

TO TRANSLATE OR NOT TO TRANSLATE: “WHO?” IS THE QUESTION

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"No literal Translation can be just to an excellent Original;
but it is a great Mistake to imagine that a rash Paraphrase
can make amends for this general Defect"

Alexander Pope [1688-1744]

A longstanding issue in patent law concerns the adequacy of the teachings of an English abstract of a prior art document that is in a foreign language vis-à-vis the full teachings contained in the original document. Assuming that an abstract is by its very nature an inadequate instrument for reflecting the spectrum of teachings afforded by the underlying reference, where does the obligation lie in providing a fuller disclosure to the Patent Office? More specifically, does the provision of an English abstract of a foreign language prior art document to the Patent Office satisfy the applicant’s duty of disclosure requirement to the Office with respect to the underlying document, or is there a translation obligation on the part of the applicant? If there is such an obligation, can the applicant properly shift the burden for obtaining a true translation, and the significant expense associated therewith, to the Patent Office. This paper explores these questions in light of recent guidance provided by the Federal Circuit and the PTO’s Board of Appeals.

A. Introduction

During the patenting process, applicants are required to prosecute patent applications with candor, good faith, and honesty under Rule 56.¹ This rule specifies that an applicant must “disclose to the Office all information known to [the applicant] to be material to patentability.”² The information is material “when it is not cumulative to information already of record or being made of record in the application.” In addition, the information is material if “[i]t establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim.”³ Approached from another viewpoint, the information is material if “[i]t refutes, or is inconsistent with, a position the applicant takes in (i) [o]pposing an argument of unpatentability relied on by the Office, or (ii) [a]sserting an argument of patentability.” It is sometimes challenging for applicants, and their attorneys, to properly assess whether a certain piece of reference is relevant and, if it is, to determine the extent of disclosure needed to properly reflect its significance to the Patent Office.

A particular challenge is faced when the prior art reference is in a language other than English. In such a case, should the applicant provide an English translation of the full text of the

¹ 37 C.F.R. § 1.56

² *Id.*

³ *Id.*

foreign language reference to the Patent Office? How extensive does the English translation need to be to satisfy the Rule 56 requirement of candor, good faith, and honesty? Is an English abstract of the reference sufficient to meet the Rule 56 disclosure obligation? If the translation of the abstract is not adequate, how much of the underlying reference on which the abstract is based should be translated into English to satisfy the Rule 56 disclosure requirements? This problem bears significant implications since increasing numbers of patent applications filed in this country have international origins. In addition, the ever intensifying global competition in technology development increases the likelihood of encounters with foreign language documents in the preparation and prosecution of domestically-originated U.S. applications.

By the same token, foreign language prior art references are increasingly being used by U.S. patent examiners to support claim rejections. Examiners routinely use just English abstracts of foreign references to reject applications since these abstracts can be provided by their on-line search capabilities. In such a case, the question then becomes what is the minimum translation requirement, if any, that is needed to support the use of a foreign language reference as a basis for claim rejections. Is an English abstract of a foreign language reference sufficient to support the Examiner's rejection? Should the English translation of the underlying foreign reference be considered? And if so, what is the extent of translation needed to fairly represent the teachings of the reference? Ultimately, who should be responsible for providing such translations?

By examining a CAFC decision in *Semiconductor v. Samsung*⁴ and a recent decision by Board of Patent Appeals and Interferences in *Ex parte Gavin*,⁵ this article attempts to address these questions.

B. Requirements for Applicants With Respect to Foreign Language References

As stated in the Introduction, applicants are required by the Rule 56 to disclose material information to the Office during patent prosecution. A Rule 56 violation may constitute inequitable conduct and consequently, patents issued resulting from such inequitable conduct are unenforceable. Examples for inequitable conduct in prosecution of patents include affirmative misrepresentation of material facts, failure to disclose material information, or submission of false material information, coupled with intent to deceive.⁶ Materiality and intent are predicate elements, but it is not necessary to prove the intent to mislead the PTO by direct evidence. Instead, "intent to mislead PTO" can be inferred from the facts and circumstances surrounding the applicant's conduct.⁷

In *Semiconductor*, plaintiff Semiconductor Energy Laboratory (SEL) sued Samsung Electronics for patent infringement in the U.S. District Court for the Eastern District of Virginia. The court decided, *inter alia*, that SEL's dealing with foreign references during prosecution of the patent constituted inequitable conduct and hence rendered its patent unenforceable.⁸ CAFC affirmed the lower court's decision.⁹

⁴ *Semiconductor v. Samsung*, 204 F.3d 1368 (Fed. Cir. 2000) *affirming* SEL 1, 4 F. Supp. 2d 473, SEL 2, 4 F. Supp. 2d 477, SEL 3, 24 F.Supp. 2d 537 (E. D. VA 1998).

