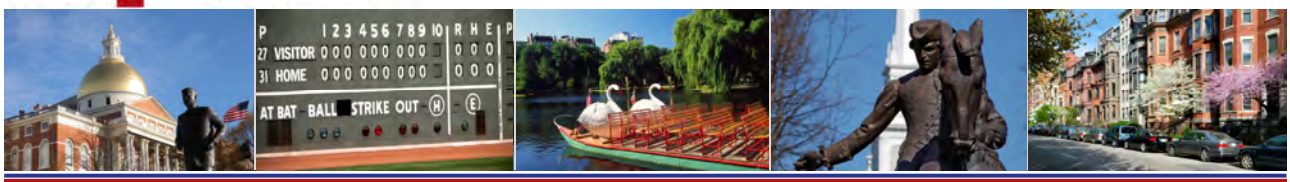
BOSTON PATENT LAW ASSOCIATION NEWSLETTER

BOSTON PATENT LAW ASSOCIATION



Summer 2010 | EDUCATION, SERVICE, COMMUNITY | Volume 41, Issue 3

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Upcoming Events

Monday, Sept. 27
USPTO Road Show

Thursday, Sept. 30
Member Networking and Cocktail Social

Tuesday, Nov. 4 - Wednesday, Nov. 5

Advanced PCT Seminar

President's Message

The Boston Patent Law Association continues to provide members with a variety of programs and functions – despite our hot summer! The Judges Dinner this year was held on June 4th and over 200 members and guests attended the event. The evening began with a cocktail reception held outside on the waterfront at the John Joseph Moakley United States Courthouse. We moved indoors for dinner, where our keynote speaker, Tyler "Dr. Vino" Colman, introduced the wine pairing to complement each course. Colman presented on "Wine Politics: How Governments, Environmentalists, Mobsters, and Critics Influence the Wines We Drink," which is the title of his first book published in July 2008. I had the privilege to present this year's BPLA Distinguished Public Service Award to the Honorable Rya W. Zobel for her significant involvement in a number of patent cases, as well as her involvement with the Federal Judicial Center, which provides training for new judges and CLEs for sitting judges. Judge Zobel graciously accepted the award, and entertained us with a "claim" reciting the key components of the plaque we awarded to her.

The BPLA Summer Outing was held at Fenway Park on Friday, July 16th when the Boston Red Sox took on the Texas Rangers. The BPLA was well represented in the 300 bleacher seats we were able to secure. The weather was extremely hot until a sudden rain shower cooled us off and caused a game delay.

President Lisa Adams

Unfortunately, the game ended with the Rangers beating the Red Sox 8-4. But despite the loss, it was an exciting evening as Bengie Molina became the eighth player and first catcher since 1900 to hit for the cycle, even managing a grand slam.

As you may recall, back in April the Amicus Committee filed an amicus brief in the appeal of *Ex Parte Bilski*. The Supreme Court handed down a decision on June 28, 2010 rejecting the machine-or-transformation test as the sole test of process patent eligibility based on an interpretation of the language of §101. In the decision, Justice Kennedy cites to the BPLA amicus brief, which explained that the machine-or-transformation test would create uncertainty as to the patentability of software, advanced diagnostic medicine techniques, and inventions based on linear programming, data

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Presidents Message Continued
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compression, and the manipulation of digital signals. *See Ex Parte Bilski*, 561 U.S.___, p. 9 (2010).

The Amicus Committee of the BPLA also recently filed an amicus brief in the appeal of *Therasense, Inc. v. Becton, Dickinson and Co.* and *Nova Biomedical Corp. and Bayer Healthcare LLC*, which is scheduled to be heard by the Federal Circuit Court of Appeals *en banc* in November 2010. Timothy D. Johnston and Rory P. Pheiffer, both of Nutter McClennen & Fish LLP, served as counsel on the *amicus* brief. Erik P. Belt and Robert M. Abrahamsen, co-chairs of the BPLA Amicus Committee, and Derek P. Roller, Andrew W. Schultz, and Michael P. Visconti, all attorneys at Nutter McClennen & Fish, as well as Joshua Matt, also contributed to the brief.

