Managing Patent Translation Risks

BY MARTIN CROSS[1]

As the globalization of intellectual property continues, ever more patent practitioners find themselves relying on translations, and while problems with translations can damage overseas filings, leave domestic patents open to challenge and undermine litigation strategies, few practitioners have policies in place to mitigate these risks.

To understand translation risk, it must be remembered 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. For example, the simple English term "you" can be expressed by numerous different words Japanese, depending on the relationship between the author and the person being addressed[2]. By choosing one of these possible translations for "you", the translator excludes the others, necessarily making the Japanese translation 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 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.

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.

For translations of prior art, the most significant risk is that of being mislead. 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[3].

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 (or litigated). 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 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 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.

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[4] and some corrections to the translation can be made even after the patent has issued[5]. China allows for correction of PCT applications but within narrower time limits[6] and South Korea allows no correction of the translation after the expiration of the time limit applicable under PCT Article 22 or 39(1)[7]. 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. Keep in mind that vague answers are usually indicative of vague policies. 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.

The risk associated with patent translation is the product of the severity of the consequences (how much is riding on the patent) 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, practitioners 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 risk assessment and knowledge of your options will lower costs and help you to sleep better.

ENDNOTES

1. Martin Cross is president of Patent Translations Inc. and co-author of the American Translator Association's *Patent Translator's Handbook*.
2. The three most common translations of the English word "you," *anata*, *kimi* and *omae*, imply different levels of intimacy and respect. All three are considered too intimate for most formal written communication and indirect terms such as "the customer" are used instead.
3. See http://www.grundipg.com/files/Excerpt__Lost_in_Translation__2006_.pdf, 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) and Semiconductor Energy Laboratory Co., Ltd. v. Samsung Electronics Co., Ltd., 204 F.3d 1368, 54 USPQ2d 1001 (Fed. Cir. 2000).
4. 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
5. See Article 126 of the Japanese Patent Law – Trial for Correction.
6. 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
7. See Korean Patent Act 201(3)(4) and WIPO PCT Applicant's Guide, National Phase, National Chapter, KR, KR.02