⁵ *Ex parte Gavin* ____ U.S.P.Q 2d ____ (Board Pat. App. Interf., Dec. 17, 2001). See also *Ex parte Jones*, 62 U.S.P.Q.2d 1206 (Board Pat. App. Interf., Nov. 28, 2001).

⁶ See *Molins PLC v. Textron, Inc.*, 48 F.3d 1172 (Fed. Cir. 1995).

⁷ *Id.* at 1180-81.

⁸ See SEL 1, 4 F. Supp. 2d 473, SEL 2, 4 F. Supp. 2d 477, SEL 3, 24 F.Supp. 2d 537 (E. D. VA 1998).

⁹ 204 F.3d 1368.

SEL is a Japanese research and development company specializing in semiconductor technologies. It has filed more than 5000 patent applications worldwide since the 1980's, and owns about 1500 U.S. and foreign patents. Its president, Dr. Yamazaki, is the named inventor or co-inventor of most of its patents including the '636 patent which is the patent in suit in this case. In other words, SEL and its president are very experienced in patent procurement and prosecution.

During the prosecution of the '636 patent, SEL filed an IDS which was fifteen pages long. In addition, the IDS included a list of ninety references. Among these references, there was a twenty-nine page long Japanese Laid-Open Japanese Application (Canon reference). SEL provided the entire Canon reference in its original Japanese language to the PTO. SEL also provided the PTO with a concise explanation of the Canon reference's relevance, and a pre-existing one-page partial English translation from a previously filed unrelated patent application. However, the one-page partial English translation only covered four short sections of the Canon reference. Further, SEL disclosed three references that a potential licensee, IBM, had brought to SEL's attention as important prior art for obviousness purpose. Two of these references were actually Dr. Yamazaki's own patents and the third reference was an article by Tsai. In the end, SEL did submit these references in the application for '636 patent, but it did so only after IBM, a potential licensee, expressly called their attention to these references.

In order to decide whether SEL had engaged in inequitable conduct in prosecution of the '636 patent, the Court first had to discern whether the withheld references, or misrepresentations in information actually provided, satisfy a threshold level of materiality. Then the Court had to decide whether the applicant's conduct meets a threshold of intent to deceive. If the Court determined that these thresholds are satisfied, the Court then balanced materiality and intent to determine whether the equities warrant the conclusion that inequitable conduct occurred.¹⁰ In the Court's words, "in light of all circumstances, an equitable judgment must be made concerning whether the applicant's conduct during prosecution is so culpable that the patent should not be enforced."¹¹

The first question the court had to decide is whether these references were material to the prosecution of the '636 patent. The court determined that the untranslated portions of the Canon reference were highly material in the application process for the '636 patent directed to semiconductor technology. As it turns out, the untranslated portions of the Canon reference contained a more complete combination of elements claimed in patent application than any other references before PTO. The Rule 56 language specifies that a written reference may be highly material in prosecuting patent when it discloses a more complete combination of relevant features, even if those features are before the patent examiner in other references.¹² The court found that Dr. Yamazaki, who reads Japanese as his native language and is an expert in the field of semiconductors, "must have consciously decided which sections to reveal to the PTO through SEL's partial translation."¹³

The Court also found that the other three references withheld initially by SEL were highly material but SEL only disclosed these three references after its potential licensee expressly called SEL's attention to these references. More specifically, these references, if

¹⁰ See *Molins*, at 1178.

¹¹ *Id.*

¹² 37 C.F.R. § 1.56.

¹³ *Semiconductor*, at 1376.

combined with the Canon reference, would have rendered the claims in '636 obvious.¹⁴ Furthermore, the Court found that the concise statement provided by SEL with respect to Canon reference's relevance to '636 application was misleading inasmuch as it led "the examiner into thinking that the Canon reference is less relevant than it really was". Therefore the Court concluded that SEL "constructively withheld the reference from the PTO."¹⁵

If there is proof that the reference at issue is high material to patentability, and the applicant knew or should have known of that materiality, it would be difficult for the applicant to show good faith to overcome an inference of intent to mislead PTO.¹⁶ In addition, the "more material the omission of the misrepresentation, the lower the level of intent required to establish inequitable conduct in prosecution of patent, and vice versa."¹⁷ In this case, there were several highly material references that SEL attempted to withhold from the PTO, apparently through various tactics. Hence, the Court concluded that the intention of deceiving PTO must be inferred.

