Translation policies in patent practice

By Martin Cross

At some point, most patent practitioners rely on translations, and while many are aware that using an inaccurate translation can put them at risk, few are able to quantify these dangers, much less develop strategies to mitigate the risks. Because translation can be a major drain on budgets, any effective risk management policy must also limit costs.

The situation is further complicated by the fact that different risk profiles are associated with translations of prior art in the context of domestic filing, translations of overseas applications and translations that will be used in litigation.

Risk arises from the reality that there is no such thing as a perfect translation. A word or a phrase in one language rarely corresponds exactly to a single word or phrase in another language.

Consider, for example, how the English word "you" can be expressed in French as either the familiar "tu" or the more formal "vous." It follows that no French translation of an English sentence including the word "you" will correspond exactly to the original. A choice will have to be made, and whether that is "tu" or "vous," the resulting French sentence will be narrower than the English original.

Because there is no single right way of dealing with such problems, translation is an interpretive art. As such, all translations necessarily carry the risk of loss or distortion of the original message.

Fortunately, patents describe cold, hard technology and are written in highly explicit language, which means that they suffer less from translation loss than highly cultural texts such as poems or advertising copy.

Nonetheless, patents are challenging for most translators. To produce an accurate translation, the translator must understand the technology that is being described. When we consider the different possible meanings for terms such as beam, factor or impregnate, it will be clear that, even at the level of individual words, understanding is a prerequisite for appropriate translation.

Complex sentence structures, particularly in the claims, and the need maintain the breadth, narrowness or ambiguity of the original language also contribute to the particular challenge posed by patents.

For these reasons, patents tend to be translated by expert translators who understand both the technical field and at least the basics of patent practice. But even the most skilled experts are still human and, as such, are liable to make inadvertent errors of omission and misunderstanding. To minimize these human errors, a reliable translation will always have been reviewed by a second translator, who will likewise need to be highly skilled.

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These exceptional demands make patent translations expensive. Even short patents typically cost several hundred dollars to translate, and it is not uncommon to see invoices for tens of thousands of dollars for bulky biotechnology specifications.

These inherently high costs for top-tier translations mean that minimizing risk by buying "the best" will not always be a viable strategy. Meanwhile, cutting costs at the expense of reliability can have disastrous consequences in certain situations. To get the balance right, practitioners must be able to identify the risks associated with the circumstances under which the translation will be used and choose solutions that match that risk profile.

DOMESTIC FILING

Even practitioners who are not engaged in international practice find themselves relying on translations when foreign documents turn up in prior-art searches. The first translation risk, in this context, is that of the practitioner being misled as to the actual content of the disclosure.

For example, a practitioner who blindly accepts an examiner's finding, based only on a machine translation, may be missing an opportunity to traverse based on a more accurate human translation.

Another less obvious but potentially more serious risk is that of a poor translation causing the practitioners to believe that a particular foreign publication poses no threat to their patent, when in reality it anticipates or renders obvious their claims. In this case, even though a practitioner who supplies such a faulty translation in an information disclosure statement may not encounter difficulties during prosecution, a risk will remain of a better translation being produced during subsequent litigation.

It should also be noted that patents can be found unenforceable for inequitable conduct during prosecution in cases where the applicant or the prosecuting attorney can read a foreign-language document but does not provide the examiner with an adequate translation of that document.[1]

For prior art, the probability of transition loss leading to serious consequences increases with the relevance of the foreign document to the application being prosecuted. If your application is directed to a method of measuring window size in a house, and a machine translation or a conversation with a bilingual colleague reveals that the cited publication is directed to estimating the size of a window of opportunity in a business method, you probably have all the information that you need.

In this case, there is no point in paying for a top-notch translation. Conversely, if the only thing that differentiates your patent from the prior art is that your method works for rectangular windows, while the foreign patent is limited to square widows, you will want to be very sure of your translation.

It can be useful to take an incremental approach to assessing relevance, and hence risk. The first step is to check databases for English-language equivalents that have been filed as part of international prosecution. If no equivalents exist, machine translation can be a fast way to grasp the gist, or at least the subject matter, of the technical idea disclosed.

Practitioners in larger firms may be able to find a bilingual secretary, and sometimes even an attorney, who speaks the language in question. Keep in mind, however, that just as not all inventors are good at drafting disclosures, not all bilingual people are good at translating. Rather than asking them to translate the entire document, it may be better for them to read it over and let you know if it mentions the matters that you are interested in.

