

## REPORT

**EXPANDED AVAILABILITY OF TRANSLATIONS OF PATENT PUBLICATIONS FOR SUBMISSION WITH INFORMATION DISCLOSURE STATEMENTS**

April 6, 2012

Patent 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 that is material to patentability. The provisions of USPTO Rules 97 and 98(a) provide Information Disclosure Statement (IDS) rules according to which patent applicants may comply with the duty of disclosure.<sup>1</sup>

An English-language translation of any non-English-language document must be filed with an 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).

Since as early as 2003, the Japanese Patent Office (JPO) has made available computer-generated English-language translations of published Japanese patent applications on the JPO website. See <http://www.jpo.go.jp>. Because individuals designated in Rule 56(c) have been able to download an English translation of a published Japanese patent application from the JPO website, our recommendation has been to download and submit computer-generated English-language translations from the JPO website for all IDSs that submit published Japanese patent applications.

For more details about computer-generated English-language translations of published Japanese patent applications on the JPO website, see our April 1, 2003, Special Report entitled *Are JPO Website Computer-Generated Translations "Readily Available"? Must They Be Submitted With Information Disclosure Statements?* That Special Report discusses in detail the availability of such computer-generated English-language translations, the duty of disclosure issues, the USPTO's position, and our recommendations. Our recommendations remain unchanged from 2003.

More organizations are now making available free computer-generated English-language translations of patent literature. Recently, computer-generated English-language translations have become available from WIPO (through WIPO's PatentScope search service) and the European Patent Office (through Espacenet). Each of these services is discussed briefly below.

- **WIPO PatentScope**

See <http://www.wipo.int/patentscope>

Free computer-generated English-language translations can be obtained for all international publications available through WIPO's PatentScope service.

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<sup>1</sup> 37 CFR §1.97 and 37 CFR §1.98(a). Details of the requirements of these rules are explained in §609 of the USPTO Manual of Patent Examining Procedure (MPEP).

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- **Espacenet**

See <http://worldwide.espacenet.com>

Free computer-generated English-language translations can be obtained for references that are originally in German, French, Italian, Portuguese, Spanish and Swedish through Espacenet. However, the EPO has announced that the translation service will be extended in the future to cover all languages of the EPO's member states, and other non-European languages such as Chinese, Japanese, Korean, and Russian. The service does not appear to be limited by date range, but rather applies to any patent literature available through the Espacenet system.

Other sources are also available for obtaining translations, including translations of patent-related literature. For example, FreeTranslation.com (see <http://www.freetranslation.com>) provides free computer-generated translations limited to 10,000 characters, and the Korean Intellectual Property Office (KIPO) (see <http://www.kipo.go.kr>) provides computer-generated English-language translations of Korean patents and utility models. However, these other services are either limited in the amount of text that can be translated free of charge and require uploading the document to the site for translation (as in FreeTranslation.com) or require payment of a fee (as in the Korean Intellectual Property Office). Accordingly, we do not believe that these services would be considered to provide translations that are "readily available" under 37 CFR §1.56(c).

### **Our Recommendations**

Out of an abundance of caution for Applicants' duty of disclosure, we continue to recommend a conservative approach of submitting computer-generated translations in an IDS whenever they are available without charge. Our approach should avoid any issue about whether our clients have satisfied their duty of disclosure, and will do so in a cost-effective manner least burdensome to our clients.

We accordingly download and submit computer-generated English-language translations from the JPO, EPO, and WIPO websites for all IDSs that submit published patent references for which such computer-generated English-language translations are available. We submit these translations to the USPTO with a suitable disclaimer regarding the accuracy of the translations. For those clients that have already indicated that we should not automatically obtain computer-generated English-language translations from the JPO, we will likewise not automatically obtain computer-generated English-language translations from the EPO or WIPO.

For references where a computer-generated English-language translation is available, you may want to consider downloading a translation from the respective website before forwarding the published patent document 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.

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

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*This Special Report is intended to provide information about legal issues of current interest. It is not intended as legal advice and does not constitute an opinion of Oloff & Berridge, PLC. Readers should seek the advice of professional counsel before acting upon any of the information contained herein.*

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