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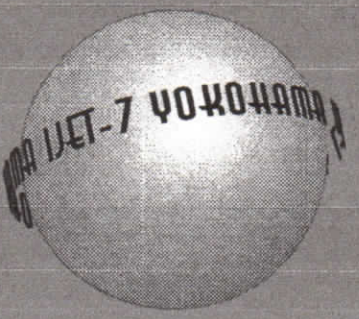


# *proceedings*

# Japanese-English Translation of Patent Documents for Filing in the US

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***Abstract:*** *Japanese-to-English patent translators often talk of differences between translating Japanese patent documents for information—usually at the behest of the reader—and translating them to produce usable filing documents—usually at the behest of the inventor or the drafter of the Japanese specification. Seldom, however, have the requirements of the latter task been treated on a level that could provide, in an organized fashion, practical information for a translator faced with the job of turning a Japanese patent document, fresh from the desk of a* benrishi, *into a usable English document conforming, for example, to US practice with regard to both style and structure. Patent style methodology and mythology are discussed in light of the style used in US patents, and practical guidelines are provided, calling on numerous examples from practice, including not only pairs of published Japanese and US patent documents for the same inventions, but also examples of the Japanese patent styles which are presented to the translator by Japanese patent/law offices in Japan.*

## INTRODUCTION

My presentation will be directed at J-E translators working with Japanese patent documents that need transformation into a form usable in filing for a patent in the US. While most of this work is ordered and done in Japan at present, J-E translators patent translators in the US might be doing more of this kind of work as some of the work shifts to off-shore providers.

### Purposes

- To examine some myths with regard to patent style
- To examine style as found in existing patent documents
- To provide the translator faced with the task of preparing usable US patent documents for filing with substantial guidelines, and in the process to make some decisions with regard to style, based on actually acceptable practice.

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***William Lise*** *served as a language specialist for the USN in Japan from 1966 to 1968. After obtaining a BSEE degree and spending a brief period in the US, working in fiber optics research, he joined an electronic measuring instrument firm for the purpose of establishing and managing its branch in Japan. The year 1979 saw a radical career move into full-time translation. His current translation work is focused on production of English patent specifications for overseas filing from Japan, this activity providing useful synergy with his study for the patent bar in the US.*

**Scope**

- Japanese patent style and US patent style as they affect the J-E translation process
- Structure, in terms of sections, headings, as well as aspects such as the much-vaunted one-sentence rule.
- Style, including some surprises from actual US patents
- Terminology

**Disclaimer About Differing Requirements**

It is common to hear people say that for-information translation, the type mostly done in the US, should follow the style of the original, including usage of such distinctly Japanese expressions as "characterized by," an expression that almost no patent practitioners in the US would use. This "follow-the-original-style" advice is commonly heard even with respect to translation for filing. In translation for filing, however, following the original style could very well produce a text that is not very useful in the US. Translators might say that fixing it is the job of the US patent attorney. In Japan, however, many (all that I deal with) patent clients demand US patent style.

Although this fact of Japanese patent translation life is not easily knowable from overseas, it is quite routine in Japan for a patent attorney to have the J-E translator produce an English patent specification conforming to US patent practice. This obviously precludes translation as is, and requires the translator to have knowledge of US patent practice.

The claims in particular must claim the same invention, and to do so undergo the most radical change in their transformation to US patent style. To be able to translate the claims, therefore, one needs to be familiar not only with how Japanese claims language is interpreted in Japan but also with the language necessary to claim the same invention in accordance with the interpretation placed on US claims language. Remember, the USPTO looks only at the English, and cannot be expected to allow an invention because it was claimed properly in Japanese. Using English words to write a Japanese-style claim could cause trouble in a courtroom, where most important patents in the US eventually are evaluated. In short, the US claims serve the same purpose as, and must claim the same invention as the Japanese claims–providing, of course, that this is the understanding of the drafter of the claims. When in doubt, ask the *benrishi* (弁理士) who drafted the claims.

