

C. PCT 1671

May 27, 2024

Madam,
Sir,

Proposed modifications of the PCT Receiving Office Guidelines (“the RO Guidelines”)

This Circular is addressed to your Office in its capacity as a receiving Office (RO), an International Searching Authority (ISA), an International Preliminary Examining Authority (IPEA), an Authority specified for supplementary search, and/or a designated or elected Office under the Patent Cooperation Treaty (PCT) for the purposes of consultation. It is also addressed to certain non-governmental organizations representing users of the PCT System.

The main purpose of this Circular is to consult on proposed modifications of the RO Guidelines implementing the amendments to the Rules 26 and 29 of the Regulations under the PCT (“the Regulations”) adopted by the PCT Assembly at its fifty-fifth session held in Geneva from July 6 to 14, 2023. The documents related to these changes are PCT/A/55/2, Annex II, and PCT/A/55/4, paragraph 32. These amendments, which will enter into force on July 1, 2024, relate to the procedure for handling international applications containing parts in different languages. The modified Administrative Instructions under the PCT (“the Administrative Instructions”) and certain Forms annexed to the Administrative Instructions were promulgated through C. PCT 1668.

Detailed explanations of the proposed modifications are provided below, noting that explanations may not be provided in every case, especially when the proposed modifications are self-evident or of an editorial nature.

I. Proposed modifications of the RO Guidelines

Paragraph 58 is proposed to be modified by adding “usually” and deleting the last sentence, to clarify that one translation is usually sufficient during Chapter I of the international phase, while recognizing certain exceptional cases.

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New paragraphs 65A to 65D are proposed to be introduced to provide detailed guidance on the language check concerning the description and claims which is conducted by the receiving Office. Paragraph 65B provides guidance in relation to the checking of the single language requirement in case of language-neutral terms. Paragraphs 65D and 65F explain a new procedure for handling cases in which the description and claims, or any part thereof, are not filed in a single language but the languages used are accepted by the receiving Office under amended Rules 26 and 29, including the issuance of new Form PCT/RO/145. Paragraph 65E explains the situation in which Rule 12.3 or 12.4 applies instead of Rule 26.3*ter*(e).

Paragraph 234 is proposed to be modified to also mention Form PCT/RO/145.

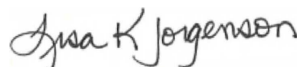
Paragraphs 283, 285 and 289A are proposed to be modified to include the reference to the amended Rule 26.3*ter*(e) for the search copy and the record copy. A new paragraph 289A is introduced to explain what constitutes the search copy under the modified Section 305*bis*(a-*bis*)(iii) of the Administrative Instructions.

./. The paragraphs of the RO Guidelines which are proposed to be modified or added are set out in Annex I to this Circular. Certain paragraphs that are not proposed to be modified have been included for ease of reference.

II. *Comments on the Proposed Modifications of the RO Guidelines*

Your Office is invited to provide comments, if any, by June 12, 2024, by e-mail to: pct.legal@wipo.int.

Yours sincerely,



Lisa Jorgenson
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Patents and Technology Sector

PROPOSED MODIFICATIONS OF THE RECEIVING OFFICE GUIDELINES

**CHAPTER II
GENERAL**

14-19. [No change]

Documents and Correspondence

20. [No change]

21. The language of any letter from the applicant to the receiving Office shall be the same as the language of the international application to which such letter relates, provided that, where the international application is to be published in the language of a translation required under Rule 12.3(a), ~~or~~ 12.4(a) or 26.3ter(e), any letter shall be in such language (paragraphs 67, 67A and 68). However, the receiving Office may expressly authorize the use of any other language (Section 104(a)). It may also accept any language on a case-by-case basis.

22-27. [No change]

**CHAPTER IV
ARTICLE 11(1) CHECK;
REQUIREMENTS FOR INTERNATIONAL FILING DATE**

35-38. [No change]

Requirements for According an International Filing Date (Article 11(1))

39-40. [No change]

41. **Language.** The receiving Office checks whether the international application is in the prescribed language. For the purposes of according an international filing date, it is sufficient that the description, other than any sequence listing part thereof, and the claims are in the language, or one of the languages, which the receiving Office, under Rule 12.1(a), accepts for the filing of international applications.¹ If the description and claims, or part thereof, contain more than one language all of which are accepted by the receiving Office, see paragraphs 65A to 65D. With regard to any sequence listing part of the description, see paragraph 56A. With regard to the language of the request, see paragraph 59. With regard to the language of the abstract and of any text matter of the drawings, see paragraph 62. Where an international application is filed with a national Office, which acts as a receiving Office under the Treaty, by an applicant who is a resident or national of a Contracting State and the international application is not in a language accepted by that national Office but is in a language accepted by the International Bureau as receiving Office, Rule 19.4(a)(ii) applies (paragraphs 274 to 277).

