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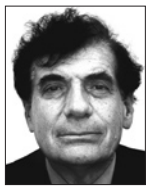
Expert Analysis

Translating Patents: Issues in Prosecution



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The current pace of industrial globalization is making both foreign prior art and international filing ever more important in U.S. patent practice. This has left many American attorneys with no choice but to rely on translations, which is not only expensive, but can involve significant risks.

Risks arise 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, that the English word "you" can be expressed in German as either the familiar "du" or the more formal "Sie." It follows that no German translation of an English sentence including the word "you" will correspond exactly to the original. A choice will have to be made, and whether one chooses "du" or "Sie," the resulting German 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.

Skilled human translators are able to minimize this loss but, being human, they are also capable of making things worse as result of errors of omission and misunderstanding. The resulting distortion will be familiar to anyone who has played the children's game of Telephone.

Because patents describe cold, hard technology and are written in highly explicit language, they suffer less from inherent translation loss than highly cultural texts such as poems or advertising copy. Nonetheless, patents are challenging for most translators. A first difficulty is the complexity of the technology described. To produce a reliable translation, the translator must understand the text. It will be clear that understanding the context is a prerequisite for choosing an appropriate translation, if we consider the different possible meanings for terms such as beam, factor or even impregnate. Complex sentence structures, particularly in the claims, and the need to maintain the breadth, narrowness or ambiguity of the original language also contribute to the particular translation 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. To minimize the human errors mentioned above, a reliable translation will always have been reviewed by a second translator. This makes patent translations expensive, ranging from a few hundred dollars for shorter patents, to tens of thousands of dollars for massive biotechnology specifications.

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When choosing strategies to reduce these costs, as when making any decisions regarding translation, it is essential to understand the specifics of the risks involved and how they can be mitigated.

Foreign Prior Art

For translations of prior art, the most significant risk is that of being misled. For example, a practitioner who accepts a finding based on a machine translation cited by the PTO may be missing the opportunity to successfully traverse the examiner based on a more accurate human translation. Another less obvious, but potentially more serious risk is that of a poor translation causing the practitioner 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, if the practitioner supplies the faulty translation in an information disclosure statement, prosecution may not be a problem, but a real worry would be that of a better translation being produced years later during 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 is able to read a related foreign language document (for example, when the applicant is a national of the country where the foreign language document was published) but they do not provide the examiner with an adequate translation of that document.

For prior art, the probability of translation loss leading to serious consequences increases with the relevance of the foreign document to the application being prosecuted. If the 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, this is probably all the information that is needed. In this case, there is no point in paying for a top-notch translation. Conversely, if the only thing that differentiates the application from the prior art is that the method works for rectangular windows, while the foreign patent is limited to square widows, the attorney will

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want to be very sure of the 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 technology 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 patent specifications, 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 then indicate whether it mentions the matters that are of interest. 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.

U.S. Filings for Foreign Clients

Considerations when filing a translation as part of a domestic application for a foreign client are somewhat different. In the U.S., translation of a Patent Cooperation Treaty (PCT) application can be corrected at any time during pendency of the U.S. national stage application. But the effective date of the eventual U.S. patent as prior art may become the date of filing of the translation correction. Moreover, if the U.S. application is not the U.S. national stage of a PCT application or does not incorporate by reference the content of a Convention priority application upon which it is based, correction of mistranslation in the U.S. application is not permitted if the correction appears substantive.

In addition to the risks and problems mentioned above, deficient translations make prosecution of applications more time-consuming and, hence, more expensive. Moreover, the U.S. Patent and Trademark Office is trying to reduce a large backlog of pending applications, and patent applications which are poor translations tax the patience of patent examiners and, therefore, the inventions to which they are directed may not be given the consideration which they may merit.

Preferably, the U.S. patent attorney should review the application and correct at least any egregious translation errors, for example by amendment filed simultaneously with the application. Such errors frequently can be spotted because they cause the technical description not to make sense. If it appears that there are significant problems with the translation, it may be advisable to have it fully reviewed by a professional translator.

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Overseas Filings, U.S. Clients

When filing all but the shortest specifications in foreign countries, translation costs often outweigh overseas attorney charges and government filing fees. Clients may want to minimize this burden and, as translation prices can vary greatly, companies with large portfolios or particularly lengthy applications can benefit greatly by shopping around. In doing so, however, it is important to assess the risks involved, which vary greatly from country to country.

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 and some corrections to the translation can be made even after the patent has issued. China allows for correction of PCT applications but within narrower time limits and South Korea allows no correction of the translation after the expiration of the time limit applicable under PCT Article 22 or 39(1). It follows that consequences of an erroneous translation may, for example, be more serious in South Korea than in Japan, and well developed translation policies will reflect this.

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, other 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.

In either case, 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, the firm may wish 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.

Conclusion

The translation options available to U.S. attorneys and the associated cost and risks vary depending on the way in which the translation will be used. Translation policies should seek to asses the risks associated with each usage context, as the product of the severity of the consequences (how much is riding on the patent being prosecuted) and the probability of an unredeemable problem arising (for prior art this varies with the relevance of the document, while for foreign filing it is impacted by opportunities for correction). As risk increases, attorneys can mitigate, by using more reliable translation services and/or requesting independent review, and transfer by way of the translator's insurance coverage. No policy will eliminate risk but proactive assessment and knowledge of the options will lower costs and provide better protection to clients.