**Differences Between Clients**

Clients ordering J-E translation for filing in the US most often demand US patent style. This inherently rules out strict translation, although that statement alone might strike fear in the hearts of translators accustomed to translating for information only.

Some clients provide a source text that is nothing more than the patent specification as submitted to the JPO for the same invention, and require the translator to make

structural rearrangements and stylistic changes to conform to US practice; others will write a patent specification with the understanding that it will be translated, the source text being poor Japanese practice, but helping the translator not that firmly grounded in US patent style.

## MARKET CHARACTERISTICS

### Size

A report published by the USPTO indicates that Japanese inventors filed in excess of 30,000 patent applications in the US in recent years. Making fairly reasonable assumptions of 8000 words/patent, and about 240 working (translating) days per year, this equates to 1 million words of patent specification production each day to serve the demand for filing in the US.

### Shift to Off-Shore Providers

A slow shift is being seen to off-shore providers of patent translation for filing. By off-shore I refer not to Malaysia or Taiwan, but to places like San Francisco, Seattle, and New York.

An increasing awareness of the need for quality, the very small number of people who can provide that quality in Japan, and the low rates (relative to Japan) in the US are factors which encourage this shift to off-shore providers.

### Shift Away From Using Patent/Law Offices in Japan as a Go-Between

Another factor in the off-shore shift is the increasing awareness on the part of Japanese manufacturers that Japanese patent/law offices often add price but not much value to translations, and merely act as a broker for the services of a US patent attorney. Yet another is the desire of translation providers in Japan to do end runs around *benrishi* (difficult, but perhaps not impossible) in getting direct work from inventing manufacturers. A translation provider in Japan acting as a liaison between such a manufacturer in Japan and a patent attorney in the US might be able to succeed at this.

## US PATENT APPLICATION REQUIREMENTS

In recommendations made below, the following abbreviations will used in citing sources.

| | |
|---|---|
| MPEP | Manual of Patent Examining Procedure. This huge document (or rather several hundred pages thereof) is a must for a patent translator, and is easy to obtained–for free, as I will explain later. |
| 37 CFR | Title 37 - Code of Federal Regulations<br>Patents, Trademarks, and Copyrights |

The parts of a patent application are:

- Written application
- Specification
- Drawing(s) (when necessary)
- Oath by the applicant

In terms of the translation task, the specification and the accompanying drawings are virtually the only parts of the filing documentation that need consideration.

**Parts of the Specification**

- Title of the invention (MPEP 606)

  The title of the invention should be placed at the top of the first page of the specification. It should be brief but technically accurate and descriptive, preferably from two to seven words .

- Background of the invention (MPEP 608.01(c))

  The Background of the Invention ordinarily comprises two parts:

  - Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable US. patent classification definitions. The statement should be directed to the subject matter of the claimed invention
  - Description of related art:

    Paragraph(s) describing to the extent practical the state of the prior art or other information disclosed known to the applicant, including references to specific prior art or other information where appropriate. Where applicable, the problems involved in the prior art or other information disclosed which are solved by the applicant's invention should be indicated.

- Summary of the invention (MPEP 608.01(d))

  A brief summary of the invention indicating its nature and substance, which may include a statement of the object of the invention, should precede the detailed description. Such summary should, when set forth, be commensurate with the invention as claimed and any object recited should be that of the invention as claimed.

  Since the purpose of the brief summary of invention is to apprise the public, and more especially those interested in the particular art to which the invention relates, of the nature of the invention, the summary should be directed to the specific invention being claimed, in contradistinction to mere generalities which would be equally applicable to numerous preceding patents. That is, the subject matter of the

invention should be described in one or more clear, concise sentences or paragraphs. Stereotyped general statements that would fit one case as well as another serve no useful purpose and may well be required to be canceled as surplusage, and, in the absence of any illuminating statement, replaced by statements that are directly in point as applicable exclusively to the case in hand.

The brief summary, if properly written to set out the exact nature, operation, and purpose of the invention, will be of material assistance in aiding ready understanding of the patent in future searches.

