

International Patenting and the Translator: An Essential Partnership

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The preparation, drafting, and filing of a successful patent application requires the skill, experience, and knowledge of the patent practitioner in combination with the inventor. As soon as the applicant for a patent decides to seek patents in multiple countries, this working partnership necessarily expands to include the translator. In the multilingual world of international patenting, the skill, experience, and knowledge of the translator can be a key factor to the success of each patent filing that is made in a language differing from the one used to draft the application. In the following paragraphs, we will look into some of the knowledge a patent translator should have regarding patents and the patenting process. In the absence of a basic understanding of patents and the requirements to obtain a patent, a patent application based on a translation may not be sufficient to obtain the full patent right the applicant—the translator’s ultimate client—is due.

The accuracy and skill of the translator can “make or break” a patent application.

What is a Patent, Anyway?

A patent grants an intellectual property right similar to trademarks and copyrights. It gives a limited exclusive right to the patentee. A patent holder has the right to exclude others from using the invention covered by the patent. An important point to keep in mind is that a patent does not grant the right to use the invention, only the right to exclude others from using the invention. A patentee may not infringe upon the rights of others in using the patented invention. A patent right is limited. Generally, it expires 20 years from the date the patent application was filed. It may also be limited by other laws.

A patent is also a business tool. Most enterprises planning to introduce a new invention into commerce will not go to the considerable expense involved without assurance that their new invention will not be copied by the competition. Holding the exclusive patent right on the invention provides this needed assurance.

At its base, the patent right is part of an agreement, a bargain between an inventor and a country. In return for an inventor fully disclosing a new invention to the public, thereby advancing science and the state of the art, the country grants the inventor (or a successor in title) an exclusive right to use the invention for a set period of time.

It is important to note that the agreement is between an inventor and the country granting the patent. If an applicant desires to secure an exclusive patent right in several countries, the applicant must strike the bargain with each individual country. Since the applicant must fully disclose the invention to the public to complete the bargain, the invention is placed in the public domain. Anyone in a country where the exclusive patent right is not secured is free to use the invention without restriction.

What is Required to Get a Patent?

Granting a 20-year exclusive right is a significant event, and most countries set a stringent set of requirements that an invention must meet to qualify for a patent.

1. The subject matter of the invention must fall within the country's definition of "patentable matter."

What is patentable varies by country. For example, in some countries methods of treatment of the human body are patentable; in most countries they are not. Methods of doing business and computer software are patentable in some countries, but not in others.

2. The invention must be new (novel).

As part of the patent "bargain," a patentable invention must advance science, making a contribution to the state of the art. If an invention was already publicly known, the invention described and defined (claimed) in the application will not advance the state of the art and will not qualify for a patent. To be novel, many countries require that an invention not be available to the public anywhere in the world by any means prior to the date the patent application is

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filed. In other words, the invention needs to be an absolute novelty. Other countries only consider an invention's previous exposure anywhere in the world by means of written disclosure to be "novelty destroying." Public exposure of an invention by other means will only affect the invention's novelty if the exposure was made within the country where the patent application has been filed. Many countries also have "grace periods," a set period of time (usually 6 or 12 months prior to filing) in which an invention may be publicly exposed without destroying the novelty of the invention.

3. The invention must possess an "inventive step."

The invention must not be obvious to people of ordinary skill in the relevant art. If the novel features of an invention are trivial or are obvious to people working the area of technology covering the invention, then no real advancement of the state of the art exists, and the inventor's half of the patent bargain is not being fulfilled.

4. The invention must have industrial applicability or utility.

In most countries, a patentable invention is one that has an application in industry. In the U.S., the law states that an invention must have utility, which is broader than industrial applicability.

5. The invention must be fully disclosed and unambiguously defined.

In order for the patent applicant to complete the patent bargain, the invention must be disclosed in the application in a manner that is understandable to those working in the relevant field, so that they can make and use the invention. This is referred to as an enabling disclosure. In addition to the enabling disclosure, the application must unambiguously define what the patent right will cover by giving a precise description of the invention.

What is Required in a Patent Application?

In general, a patent application for a novel, non-obvious, and industrially applicable invention contains:

- An introductory or background section describing the field of technology covering the invention, the state of the art, and the use of the invention or the problem the invention solves.
- A brief summary of the invention.
- A brief description of any drawings included in the application.
- The full and enabling disclosure of the invention, including examples of use.
- One or more claims that precisely define the invention. ➔

- A brief abstract (to aid others in searching inventions in the art).

An understanding of patent terminology and practice is critical for proper translation in two areas of the application: the examples and the claims. The examples included in a patent application serve two purposes. First, they provide information to help show how the invention is to be made and used. Second, they provide proof that the invention works and has utility. In general, working examples detail experiments that have been conducted and the results of those experiments. In some instances, however, it is not possible to conduct actual experiments, and the patent drafter must resort to using hypothetical or prophetic examples. When it is necessary for some of the examples in an application to be prophetic, it must be clear that the examples are not real. This is generally done via the tense in which the example is written.

Working (real) examples are written in the past tense while prophetic examples are written in the present or future tense. Misrepresenting a prophetic example by writing it in the past tense can (and has) resulted in invalidation of the patent. When translating the examples, it is important that the translation properly reflect the nature of the example (working or prophetic). To complicate this situation, some patent systems do not accept the inclusion of hypothetical examples in an application, and in some languages there is no easy way to distinguish between tenses. When translating a patent application with present or future tense examples, it is important for the translator to check with the client if the nature of a prophetic example cannot be properly conveyed in the target language.

