



69 68' 69' 72 123 126 150 160 61 62 58 56 50 52 59 57 60 53 118 54 55

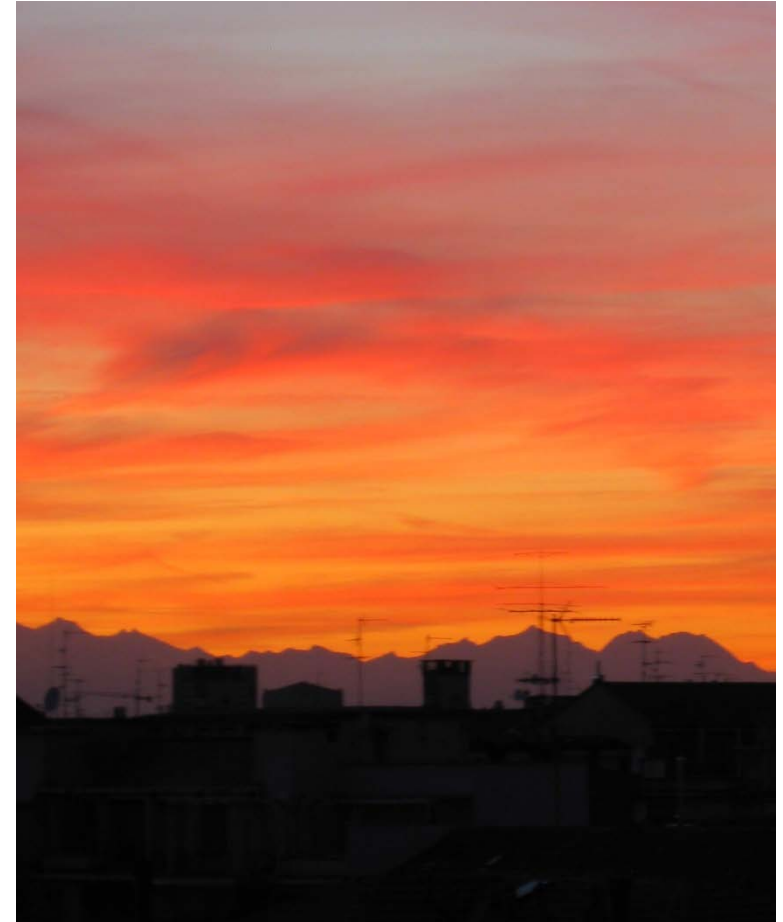
Patent Translation - An Introduction to the Legal Framework, Terminology and Opportunities Associated with Patent Rights

