

## **Section 51: Translations of documents forming part of a Treaty Application (PCT National Phase Entry)**

### **Introduction**

1. Regulation 65 requires that a **verified translation** of **any** document filed in a language other than English and forming part of a Treaty application must be filed within 5 months (3 months plus 2 months extension) of the commencement date of the national phase.

2. More particularly, separate **verified translations** of the following may be required to be filed within 5 months of the commencement date:

- the description, claims and drawings (if there are drawings) of the original Treaty application,
- Article 19 amendments (or the entire document published by WIPO incorporating the Article 19 amendments), and
- Article 34 amendments.

3. Any translations of this type, not just translations of the description, claims and drawings, should be labelled as a **CETOS** (Certified English Translation of Original Specification) document type in the IPONZ case management facility.

4. If any drawings are not indexed or notated in English then the drawings with translated indices or notations should be supplied as part of the verified translation (the lettering used in the drawings should be in the Latin or Greek alphabet and any non-English text should be translated into English). This requirement applies to other specialized parts of documents, sequence listings for example, that are not indexed or notated in English.

5. If a **verified translation** is not filed within the time allowed under Regulation 65, then the applicant may have failed to fulfil their obligations under Article 22(1) or Article 39(1), as the case may be, within the prescribed time limit, and consequently the application may be treated as void under Section 51(1)(d) or (e) of the Act.

### **Regulations and definitions**

6. In accordance with regulation 3 of the Patents Regulations 2014 or common usage:

- **Translation** means an English language document that is ostensibly a translation of a document in a language other than English (foreign language document).
- A **verified translation** means a translation to which a certificate of verification is attached.
- A **certificate of verification** means a signed and dated statement that the translation is, to the best of the knowledge of the person who signs the statement, a true and complete translation of the foreign language document. The statement should clearly identify the accompanying document to which it relates. Example: translation of PCT/JP2017/0345768.

- The **‘accompanying document’** means any foreign language document forming part of a treaty application for which a verified translation may be required. These documents include the original description, claims and drawings of the application, and amendments made under Article 19 or Article 34 of the Patent Cooperation Treaty. In the case of a Treaty application any accompanying document for which a verified translation may legitimately be provided is ostensibly filed at IPONZ when the International application designating New Zealand is made, or in the case of amendments proposed during the international phase under Articles 19 or 34, when those amendments are filed.
- The **‘commencement date’** means the date of entry of national phase, that is the date the application is submitted into national phase.

7. Although a **verified translation** is sometimes referred to as a certified translation, a verified translation is ‘verified’ by the translator as being a true and complete translation whereas a certified translation indicates not only that the translation is verified by the translator but also that the translator is ‘certified’ by some official organisation. IPONZ will generally only require verified translations.

#### **Filing translations into the IPONZ online case management facility**

8. A verified translation should be filed on the patent application file via the IPONZ case management facility as either:

- a single electronic document including the translation and the certificate of verification
- a bundle of documents filed substantially at the same time and including the certificate of verification and the document or documents (e.g. separate electronic files for the translations of the description, claims and drawings respectively) purporting to be the translation(s) to which the certificate statement relates.

9. On the occasion of entering a Treaty application into the national phase, if the IPONZ case management facility detects (from a language tag held in PatentScope) that the International application was made in a language other than English, then the option to file a CETOS (Certified English Translation) is made available. If the CETOS is not filed immediately, the case contact is provided a task with a 5 month deadline to do so.

10. Filing an English language complete specification when a Treaty application is entered into the national phase does not circumvent the requirement to file a verified translation. The complete specification document should be filed as the type ‘Complete specifications’ and although it may be derived from a verified translation document, by removal of the verification certificate for example, two distinct documents should be filed: the English language complete specification and the verified translation. In the rare case in which the English language complete specification is a copy of a verified translation that is not a translation of the accompanying document (the wrong translation has been filed), not only must the correct verified translation be filed, but the correct original ‘accompanying’ document should also be identified and filed.

11. If the 'file CETOS' task is not completed by the deadline set then the application will be marked off as void. Therefore, if the applicant wishes to progress the application it is important to utilize the task to file the verified translation(s) by the set deadline.