The claims are a critical portion of the application as they set forth the

precise definition of the invention seeking the patent right. A patent claim is made up of a single sentence. It can be a very long, even multi-page, sentence, full of commas, colons, and semicolons, but it will have only one full stop. (A claim of more than one sentence is considered indefinite.) A claim is made up of three parts:

1. An introductory phrase or preamble.
2. The body of the claim.
3. A connecting or transitional phrase.

The preamble indicates the subject of the claim (“A widget...”; “A process for making a widget...”; “A method for using a widget...”). The body of the claim provides the precise definition of the invention. A literal translation of the preamble and the body of the claim is generally required. It is the transitional phrase that can be problematic.

The connecting or transitional phrase dictates how the parameters in the body of the claim relate to what is being claimed. The transitional phrase can be “open-ended” or “closed-ended.” In most countries, the word “comprising” is the accepted open-ended connector. When an open-ended connector is used, any article that possesses all of the features set forth in the body of the claim falls within the scope of the claim regardless of what other features the article may have. If a stool is claimed as comprising three legs, a stool having three legs would be within the scope of the claim. A stool with four, five, or six legs would also fall under the claim because stools with four, five, or six legs have “three legs.”

The generally accepted close-ended connector is “consisting of.” When a closed-ended connector is used, only articles possessing the features set

forth in the body of the claim, and nothing more, will fall within the scope of the claim. In the last example, if the stool was claimed as “consisting of” three legs, the four-, five-, or six-legged stools would not fall under the scope of the claim.

Since the connotation of the transitional phrases are not universal, when translating claims, it is important to know the accepted open-ended and closed-ended transitional phrases in both the source language and the target language and to ensure that the proper meaning is conveyed in the translation. If there is any doubt, a check with the client will provide the information needed to make the proper translation.

What Happens Next?

When the patent application is completed, it is filed in the patent office of the countries where a patent is desired. Because filing in a broad range of countries speaking a variety of languages is both expensive and difficult, most patent applicants utilize one or more international treaties to aid in the process.

The Paris Convention for the Protection of Intellectual Property allows an applicant to establish a filing date in one member state and maintain that first filing date in the other member countries, provided the application is filed in the other countries within 12 months. The filing date of the application is critical because determination of the novelty and inventive step of the invention in all member countries will be judged as of the first filing date. This system of priority is the reason translations and filings in most countries have a strict deadline of 12 months after the first filing. Missing this date means lost priority and possible loss of novelty, depending on what was made public during the priority year.

Regional patent offices also help.

In some areas, countries have banded together and formed regional patent offices. The best known is the European Patent Office, but there are four other regional offices covering parts of Africa, the Arabian Peninsula, and some of the former Soviet republics. An applicant can file in a regional office and seek patent protection in all member states. Since most regional office members are also members of the Paris Convention, priority to a first filing can be claimed in regional applications.

The Patent Cooperation Treaty (PCT), a treaty under the Paris Convention, provides an applicant with the ability to secure a filing date (with priority) in all PCT member countries (currently 138) and 4 regional offices by filing a single application in one language, generally in the applicant's home patent office. Unlike national and regional patent offices, the PCT does not grant patents. It secures a filing date and provides an applicant with time and information to help make decisions on where to seek patents. At 30 months from the priority date the "international phase" of the PCT ends. An applicant must then enter the "national or regional phase" before the local offices, and appoint agents and provide translations where necessary.

In all cases, the application will be examined in the local language by a local examiner. Working with the applicant (generally through a local patent agent), the patent examiner will determine if the disclosure is enabling and if the claimed invention is patentable under local law. If it is, a patent will be granted by the country.

Issues for Translators

The translator plays a key role in international patenting. Each application must be filed in the local lan-

For More Information

European Patent Office
www.epo.org

Japanese Patent Office
www.jpo.go.jp

Paris Convention for the Protection of Intellectual Property
www.wipo.int/treaties/en/ip/paris/trtdocs_wo020.html

Patent Cooperation Treaty
www.wipo.int/pct/en

U.S. Patent and Trademark Office
www.uspto.gov

World Intellectual Property Organization
www.wipo.int

guage. Any application filed in a language differing from the original will be judged and granted or rejected based on a translation. In general, in an application directly filed in a national or regional office, no corrections can be made to the filed text. An application filed with mistranslated words may prove to be so flawed that no patent will be allowed—it has happened. For applications filed under the PCT, there may be some relief from a mistranslation. The translation of an application filed under the PCT is not due at 12 months from the priority filing, but at 30 months (31 in some countries). Since the PCT is equivalent to a national filing in all member states, the publication under the PCT is viewed as the controlling legal text by most (but not all) countries. A mistranslation can often be corrected by a reference to the PCT publication. Most PCT countries require that the national phase translation of the PCT publication be literal; polishing the text for grammar or phraseology can come later. (In the U.S., if a translation is not literal when filed, it will be considered insufficient and the application will be held "abandoned.")

When examining an application, the examiner will look at the claimed

invention and the enabling disclosure that supports the claims. It is critical that terminology be consistent throughout the translation. This may be difficult because many patent drafters like to be their own lexicographers, inventing words and terms of art to fit the invention. This is acceptable as long as the terms are clearly defined in the disclosure. Often a word will not retain its common meaning in a patent application, making contextual translation more difficult. This is why it is important for the translator to watch out for invented words.

Parting Thoughts

The translator is a key partner in the patenting process. The accuracy and skill of the translator can "make or break" a patent application. It is important that anyone translating for a patent filing be familiar with the local patent process and practice in both the originating country and the country for which they are translating. Knowing the systems and their idiosyncrasies will help the translator do the very best job for the client and maximize the applicant's chance of obtaining the full scope of patent protection due.

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