

The opinion in support of the decision being entered today is not binding precedent of the Board.

Paper 54

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES
(Fred E. McKelvey, Senior Administrative Patent Judge)

STAN WOJCIAK

Junior Party,
(Patent 5,922,783),

v.

YUKO NISHIYAMA and HIRAYUKI MIKUNI

Senior Party
(Application 08/730,025).

Patent Interference No. 104,539

MEMORANDUM OPINION and ORDER
(Cross-examination through interpreter)

A. Conference call

A telephone conference call was held on 23 February 2001, at approximately 09:30 a.m., involving:

- (1) Counsel for Wojciak;
- (2) Counsel for Nishiyama; and
- (3) Fred E. McKelvey, Senior Administrative Patent Judge.

B. Discussion

During the telephone conference call, the board was advised that cross-examination of at least one of Nishiyama's witnesses would take place through an interpreter (English to Japanese and vice-versa). An order will be entered establishing guidelines to be used in connection with cross-examination through an interpreter so that any cross-examination deposition can proceed in an orderly fashion consistent with the "just, speedy and inexpensive" philosophy of the rules (37 CFR § 1.601). The guidelines will govern further proceedings in this interference.

C. Guidelines

1. The term "party" refers to the party who presents direct affidavit testimony to be cross-examined.

2. The term "opponent" means the party who will cross-examine.

3. The party who presents direct affidavit testimony of a witness is responsible for providing a "first interpreter" who can interpret using a consecutive mode of interpretation. Since consecutive interpretation is taxing on interpreters, there may be situations where a party may wish to retain multiple interpreters. The term "first interpreter" refers to one or more interpreters as may be retained by the party.

4. The party bears the expense associated with any first interpreter.

5. If an Administrative Patent Judge (APJ) attends any cross-examination deposition, the APJ will conduct a voir

dier on the record with respect to the qualifications of the "first interpreter" prior to cross-examination. Thereafter, the party and opponent may conduct such further voir dier as may be appropriate. If an APJ does not attend the cross-examination deposition, the party and opponent shall conduct the voir dire on the record prior to cross-examination. The voir dire shall be conducted in the absence of the witness. Interpreters shall accurately and completely represent their certifications, training and pertinent experience. A suggested voir dire appears in Appendix A. The board ultimately will determine whether any first interpreter is qualified, and what weight, if any, shall be given to any interpretation by the first interpreter.

6. Prior to any voir dire, any interpreter shall take an oath that they will make a true and impartial interpretation using their best skills and judgment in accordance with the standards and ethics of the interpreter profession.

7. At least **five (5) business days** before any cross-examination deposition, the party shall provide to the opponent the following material: (1) the name, (2) business address, (3) business telephone number, (4) business e-mail (if any) and (5) resume of the first interpreter.

8. Prior to any cross-examination deposition, counsel for the opponent may contact the first interpreter ex parte.

9. The opponent may also have the services at counsel table of a "second interpreter."

10. The opponent bears the expense associated with any second interpreter.

11. If a second interpreter is present at any deposition, a voir dire shall be conducted in the manner previously described. The board ultimately will determine whether any second interpreter is qualified, and what weight, if any, shall be given to any interpretation by the second interpreter.

12. If the opponent plans to have a second interpreter present, at least **five (5) business days** before cross-examination, the party shall provide to the opponent the following material: (1) the name, (2) business address, (3) business telephone number, (4) business e-mail (if any) and (5) resume of the second interpreter.

13. Prior to any cross-examination deposition, counsel for the opponent may contact the first interpreter ex parte.

14. Cross-examination begins after any voir dire.

15. The consecutive mode of interpretation shall be used.

16. Specifically, the following procedure is to be followed in asking questions and obtaining answers:

a. Counsel for the opponent shall ask a question (the "pending question") in English.

b. The first interpreter, using the consecutive mode, shall interpret the pending question into the foreign language.

c. The witness will answer the pending question in the foreign language.

d. The first interpreter, using the consecutive mode, will interpret the answer into English.

17. In the event the second interpreter should have a disagreement with the first interpreter with respect to any interpretation of the pending question and/or the answer, the second interpreter is to raise a hand (**without speaking**), but steps (a) through (d) with respect to the pending question are to continue until completed. If during steps (b) through (d), the second interpreter raises a hand, upon completion of step (d), the following procedure is to be followed (without discussion by counsel for the party or opponent, or debate between interpreters, if there is more than one interpreter) with respect to the pending question and answer:

a. The second interpreter shall ask the court reporter to read back the pending question in English.

b. The second interpreter, using the consecutive mode, shall interpret the pending question into the foreign language.

c. The witness will answer the pending question in the foreign language.

d. The second interpreter, using the consecutive mode, will interpret the answer into English.

18. If upon hearing the two interpreted English answers, and should the answers in the opinion of counsel asking

the pending question, appear to be different, inconsistent or other confusing, counsel is on notice that a problem may have occurred with the interpretation process. Counsel may wish to rephrase the question or ask further questions.

19. There shall be no discussion or debate between interpreters as to whether a particular interpretation is right or wrong.