- Brief description of the drawings (MPEP 608.01(f))

- Description of the Preferred embodiments (Detailed Description of the Invention) (MPEP 608.01(g))

A detailed description of the invention and drawings follows the general statement of invention and brief description of the drawings. This detailed description, must be in such particularity as to enable any person skilled in the pertinent art or science to make and use the invention without involving extensive experimentation. An applicant is ordinarily permitted to use his or her own terminology, as long as it can be understood. Necessary grammatical corrections, however, should be required by the examiner, but it must be remembered that an examination is not made for the purpose of securing grammatical perfection.

The reference characters must be properly applied, no single reference character being used for two different parts or for a given part and a modification of such part. In the latter case, the reference character, applied to the given part, with a prime affixed may advantageously be applied to the modification. Every feature specified in the claims must be illustrated, but there should be no superfluous illustrations.

Important statutory language for the translator:

> The description is a dictionary for the claims and should provide clear support or antecedent basis for all terms used in the claims.

- Claims (MPEP 601.01(i))

The specification must conclude with a claim particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention or discovery.

This says it all: the claims are the invention. This, and the fact that claim structure differs so greatly between Japan and the US, present the most difficult challenges to the J-E patent translator.

- Abstract of the disclosure

The abstract of the disclosure is added as a convenience for searching, and in no way bears on the breadth of the claimed invention. The translator should use a style that is close to that of the descriptive part of the specification, and should not use the word "said," as it is used in claims.

### Statutory Classes of Inventions

It might seem unnecessary to the translator to worry about what statutory classes of inventions exist; it is not, as will be discussed later.

- Machine or apparatus
- Process or method
- Article of manufacture
- Composition of matter

For the purpose of translation, machine or apparatus inventions and articles of manufacture inventions are very similar, but process or method inventions are quite different in terms of the elements that make up the invention as recited in the claim. More on this later.

## OBJECT OF THE PATENT SPECIFICATION

For the purpose of the translator needing to write the patent specification, the purpose of the specification is:

- to inform the examiner of the invention as perceived by the inventor, and
- to convince the examiner that the invention is novel.

## TERMINOLOGY

There is very little technical terminology that is unique to patents. Most patent glossaries are highly padded with terminology the patent translator would have needed to know even before thinking about starting patent translation. They are often padded in this way to create a book large enough to be commercially attractive to the sellers. *The Japanese-English Dictionary of Patent Terms* by Yukisato Iida and the accompanying E-J volume are good examples of two such books, 5% of the content of which might be useful.

### Statutory Guidelines

MPEP 608.1(g)

> An applicant is ordinarily permitted to use his or her own terminology, as long as it can be understood.

MPEP 608.01(o)

> The meaning of every term used in any of the claims should be apparent from the descriptive portion of the specification with clear disclosure as to its import; and in mechanical cases, it should be identified in the descriptive portion of the

specification by reference to the drawing, designating the part or parts therein to which the term applies. A term used in the claims may be given a special meaning in the description. No term may be given a meaning repugnant to the usual meaning of the term.

When a translator is asked to translate only the claims of a patent for the same rate as translation of the entire document, the translator might remember the above language, as it clearly indicates that even the USPTO recognizes the importance of the descriptive portion of the specification in understanding the meaning of the claims.

**Two-Character Japanese Compounds**

One type of Japanese terminology that plagues patent translator on both sides of the filing fence is the two-kanji compound form that is often used to describe how elements of an invention are connected or otherwise interrelated.

(Examples)

突設　　枢設　　巻設　　係止　　螺合

These terms are completed ignored by all reputable terminology organizations and dictionaries, and until recently I was under the impression that the only books that even mentioned them were ones written for lay-people who wish to "make big money in the patent field," as I mentioned in my talk at IJET-5. Then, just a few weeks before IJET-7, a good patent client of mine called me with a job to translate a list of about 300 of just this class of term. It was like dying and going to patent translator heaven. Even though I have added a lot of material, including citings from real patents (missing from the original "ideal" definition list), I agreed not to make this dictionary public until after my client put up some of the material on its WWW page. When this condition is met, I will make the dictionary available in the honyaku archive at netcom.com.

