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## Article

### Patent translation – An important aspect of patent protection

By Prashant Phillips & Manish Singh

Incredible growth of businesses and advancement in technology in recent times has expanded the horizons of the patent landscape, which now cuts across international boundaries. This growth has transformed a seemingly small focus area related to patents – patent translation - into an area which is now considered as very important by both patent authorities as well as patent practitioners, everywhere.

Translation as an activity is most important at the time of preparation of a patent for filing, in jurisdictions which have strict filing language requirements. A patent document is akin to a legal instrument and is therefore required to be drafted with great precision and accuracy<sup>1</sup>. Consequently, translation of patent related documents also plays an essential role in litigation, especially in cases where a patent is being invalidated based on prior art references in languages different from the patent under consideration.

#### Patent translations during patent preparation

The importance of patent translation may arise as a result of statutory requirements. The basis of such requirements stems from the fact that priority from a first filing can be claimed at the time of subsequent filings, as per the Paris Convention. However, to ensure that the subject matter claimed in subsequent filings is within the scope of the priority application, the priority document may have to be relied on. In cases where the priority document is in a language other than the local language where the subsequent filing is sought, a translated version

of the priority document would also be required.

Various patent authorities mandate that a patent specification should be filed in their local language. Even in cases where the patent authorities allow filing patent specifications in English, if the priority application is in a foreign language, such patent offices require that a verified translation also be submitted.

#### Statutory basis for submitting translations

##### India

Rule 20 of the Patent Rules requires that in cases where the international application is not in English, an application for a patent in India has to be accompanied with an English language translation. A similar requirement<sup>2</sup> also exists in relation to priority documents in a non-English language, which mandates that the English language translation be submitted within the prescribed time limits. The implications of non-compliance are severe as the Patent Office can disregard the priority claim of the applicant.

##### Europe

The present system under the European Patent Convention requires a European patent granted by the European Patent Office (EPO), to be validated by each of the contracting states in which the applicant seeks patent protection<sup>3</sup>. This particularly requires the applicant to submit the local language translation of the complete specification. Independent of this requirement, the translation of the claims in the official languages other than the language in

<sup>1</sup> *Topliff v. Topliff*, 145 U.S. 156

<sup>2</sup> Rule 21 of the Patent Rules

<sup>3</sup> Article 65 of the European Patent Convention (EPC)

which the claim was originally filed also has to be submitted with the EPO<sup>4</sup>.

### United States

Similar to the requirements as prevailing in India, the USPTO also requires an English language translation of international application<sup>5</sup>. Failure to comply with this requirement (amongst others) within the prescribed time period will result in the national phase application being regarded as abandoned. However, it is to be noted that in case the applicant fails to submit the translation, he can request the Director of USPTO to condone such failure provided the applicant is able to establish that such failure was unavoidable<sup>6</sup>.

### Importance of translation

Any patent related right imposes an obligation on an applicant to disclose the manner in which the claimed subject matter can be worked. More importantly, almost all jurisdictions also require that the claims clearly identify the true scope of the subject matter being claimed. In the event a translation of the patent specification is required, the translation should be done as precisely as possible so as not to deviate from the scope of the subject matter claimed in earlier filing(s). Inaccurate or poor translations of the patent specification can render the patent unenforceable, thereby seriously prejudicing the rights of the applicants.

Making accurate and true translations, which aim to do justice to the claimed subject matter, is a time intensive task. In cases where accurate translations are required, the applicant should factor the same into their timelines, especially if they are planning to enter different jurisdictions through the convention route. The time taken for translation will also depend on the complexity of the technology.

The more complex the technology, the longer the time spent on translating the patent specification.

Translation of patent documents is a skill requiring expertise both in technology and the languages concerned. Considering the implications of inaccurate translation, good translation skills are highly valued across the industry.

### Patent translation in other areas

Translation requirements are not limited to patent preparations only. Projects related to prior art search, freedom-to-operate analysis, etc., may also require patents to be translated. Even in such situations, the translations have to be as accurate as possible to precisely determine whether the documents being researched are pertinent or not. The scope of such translation activities may range from translating only the abstract to determine whether a given document is relevant or not, to translating the entire patent document.

Translation can also play a vital role in patent litigation. Such litigations may involve the need to translate several documents, as quickly and precisely as possible. The translated documents may be admissible as evidence and can form the basis on which the outcome of such disputes will depend.