Eline M. E. Van De Wiele, 7th October 2011

FIG. 1

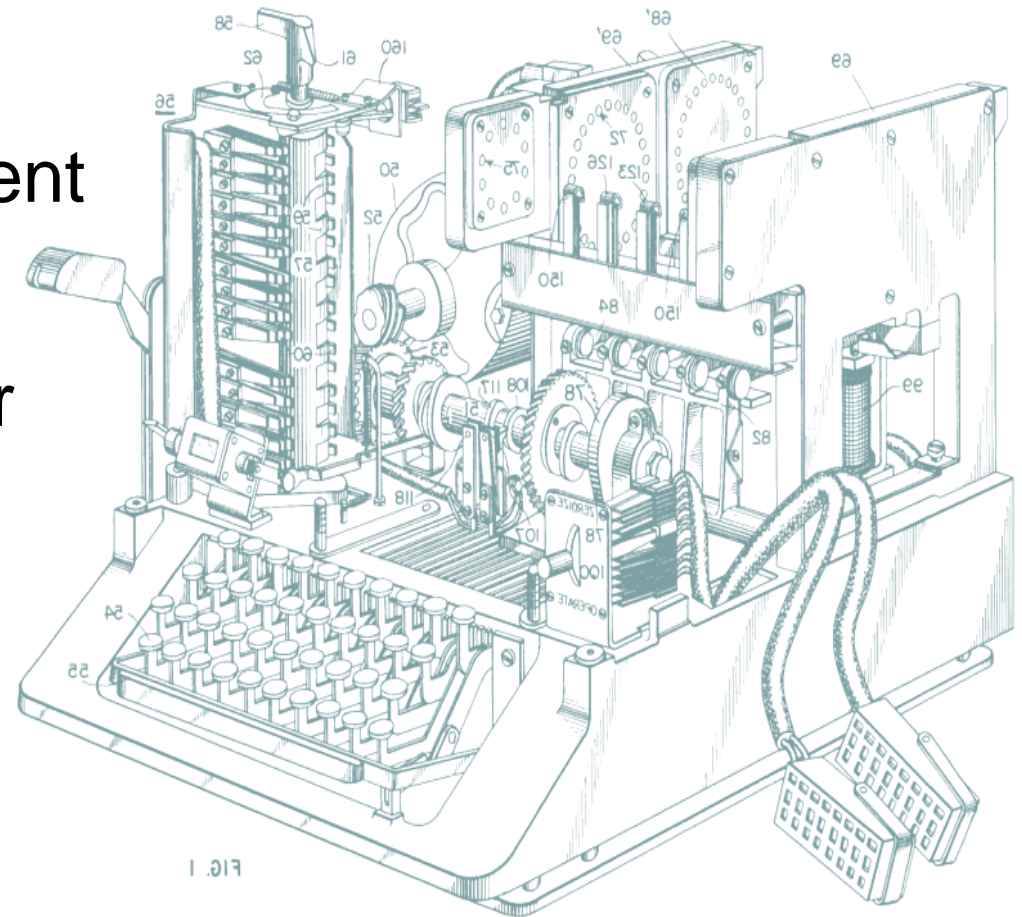
Me, me, me

- Born in Belgium, brought up in UK, worked in Japan & UK
- Freelance JP-EN and NL-EN translator based in Italy
- Qualified in linguistics, teaching, translation & physics
- In-house experience in the IP Department of SHARP lab in UK



The view from my office...

1. What is a patent?
2. How does one obtain patent rights?
3. Where does the translator come in?
4. A day in the life of...





1. What is a patent?

It is...

- A legal agreement between an inventor (or his assignee) and a state
- A publicly available description of a new invention
- A piece of property that is valid for up to 20 years
- A piece of property that can be licensed, sold, abandoned, etc.

It is not...

- A literary or artistic work
- A discovery, scientific theory or mathematical method
- A medical method
- A mental act



1. What is a patent?

It must...

- Cover technology that is:
 - » **Novel** (new)
 - » **Inventive** (non-obvious)
 - » **Industrially applicable** (useful)
- Describe the invention in full detail, so that **a person skilled in the art** may reproduce it
- Cover no more than **one inventive concept**

1. What is a patent?

It is governed by...

- National laws, in both application and enforcement
 - » National legislation is guided by international treaties
 - **Paris Convention** for the Protection of Industrial Property – 1883
 - **WTO's Trade-Related Aspects of Intellectual Property Rights Agreement (TRIPS)** – 1994
 - » Additional treaties centralise portions of the application procedure
 - **WIPO's Patent Cooperation Treaty (PCT)** – 1970

& administered by...

- National patent offices
 - » UK Intellectual Property Office (UK-IPO)
 - » United States Patent and Trademark Office (USPTO)

1. What is a patent?

It includes...

- An **Abstract**
- A **Description:**
 - » related technology
 - » the invention itself, in all its possible guises
 - » accompanying drawings
- A set of **Claims:**

“1. A method of growing a thin film, the method comprising: growing a thin film by conformal layer over a substrate having structures extending from a surface of the substrate, wherein each layer is formed over the surface of the substrate and over the structures extending from the surface of the substrate, the thickness of the conformal layer, or the sum of the thicknesses of the conformal layers, is at least half the average spacing of the structures; and wherein at least one of the length of the structures, the average spacing of the structures and the size of the smallest dimension of the structures is set so as to provide an enhanced growth rate for the or each conformal layer.”



1. What is a patent?

A closer look at a patent claim:

- A method of growing a thin film, the method comprising:
 - » growing a thin film by conformally forming at least one layer over a substrate
 - having structures extending from a surface of the substrate, whereby the or each layer is formed over the surface of the substrate and over the structures extending from the surface;
 - » wherein the thickness of the conformal layer, or the sum of the thicknesses of the conformal layers, is at least half the average spacing of the structures;
 - and wherein at least one of the length of the structures, the average spacing of the structures and the size of the smallest dimension of the structures is set so as to provide an enhanced growth rate for the or each conformal layer.”