**Developing a Stock of English Terminology**

There+Preposition Constructions

thereafter, thereagainst, therealong, thereamongst, therearound, therebecause, therebefore, therebeneath, therebetween, therebeyond, thereby, thereduring, therefor, therefrom, therein, thereon, therethrough, therethroughout, thereto, thereunder, thereupon, therewith, therewithin

All very official sounding, and some may think that these words serve no other purpose than to make the patent specification author sound unctuous. But wait; there is a reason for having even some of the bizarrest of the above terms, and that is to

avoid having to use both singular and plural forms in a case in which either condition applies. For example:

> Plate 23 has one or two apertures, a bushing being fitted to the inside edge thereof.
>
> versus
>
> Plate 23 has one or two apertures, a bushing being fitted to the inside edge of the aperture or apertures.

The latter rendering is clearly strange, and the use of "edge of each aperture" also fails when there is only one aperture.

### Terminology Used in US Patents

Patent drafters make use of an arsenal of terminology that is broader than normally found in technical writing. Some of it appears superfluous, and is indeed superfluous. But some of the arcane terms used in US patents has gained a foothold for reasons that the translator should become aware of. In the world of patents, the author of the specification (and most certainly, the drafter of the patent claims) wishes to keep the language used as generic as possible.

In the interest of maintaining the generic nature of the terminology, and therefore the breadth of the description, *opening* or *aperture* will often be seen for *hole*. *Cutting means* allows the author to include scissors, razor blades, nail-clippers, and virtually any other device that can cut in the description of an element that cuts. *Propulsion means* can include an internal combustion engine and drive train, jet engine for a fighter plane, or a battery-driven motor for a toy. The diligent translator should keep a record of such terms, as well as shape-describing terms which are encountered.

The translator should strive to develop not only a stock of such terms, but also the sense of when to use them. The best way to do this is simple, but not easy. It is to read as many US patents as you can obtain. With the World Wide Web available, obtaining US patents is no problem at all, and involves only the cost of a local telephone call. More detail on this when I discuss where to go for more information.

## GENERAL STYLE AND STRUCTURE

### One-Sentence Rule

The one-sentence rule–essentially the rule of practice that says that a claim is a single sentence (more precisely, a noun clause which forms a sentence when appended to the introduction to the claim) has absolutely no affect on the way the translator treats sentences in the descriptive part of the specification. Outside of the claims, the translator is free to break sentences up or combine them as required by the translation task and the target US patent style. The application of the one-sentence rule to claims will be discussed as part of the claims problem.

**Articles**

The indefinite is used upon the first reciting of an element, and the definite article is used at subsequent recitings.

Outside of the claims, however, this is not always adhered to, especially when a number of different embodiments are being described, each having a repetition of elements from a previous embodiment. A patent author might very well describe valve 23 as "a valve 23" in the second embodiment, even if it has appeared as valve 23 in the first embodiment.

**Said**

This almost universally used substitute for the definite article need not be used. The word "the" serves the same purpose. An investigation of many recent US patents indicated that "the" is gaining ground, but very slowly; most patent practitioners and translators still tend to cling to "said," thinking perhaps that it is more official. I suspect that Japanese clients would be more fearful of using this substitution than US practitioners, and the translator might want to think about that before becoming a pioneer in patent style reform.

Having said the above about "said," I would offer the following advice:

- Don't use "said" outside of the claims
- Never use the redundancy "the said" unless comic relief is intended.

**Drawings**

The patent translator is blessed with something the instruction manual translator sometimes does not have–a full set of drawings describing the thing being written about.

It is best to refer to the drawings by the type names that appear in the rules for patent practice. Examiners are accustomed to seeing these names. This list of names would include the following types of views.