Ideally in such cases, translations would be considered as issues relating to facts, and be finalized and agreed upon by parties to the dispute as early as possible. On the agreed basis the trial can then proceed. This issue was highlighted in a case decided by the English and Wales Court of Appeal in the case of *Gemstar*<sup>7</sup>. In this case, the issue revolved around a patent reference in Japanese. The Court making its ruling stated that issues which are based on translations should be resolved

<sup>4</sup> Rule 71(3) of the EPC

<sup>5</sup> 35 U.S.C. § 371(c)(2)

<sup>6</sup> 35 U.S.C. § 371(d)

<sup>7</sup> *Gemstar Tvguide International Inc & Others v. Virgin Media Ltd & Another* - [2011] EWCA Civ 302

and agreed upon as early as possible. Moving ahead, the Court further stated that for deciding the dispute the translated document itself would be the basis for constructing the true scope of the subject matter being claimed. It was further stated that when considering the translated document the Court would be responsible for the *question of construction*<sup>8</sup>.

### **Translations entail additional expenditure**

Translation is considered to be one of the significant cost-components for securing patent rights in any jurisdiction<sup>9</sup>. Furthermore, various requirements laid down by the EPO also require that translated version of the granted claims be provided to the EPO. This additionally induces a cost on the applicant. The costs get further compounded if the applicant seeks patent protection in other contracting states of the EP, as the applicant would be under an obligation to provide the translated specification to the respective member states.

### **Developments and recent changes**

Various regulations are being updated so as to ease the costs related to translation. Furthermore, different jurisdictions are also providing online tools which provide translation facilities. For example, a recent collaboration between EPO and Google has resulted in a service – Patent Translate<sup>10</sup>. The online tool enables translation from and to English and other languages which include French, German, Spanish, Italian, Portuguese and Swedish, covering approximately a

vast majority of all patents issued in Europe. The collaboration seeks implementing translation services allowing translation of patents from and into all 28 languages of the EPO member states, as well as Chinese, Japanese, Korean and Russian.

Although this step may not have a direct impact for applicants seeking to ensure patent protection in different jurisdictions, it clearly does make the patent references in other languages largely accessible for other activities such as prior art search, invalidation analysis and FTO analysis.

### **Conclusion**

Translation is certainly one of the more important and perhaps one of the less publicized aspects of patent protection. The importance of this activity is realized by both the patent practitioner who is now providing only translation related services, as well as by patent offices around the world. It is true that translation can be heavy on the pocket, but this financial burden is outweighed by the prospects of the end result, i.e. balanced and secure patent protection.

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<sup>8</sup> [2011] EWCA Civ 302, para 11-12

<sup>9</sup> How much do patents cost? [[http://www.wipo.int/sme/en/faq/pat\\_faqs\\_q2.html](http://www.wipo.int/sme/en/faq/pat_faqs_q2.html)]

<sup>10</sup> EPO Website - EPO and Google remove language barriers from patent documentation [<http://www.epo.org/news-issues/news/2012/20120229.html>]

## STATUTORY UPDATE

### Copyright (Amendment) Act, 2012 comes into force

Amendments to the Indian copyright law have come to force. The Copyright (Amendment) Act, 2012 received the Presidential assent on 8th June, 2012 and it was notified on 21st June, 2012. New Section 31B has been inserted providing for issuance of compulsory license for the benefit of the disabled. Section 38 has been amended and new Sections 38A and 38B have been inserted to confer exclusive rights to performers without prejudice to rights of authors, to make sound recording or visual recording of a performance and to broadcast and communicate to the public except when perfor-

mance is already broadcast. Another highlight is the introduction of protection of technological measures by inserting new Sections 65A and 65B. They provide for punishing any person who circumvents a technological measure with the intention of infringing rights conferred under the Act or knowingly removes or alters any Rights Management Information (RMI). RMI includes the title or other information identifying the work or performance, name of the author or performer and terms and conditions regarding use of the rights.

## NEWS NUGGETS

### European Parliament rejects ACTA

On the 4th of this month, the European Parliament voted against the Anti-Counterfeit Trade Agreement. The rejection has come as a relief to those who have been vehemently opposing the controversial agreement. The series of protests from Poland to Bulgaria, Czech Republic and many other European nations was one of the main reasons behind the EU Parliament rejecting the Agreement by a clear majority (478 to 39). With the European Union's rejection, the future of this agreement looks bleak. The Trans Pacific Partnership (TPP) Agreement is perceived to be similar if not more stringent than ACTA. This free trade agreement is being negotiated by the US with other nations and negotiations are likely to conclude by 2012.

### When a plain rectangle is more distinctive than a decorated bunny

Perhaps emulating the bitter taste of cocoa which yields sweet chocolate, the trademark saga

of shape and colour of chocolates is, bitter-sweet. Hershey was successful in securing its rights to the rectangular shaped bars described as 'configuration of a candy bar that consists of twelve (12) equally-sized recessed rectangular panels arranged in a four panel by three panel format with each panel having its own raised border within a large rectangle'. The Trademark Trial and Appeal Board (TTAB) found sufficient distinctiveness in the 'recessed rectangle' shape and reasoned that overall combination of elements was non-functional. Though a segmented candy bar was easy to consume and represented functionality, the applicant was entitled to register the segmented candy bar as specified.