12. It is possible that a failure to set a 'file CETOS' task or to respond to such a task may in some circumstances indicate that the "essential English documents" that are required for substantive examination of the application have not been filed. It is important that the applicant ensures that these essential English documents (translations) are filed at the time the application is entered into the national phase, and have been properly verified within 5 months of the entry into national phase.

13. Any cases marked void in this way are restorable, because ostensibly the applicant has failed to fulfil the applicant's obligations under Article 22(1) or 39(1)(a) of the PCT (to file a verified translation within the allowed time).

### How IPONZ examines verified translations

14. The translation as filed in the IPONZ case management facility may not be verified to the satisfaction of the Commissioner for one or more of the following reasons:

- The certificate may be properly completed, but the translation does not explicitly identify the accompanying document, for example by including the PCT application number, or the examiner is unable to ascertain, by inspecting the documents or otherwise, that the translation is indeed a translation of the accompanying document.
- The translation is not a translation of the accompanying document (i.e. the wrong document has been filed). This sometimes happens, for example, when translations of co-pending applications with similar subject matter get mixed up.
- The certificate of verification is not filed with the translation on the patent file in the IPONZ case management facility as noted in paragraph 8 above.
- The certificate is not properly completed so as to include the translator's signed and dated statement of truth and completeness and/or the identity of the accompanying document.

15. If, when a case is taken up for examination, the examiner determines that a translation already filed **has not been satisfactorily verified**, an objection will be entered in the first examination report. The applicant should file a properly verified translation and request an extension of time under regulation 147 in which to do so in their response to the objection. Alternatively the applicant may request the Commissioner waive the requirement to file these translations (under regulation 149).

16. An Examiner will only commence examination of the application and complete specification once the necessary documents to do so are available in English (the complete specification, sequence listing, deposit certificate, and amendments to complete specification). The substantive examination will commence on the basis of those English language documents, notwithstanding that a translation or properly verified translation has not yet been filed. However, the examiner will raise an objection in the first examination report requiring a translation or properly verified translation to be provided.

## **Correcting administrative and filing errors:**

17. If the applicant files verified translations in time but fails to use the 'file CETOS' task resulting in the application being marked void, the voiding of the application will be corrected by IPONZ under section 201. The applicant can request this correction if necessary using 'maintain patent' in the IPONZ case management facility. If the application is taken up for examination before the application is marked void, IPONZ will cancel the 'file CETOS' task and proceed with the examination.

18. Sometimes, a 'file CETOS' task is not set, for example when an application is filed as a standard application in lieu of being able to enter the national phase before publication of the international application (very early entry). If the applicant does not file a verified translation in time, then when the application is taken up for examination the first examination report will advise that the translations have not been filed. The applicant should file the verified translations and request an extension of time under regulation 147 in response to the objection.

## **Regulation 65: Filing verified English translations of Treaty applications**

This guideline outlines IPONZ's practice regarding the filing of translations of Treaty applications under regulation 65.

### **Regulation 65**

#### **65 English translation of documents as required**

(1) If any document or documents forming part of a Treaty application have been filed in a language other than English, the applicant must, within 3 months after the commencement date of the national phase, file a verified translation of that document or those documents.

(2) However, the Commissioner may, on any terms that the Commissioner thinks fit, extend that time for a period of up to 2 months.

(3) The Commissioner may grant an extension under subclause (2) even if the time for the filing of the verified translation has expired under subclause (1).

### **Introduction**

1. Regulation 65 sets out the requirements for filing **verified translations** for national phase entries.

2. **Verified translations** are required for **any** document that forms part of a Treaty application that was never in English at the international stage. This includes:

- the description, claims and any sequence listings or drawings of the original Treaty application
- any Article 19 amendments
- any Article 34 amendments
- any documents rectified under rule 91.

Article 19 of the Patent Cooperation Treaty – WIPO

Article 34 of the Patent Cooperation Treaty – WIPO

Rule 91 of Regulations under the Patent Cooperation Treaty – WIPO

3. A verified translation of the original Treaty application is still required even if Article 19 or Article 34 amendments have been made.

4. Regulation 65 provides a period of five months (three months plus a two-month extension) for providing **verified translations** of national phase entries.

5. If verified translations aren't filed within the time allowed under regulation 65, then the applicant hasn't met their obligations under Article 22(1) or Article 39(1) within the prescribed time limit. Consequently, the application must be treated as void under section 51(1)(d) or (e) of the Patents Act 2013.