The BPLA also recently announced the *Invented Here!* Program, which was jointly developed by the BPLA and the Museum of Science (MoS). Past-President Mark Solomon and the New Lawyers and Law Students Committee have been working closely with the MoS over the past year to rekindle the relationship the BPLA and the MoS enjoyed in the late '80's and early '90's with the Inventors Weekend Program. The new Program, the Invented Here! Program, is expected to be an annual recognition event that honors New England's newest and most innovative technologies. The honorees will advance a MoS mission of playing a leading role in transforming the nation's relationship with science and technology and will advance the BPLA's missions of Education, Service and Community. The innovative technologies are expected to shape the way people interact with each other and the world around them, fulfill important individual and/or social needs in novel ways, educate and inspire students both in the classroom and outside of school-time, or ensure a more sustainable future for our environment. More information about the program can be found on our website.

The Contested Matters Committee, co-chaired by Susan Glovsky of Hamilton, Brook, Smith & Reynolds, Michael McGurk of Finnegan, Henderson, Farabow, Garrett & Dunner, and Donna Meuth of Eiasi Inc., welcomed Chief Administrative Patent Judge Michael R. Fleming as the guest speaker for the Board of Patent Appeals and Interferences – State of the Board held on June 7, 2010. Chief Judge Fleming provided a presentation on the State of the Board and New Board Initiatives, along with a brief update on Patent Reform as it applies to the Board.

The Litigation Committee, co-chaired by Martin O'Donnell of Cesari and McKenna, and Douglas Doskocil of Goodwin Procter, organized an event held on June 15, 2010 entitled "Engaging Your Patent Jury," which featured the Honorable William G. Young. Judge Young gave guidance on how the bench would like litigators to handle jury trials to minimize juror confusion.

We have a full schedule of events in store for the fall as well. Please keep your eyes out for a member social that we are planning for late September. We will also host the annual USPTO Road Show on September 27th, and an announcement with be sent out shortly. Our annual PCT Seminar will be held on November 4th and 5th at the Holiday Inn Boston at Beacon Hill. As a reminder, you can register for all events on our website.

Please continue to check out our calendar of events on the website, where upcoming events are featured.

I encourage each of you to remain actively involved with the BPLA, and to reach out to the Board of Governors and the Committee Chairs with any comments or suggestions.◇

We would like to thank our accountants for providing the BPLA with outstanding service over the years

BPLA's Influence Seen in *Bilski* Decision

The Boston Patent Law Association has been making the voices of its members heard on patent and other intellectual property controversies by contributing two to three *amicus curiae* briefs to trial and appellate courts each year. As the BPLA has become more vocal, the courts have started to listen. Most recently, Justice Kennedy cited to the BPLA's *amicus* brief in *Bilski v. Kappos*, which left open the possibility that business methods can qualify as patentable subject matter under 35 U.S.C. § 101 (the threshold provision of patent law, governing what subject matter is eligible for patent protection).

A major theme of the BPLA's *amicus* briefs in *Bilski* and in other cases has been the importance of patents to innovation and the American economy. A subset of that theme is that the nature of innovation has changed since the patent laws were originally drafted by Thomas Jefferson and that patent law must be read to accommodate that change. The original patent laws were drafted in an age when the state of the art involved gears and cogs and springs. Now, state of the art involves amino acid sequences and data packets and information. If the patent laws cannot be read to accommodate innovations in emerging technologies, particularly those in biotechnology and digital communications, then innovation will stall and the economy will suffer.

Justice Kennedy relied on this theme in crafting the Supreme Court's *Bilski* opinion. Indeed, the three most important words of that opinion may be "But times change." *Bilski v. Kappos*, 177 L. Ed. 2d 792, 803 (2010). In keeping with that spirit, the opinion goes on to interpret § 101 as a "dynamic provision designed to encompass new and unforeseen inventions." *Id.* (citation omitted).

The question then became whether the test of patent eligibility that the Federal Circuit applied was proper under § 101. In an appeal from the United States Patent & Trademark Office's rejection of certain business method claims, the Federal Circuit applied the so-called "machine-or-transformation" test. The BPLA's concern was that this test is a relic of the Industrial Age of the 19th Century and thus could be used to reject patents on emerging technologies, such as medical diagnostics and computer-related inventions.

