is required under Rule 55.2, the demand shall be in the language of that translation.

* The title has been amended to read "Language of Demand" instead of "The Demand".

55.2 Translation of International Application

(a) Where the international application is neither filed nor published in the language, or one of the languages, specified in the agreement concluded between the International Bureau and the International Preliminary Examining Authority competent for the international preliminary examination of that application, that Authority may require that, subject to paragraph (b), the applicant furnish with the demand a translation of the international application into the language, or one of the languages, specified in the said agreement.

(b) Where a translation of the international application into a language referred to in paragraph (a) was transmitted to the International Searching Authority under Rule 12.1(c) and the International Preliminary Examining Authority is part of the same national Office or intergovernmental organization as the International Searching Authority, the applicant need not furnish a translation under paragraph (a). In such a case, unless the applicant furnishes a translation under paragraph (a), the international preliminary examination shall be carried out on the basis of the translation transmitted under Rule 12.1(c).

(c) If the requirement of paragraph (a) is not complied with and paragraph (b) does not apply, the International Preliminary Examining Authority shall invite the applicant to furnish the required translation within a time limit which shall be reasonable under the circumstances. That time limit shall not be less than one month from the date of the invitation. It may be extended by the International Preliminary Examining Authority at any time before a decision is taken.

[Rule 55.2, continued]

(d) If the applicant complies with the invitation within the time limit under paragraph (c), the said requirement shall be considered to have been complied with. If the applicant fails to do so, the demand shall be considered not to have been submitted.

(e) Paragraphs (a) to (d) shall apply only where the International Preliminary Examining Authority has declared, in a notification addressed to the International Bureau, that it accepts to carry out international preliminary examination on the basis of the translation referred to in those paragraphs.

55.3 Translation of Amendments

(a) Where a translation of the international application is required under Rule 55.2, any amendments which are referred to in the statement concerning amendments under Rule 53.9 and which the applicant wishes to be taken into account for the purposes of the international preliminary examination, and any amendments under Article 19 which are to be taken into account under Rule 66.1(c), shall be in the language of that translation. Where such amendments have been or are filed in another language, a translation shall also be furnished.

(b) Where the required translation of an amendment referred to in paragraph (a) is not furnished, the International Preliminary Examining Authority shall invite the applicant to furnish the missing translation within a time limit which shall be reasonable under the circumstances. That time limit shall not be less than one month from the date of the invitation. It may be extended by the International Preliminary Examining Authority at any time before a decision is taken.

(c) If the applicant fails to comply with the invitation within the time limit under paragraph (b), the amendment shall not be taken into account for the purposes of the international preliminary examination.

Rule 60

Certain Defects in the Demand or Elections

60.1 Defects in the Demand

(a) If the demand does not comply with the requirements specified in Rules 53.1, 53.2(a)(i) to (iv), 53.2(b), 53.3 to 53.8 and 55.1, the International Preliminary Examining Authority shall invite the applicant to correct the defects within a time limit which shall be reasonable under the circumstances. That time limit shall not be less than one month from the date of the invitation. It may be extended by the International Preliminary Examining Authority at any time before a decision is taken.

(b) to (g) [No change]

60.2 [No change]

Rule 61

Notification of the Demand and Elections

61.1 Notification to the International Bureau and the Applicant

(a) [No change]

(b) The International Preliminary Examining Authority shall promptly inform the applicant in writing of the date of receipt of the demand. Where the demand has been considered under Rules 54.4(a), 55.2(d), 57.4(c), 58.2(c) or 60.1(c) as if it had not been submitted or where an election has been considered under Rule 60.1(d) as if it had not been made, the International Preliminary Examining Authority shall notify the applicant and the International Bureau accordingly.

(c) [No change]

61.2 to 61.4 [No change]

Rule 66

Procedure before the International Preliminary Examining Authority

66.1 to 66.8 [No change]

66.9 Language of Amendments

(a) Subject to paragraphs (b) and (c), if the international application has been filed in a language other than the language in which it is published, any amendment, as well as any letter referred to in Rule 66.8(a), shall be submitted in the language of publication.

(b) If the international preliminary examination is carried out, pursuant to Rule 55.2, on the basis of a translation of the international application, any amendment, as well as any letter referred to in paragraph (a), shall be submitted in the language of that translation.

(c) Subject to Rule 55.3, if an amendment or letter is not submitted in a language as required under paragraph (a) or (b), the International Preliminary Examining Authority shall, if practicable having regard to the time limit for establishing the international preliminary examination report, invite the applicant to furnish the amendment or letter in the required language within a time limit which shall be reasonable under the circumstances.

(d) If the applicant fails to comply, within the time limit under paragraph (c), with the invitation to furnish an amendment in the required language, the amendment shall not be taken into account for the purposes of the international preliminary examination. If the applicant fails to comply, within the time limit under paragraph (c), with the invitation to furnish a letter referred to in paragraph (a) in the required language, the amendment concerned need not be taken into account for the purposes of the international preliminary examination.

Rule 70

The International Preliminary Examination Report

70.1 to 70.16 [No change]

70.17 Languages of the Report and the Annexes

(a) The report and any annex shall be in the language in which the international application to which they relate is published, or, if the international preliminary examination is carried out, pursuant to Rule 55.2, on the basis of a translation of the international application, in the language of that translation.

(b) [Remains deleted]

Rule 74

Translations of Annexes of the International Preliminary
Examination Report and Transmittal Thereof

74.1 Contents of Translation and Time Limit for Transmittal Thereof

(a) Where the furnishing of a translation of the international application is required by the elected Office under Article 39(1), the applicant shall, within the time limit applicable under Article 39(1), transmit a translation of any replacement sheet referred to in Rule 70.16 which is annexed to the international preliminary examination report, unless such sheet is in the language of the required translation of the international application. The same time limit shall apply where the furnishing of a translation of the international application to the elected Office must, because of a declaration made under Article 64(2)(a)(i), be effected within the time limit applicable under Article 22.

(b) Where the furnishing under Article 39(1) of a translation of the international application is not required by the elected Office, that Office may require the applicant to furnish, within the time limit applicable under that Article, a translation into the language in which the international application was published of any replacement sheet referred to in Rule 70.16 which is annexed to the international preliminary examination report and is not in that language.

Rule 92

Correspondence

92.1 [No change]

92.2 Languages

(a) Subject to Rules 55.1 and 66.9 and to paragraph (b) of this Rule, any letter or document submitted by the applicant to the International Searching Authority or the International Preliminary Examining Authority shall be in the same language as the international application to which it relates. Where a translation of the international application has been transmitted under Rule 12.1(c) or furnished under Rule 55.2(a) or (c), the language of such translation shall be used.

(b) to (e) [No change]

92.3 [No change]

92.4 [No change]

[End of Annex and of document]