¹ If the international application is filed with the United States Patent and Trademark Office as a receiving Office, all elements of the international application (that is, request, description, sequence listing part of the description, claims, abstract, any text matter of the drawings) must be exclusively in English (see Rule 20.1(c) and (d)).

42. [No change]

CHAPTER V
LANGUAGE CHECK
(ARTICLE 3(4)(i); RULES 12.1, 12.3, 12.4 AND 26.3ter)

General

55. [No change]

56. With regard to the description (other than any sequence listing part thereof) and claims, compliance with the requirement that the international application be in a prescribed language is a condition for according an international filing date (Article 11(1) and Rule 20.1(c) (if the description and claims, or part thereof, contain more than one language, all of which are accepted by the receiving Office, see paragraphs 65A to 65D). If the description and/or the claims, or any part thereof (for any sequence listing part of the description, see paragraph 56A), are not in ~~such~~ a prescribed language, the receiving Office must, subject to any required national security clearance and payment of any required fee, transmit the international application to the International Bureau as receiving Office (paragraphs 41 and 274 to 282).

56A-57. [No change]

58. Under Rule 12.1(a), receiving Offices may accept for the filing of international applications languages which are not accepted by the competent International Searching Authority(ies) for the purposes of international search. Where the applicant files an international application in a language not accepted by the competent International Searching Authority chosen in respect of that application, the applicant is required to furnish a translation for the purposes of international search as outlined in paragraph 69. The provisions relating to the language of the international application operate in such a way that either the international application in its original language or any required translation is usually sufficient for each stage of the procedure during Chapter I of the international phase (for the processing of the international application by the receiving Office, for the carrying out of the international search and establishment of the written opinion by the International Searching Authority and for the international publication) (Rules 12.1(b), 12.3(a), ~~and~~ 12.4(a) and 26.3ter(e)); ~~where the international application must be translated, only one translation is required for all the above-mentioned stages.~~

59-65. [No change]

Language of Description and Claims

65A. **Requirements.** The receiving Office checks whether the description and claims are filed in a single language that is accepted by the receiving Office.

65B. The receiving Office may determine that the description and claims comply with the requirement to be in a single language accepted by the Office if the use of multiple languages assists in the comprehension of the disclosure. For example, translation of the description and claims into a single language may not be appropriate in the case of language-neutral terms, transliteration or translation of technical terms, or inventions relating to translation technology.

65C. If one of the languages used in the description and claims is not accepted by the receiving Office, Rule 19.4(a)(ii) applies (paragraphs 41 and 274 to 277).

65D. *Invitation to Furnish Translation of Description or Claims (or Part Thereof) and Late Furnishing Fee.* If the description and claims, or part thereof, are not filed in a single language but all the languages in the description and claims as filed are accepted by the receiving Office, the receiving Office invites the applicant to furnish a translation to provide the description and claims in a single language within one month from the date of receipt of the international application (Form PCT/RO/145) unless the receiving Office determines that such translation is not required (paragraph 65B). This invitation should preferably be sent together with Form PCT/RO/105. The translation must provide the description and claims in a single language which is:

- (i) one of the languages contained in the description or claims as filed;
- (ii) a language accepted by the International Searching Authority chosen by the applicant;
and
- (iii) the language in which the international application is to be published.

65E. If not all three criteria under Rule 26.3ter(e) can be satisfied, the receiving Office invites the applicant to furnish a translation of the international application under Rule 12.3 or 12.4 (see paragraphs 66 to 69A) (for example, the languages used, while accepted by the receiving Office, are not languages accepted by the chosen International Searching Authority or languages of publication).

65F. If the required translation is not furnished within the one-month time limit, the Office invites the applicant to furnish the translation and pay any applicable late furnishing fee (Rule 12.3(e)) within one month from the date of the invitation or two months from the date of receipt of the international application by the receiving Office, whichever expires later (Rule 12.3(c)).

Language(s) Accepted for the Purposes of International Search and International Publication

66-69A. [No change]

70. ***Checking of Translation.*** Where the receiving Office has received a translation under Rule 12.3, 12.4 or 26.3ter(e) ~~for the purposes of international search or international publication~~, it indelibly marks, in the upper right-hand corner of each sheet of that translation, the international application number (Section 308(b)) and, immediately below, the date of receipt. If the receiving Office notices, before the expiration of the applicable time limit (paragraphs 69 and 69A), what appears to be a significant inconsistency between the original text and the translation, for example, when comparing the number of pages, the number of claims, the titles, etc., it should draw the applicant's attention to that inconsistency and give the applicant an opportunity to make any necessary corrections within the applicable time limit (paragraphs 69 and 69A). Within the applicable time limit, the applicant is entitled to furnish a corrected version of the translation that should be stamped as provided for in Sections 305bis(e) and 308(b). In case where the receiving Office has already sent the initial version of the translation to the International Bureau, the receiving Office should draw the attention of the International Bureau to the fact that these sheets should replace the previously transmitted version of the translation. For compliance with the requirements for satisfactory reproduction and/or reasonably uniform publication, see paragraphs 132 to 138. The receiving Office is not required to check the translation of any sequence listing.