Names of views: plan, elevation, section, perspective, exploded, partial, sectional (37 CFR 1.84)

Other types of drawing names: block diagram, flowchart

The translator should strive for consistency in referring to views of drawings, and again the typing enhancer is a valuable tool in achieving that goal.

When drawings are referred to in text, the most common form is the abbreviation FIG. N. Although I personally do not like plurals of abbreviations, the common practice in the US is to use them for drawings. Thus "FIGS. 3 through 7" is the normal, and I have learned not to cringe when using this format.

**Reference Characters**

The normal style for reference characters is a simple integer. If an element assigned a reference character is further broken up into sub-elements, lower-case letter suffixes are usually attached to the parent reference character, in contrast to the upper-case letters sometimes used to label parts of a drawing (e.g., FIG 2(A)).

A reference character should not be allowed to appear at the beginning of a sentence. Common sense style, but sometimes violated by translators overeager to maintain the structure of the original. If this stylistic no-no lurks near, rearrange the sentence; you have the freedom to do this as the translator.

When two or more of the same element appear in a sentence adjacent to one another, phrases like "widgets 34, 35 are driven by the control signal output from the drive amplifier 32" are sometimes seen in US patents. Note that a mere comma + space separate the two reference numerals. It appears that US patent practitioners have latched onto this as a conventional shortened notation. I do not feel it is necessary to follow this.

Ranges of three or more reference numerals should be indicated by the word "to" or "through."

**Referring to the Invention**

The invention can be referred to in a number of ways. The translator does not need to spend time worrying about this. Some of the ways are:

the present invention
the invention
this invention (first use, followed by the present invention)
the disclosed invention (used in the abstract)
the instant invention
my invention
our invention

My choice happens to be "present invention," which is by far the most common expression. This expression avoids the problem of wondering, in some cases, whether there are two or more inventors. (Remember, even though the assignee is a company in most cases, it is the inventor who claims the invention.) To achieve consistency, I evoke this from my typing enhancer with the sequence "pri" followed by a space.

A brief comment about real-time typing enhancers. Because the version of wordprocessor that I use has a very inconvenient abbreviation-expansion function, I use an outboard program for this function–one which runs with whatever applications I select. My particular typing enhancer is *Thunder 7*, but there are many others. This type of program is of great value to patent (and other) translators because (1) it saves a great amount of typing (i.e., makes you money) and (2) it improves consistency, and essential quality in patent translation. I routinely use a general patent abbreviation dictionary (which has such commonly used equivalents as: pri=present invention, api=according to the present invention, and atc=according to claim), and a

job-specific abbreviation dictionary which I develop as I go along, including abbreviations for elements of the invention, thereby both saving the typing effort and expressing the name of the element the same way each time.

## CLAIMS

### Purpose

To particularly point out and distinctly claim the subject matter which the applicant regards as his invention. (MPEP 608.01(i)(a); sexist language is the USPTO's)

### Relationship to the Description of the Invention in the Preceding Part of the Specifications

As I said earlier, the claims are the invention, but depend upon support from the descriptive part of the specification, in terms of both structure of the invention and meaning of terminology. It should be clear from the earlier parts of the specification to what the terms used in the claims refer.

### General Structure

Strange as it might seem, there is no set statutory form for claims, but the present USPTO practice is to insist that each claim must be the object of a sentence starting with "I (or we) claim," "The invention claimed is," or an equivalent phrase. It begins with a capital letter and ends with a period. Periods may not be used elsewhere in the claims except for abbreviations (MPEP 608.01(m)). It is this last sentence, of course, that is the one-sentence rule. To avoid worrying about the number of inventors, my choice is "What is claimed is:".

From the above MPEP language, it is clear of what is normally called a claim is a noun clause. Each claim has an integer number. In the case of a single-claim patent (very rare), the claim does not have a number.