If none of these options are available, overseas discount translation providers, which have proliferated on the Internet in recent years, can sometimes provide a rough idea of the content at a fraction of the price of an expert translation. Some domestic translation agencies also offer lower prices for first-draft translations, which have not been reviewed by a second translator.

The result of such preliminary translations may be that certain sentences or paragraphs appear to have particular relevance, while the rest of the document does not. In this case, it makes sense to obtain an expert translation of only the relevant sections. If this partial translation shows that the relevance is in fact very high, it may be a good idea to get an expert translation of the entire document.

When procuring the final translation of an important document, it may be possible to transfer some of the risk by making sure that the translation provider has adequate professional insurance. Requesting a statement of certification/verification may also help to focus the attention of the translator, but keep in mind that such statements only attest to the good-faith belief of the translator and are not a guarantee of quality.

OVERSEAS FILING

Risks associated with translations for overseas filing must be assessed differently. There is clearly no case in which a poor translation will stand up in prosecution, much less enforcement, but there are some situations in which translation loss has greater potential to cause problems than others.

In Japan translations can be corrected during national phase prosecution,[2] and some corrections to the translation can be made even after the patent has issued.[3] China allows for correction of PCT applications but within narrower time limits,[4] and South Korea allows no correction of the translation after the expiration of the time limit applicable under PCT Article 22 or 39(1).[5]

When making decisions about important translations, it is essential to know what remedies will be available if a problem arises.

As with translations of prior art, risk is best mitigated by ensuring that the translation is prepared and reviewed by experts. Most foreign law offices provide translations, but it is important to realize that while, in some firms, these are prepared in-house by the attorneys themselves, others offices farm translations out to the lowest bidder and file them with little or no review.

In addition to foreign law firms, both domestic and foreign translation agencies can be used, and similar variations in quality assurance can be expected. Prices for translations vary greatly, meaning that clients with large portfolios or particularly long specifications are well served by shopping around, but it is important to ask for a description of the translation process and the people involved in it. A good translation and review process will never be so complicated that it cannot be described in a few sentences.

For maximum risk mitigation, you may want to consider having some translations reviewed by a third party, either as an occasional quality spot check or when filing a patent that is particularly likely to see litigation. Many translation agencies provide this service.

LITIGATION

The management of risk in the context of patent litigation is particularly challenging. If the case has an international component, there may be thousands of pages of foreign documents that must be translated in a matter of weeks.

Although time and cost constraints may make it impossible to procure polished, carefully reviewed translations of each and every document in the stack, litigation is the arena in which inaccurate translations are most likely to be exposed and to result in serious damage.

Clearly, it is unsafe to assume that a translation prepared on a rush basis by the lowest bidder will be free of errors. Simple omission, which is the most common type of translation error, can have a profound impact on arguments concerning disclosure, and more subtle mistakes, caused by insufficient understanding of the source text, can easily derail technical arguments when they are exposed.

A rational approach is to incrementally adjust the time and money spent on the translation of each document to the importance of the same. Triage, in which a translator helps the attorney to sort through the initial stack, reduces costs by eliminating documents that are not pertinent.

Draft-quality translations are then ordered for documents that appear to be relevant. Subsequently, those documents that have been identified as being of importance based on the initial translation are carefully reviewed and revised by at least one additional translator.

Once a document has been identified as being important, the translation review should be performed before any further work is done. Basing new work on the translation before it has been verified can waste time, as any changes that are made to the wording of the translation will have to considered by anyone who has relied on the translation and carried forward into any reports that have been drafted.

It is of particular note that, while the risks associated with prosecution described above have been tied to inadvertent mistakes, in the context of litigation it is also possible for two different opinions to emerge as to the correct translation of a particular sentence or a term.

If such a situation arises and the translation is contested, special strategies will be required. Here again, early implementation is important. For this reason, when important translations are first reviewed by a second translator, attorneys may wish to ask the

reviewing translator whether key sentences, phrases or terms are open to more than one interpretation. This is a the sort of question that an experienced translator can answer over the telephone.

Ambiguity is the exception, but it is well worth ruling it out. If the possibility of disagreement exists, and the document is of real importance, it may be advisable to procure a new translation, which is handled in the manner of an expert report.

This is not to say that an expert report has to be commissioned for every important translation that could be disputed, but rather that the same considerations as would come into play in commissioning an expert report should be applied in commissioning the translation. In this way, if the translation is actually contested and expert testimony becomes necessary, you will be prepared.