Considering SEL's conduct during the prosecution of the '636 patent, the Court held that SEL conducted a "sophisticated, subtle, and consistent effort to hide the ball from the PTO in a manner plainly at odds with an applicant's duty to candor, good faith, and honesty."¹⁸ The court was convinced that SEL effectively failed to disclose material reference to PTO, by providing a one-page, partial English translation of a 29-page long Japanese application. Such limited amount of translation provided by SEL gave the examiner the impression that no further translation of the reference or investigation were needed to complete the examination process. As a result of this action or inaction, SEL's '636 patent directed to semiconductor technology was held unenforceable due to inequitable conduct resulting from providing a misleadingly incomplete, partial translation of Japanese reference and a narrow and incomplete concise statement.

The court also indicated that the '636 patent can be held unenforceable on two alternative theories. First, the district court determined that, by submitting a concise explanation and a one-page partial translation of the Canon reference that were accurate but misleadingly incomplete, SEL had intentionally withheld the Canon reference from the PTO.¹⁹ For example, the concise statement only identified the material used as pertinent, but failed to disclose Canon reference's warning to avoid impurities. Second, the district court determined that, by mischaracterizing the Tsai patent, the applicant had intentionally misled the examiner into believing that the Tsai reference was not material.²⁰ Based on the doctrine of "infectious unenforceability," the court held that SEL's misrepresentations during the prosecution of the ancestor applications of the '636 patent provided an alternative basis for rendering the patent at issue unenforceable.

Upon SEL's appeal to the Federal Circuit, that court affirmed the district court's finding that the evidence supported the finding that applicant intended to mislead PTO in its disclosure provided to the Office.²¹

¹⁴ *Id.* at 1374.

¹⁵ *Id.* at 1377.

¹⁶ *See Critkon v. Becton Dickinson*, 120 F.3d 1253 (Fed. Cir. 1997).

¹⁷ *Id.* at 1256.

¹⁸ *SEL 2*, 4 F. Supp.2d at 496.

¹⁹ *See SEL 2* at 484.

²⁰ *Id.* at 486.

²¹ 37 C.F.R. §§ 1.98 (a) (c).

The holding of *Semiconductor* has imposed a heavy burden on applicants with respect to disclose foreign language references. Several factors seem to have significant bearings. First, the ability of the inventor to read and comprehend the foreign language is important. Should the Canon reference be in German as opposed to Japanese, assuming Dr. Yamazaki does not read German, the court may have ruled differently. Second, the familiarity of the applicants with the field of invention and the references at issue can be critical. Obviously, an applicant like Dr. Yamazaki who has very significant amount of experience in patent applications and in his field of specialty, is more likely to be subject to a very close scrutiny and even his honest mistakes may be inferred to as intentional deceiving conducts. Third, selectivity of translation for the foreign reference has to be carefully considered.

Preferably, the applicant should provide a complete translation to the PTO if the reference is believed to be highly material. Of course, the cost factor has to be considered. It can become economically cost-prohibitive to provide full translations of all the foreign references that might be relevant in certain fields of technology. Perhaps a risk and benefit analysis should be used to insure that, at least for patents with high litigation potential, full translations of the most relevant art are provided. Also, careful evaluation of the foreign reference by the inventor and practitioner to decide scope of translation are warranted especially, when the inventor can read that foreign language.

C. Requirements for Examiners With Respect to Foreign Language References

A recent opinion from the Board (not intended to set binding precedent) provides a comprehensive review of the patent examiner's obligations with respect to translations and abstracts of foreign language documents. *Ex parte Gavin* is an appeal to the Board of Patent Appeals and Interferences of a patent application rejected by the examiner. One of the examiner's rejections of all claims in the application is that the claims in the application are anticipated by an abstract of "Nagata". The Nagata reference is a published Japanese patent application. The examiner did not provide an English translation of the Japanese patent application in his rejection. Additionally, an abstract of another Japanese patent application "Fujita" was also used by the examiner to reject the claims. Similarly, Fujita is a published Japanese patent application, and the examiner did not provide English translation of the Fujita application. Thus, the examiner relied on abstracts of two published Japanese patent applications without referring to translations of the underlying applications of the abstracts cited by the examiner as the anticipation prior art references. The Board reversed the examiner's rejections based on these two abstracts.

In its opinion, the Board of Patent Appeals and Interferences first acknowledges that one of the recurring problems before the Board is the citation and reliance by examiners on abstracts, without citation and reliance on the underlying scientific document. In making its determination, the Board reasoned that an abstract is a summary of its underlying document. Therefore, the

abstract and its underlying document are distinct documents. The Board pointed out that an abstract is often not written by the author of the underlying document, and may be erroneous, or misleading. Further, the Board concluded, that abstracts are, in virtually all cases, incomplete in their disclosures vis-à-vis the underlying document.

