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SPECIAL
REPORT

Are JPO Website Computer-Generated Translations "Readily Available"? Must They Be Submitted With Information Disclosure Statements?

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Applicants and other individuals substantively involved with the preparation and/or prosecution of U.S. patent applications have a duty to submit to the U.S. Patent and Trademark Office (USPTO) information which is material to patentability as defined in USPTO Rule 56 (37 CFR §1.56). The provisions of USPTO Rules 97 and 98(a) (37 CFR §1.97 and 37 CFR §1.98(a)) provide mechanisms by which patent applicants may comply with the Rule 56 duty of disclosure.[1]

An English translation of any non-English language document must be filed with an Information Disclosure Statement (IDS) under Rule 98(a)(3)(ii) when the translation "is within the possession, custody, or control of, or is readily available to any individual designated in §1.56(c)" (emphasis added).

The Japanese Patent Office (JPO) has recently made available computer-generated English language translations of published Japanese patent applications on the JPO website. See *http://www.jpo.go.jp*. Individuals designated in Rule 56(c) can now download an English translation of a published Japanese patent application from the JPO website.

The Duty of Disclosure Issues

The availability of a translation from the JPO website raises several issues regarding the duty of disclosure:

- **Should computer-generated "translations" be considered translations in the context of Rules 56 and 98?** As stated in MPEP §609, "Translations are not required to be filed unless they have been reduced to writing and are actually translations of what is contained in the non-English language information." The manual process of translating a document by a human being requires subjective decisions and interpretation, because words and phrases can have variable meanings based on the substantive and grammatical context in which they are used. However, the JPO website translations are computer-generated, and as a result, are often inaccurate. In other contexts, the USPTO has required submission of "accurate" translations of applications that are filed in languages other than English, requiring that the accuracy of the translation be affirmed by a human being. See e.g., Rules 52(d)(1) and 78(a)(5)(iv) (37 CFR §1.52(d)(1) and 1.78(a)(5)(iv)). Where it has received inaccurate translations, e.g., under Rule 495(e) (37 CFR 1.495(e)), the USPTO has taken the position that a translation has not been filed at all in view of the inaccuracy.
- **Must computer-generated translations be reviewed for accuracy?** Rule 98(a)(3)(i) requires a translation when it "is within the possession, custody, or control of, or is readily available to any individual designated in §1.56(c)." There is no requirement in Rule 98(a)(3)(ii) to review the translation for accuracy. However, Rule 56(a)

[1] Details of the requirements of these rules are explained in §609 of the USPTO Manual of Patent Examining Procedure (MPEP).

imposes a duty of candor and good faith that could be questioned if an inaccurate translation is submitted by one with knowledge of both the original document language and the English language.

- **Are the JPO website computer-generated translations "readily available" in the context of Rule 98(a)(3)(ii)?** Our experience indicates that it can take several minutes, sometimes more than fifteen minutes, to download a single translation from the JPO website. In addition, the JPO website is sometimes inaccessible. Therefore, downloading translations may take a significant amount of time and effort, and increase the costs of filing an IDS. Review of the translations for accuracy would require substantial additional professional time and thus cost.

- **Are other internet-available translations "readily available"?** Documents can be electronically forwarded to numerous internet translation services where the documents are translated by a computer program into any desired language. These services are often free, although some are limited to a specified word count. See e.g., the aptly-named www.FreeTranslation.com; 1800 word maximum. While this question has not been posed to the USPTO, these services require uploading the document to the site for translation, in contrast to the automatic posting on the JPO website of computer-generated English language translations of published Japanese patent applications.

- **Who has the burden of obtaining the translation?** In other contexts, the USPTO Board of Patent Appeals and Interferences has expressed a desire for an English translation of documents, as opposed to English abstracts of them, but has placed the burden squarely on the Patent Examiner to obtain the translation. See *Ex Parte Gavin*, 62 USPQ2d 1680, 1684 (Bd. Pat. App. & Inter. 2001) (non-precedential). Rule 98(a)(3)(ii) imposes no burden on an applicant to search for or prepare a translation.