2. How does one obtain patent rights?

Prepare the application
(specification)

File in 1 country
(1st filing)

One year
(Convention Year)

File in multiple countries
(2nd filing)

- After a **Prior Art Search**
- By a **patent attorney**

Sets the **Priority Date**

- Further development
- Watch markets
- Receive **Search Report**

- Competitors?
- Market?
- Manufacturing?
- Budget??

2. How does one obtain patent rights?

Patent is
published &
examined

Patent is
examined
again...

Notice of
Allowance

Grant &
final
publication



- **Examination Report or Office Action**
- Inventor (attorney) response



- Last chance to file a **divisional application**
- Appeal in case of failure

2. How does one obtain patent rights?

Pay Maintenance Fees

Up to 20 years
from
Priority Date

- Earn **licensing revenue**
- Pursue others for **infringement**
- Defend against **invalidation**

2. How does one obtain patent rights?

A few points to remember:

- Patents are **territorial rights**, but portions of the application can be done at:
 - » the **European Patent Office**
 - file 1 application, go through examination
 - **ratify** in individual countries upon grant
 - » the **World Intellectual Property Organisation (under PCT)**
 - file at a receiving office
 - receive an **International Search Report & Preliminary Examination Report**
 - file in individual members states depending on outcome



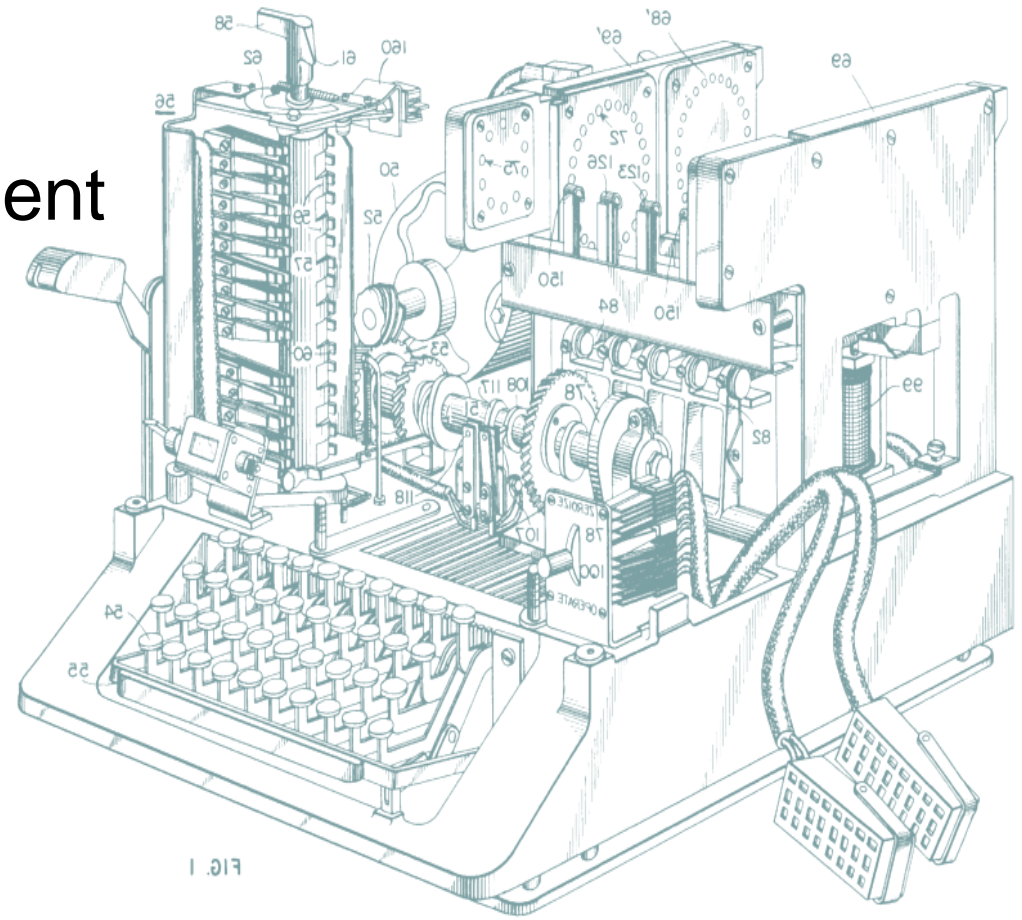
2. How does one obtain patent rights?