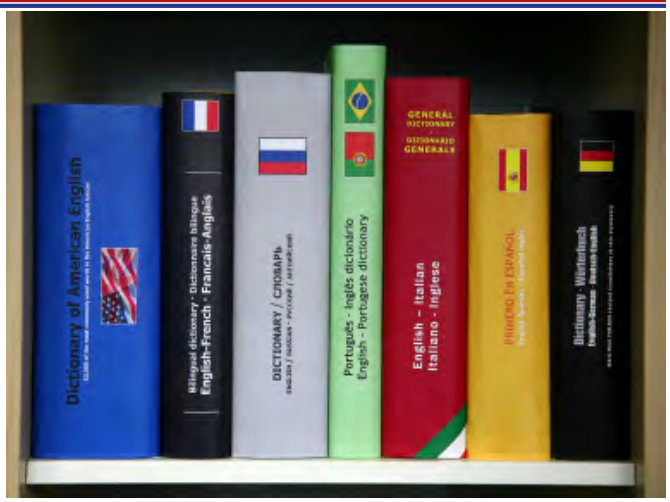
Relying explicitly on the BPLA's *amicus brief*, among others, Justice Kennedy signaled the Court's willingness to protect innovation in emerging technologies:

> The machine-or-transformation test may well provide a sufficient basis for evaluating processes similar to those [**20] in the Industrial Age -- for example, inventions grounded in a physical or other tangible form. But there are reasons to doubt whether the test should be the sole criterion for determining the patentability of inventions in the Information Age. As numerous *amicus* briefs argue, the machine-or-transformation test would create uncertainty as to the patentability of software, advanced diagnostic medicine techniques, and inventions based on linear programming, data compression, and the manipulation of digital signals. See, *e.g.*, Brief for Business Software Alliance 24-25; Brief for Biotechnology Industry Organization et al. 14-27; Brief for Boston Patent Law Association 8-15; Brief for Houston Intellectual Property Law Association 17-22; Brief for Dolby Labs., Inc., et al. 9-10.

Id. at 803.

The BPLA hopes to have more influence on pressing matters of intellectual property law. If you become aware of *amicus* opportunities, please bring them to the attention of the Amicus Committee Co-Chairs, Erik Belt of McCarter & English LLP and Bob Abrahamsen of Wolf Greenfield & Sack, P.C.◇

Accuracy in Patent Translation



By Bruce D. Popp, Ph.D., American Translators Association Certified Translator for French and English

Introduction

Accuracy is essential to a patent translation. An inaccurate translation which is not recognized as such can have serious consequences for the patent practitioner or the inventor. The consequences can even be so severe as to lead to loss of patent right or enforceability. A better understanding of what is involved in translation helps make it clear that it is a demanding intellectual activity requiring excellent reading comprehension in the language of the original document, knowledge of the technical subject matter of the document, and good writing and editing skills in the language of the translation. A skillful translator brings all these elements together.

This article starts with an example of an error in the translation of a patent application from Japanese into English and the significant effort involved in getting the error corrected. The matter was finally decided by the Court of Customs and Patent Appeals (*In re Oda*).

The article then provides a simplified example of a translation of one sentence. There are many reasonable translations of this one simple sentence. Beyond the paramount issue of accuracy, important factors include: clarity, writing style, and readability. These factors will generally be clear to the reader. The differences between the examples shown relate to these factors. While necessary, good writing style is not sufficient for obtaining or recognizing a quality translation because a translation error could have been introduced when the original document was misunderstood or its meaning distorted.

This discussion provides some insight into what is needed to get an accurate translation. Finding the right translator is important, and consideration needs to be given to qualification, specialization, and subject matter. A good translator can provide more than just an accurate patent translation: working with a translator can provide more information about the patent, including errors in the foreign patent, and understanding of patent process in the other country.

What's at Stake?

To err is human, and humans preparing, prosecuting, and translating patents all err occasionally. The severity of errors can range from minor grammatical or punctuation errors that are hardly worthy of note; through more serious errors that may need to be corrected and require a certificate of correction or even a reissue in order to correct them; to the most serious errors, which cannot be corrected and are prejudicial to the enforceability and value of the patent. The time, effort, and cost to correct an error (and the injury if the error cannot be corrected or is unrecognized) increases dramatically along this range.

In re Oda (443 F.2d 1200; decided by CCPA July 1, 1971) arose from an effort to correct a translation error present in an issued patent. The patent claimed three organic dyes that could be used in a printing process. The error involved the name of a chemical used in the synthesis of the dyes. Because of the error in the chemical name, the description of the process for synthesis of the dye was insufficient and consequently there was a risk that the patent would be found invalid and unenforceable.