Far across the Atlantic another chocolate maker found that the bunny-shaped chocolate with red-ribbon referred to as chocolate Easter bunnies were ineligible to be registered as a community trademark. The CJEU stated that gold foil wrappings, neckties and bell would be common place and registration in 15 member states was not sufficient proof of having acquired distinctiveness.

## RATIO DECIDENDI

### Novelty and not simplicity of invention, relevant for patentability

The Intellectual Property Appellate Board, in its order dated 12 June, 2012, revoked the patent held by respondent on the impugned water purifier system. The applicant in this case had sought revocation of the invention of Patent No.195937 titled "Filter Device" on the ground that every feature that was claimed by the inventors as its essential feature were already disclosed in prior art US '260 which was an invention for purification of liquids. The IPAB upheld this contention after discussing the prior art and held that the invention was not new, nor was there any inventive step. It also relied on another prior art EP '578 which according to IPAB, proved non-obviousness of the respondent's invention.

Narrating the facts, the order notes that in the impugned invention, water entered with the gravitational force down the hollow passage and met the filter material at the bottom and turned upwards making a U-turn and according to the inventor and the respondent, this interplay was the invention. The IPAB held that if it was so the person skilled in the art who looks at prior arts would not find it difficult to construct such cartridge. It reasoned that the ground for holding the invention as not patentable was not its simplicity but its lack of novelty as seen from prior art. It held that from the prior art any person skilled in the art would have constructed the invention and hence the invention was anticipated and obvious and the patent was liable to be revoked.

Further, the Tribunal found that the applicant

had violated Section 8 of Patent Act by not fully disclosing foreign filing information. Statement regarding an application filed in Great Britain as pending when it was terminated, was held as incorrect. The International Preliminary Examination Report (IPER) had held against the respondent on novelty, inventive step and industrial applicability and the same was not submitted by the respondent. Therefore, the IPAB held that the patent was liable to be revoked for non-compliance with Sections 8(1) and 8(2) [*Tata Chemicals Ltd. v. Hindustan Lever Ltd.*, IPAB Order No. 166 of 2012 dated 12-6-2012].

### Trademark should not be descriptive nor refer to geographical origin of services

The IPAB upheld the order of Deputy Registrar of Trade Marks refusing registration of 'American Gem Society Laboratories' and 'Setting the highest grade for diamond grading'. It reasoned that the bar on geographical origin as laid down in Section 9(1)(b) of the Trade Marks Act, 1999 extended to adjectival form as well as the noun substantive and hence, the word 'American' is ineligible for registration and having been registered in other countries did not improve its case.

Descriptiveness was the ground for refusal to register 'Setting the highest grade for diamond grading'. Upholding the Deputy Registrar's order, the IPAB stated that though there were instances of slogans and taglines like 'Make your prayer truly divine' (for incense stick) being accepted earlier, it depended on facts of the case. In the instant case, it was merely descriptive and laudatory [*American Gem Society Laboratories LLC v. The Deputy Registrar of Trade Marks*, IPAB order dated 8-6-2012].

## Exhaustion of distribution rights and resale of computer program

The European Court of Justice has recently held that the copyright holder of the computer program cannot object to resale of copy of the program for which his distribution rights are exhausted. It was observed that downloading a copy of a computer program and the conclusion of a user licence agreement for that copy which form an indivisible whole, involve transfer of right of ownership of the computer program and it makes no difference, whether the copy of the computer program was made available to the customer by the right-holder by means of a download from the right-holder's website or by means of a material medium such as a CD-ROM or DVD. The court held that there is exhaustion of the right of distribution of the copyright holder even if the program downloaded is subsequently corrected or updated by the copyright holder under a maintenance agreement.

It was held that notwithstanding the existence of contractual terms prohibiting further transfer, the right-holder can no longer oppose the resale of that copy and that a second acquirer of the copy and any subsequent acquirers are 'lawful acquirers' within the meaning of the provisions.

The order came in a case concerning resale of used software of a software major by another company who acquires such used licenses for resale. It was however observed by the court that before such resale, the original acquirer of the copy of the computer program must make the copy downloaded in his computer unusable and that he is not authorised to divide the licence and resell only the user right corresponding to a number of users as determined by him if the licence relates to a greater number of users than he needs. [*Usedsoft GmbH v. Oracle International Corp.*—European Court of Justice (Grand Chamber) order dated 3-7-2012 in C-128/11].

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