A few points to remember (cont.):

- The guidelines issued by WTO etc. can be interpreted very differently
- Military inventions → often subject to separate regulations

Contents

1. What is a patent?
2. How does one obtain patent rights?
3. Where does the translator come in?
4. A day in the life of...



3. Where does the translator come in?

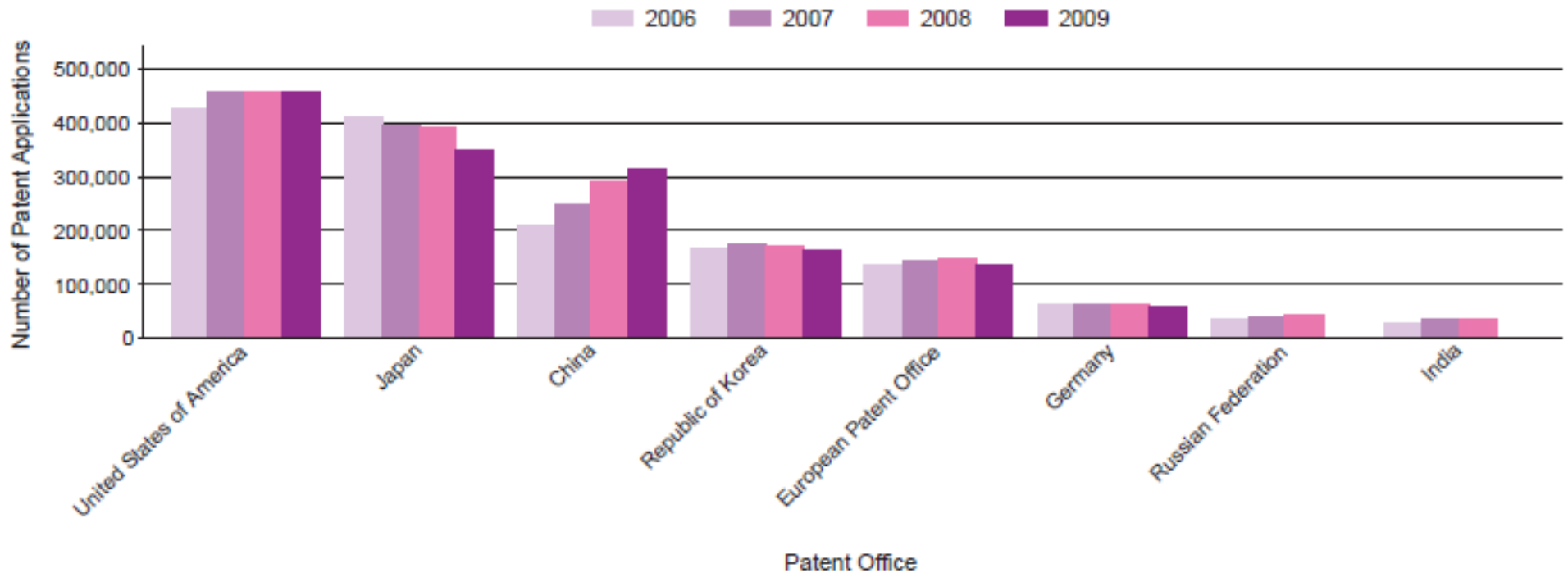
First, some statistics...

- 2008: ca. 6.7 million patents in force
- Most popular fields of technology
 - » electrical & electronic engineering
 - » chemistry (incl. pharmaceutical)
 - » mechanical engineering
- Fastest growing area: energy-related technologies
- Biggest spenders:
 - » Republic of Korea
 - » US
 - » Japan

3. Where does the translator come in?

...and languages

Figure 9: Patent applications by patent office: selected offices



Source: WIPO Statistics Database, June 2010

3. Where does the translator come in?

Translation 'for information'

- Prior Art
 - » older patents
 - » research papers, etc.