The US patent application was based on the translation into English of the Japanese patent application from which priority was claimed. In the US application as filed (which included the translation error), one step in the synthesis of the organic dye involves a nitration reaction in the presence of nitrous acid and sulfuric acid. The US application referred to nitrous acid six times. The correct translation was nitric acid, not nitrous acid, and that was the error that needed correction. Nitric acid, H_2NO_3, is a common laboratory reagent and strong acid. Nitrous acid, HNO_2, is less common—it decomposes rapidly—and a weak acid.

To correct the error, a reissue application was filed. The reissue application was rejected by the examiner, and the rejection was

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Accuracy in Patent Translation
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sustained by the Board of Patent Appeals and Interferences. The issue in case was whether the change from nitrous acid to nitric acid to correct the error in the reissue application introduced new matter not present in the original application as filed. The examiner and the BPAI held that correcting the error did introduce new matter. On appeal, the CCPA found that, since affidavit evidence had been provided showing that the error and its correction would be obvious to a person skilled in the art, new matter had not been introduced. The decision is cited often for what it says about new matter.

At a practical level this illustrates the time, effort and expense that can be incurred when attempting to correct an error in a patent.

Although the above example deals with a US application based on translation of a Japanese application, it should be noted that errors in translations of other documents could have serious consequences. A translation error in a foreign patent or non-patent literature could, for example, lead to a flawed understanding of the prior art with consequences for the assessment of the novelty and obviousness of a client's invention.

A partial defense against errors in translations to be filed as US patent applications, is to incorporate by reference the foreign application, either explicitly or through a claim under 37 CFR 1.55 for priority of a prior-filed foreign application. This incorporation by reference would then provide a route for introducing material from the foreign application into the US application to correct omitted or incorrectly translated material without raising questions about new matter. The issue of whether there was deceptive intent would still need to be addressed.

Incorporating the foreign patent by reference does not resolve the challenge of identifying the omission or other translation error and supplying and justifying the correction. Perhaps more difficult, the omission or other translation error must still be identified and the correction supplied and justified.

A better approach, with broader scope and lower-cost, is to avoid or at least find the translation error before it makes its way into an application or other documents filed with the USPTO. To help you avoid translation errors, the remainder of the article will discuss what is involved in translation, how errors in translations can be assessed and understood, and how to get accurate translations that meet your needs.

What Does Translation Involve?

To help you understand what is involved in translation, I'd like to start with an example of a simple, famous French sentence. Since many people take French in high school, I hope this is a good language for an example. The sentence is from *Le petit prince* by Antoine de Saint-Exupery. It is, "On ne voit bien qu'avec le cœur. L'essentiel est invisible pour les yeux." The vocabulary is basic, and so is the grammar although one does need to recognize the *ne… que* negative construction.

A hypothetical high school student in a third or fourth year French class should reasonably be able to come up with "One does not see well except with the heart. The essential is invisible for the eyes." With a small improvement on this would be, "One sees clearly only with the heart. What is essential is invisible to the eyes." This offers three improvements. First, using *only* instead of *does not… except* is less literal (It's no longer an exact parallel of the French construction.) and sounds a little better in English. Second, the French adverb *bien* has a much broader range of meaning than the English word *well* so "sees clearly" is certainly well within the meaning of the French sentence and gets at what it means to see well. Third, perhaps influenced by the French preposition, the first variant says *invisible for* and is corrected to read *invisible to*.

With a professional translator one can hope for something a little better. The first thing to recognize is that the real subject of the first sentence is *the heart*. Placing it at the end of the sentence is effective in French, but in order to receive its proper emphasis and attention in English it really needs to be near the beginning of the sentence. The next objection is that in normal spoken English, *one* is not normally used as a pronoun for an unspecified individual; that use is normally reserved for more formal written language and in fact I used it that way two paragraphs ago. Then there is the handling of *L'essentiel* which has left something behind in becoming *The essential*. This is a harder issue to deal with satisfactorily. With those considerations in mind, the sentences can beneficially be rewritten as, "Only the heart sees clearly. What matters on the inside is invisible to the eyes."

In translating, three key intellectual skills are used. The first is good reading comprehension of the source document -- the document to be translated. For documents about complex subject matters, such as quantum well lasers or existential philosophy, knowledge of the subject matter and its specific vocabulary is essential to reading comprehension. This is why the importance of finding a translator with both linguistic skills and subject matter knowledge should not be overlooked.

Skipping over the middle, the third skill is good writing in the target language – the language into which the document is being translated. As people experienced with preparing patent applications and writing briefs, you certainly know firsthand the value of good writing skills. Writing skills are

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