

# Types of Patent Translation

By Martin Cross

*A patent translation must be literal!*

*When it comes to patents, literal translations will not do!*

*Never use the expression, 'characterized in that.'*

*Always use 'characterized in that.'*

*The attorney relies on you to explain anything that is not clear with notes and comments.*

*The translation must be free of all notes and comments.*

*The main thing is that it be easy to read.*

*Readability is neither here nor there.*

These contradictory recommendations can be found in books, on websites, chat boards and e-mail lists, as well as in the form of instructions from both direct clients and project managers. The trouble with the above statements is that they are all correct. Of course, that is not a problem as long as your client tells you which set of rules to follow. The real head scratching starts with that call from the new project manager that goes, "You know how to translate patents, right?" Or the paralegal who says, "The attorney just needs a standard translation." These situations may seem to call for a coin toss as to which set of contradictory instructions to go with, but there is a more reliable way of making that choice.

The rules that govern how a patent should be translated are themselves determined by how the translation will be used. While this article is too short to cover all of the rules, we can designate some basic boundaries between the different sets of rules. This should make it easier to apply the right type of advice to the right job.

Of course, one way to find out how the translation will be used is to ask, but the person placing the order for the translation may not always be able to answer, so it helps to have some rules of thumb.

## What will the translation be used for?

At the broadest level, a translation can be used to find out what a patent says (translation for information); the translation can also be filed with a national patent office in order to receive new patent rights in a partic-

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ular country (translation for filing).

Because translations for filing require particular skill and have so much money riding on them, people placing this kind of translation order are usually higher up in the chain of command and generally know why they need a translation. Furthermore, if they place the order through an agency, they will generally make sure that the project manager knows the purpose of the translation. That brings us to our first rule of thumb: *If the person placing the order does not know exactly what the translation will be used for, it probably will not be used for filing.*

It also happens that the law defines narrow windows of time within which a translation of a patent can be filed in another country in order to receive patent rights. Government patent offices also publish patents according to specific

timeframes. Without going into exact date calculations, let me offer another handy rule: *If the patent that you are given to translate is published by any patent office other than the World Intellectual Property Organization (WIPO), the translation will not be used for filing. What is more: If it was published by the WIPO and more than 32 months have passed since the priority date, the translation will not be used for filing. If you are not sure whether the patent on your desk has been published, look on the front page for a publication date. If you find one, the patent has been published. That same front page will also tell you if it was published by the WIPO and what the priority date is.*

The really good news is that, for most translators, the rules of thumb mentioned above are all they will ever need, because most translators will never be asked to translate a patent for filing.

## Translation for Information

If the translation will not be used for filing, then it is a translation for information. There are three subclasses to this kind of translation: translations for legal evidence, translations for legal information, and translations for technical information.

Translating for legal evidence is similar to the work of a court interpreter: you are required to reproduce the original without embellishment or omission and your opinions must be kept to yourself. People often refer to this as a literal translation or a mirror translation. In reality, such a translation would be no easier to read than a machine translation, so some degree of linguistic adjustment will be necessary in order to convey the original meaning. The key rules are to conserve sentence and paragraph breaks and to make sure that each

lexeme (noun, verb, adjective, or adverb) found in the source text is reproduced in the target text. Likewise, if constraints of grammar make it necessary to add lexemes, these may be enclosed in square brackets, so as to indicate that they were not found in the original.

Translations for legal information are the same as translations for evidence, but you are allowed to provide extra information, such as footnotes concerning cultural issues, indications showing mistakes in the original (usually by inserting “[sic]” after the mistake), or comments. As with translations for evidence, however, you must not correct, embellish, or simplify, because the reader wants to know exactly what was written in the source document.

Translations for technical information are no different from ordinary technical translations, with the emphasis being on clarity of expression.

The issue at hand is which category the text falls under. The rule of thumb for determining which set of rules to apply when translating is: *Unless specifically told otherwise, assume that the translation will be used for legal information.* The reason for this is that you will usually be notified if the client intends to use your translation as evidence, because in such cases you will usually be asked to certify the translation. (Even if you are asked to certify the translation, the client may prefer to have your footnotes and comments, so it is best to ask.) Another reason for translating on the assumption that your work will be used for legal information is that, while a translation for legal information will satisfy a researcher, a translation for technical information may not satisfy a lawyer. Keep in mind that even if the person who requested the translation works in the research department, they will probably pass your translation on to

the legal department if they end up basing decisions on it.

### Translation for Filing

Some indications that the translation might be used for filing include the following: the document is sent to you as electronic text; the document is sent to you by fax or as an image file, but it is not in a recognizable patent office publication layout; the document is a WIPO publication with a priority date that is less than 32 months earlier than the due date for your translation; or you are explicitly reminded that this particular document is highly confidential.