Translation 'for filing'

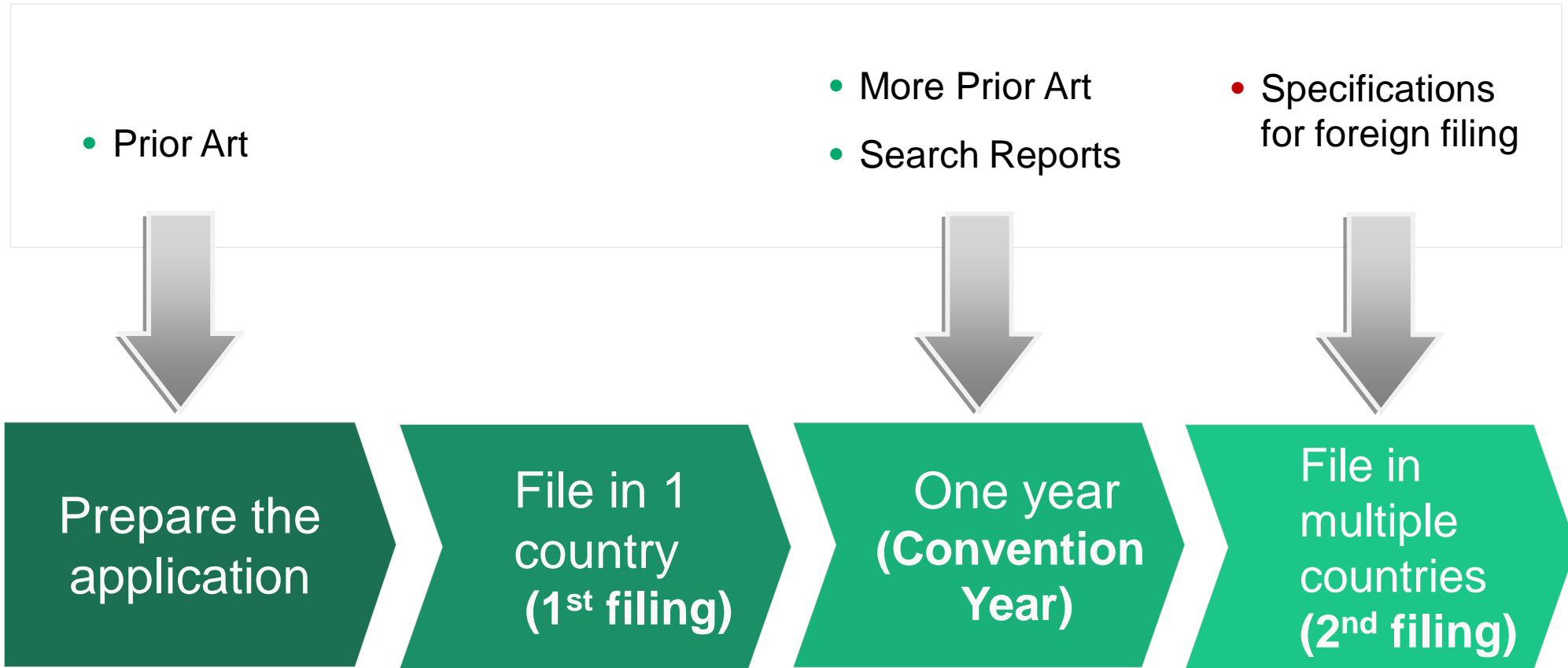
- Foreign Filing Specification

Requires joint translator-attorney effort

Translation 'for legal purposes'

- Patent Office reports
 - » PCT: FR, DE, ES, PT, CN, JP, KR, RU -> EN
- Office Actions/Examinations
- Evidence for litigation

3. Where does the translator come in?



3. Where does the translator come in?

- Yet more Prior Art
- Exam Reports
- Responses

- Final copy

Patent is published & examined

Patent is examined again...

Notice of Allowance

Grant & final publication

3. Where does the translator come in?

- Yet more Prior Art
- Product descriptions, specifications
- Internal reports, emails, etc.