Article 22 of the Patent Cooperation Treaty – WIPO

Article 39 of the Patent Cooperation Treaty – WIPO

Section 51 of the Patents Act 2013 – New Zealand Legislation

### Regulations and definitions

6. In accordance with regulation 3 of the Patents Regulations 2014 or common usage:

- **Translation** means an English language document that is a translation of a document from a language other than English. The mode of translation doesn't matter—it may be produced by a machine or person. Either is allowable provided the translation is verified.
- A **verified translation** means a translation to which a certificate of verification is attached.
- A **certificate of verification** means a signed and dated statement that the translation is, to the best of the knowledge of the person who signs the statement, a true and complete translation of the accompanying document. The statement should be in English.
- A **certified translation** is a verified translation that also indicates the certification of the translator by an official organisation.
- The **accompanying document** means any non-English language document forming part of a Treaty application for which a verified translation is required. These documents include the original description, claims and any drawings or sequence listings as well as any Article 19 amendments, Article 34 amendments and/or documents rectified under rule 91.
- **National phase entry** means a national phase application of a Treaty application.

- **National phase entry date** is the date when a Treaty application becomes a national phase entry.
- A **VETOS task** is a task in the case management facility with the name **File Verified English Translation**. It's for filing a verified translation of a corresponding Treaty application via the case management facility.

Regulation 3 of the Patents Regulations 2014 – New Zealand Legislation

### Documents required for the filing process

7. A **verified translation** should be filed on the patent application file. This is done in the case management facility by filing:

- a single electronic document including the **translation(s)** and the **certificate of verification** or
- multiple electronic documents at the same time, including the certificate of verification and the document(s) to which the certificate statement relates. For example, separate electronic files for the certificate of verification and the complete specification. This option is acceptable provided it is clear what documents the certificate relates to.

8. IPONZ only requires verified translations, but **certified translations** are also acceptable. This is because certified translations also meet the requirement of verified translations.

9. When providing verified translations, any non-English text should be translated into English. This requirement applies to drawings and sequence listings that include lettering and other notations.

10. Applicants filing a verified translation of a priority document should use the document type **Verified English translation of the priority document**.

### No verified translation at the national phase entry date

11. If a verified translation isn't available at the **national phase entry date**, a foreign language or a non-verified English complete specification should be filed as the document type **Complete Specification**.

12. The case management facility will detect that the **national phase entry** was a Treaty application not filed in English. It will provide the option to file a verified translation later. The case contact will be sent a **VETOS task** with a **five-month** deadline.

13. The verified translation should be filed by responding to the VETOS task. It should be filed as the document type **VETOS (Verified English Translation of Original Specification)**.

14. If the VETOS task isn't responded to by the deadline, then the application will be void under section 51(1). It's important to use the task to file the verified translation(s) to prevent the application going void.

### Incorrect responses to the VETOS task

15. If the applicant files **verified translations** in time but fails to use the **VETOS task** this will cause the application to go void. However, this can be corrected under section 202.

#### Section 202 of the Patents Act 2013 – New Zealand Legislation

16. The case management facility doesn't allow requests for correction on void applications. Therefore, an ad-hoc request for the correction under section 202 should be made via email to mail@iponz.govt.nz. Once the correction is validated, the application will be reinstated and will proceed in the normal manner.

17. In the above situation, the applicant shouldn't request restoration of the void application under section 125. This is because the application isn't void under section 51(1)(d) or (e).

#### Section 125 of the Patents Act 2013 – New Zealand Legislation

18. Sometimes, a VETOS task isn't created. This can occur when a Treaty application becomes a national phase application before the Treaty application is published (early entry PCT). When the VETOS task isn't automatically created, the applicant may file the verified translations within the time limit of regulation 65 by voluntary amendment.

### Deficiencies in verified translations

19. A **translation** filed in the case management facility may not meet the requirements of regulation 65 for one or more of the following reasons:

- The certificate of verification doesn't identify the **accompanying document**.
- The translation filed isn't a translation of the document identified in the certificate—ie the **wrong document has been filed**. This can happen when translations of co-pending applications with similar subject matter get mixed up.
- The **certificate of verification** isn't filed with the translation in the case management facility.
- The certificate of verification isn't in English.
- The certificate of verification isn't correctly completed. For example, if the certificate isn't signed, is not dated, or does not include a statement of truth and completeness.
- The translation doesn't include the Article 19 or Article 34 amendments.
- The only specification on file isn't in English.