71. ***Failure to Furnish the Required Translation.*** Where the receiving Office has sent to the applicant an invitation under Rule 12.3(c), ~~or~~ 12.4(c) or 26.3ter(e) and the applicant has

not, within the applicable time limit under Rule 12.3(c)(ii) or 12.4(c), furnished the required translation, or the translation furnished does not comply with the above-mentioned requirements, or any required late furnishing fee has not been paid, the receiving Office declares (Form PCT/RO/117) the international application withdrawn, provided that any translation and any payment received before that declaration is made and before the expiration of 15 months (Rule 12.3(d)) or 17 months (Rule 12.4(d)), from the priority date are considered to have been received before the expiration of the applicable time limit (Rules 12.3(d) or 12.4(d)). A copy of that notification is sent to the International Bureau and to the International Searching Authority if the record copy and the search copy, respectively, have been transmitted.

CHAPTER VI ARTICLE 14 CHECK AND OTHER FORMAL REQUIREMENTS

72-131. [No change]

Compliance with the Physical Requirements Referred to in Rule 11

General

132-134. [No change]

135. Where the international application is filed in a language which is not a language of publication, in which case not the original text but a translation furnished by the applicant under Rule 12.3 or 12.4 will be published, the receiving Office checks that original text of 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 purposes of satisfactory reproduction (Rule 26.3(b)(i) and paragraph 134). The translation and the drawings in the language of publication are checked for compliance with the physical requirements referred to in Rule 11 to the extent that compliance is necessary for the purpose of reasonably uniform international publication (Rule 26.3(b)(ii)), including image scanning and OCR by the International Bureau. This also applies where the applicant has furnished a translation of the abstract or drawings containing the translation of text matter into the language in which the international application is to be published (Rule 26.3ter(a)) or furnished a translation of all or any part of the description or claims (Rule 26.3ter(e)).

136-165. [No change]

CHAPTER X REFERENCES TO DEPOSITED MICROORGANISMS OR OTHER BIOLOGICAL MATERIAL

228-233. [No change]

Requirements as to the Language of Sheets Containing References to Deposited Microorganisms or Other Biological Material

234. Sheets containing references to deposited microorganisms or other biological material must, if they are part of the description, be in the language of filing, or, where a translation of the international application is required under Rules 12.3(a) or 12.4(a), both in the language of filing and the language of the translation. If the receiving Office notices that such sheets are not furnished also in the language of the translation, it promptly invites the applicant

(Form [PCT/RO/145](#), PCT/RO/150 or Form PCT/RO/157) to furnish the translation of such sheets.

CHAPTER XIII RECORD COPY, SEARCH COPY AND HOME COPY

Preparation of Record Copy, Search Copy and Home Copy

General

283. Where the international application and documents referred to in the check list (Rule 3.3(a)(ii)) are required to be filed in more than one copy and the receiving Office has not received the number of copies required, the receiving Office prepares the required additional copies (Rules 11.1 and 21.1). Where a translation is furnished for the purposes of international search under Rule 12.3 [or a translation of a part \(or all\) of the description or claims under Rule 26.3ter\(e\)](#), the search copy consists of the request and the translation (Rule 23.1(b)). The procedure for preparation, identification and transmittal of the copies of the international application is outlined in detail in Sections 305 (for the international application as filed) and 305bis (for any required translation).

284. [No change]

Transmittal to the International Bureau of the Record Copy of the International Application and Other Items

285. **Items to Accompany the Record Copy.** Items which should accompany the record copy are listed in Section 313(a). Form PCT/RO/118 is used to transmit the record copy and items to accompany it (paragraph 22). A copy of any required power of attorney should always be transmitted. Where an international application has been received by facsimile transmission and a confirmation copy has been received subsequently, both the facsimile copy (which is the record copy) and the confirmation copy are transmitted to the International Bureau (Section 331). Where a translation of the international application is furnished under Rule 12.3 ~~or~~ 12.4 [or 26.3ter\(e\)](#), that translation is transmitted together with the record copy (that is, the international application in the original language) (Section 305bis). The transmittal of the record copy must also be effected if the international application is considered withdrawn by the receiving Office or has been withdrawn by the applicant, in which case the notice effecting withdrawal must also be transmitted (paragraphs 314 to 324).

286-287. [No change]

Transmittal to the International Searching Authority of the Search Copy and Other Items

General

288-289. [No change]

[289A. If a translation of the international application is furnished under Rule 26.3ter\(e\), that translation, together with the parts of the international application that have not been translated and a copy of the request, is considered to be the search copy under Article 12\(1\) \(Section 305bis\(a-bis\)\(iii\)\).](#)

290-295. [No change]

[End of Annex I and Circular]