Pay Maintenance Fees

Up to 20 years
from
Priority Date

3. Where does the translator come in?

Possible clients:

- Patent Attorney firms
- Translation Agencies
 - » ones that specialise in IP

- Corporate IP departments
- Individual inventors

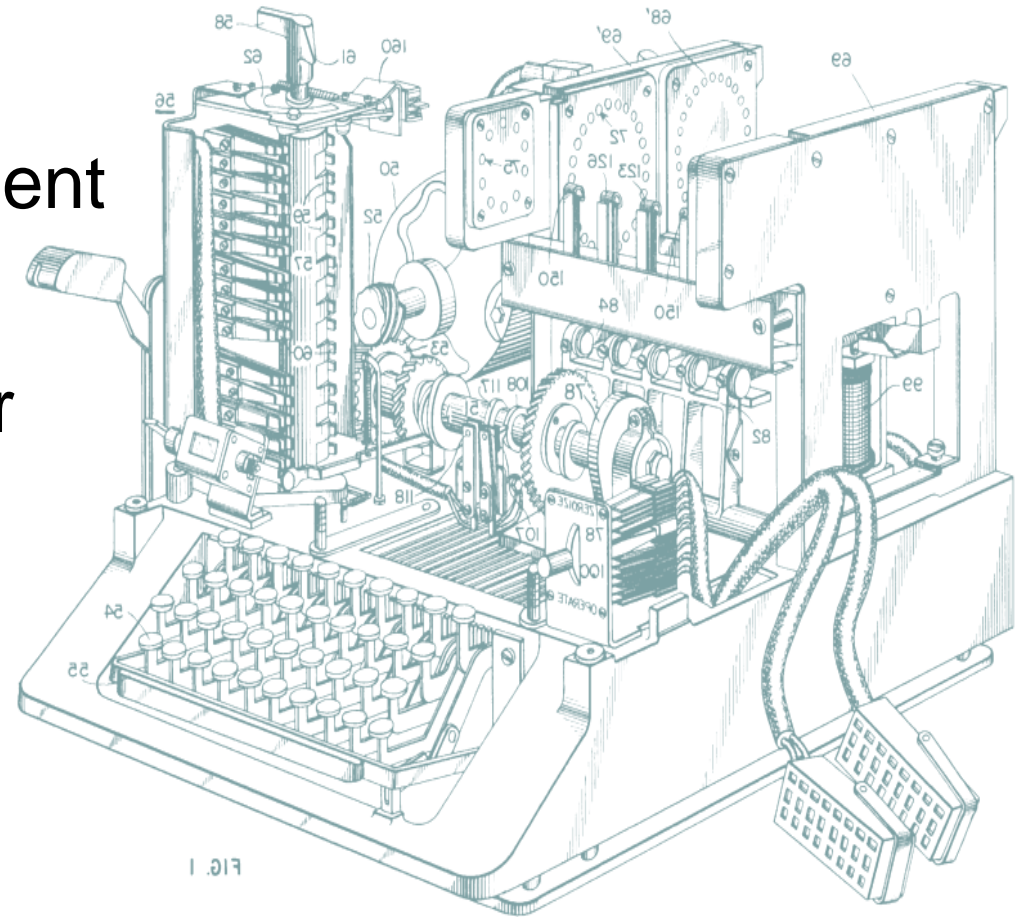
WARNING!

Beware “for filing” requests

Beware ... Everything!

Contents

1. What is a patent?
2. How does one obtain patent rights?
3. Where does the translator come in?
4. A day in the life of...



4. A day in the life of...

Patent translation challenges:

- Linguistic challenges
 - » Degree of 'literalness'
 - » Fitting long, complex structures into TL grammar
 - » Finding equivalents for new concepts
- Keeping up with change
 - » Shifts in filing trends
 - » Shifts in technology focus

4. A day in the life of...

Patent translation challenges (cont.):

- Financial pressures
 - » London Agreement (1 May 2008) - aims to reduce translation costs of EPO patent **by ca. 50%**
 - » Decline in overseas filings due to recession
 - » Increased use of Machine Translation

Thank you for your attention

- Any questions?

(a list of further reading & useful links is included on the conference CD)

-
- eme.vandewiele@jadelanguagesolutions.com
 - www.jadelanguagesolutions.com
-