Each claim is formed from a preamble, a transition phrase, and a body, the nature of the body depending upon the statutory class of the invention. More on that later. The general form, then, is:

> Preamble [usually a form of the name of the invention]
>
> Transition [usually "comprising"]
>
> Body [catalog of elements and the relationship between them]

The sample you see here is that of an apparatus claim format.

> 1. A high impedance, high frequency input circuit for an instrument suitable for measuring ac signals whose frequencies are within a predetermined frequency range, comprising:
>
> (a) an input terminal for receiving the ac electric signals that are to be

measured and an output terminal;

(b) an input resistor having a first end coupled to said input terminal;

(c) an operational amplifier having an amplifier input coupled to a second end of said input resistor and an amplifier output coupled to said output terminal; and

(d) a feedback path coupled from said amplifier output to said amplifier input, said feedback path having a first resistor and a voltage divider, wherein said input resistor, first resistor and voltage divider determine the gain for said input circuit and both the resistance of said first resistor and the total resistance of said voltage divider are significantly less than the resistance of said input resistor such that when said ac electric signals are within said predetermined frequency range said gain of said input circuit is unaffected by stray capacitance associated with said first resistor and voltage divider.

Several things can be said about the style of the above claim (from US Patent 5332963; High input impedance buffer with low feedback resistance). It has sub-paragraphs and these sub-paragraphs have been assigned symbols. Neither of these is usually seen in a Japanese claim, which normally is just a single, long paragraph, looking like a sea of characters with no distinguishing features to help the reader or the translator navigate. The USPTO encourages sub-paragraphing and assignment of symbols. As the translator in charge of writing the English patent specification, you should feel free to use these tools of expression, especially for extremely long and complex claims with many elements. One exception might be in the case in which a Japanese version of the application has been rushed to the USPTO, and is being followed up by your English. More on this later.

**Preamble**

The preamble is simply an introductory phrase which names or defines (generally) the invention being recited in a particular claim. In general, the simpler the better. Since the foregoing descriptive part of the specification must clearly define the subject matter of the invention and describe how to practice the invention to someone skilled in the art, there is no particular need for detail in the preamble. The body of the claim provides the detail. Thus, a claim for an extremely complex semiconductor device might be extremely simple.

(Example)

18. A semiconductor device...

When the claimed invention is a machine that operates on a workpiece, details of the workpiece must not be put in the body of the claim (since they are not the invention). They should be included in the preamble.

(Example)

23. An apparatus for cutting the end of an optical fiber having a diameter of no greater than 150 micrometers...

In the above example, the optical fiber is not part of the invention.

**Transition**

The most commonly (almost universally) used transition is "comprising" or "which comprises." Both of these expressions are "open," meaning that they precede a list of elements that the invention includes, but is not necessarily limited to. This makes it more difficult for a potential infringer to develop a workaround by merely adding elements.

Regardless of how many times people have said that "characterized by having" is patent language, rest assured that it lies clearly in the domain of for-information translation and has no place in J-E patent translation for filing, which must conform to US patent practice. Again, this is something that is difficult to know from outside this market. This market is breaking across borders, however, and the word will probably be getting out that some patent translators have been freed from the yoke of "characterized" by the perhaps more stringent yoke applied by the need to learn real US patent style.

**Body**

The body of the claim is generally a catalog of the elements of the invention, and must also include the manner in which the elements interact and cooperate with one another in order to achieve the object of the invention. Thus, it is not allowable to have an element named but not defined in terms of such a relationship to at least one other element. An examination of Japanese *kokai* will reveal that the body of a Japanese claim sometimes does not follow this convention very closely. Fortunately for the patent translator, however, when *benrishi* draft claims for the purpose of US filing, they tend to follow US practice when writing the claim in Japanese. Thus, there is a string of noun clauses ending with "と" , the last one of which often ends with "とを有する事を特徴とする...". If the translator is presented with the Japanese claims as filed in Japan, he or she will need to rearrange things, again well within the responsibilities of the translator given this type of assignment.