There are two basic ways that a translated patent can be filed in another country: under the Paris Convention, or under the Patent Cooperation Treaty (PCT). Under the Paris Convention, a satisfactory translation is one that describes the same invention as was documented in the original. There is no special need to stick to the original wording, and in many cases using the original wording will not do. Under the PCT, the translation must be an exact translation of the International Application, which is published by the WIPO. There is also an unusual third option, in which a patent can be filed with the U.S. Patent and Trademark Office in a foreign language and a translation can be provided afterward, in accordance with Patent Rule § 37 CFR 1.52. You should seek the client’s guidance for this special case, but you will be asked to handle the translation as if it were a translation for evidence or a translation for PCT filing.

If you suspect that the translation you have been assigned will be used for filing, the rule of thumb is: *Always ask the client and, if they say that the translation will be filed, insist on being told whether it will be filed under the PCT or the Paris*

*Convention.* Remember, if you cannot confirm how the translation will be used, it is safest to treat it as a translation for legal information.

### Filing Under the PCT

If the translation is to be filed under the PCT, it is a good idea to ask if the client has any specific requirements in terms of how they would like things translated. For example, the client may prefer that you do not use the term “said” in the claims, but the word “the.” The two words mean exactly the same thing from a legal standpoint, so the choice between the two is a matter of style. Keep in mind that there are many other points of style regarding which the attorney may have a preference.

With the exception of matters of style, you should be guided in your translation by the *United States Manual of Patent Examining Procedure (MPEP)*, which states in MPEP § 1893.01(d) that, “Amendments, even those considered to be minor or to not include new matter, may not be incorporated into the translation.” In other words, the task of a PCT translator is similar to that of a person producing a translation for legal evidence or legal information. That is to say, the original must be translated without corrections, embellishments, or omissions. Notably, it is generally not acceptable to restructure claims significantly or to change headings so as to comply with U.S. practice. I say, “generally” because attorneys can and do have varying opinions as to the meaning of MPEP § 1893.01(d). That is fine, but your default translation style should be to respect the original sentence and paragraph breaks and to conserve the original lexemes.

Another difference between translations for information and translations for PCT filing is that comments,

references, and translator's notes have no place in a translation for filing. So if a lexeme must be added for the sentence to make sense, just add it—enclosing a word in square brackets is not allowed. Likewise, where you would insert the note “[sic]” after a mistake in the original in a translation for legal information, you would simply leave the mistake without signaling it in any way in a translation for PCT filing. This is not to say that you cannot bring it to the attention of your client, for example, in a cover letter, but the finished document that will be sent to the patent office for examination must stand on its own—mistakes, cultural differences, and other problems can be amended separately by the attorney.

In general, however, as compared to translations for legal evidence or legal information, clients will expect you to put more effort into producing a clear and readable target document, and to be less concerned with reproducing the original wording in a translation for PCT filing. One reason for this is that the end client will often be the person who wrote the patent, and he or she will want the patent to sound good.

#### Filing Under the Paris Convention

The rule of thumb for identifying translations for filing under the Paris Convention is: *Unless your client specifically says the translation will be used in this way, and further specifically asks you to restructure the specification to suit U.S. practice, you should not do so.* What this means is

that, unless you are told otherwise, you can ignore most of the advice you may have heard regarding structure in U.S. claim drafting practice, U.S. section headings, and the like. The subject of how to produce a restructured translation for Paris Convention filing is far beyond the scope of this article. A short and inex-

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pensive introduction to U.S. patent drafting can be found in the *Inventor's Guide to Successful Patent Applications*, by Thomas E. Deforest, and anyone who will be taking on such work regularly should study *Landis on Mechanics of Patent Claim Drafting*, by Robert C. Faber. Both of these references can be purchased at [www.amazon.com](http://www.amazon.com). For Japanese-to-English translators, William Lise's excellent introduction can be found in ATA's *Japanese Patent Translation Handbook* (to order, go to [www.atanet.org/publications/index.php](http://www.atanet.org/publications/index.php)).

#### Conclusion

In review, we have seen that there are five main types of patent translation. Patent translations that will only be used for technical information are uncommon. Translations for evidence, for legal information, and for PCT filing differ mainly in terms of a translator's notes and comments, as well as in the degree of literalness that governs your style. Translations for Paris Convention filing are in a class of their own and require considerable specialized knowledge. Though there is much to learn about each type of translation, knowing which type of translation is on your desk is an excellent place to start.

#### For More Information:

##### Paris Convention

[www.wipo.int/treaties/en/ip/paris/index.html](http://www.wipo.int/treaties/en/ip/paris/index.html)

##### Patent Cooperation Treaty

[www.uspto.gov/web/offices/pac/mpep/documents/appxt.htm](http://www.uspto.gov/web/offices/pac/mpep/documents/appxt.htm)

##### U.S. Patent and Trademark Office

[www.uspto.gov](http://www.uspto.gov)

##### United States Manual of Patent Examining Procedure

[www.uspto.gov/web/offices/pac/mpep/index.html](http://www.uspto.gov/web/offices/pac/mpep/index.html)

##### World Intellectual Property Organization

[www.wipo.org](http://www.wipo.org)

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