

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~~ may be required for **any** document that forms part of a Treaty application that was ~~never~~ not in English at the international stage. This includes:

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

[Article 19 of the Patent Cooperation Treaty](#) – ~~WIPO~~ World Intellectual Property Organization

[Article 34 of the Patent Cooperation Treaty](#) – ~~WIPO~~ World Intellectual Property Organization

[Rule 91 of Regulations under the Patent Cooperation Treaty](#) – ~~WIPO~~ World Intellectual Property Organization

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

~~43.~~ Regulation 65 provides a period of five months (three months plus a two-month extension) for providing **verified translations** of national phase entries.

~~54.~~ 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 World Intellectual Property Organization](#)

[Article 39 of the Patent Cooperation Treaty](#) – [WIPO World Intellectual Property Organization](#)

[Section 51 of the Patents Act 2013](#) – New Zealand Legislation

Regulations and definitions

65. 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

76. 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.

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

98. 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.

9. A **verified translation** of all foreign language documents that form part of the Treaty application should be provided. For example, verified translations of both the application as filed (or published) and the Article 19 or Article 34 amendments should be provided where they are both in a foreign language.

10. Where a Treaty application includes an English translation for the purpose of international publication (i.e. provided under Rule 12.4), IPONZ will not generally require a verified translation of the foreign language treaty application as originally filed.

Rule 12 of Regulations under the Patent Cooperation Treaty – World Intellectual Property Organization

1011. 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

1112. 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**.

1213. 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.

1314. 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)**.

1415. 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

1516. 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

1617. 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.

1718. 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

1819. 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

1920. 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

2021. If a Treaty application wasn't filed (**or published**) 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.

2122. 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.

2223. 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~~ regulation 65 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

2324. 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.

2425. 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.

2526. 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.

2627. 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

2728. 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

~~2829~~. The extensions mentioned and exemplified in paragraphs 22-26 are provided under section 230.

[Section 230 of the Patents Act 2013](#) – New Zealand Legislation

~~2930~~. 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.

~~3031~~. 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.

~~3132~~. As such the Commissioner will generally exercise discretion for said deficiencies.

~~3233~~. 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 (or published) 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