### IPONZ approach to deficiencies in verified translations

20. If a Treaty application wasn't filed in English, the examiner will determine if the application meets the requirements of regulation 65. This will be done at first exam. If the examiner finds that the requirements aren't met, they will give the applicant one of two options to resolve the deficiency.

21. The option selected will depend on the deficiency. The examiner's primary consideration will be whether they can start the examination despite the deficiency. They will also consider how likely it is that the translation on file is the verified translation given the deficiency.

22. If the examiner determines that examination can start an extension of time to meet the regulation 65 requirements will be given. An objection under section 51 will be raised in the first examination report. The objection will outline the documents required. The applicant must respond to the objection by the section 67 deadline.

#### Section 67 of the Patents Act 2013 – New Zealand Legislation

23. Examples of deficiencies where examination can start include:

- There's no certificate of verification on file, but the examiner can see there is one available on an equivalent overseas application.
- The certificate of verification has a deficiency. For example, it doesn't identify the accompanying document.
- There's no translation of the Article 19 or 34 claims, but the claims have been further amended in the national phase.
- There's no certificate of verification on file for an early entry into national phase. This is due to the case management facility not creating a VETOS task due to the conversion process.
- The certificate of verification is not in English.

24. If the examiner determines that examination can't start, the applicant will be contacted via the case management facility. This will be via open discussion. The applicant will be given an extension of time to meet the requirements of regulation 65. The discussion will ask the applicant to provide the missing documents or explain why the requirements haven't been met.

25. Examples of deficiencies where examination can't start include:

- There's no translation of the Article 19 or 34 claims and these are the claims required for the examination.
- There's no certificate of verification on file and the examiner can't find one at an overseas office.
- The wrong translation is on file due to translations of related applications being mixed up.

26. The applicant will have two months to respond to the discussion. The applicant should upload the required documents to the discussion. If no response is provided the application will be deemed void.

#### No English specification on file

27. The exception to the approach outlined above is if there is no English specification on file at first exam. In this situation the application will be made void. If the applicant wants to progress the application, they must apply for restoration.

### **Statutory basis for extensions of time**

28. The extensions mentioned and exemplified in paragraphs 22-26 are provided under section 230.

#### Section 230 of the Patents Act 2013 – New Zealand Legislation

29. Section 230 gives the Commissioner discretion to grant extensions of time where there has been a delay by the Commissioner. This generally relates to delays where IPONZ has failed to act in a timely manner and which affects the position of the applicant.

30. IPONZ does not conduct a formalities review until examination. Therefore, deficiencies in verified translations are normally only identified after the time provided under regulation 65 has expired. As a result, it's considered that there is a delay in identifying the deficiencies and this delay affects the position of the applicant.

31. As such the Commissioner will generally exercise discretion for said deficiencies.

32. Exercising discretion as above is not intended, and should not be construed as an admission, either express or implied, of a general delay by the Commissioner in examination or other matters.

### **Examples**

#### **Example 1:**

At first exam a translated complete specification of the Treaty application is on file. However, there is no **certificate of verification** on file with the specification. The examiner notices that there is a certificate of verification on an equivalent overseas application.

The examiner determines that examination can start. They have a translated specification they can examine. Based on the certificate of verification on the overseas application it's highly likely that the translation is the true and complete translation.

The examiner raises an objection in the first examination report. The objection requires the applicant to file a copy of the translated complete specification with the certificate of verification attached. The applicant has until the section 67 deadline to do this.

#### **Example 2:**

An examiner is allocated a Treaty application that wasn't originally filed in English. The examiner finds that the claims were amended under Article 34, but there is no **verified translation** of them on file. As the Article 34 amended claims supersede the original claims the examiner needs a translation of them to start examining the application.

The examiner sends an open discussion to the applicant. The discussion requests a verified translation of the Article 34 amended claims. The applicant is given a deadline of two months to provide these documents.

If the applicant doesn't respond to this discussion with the required documents the application will be marked off as void. This is because the requirements of section 51(1) haven't been met.

SUPERSEDED