Referring to the sample apparatus claim given earlier, note that there are four major elements in this claim (invention), and also note that the fourth element, a feedback path, is detailed as having two further sub-elements (a first resistor and a voltage divider). It is common to use such sub-elements to describe the detail of each element as it appears in the "catalog" of elements that is presented in the body of the claim.

The usual format for the catalog of elements these days is a string of paragraphs, each ending with a semicolon, the last semicolon being followed by "and" just before the last paragraph (element).

**Sub-Paragraphing and Japanese-Language Filing**

It is now possible to file a patent application in the US with a Japanese-language specification, to be followed by an English specification. This could create great problems for both Japanese patent applicants and translators. Since there are hints that the USPTO does some checking to see that new matter was not added to the specification at the time of the translation, the use of sub-paragraphing and other structural changes could cause problems.

This is set forth in 37 CFR 1.52. A verified English translation of the non-English language application is required to be filed with the application or within such time as may be set by the Office. The translation must be a literal translation verified as such by the translator and must be accompanied by a signed request from the applicant, his or her attorney or agent, asking that the verified English translation be used as the copy for examination purposes in the Office. If the verified English translation does not conform to idiomatic English and United States practice, it should be accompanied by a preliminary amendment making the necessary changes without the introduction of new matter prohibited by 35 U.S.C. 132. In the event the verified literal translation is not timely filed in the Office, the application will be regarded as abandoned. This allowance of this practice is intended for emergency situations–to enable applicants to obtain filing dates, and is only recommended for emergency situations. It is clearly stated that this type of filing should not be routinely used for filing applications. The reasons given for this are the dangers to the applicant and the public if he or she fails to obtain a correct literal translation, and the significant administrative work load that would result if a large number of applications were to be made in this way.

I have only encountered one translation job following after a Japanese-language application, and can only say that it cramps the style of the translator and results in a patent specification that is extremely difficult to understand (and probably equally difficult to examine).

The translator should always make sure that the client knows enough to mention if the above type of filing is happening.

**Apparatus Claims**

In an apparatus claim, the elements are physical objects which are interrelated, usually forming what can be classified as a machine, which operates according to some set of rules.

**Article of Manufacture Claims**

An article of manufacture, unlike a machine, usually does not have moving parts. For the purpose of claims, however, it appears to be in virtually the same format, and should not need to be a concern of translator.

**Means**

To assert the generic nature of an element, one common device is the use of a means clause.

(Example)

means for cutting said plate to a length which is responsive to said control voltage;

The general form is "means for [verb]-ing...."

Note that no indefinite article is used before means in this format. Subsequent recitings this element will most often be a shortened form such as "cutting means," providing there was only one such cutting means.

**Method or Process Claims**

The drafter must remember that the subject matter of a method or process claim is neither the object or substance produced by, nor a workpiece processed or acted on by the process or method; it is the method or process itself.

Generally, the elements in a method claim are gerundial phrases.

(Examples)

grinding said rock...

cutting said prescribed length of wire...

multiplying said constant by said...

detecting the ambient temperature

Unless it is necessary for the achievement of the purpose of the invention, sequence of steps should not be specified. This presents a problem for the J-E translator, since it is not generally clear whether or not a —て, —て, —て series (common in Japanese method claims) should be taken to imply any particular temporal relationship. When in doubt, ask the author. Fortunately, in this type of translation the author (*benrishi*) is usually available.

Thus, unless there is some basis for them, gratuitous additions such as "then," "after which," and the like will add limitations that could cripple the patent in terms of breadth of coverage, since specifying an unneeded limitation of sequence clearly invites a workaround by using a different sequence of steps that achieves the same object.

**Composition of Material Claims**

Since I do not encounter composition of matter claims in my work, I am not qualified to speak on them, and will defer to colleagues who might wish to speak or write on that topic.

### Dependent Claims

A dependent claim places added restrictions on the territory staked out by the independent claim to which it is dependent. It is an extension of an independent claim and includes by reference all the restrictions of the base (independent) claim. A test of whether a claim is truly dependent is whether or not any invention which infringes the dependent claim also infringes the claim upon which it is based.

