

WIPO



PCT/CAL/VI/4
ORIGINAL: English
DATE: April 29, 1996

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

**INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)**

**PCT COMMITTEE
FOR ADMINISTRATIVE AND LEGAL MATTERS**

Sixth Session*
Geneva, April 29 to May 3, 1996

FILING LANGUAGES FOR INTERNATIONAL APPLICATIONS AND
TRANSLATIONS FOR INTERNATIONAL SEARCH AND/OR INTERNATIONAL
PUBLICATION: POSSIBLE LIBERALIZATION OF THE REQUIREMENTS
OF THE PCT REGULATIONS

Document prepared by the International Bureau

* *Editor's Note:* This electronic document has been created from the paper original and may contain errors. Please bring any such errors to the attention of the PCT Legal Division by e-mail at pct.legal@wipo.int

PRESENT REQUIREMENTS AS TO LANGUAGES IN WHICH INTERNATIONAL APPLICATIONS MAY BE FILED

1. The PCT and the Regulations thereunder¹ make specific provision for the language in which an international application must be filed. The intention behind these provisions is to ensure that:

(i) the receiving Office will be able to carry out the necessary checking of the international application at the time of filing;

(ii) the International Searching Authority will be able to carry out an international search on the international application;

(iii) the international application will be published in one of the seven languages (namely, Chinese, English, French, German, Japanese, Russian and Spanish) in which international applications may, as agreed by the Assembly of the PCT Union, be published (“languages of publication”);

(iv) the International Preliminary Examining Authority will be able to carry out an international preliminary examination on the international application.

2. Article 11(1)(ii) thus provides that, in order to be accorded an international filing date, an international application must be in “the prescribed language.” The relevant prescription is contained in Rule 12.1, which presently requires, in general, that an international application be filed in the language, or one of the languages, accepted by an International Searching Authority specified as competent by the receiving Office concerned. The language or languages accepted by each International Searching Authority are set out in the applicable agreement referred to in Article 16(3)(b) between the Authority concerned and the International Bureau. Where several languages are accepted by the International Searching Authority, the receiving Office may prescribe which of those languages it will accept for filing purposes.

3. The languages accepted for international search by the International Searching Authorities are, at present, with the exceptions outlined in the following paragraph, also languages of publication. Those exceptions already permit certain applicants to file international applications in their national language.

4. The exceptions arise because two of the present International Searching Authorities (the European Patent Office and the Swedish Patent Office) are prepared to undertake searches on international applications filed in certain languages which are not languages of publication but in which the Authorities have a particular capacity (namely, Dutch and certain Scandinavian languages, respectively). In such cases, the international application may be filed in one of those languages and the international search will be undertaken in the language of the international application in which it has been filed. In these cases, the international

¹ References in this document to “Articles” and “Rules” are, respectively, to those of the Patent Cooperation Treaty (PCT) and of the Regulations under the PCT (“the Regulations”), or to such provisions as proposed to be amended or added, as the case may be.

application will be published in English, the translation into that language being prepared, pursuant to Rule 48.3(b), under the responsibility of the International Searching Authority which undertakes the search.

5. It is also to be noted that, under existing Rule 12.1(c), an International Searching Authority may agree, in certain circumstances, to search an international application on the basis of a translation. However, that Rule applies only where the language in which the international application is filed is one of the languages of publication. At present, this possibility applies in practice only to international applications which are filed in Spanish with the Mexican Institute of Industrial Property and where the applicant chooses, as competent International Searching Authority, the European Patent Office, the Swedish Patent Office or the United States Patent and Trademark Office, none of which accepts Spanish as a searching language.

POSSIBLE LIBERALIZED REQUIREMENTS

6. The present requirements as to languages of filing mean that applicants in many countries cannot file an international application in their national language (for example, in the form of a copy of a national application which would be used as the basis for a priority claim in the international application), but must prepare a translation before filing an international application. The International Bureau wonders whether the Regulations could be liberalized so as to permit the filing of international applications in a broader range of languages, subject to the furnishing by the applicant of the required translation to be used for the purposes of international search, international publication and/or international preliminary examination.

7. It is envisaged, in particular, that an international application would be permitted to be filed in any official language in which the receiving Office accepts the filing of national applications under the applicable national law, even if that language is not accepted for international search by any competent International Searching Authority. In addition, provision could be made enabling an international application to be filed in any other language which the receiving Office is prepared to accept. The existing provision for an international application to be filed in a language accepted by a competent International Searching Authority would be retained, but only as one of the possibilities open to applicants.

8. The international search would, as at present, be carried out only in languages accepted by the International Searching Authority concerned. Moreover, international applications would continue to be published only in one of the prescribed languages of publication. In order to meet those requirements, where an international application is filed in a language which is not accepted by the International Searching Authority concerned and/or is not one of the prescribed languages of publication, the applicant would be required to furnish the required translation for the purposes of international search and/or international publication. It seems appropriate to provide that the furnishing of such a translation would be the responsibility of the applicant and not, as under present Rules 48.3(b) and 12.1(c), of the International Searching Authority or the receiving Office, respectively.

9. The principle contained in present Rule 12.1(b)(ii) and (iii), whereby any text matter of the drawings and the abstract may be filed in the language in which the international application is to be published, even if the description and claims are filed in another language, could be retained. It may, however, be appropriate to review the existing provisions of Rule 26.3*ter* for remedying non-compliance of the text matter of the drawings or the abstract with the language requirements of Rule 12.1, since the required corrections might be more easily dealt with in the context of the new provisions for requiring translations generally.

10. In order to avoid the proliferation of request forms in a variety of languages, the provisions of Rule 12.1(b)(i) in relation to the request could be amended so as to require that the request always be filed in one of the languages of publication referred to in Rule 48.3(a) which is accepted by the receiving Office for the purpose.

11. If the Committee agrees in principle to the ideas set out in the present document, the International Bureau would proceed to develop a detailed proposal for amendment of the Regulations, taking into account the advice expressed by the Committee.

12. The Committee is invited to consider, and express its advice on, the questions outlined in the present document.

[End of document]