Generally, an abstract stands on its own when used as a basis to support a rejection. That is, the abstract does not incorporate by reference any disclosure of the underlying document. For example, in the case at hand, neither the Fujita abstract nor the Nagata abstract expressly describe or teach the claimed invention, nor do they refer to anything in the underlying references that may disclose the claimed invention. The Board concluded that those abstracts do not provide enough information to permit an inference that the claimed invention is an inherent, i.e., a necessary, result of the disclosure of either reference. Moreover, the examiner is said to have failed to explain where the claimed inventions are described within the abstracts.

The Board noted that, in general, an abstract does not contain adequate information to enable the subject matter of the underlying document to be properly evaluated. The main function of an abstract is to provide a brief summary, and thereby to alert a reader of possible interest in the underlying document. The Board indicated that an abstract is only a little more reliable than headlines or brief newspaper articles. Hence, the Board ruled that a citation of an abstract as the prior art without citation and reliance on the underlying document itself is generally inappropriate.

The Board suggested that the preferred practice for the examiner is to cite and rely on the underlying document. If, however, an examiner cites and relied only on an abstract, the applicant may wish to obtain a copy of the underlying document and submit a copy to the examiner when responding to a rejection relying on an abstract.

If the underlying reference for the cited abstract is in a foreign language, as in this case, and the applicant does not wish to expend resources to obtain a translation, the question becomes who is responsible for the translation of the underlying reference. The Board actually suggested that in such situation, the applicant may request the examiner to supply a translation. Furthermore, if the examiner refuses to provide a translation of the underlying reference, the applicant may seek supervisory relief by way of a petition under 37 C.F.R. § 1.181 to have the examiner directed to obtain and supply a translation.

The Board stated that historically, when neither the examiner nor the applicant relies on the underlying article, the Board has often expended the resources necessary to obtain a copy of the underlying scientific article, as well as its translations if the underlying reference is in a foreign language. The Board lamented that in so doing, the burden of examining the application, in the first instance, then fell on the Board. Moreover, to the extent that the Board relies on parts of a translation not previously to an applicant, any affirmance generally has to be a new ground of rejection under 37 C.F.R. § 1.96(b) which can result in protracted prosecution time and expense.

In vacating the rejections based on Nagata and Fujita, the Board sent a strong message back to the examiner. Translations need be obtained for foreign documents cited by the examiner, and the examiner, in the final analysis, has the responsibility to provide those translations.

D. Shifting the Translation Burden from the Applicant to the Patent Office

In view of the significant costs associated with translations, a practice tip can be discerned from the above case law discussion. The prosecuting attorney, aware of a foreign reference, but not in possession of an English translation, might consider awaiting a first Office Action prior to submitting an IDS. If the Examiner cites that foreign document, this sets the stage for applicant's request to the Patent Office for a full translation of the foreign language document. If the document is not cited by the Examiner, the prosecuting attorney would then submit the IDS with a copy of the English abstract of the document and a statement of relevance, and a approximately two hundred dollar penalty for the late filing of the IDS. This penalty can be easily several thousand dollars less than the cost of obtaining a document translation, and therein lies the opportunity for significant cost savings for the applicant. Of course, the prosecuting attorney must be aware of the possible adverse effect in terms of potential reduction of patent term adjustment under 37 C.F.R. 1.704 associated with a delay in filing the IDS.

E. Conclusion

Clearly recent case law addresses aspects of the translation obligation from both the Patent Office's and applicant's perspective. It seems equitable that applicants and examiners should be subject to the same standard regarding the adequacy and extent of translation that is required with respect to foreign documents cited by each. For patent practitioners, the inventor's knowledge of a particular foreign language reference should be carefully evaluated in determining the extent of the translation obligation, if any, above and beyond the supplying of an English abstract. More specifically, the inventor's ability to comprehend the foreign language and his or her familiarity with the reference will help to determine the extent or scope of translation required.

On the other hand, applicants and patent examiners alike would do well to pay close attention to the translation guidelines offered in *Ex parte Gavin*. If the examiner's rejection relies, in whole or in part, upon an abstract and the underlying reference is in foreign language, the applicant should consider requesting the examiner to provide an adequate translation of the underlying reference, and petitioning if the examiner denies the request. Hopefully a balance will be struck by virtue of these decisions in assuring a sharing of the translation obligations, and associated costs, between applicants and the Patent Office. In any event, examiners will doubtless be less likely to base their rejections upon only an abstract of a foreign language document.