There are some conventions of practice with regard to the sequence of dependent and independent claims. These are covered in detail in *Landis on Mechanics of Patent Claim Drafting*.

Since a dependent claim must refer to a preceding claim, it usually starts out by renaming the invention, followed by a phrase giving the base claim number or numbers.

(Examples)

35. A spittoon as recited in claim 34, wherein said aperture is elliptical...

45. The optical fiber cutting method according to claim 44, wherein said jaws....

An issue that arises, as shown above, is that of whether to use the indefinite or definite article when referring to the name of the invention. Some argue that since it appeared in the base claim it should warrant a "the," but my choice is the indefinite article, this choice being supported by about half the dependent claims have looked at recently.

## WHERE TO GO FOR MORE INFORMATION

### US Patents Themselves

It is highly unlikely that a translator will miraculously wake up one day and be endowed with the ability to write in good US patent style. It takes diligence and a willingness to sacrifice at least some immediate profits. One of the best ways to learn what is acceptable style is to read US patents issued to US entities (i.e., conceived originally in English). US patents are easy to obtain from a number of sources.

### The JPO Reference Room

The JPO's reference room in their main building in Toranomon in Tokyo has an extensive collection of US patents. Copies from bound volumes can be obtained, and terminals are available, from which patents can be searched (using very elementary searching capability) and printed out. The charge is 50 yen per sheet– expensive for copying but use of the terminal is otherwise free. More sophisticated searching is available from JAPIO, an *amakudari*-ridden group ostensibly providing a service to the public; the rates for use of their on-line system are so high no translator would consider them, and merely point up one of the salient features of such groups.

**Patent Deposit Libraries**

Although being Japanese-based takes me out of the picture for using this source, the USPTO's web site (see below) gives information on many libraries in the US which have US patents available for viewing and copying. See

**Valuable Patent Web Sites**

- USPTO

  Bibliodata and abstracts for US patents back to 1976 are boolean searchable and available for free downloading from:

  US Patent and Trademark Office

  http://www.uspto.gov/

  [or (more directly)]

  CNIDR U.S. Patents Project

  http://patents.cnidr.org:4242/

  This valuable service can be combined with a service or location that can provide full texts of US patents.

- MicroPatent

  http://www.micropat.com/

  This company provides a searchable database of the full texts of US patents for the current week and last week. This probably represents 4000 patents at any one time. Full texts can be downloaded for free. This part of the service is usable free-of-charge after registering and receiving a password; registering costs nothing–they are hoping you use their other for-pay services.

**Japanese Patents**

Available in bound books and at terminals at the JPO in Toranomon. Printouts from the terminal cost 50 yen each, sold by JAPIO (see comments elsewhere). The JPO has a web site at http://www.jpo-miti.go.jp/. As might be expected, there are no patents but plenty of platitudes available there, along with ample advertising for expensive JAPIO services.

**Laws and Regulations**

The single most valuable document the J-E patent translator can obtain from the USPTO is the Manual of Patent Examining Procedure. Before I had access to the WWW, I purchased a paper version of this manual. It is about 15 cm of paper. After getting access to the web, I realized that this purchase (and the storage space it requires) was wasteful. The USPTO web site given above will lead you (with just a few clicks on links) to an FTP site for the entire manual. I suggest that you download

Section 600, as this contains most of the information the translator needs.

**Books**

*Landis on Mechanics of Patent Claim Drafting* (Third edition, 1990) is a must for the J-E patent translator doing the work I have been discussing. It has been the authority on claims drafting for decades.

Look for it at any of the addresses given below.

http://www.pli.edu/
email: info@pli.edu.
810 Seventh Avenue
New York, NY 10019-5818
(800) 260-4PLI or (212) 824-5710

## CONCLUDING COMMENTS

The above has been a rushed, very scanty coverage of a topic which could occupy an entire book. I encourage people with comments (including corrections to the above information) to contact me (contact information listed elsewhere in these proceedings).