In practice, this means determining whether the translator will be available to serve as an expert witness if that should become necessary, reviewing the translator's qualifications and being careful to avoid communications that could be seen as prejudicing the translation. It should also be noted that even experts are human, and therefore the individual translator you choose for a critical translation should be supported by at least one other translator who will comb the translation for inadvertent errors or omissions.

This review procedure is universally seen as best practice in the translation industry, and it is particularly important in litigation situations, as an error at any point in a long translation will detract from the translator's authority as an expert witness.

While it is true that this extra work can be avoided by simply submitting the translation you already have and looking for a new translator to serve as an expert only if problems arise, there is a clear disadvantage to such an approach. Specifically, without prejudicing the newly commissioned expert, it may not be possible to find someone who agrees with the wording that you have relied on. And even if the new translation is substantially the same, it is unlikely that it will be word-for-word identical to the translation you first submitted. Not only is more difficult to defend two translations that it is to defend one, but any differences between the translations can be used by the other side as a way of casting doubt on both.

CONCLUSION

As we have seen, the risks associated with translations are dependent on the relevance of the document being translated to your case and the extent to which it will be possible to correct the translation at a later time. If a poor translation is used when reviewing prior art in prosecution, the opportunity to draft suitably distinct claims may long have passed by the time an accurate translation comes to light. For overseas filing, the ability to correct depends on the individual country.

While in litigation, the risks of working from unreliable documents are clear, and any changes made to a translation that has already been submitted can be damaging. Understanding the risk profile for each situation will help you to avoid such problems and allow cost-cutting measures to be implemented with a clear conscience. WJ

NOTES

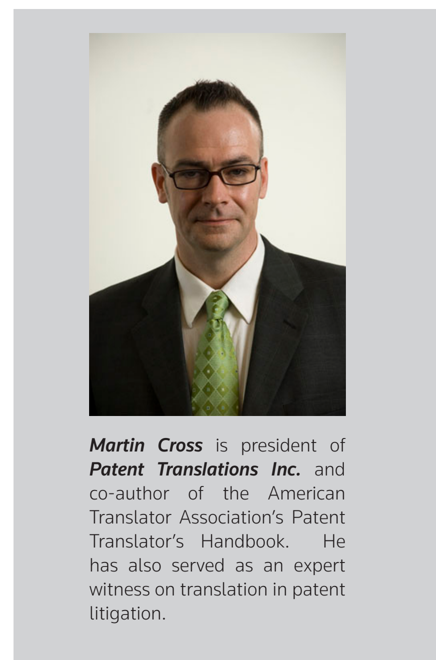
[1] See Donald Chisum & Stacey Farmer, *'Lost in Translation': The Legal Impact of Patent Translation Errors on Claim Scope,* Grund Intellectual Property Group (October 2006), *available at* http://www.grundipg.com/files/Excerpt__Lost_in_Translation__2006_.pdf; Dale L. Carlson & Zhun Lu, *To Translate or Not to Translate: 'Who?' Is the Question*, Presented in Manhattan May 2, 2002, at the 18th Annual Joint Patent Practice Program sponsored by the NJIPLA, CTIPLA, NYIPLA & Philadelphia IPLA, *available at* http://www.wiggin.com/db30/cgi-bin/pubs/Carlson5-2-02.pdf; *Gambro Lundia AB v. Baxter Healthcare Corp.,* 110 F.3d 1573, 42 USPQ2d 1378 (Fed. Cir. 1997); *Semiconductor Energy Lab. Co. v. Samsung Elecs. Co.,* 204 F.3d 1368, 54 USPQ2d 1001 (Fed. Cir. 2000).

[2] Corrections can be made up to the time limit for response to the first office action. See Article 17-2 of the Japanese Patent Law and WIPO PCT Applicant's Guide, National Phase, National Chapter, JP, JP.10

[3] See Article 126 of the Japanese Patent Law – Trial for Correction.

[4] Corrections can be made before preparations for national publication are complete or within three months of the start of the substantive examination phase. See Rules for the Implementation of the Patent Law of the People's Republic of China, Article 110, and WIPO PCT Applicant's Guide, National Phase, National Chapter, CN, CN.02

[5] *See* Korean Patent Act 201(3)(4) and WIPO PCT Applicant's Guide, National Phase, National Chapter, KR, KR.02.



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