- **Can the submission of a computer-generated translation be avoided by submitting a concise statement of relevance of any non-English language document?** Rule 98(a)(3)(i) requires a concise explanation of relevance for documents not in the English language. If an English translation is supplied, a concise explanation of relevance is not required because the document is now in English. However, Rule 98(a)(3)(ii) imposes a separate requirement for an English translation if it is readily available, regardless of whether a concise explanation of relevance is supplied.

The USPTO Position

The USPTO has not published a written policy statement on this issue. The USPTO Solicitor has refused to comment on the issue in response to informal inquiries. However, Ms. Magdallen Y.C. Greenlief, Editor of the USPTO Manual of Patent Examining Procedure (MPEP), has stated that English translations of Japanese patent applications from the JPO website are considered "readily available" in the context of Rule 98(a)(3)(ii). According to Ms. Greenlief, the translations can be downloaded easily and without charge from the JPO website, and this makes them readily available to the applicant under Rule 98(a)(3)(ii). Based on Ms. Greenlief's characterization of USPTO policy, to satisfy the duty of disclosure under Rule 56, a translation from the JPO website must be submitted with any published Japanese patent application that is cited in an Information Disclosure Statement (IDS) and not otherwise accompanied by a translation. Ms. Greenlief's description of USPTO policy clearly places the burden of obtaining the translation on the applicant.

Our Recommendations

We recommend a conservative approach until this issue is resolved. Our approach should avoid any question that our clients have satisfied their duty of disclosure, and will do so in a cost-effective manner least burdensome to our clients.

We are downloading and submitting computer-generated English language translations from the JPO website for all IDSs that identify published Japanese patent applications. However, we are submitting these translations to the USPTO with a disclaimer regarding their accuracy. For example, when filing an IDS with JPO website computer-generated translations, we are including a disclaimer that indicates:

> A computer-generated English translation of the following Japanese Patent Publication has been obtained from the website of the Japanese Patent

Office ([http://www.jpo.go.jp]), and is attached, but has not been reviewed for accuracy. See Reference _____.

You may want to consider downloading a translation from the JPO website before forwarding any published Japanese patent application to us for filing with an IDS. When sending a translation, please indicate whether it was computer-generated and whether it has been reviewed for accuracy.

Regardless of whether the computer-generated translation has been reviewed for accuracy, please also consider submitting a brief explanation of relevance of the reference in addition to its computer-generated translation and/or abstract. This procedure has the dual benefits of: 1) satisfying both Rule 98(a)(3)(i) and (ii) and the USPTO's desire for a translation of the actual document as expressed by the USPTO Board of Patent Appeals and Interferences in *Ex Parte Gavin*; and 2) addressing the potential for any inaccuracies or omissions in the computer-generated translation or abstract.[2] If inaccuracies exist, the applicant has still provided its own explanation of relevance independent from the computer-generated translation. More importantly, the applicant's explanation of relevance must be considered "a concise statement of relevance, as it is presently understood by the individual designated in §1.56(c) most knowledgeable about the content of the information … that is not in the English language." See Rule 98(a)(3)(ii) (emphasis added). In our opinion, the applicant's explanation of relevance should overcome any inaccuracies in a computer-generated translation, and this may minimize any duty of disclosure issues based on submission of computer-generated translations that are later asserted to contain inaccuracies.

We will continue to monitor this important issue and report any significant developments.

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[2] The importance of an accurate and complete translation and/or explanation of relevance was highlighted by the U.S. Court of Appeals for the Federal Circuit (CAFC) in Semiconductor Energy Laboratory Co. v. Samsung Electronics Co., 204 F.3d 1368, 1378, 54 USPQ2d 1001, 1008 (Fed. Cir. 2000): "The duty of candor does not require that the applicant translate every foreign reference, but only that the applicant refrain from submitting partial translations and concise explanations that it knows will misdirect the examiner's attention from the reference's relevant teaching."