20. In cases where cross-examination takes place before an administrative patent judge, the court reporter shall use a steno machine and microphones will not be permitted.

21. The court reporter shall prepare a written transcript in English.

22. The court reporter, as is usually the case, may tape record the proceedings for the purpose of having a backup. Any tape recording should record the entire proceeding (except when matters are properly taken off the record), including everything said in English and the foreign language.

23. In the event of different interpretations by interpreters, the board will determine which interpretation, if any, is to be accorded more weight.

24. Collateral attacks through a "third interpreter" with respect to the qualifications of any interpreter, or the manner in which a particular question or answer was interpreted, shall **not** be allowed after conclusion of the deposition. Rather, the party and opponent shall make a record during the deposition

upon which the board may make findings with respect to accuracy of interpretations or credibility of interpreters.

25. Any interpreter should be neutral, impartial, detached and unbiased.

26. An interpreter shall render a complete and accurate interpretation or sight translation, without altering, omitting or adding anything to what is stated or written, and without expression.

27. An interpreter, at any time, may inform the party or opponent, their counsel or the witness that the role of an interpreter does not include advocacy.

28. There is a fatigue factor associated with consecutive interpreting. Hence, necessary pauses as may be requested by the interpreter may be necessary. A request for a pause every thirty (30) minutes is not unreasonable.

29. Copies of any documents which an interpreter will be requested to "sight translate" at the deposition shall be provided directly to the interpreter prior to any deposition no later than three (3) days prior to any deposition. Failure to timely provide copies may result in the document being excluded from evidence. Unless otherwise agreed by the party and opponent, the interpreter shall not reveal to opposing counsel the nature of any document provided.

30. At the request of an interpreter, the party and opponent shall provide the interpreter with an opportunity to converse with the witness. Counsel for the party or opponent may

inquire on voir dire as to any conversation between the witness and the interpreter.

31. If at any time an interpreter reaches a conclusion that the interpreter is unable to interpret or translate a word, expression or special term, the interpreter, on the record, shall immediately advise the APJ, if present, and if the APJ is not present, shall immediately advise those in attendance at a deposition.

32. Counsel shall advise witnesses that (1) they must speak so that all present can hear, not just the interpreter, (2) to direct answers to question to the person asking the question (not the interpreter) and (3) not to ask questions, seek advice or engage in discussion during a deposition with an interpreter.

33. An interpreter may ask the APJ, if present, for permission to ask a question of a witness to clarify an answer or word. If the APJ is not present, the interpreter shall seek permission from the attorney asking the question.

34. At any deposition, only one person shall speak at any one time. An interpreter cannot interpret two statements being made at the same time.

35. All individuals shall speak with clarity and in a normal speech speed. Moreover, questions should be short and to the point. An interpreter "translates" in the brain while a pending question or answer is being given and if the pending question is too long (1) it probably is not a good question and

(2) it unduly taxes even the most proficient interpreter. Additionally, counsel should assume that the witness is unfamiliar with both legal and administrative proceedings which take place in the United States. Thus, it is highly likely that a witness will not know what is meant by "affidavit," "deposition," "interrogatory," "admission," etc.

36. Counsel, the party and the opponent must recognize that a short question in English may turn out to be a long question in a foreign language and vice versa.

37. An individual may not serve simultaneously as attorney for a party and as an interpreter.

D. Order

Upon consideration of the record, including the discussion at the telephone conference call, it is

ORDERED that the guidelines set out above govern further proceedings in this interference.

FURTHER ORDERED that, unless otherwise agreed by the parties, the opponent need not serve, prior to the deposition, any document upon which it intends to base cross-examination.

FURTHER ORDERED that the parties shall have at the deposition copies of all documents to be discussed on the record for the court reporter, the interpreter, opposing counsel and the APJ.

FURTHER ORDERED that a copy of this MEMORANDUM OPINION and ORDER shall be provided to any interpreter to be present at

the deposition at least **three (3) business days** prior to the deposition.

23 February 2001
Arlington, VA

FRED E. MCKELVEY
Senior Administrative Patent Judge

Appendix A

1. What is your training as an interpreter?
2. What is your native language?
3. How did you learn English?
4. How did you learn the foreign language?
5. What is the highest grade you completed in school?
6. Have you spent any time in a foreign country where the language we are interpreting today is spoken? If so, explain.
7. Did you formally study English or the foreign language in school? If so, explain.
8. How many times have you used the consecutive mode of interpretation in court or administrative proceedings involving live testimony?
9. What is your experience in interpreting in proceedings involving scientific matters?
10. What is your experience in interpreting in matters involving legal matters?
11. Are you a potential witness in this matter?
12. Do you have any known conflicts of interest?
13. Are you an inventor?
14. Have you ever filed a patent application? If so, have you ever been involved in an interference?
15. Did you have an opportunity to speak to the witnesses informally prior to today's proceeding? If so, were there particular communication problems?

16. In your opinion, does the witness have any dialectal or idiomatic peculiarities? If so, are you familiar with those dialectal or idiomatic peculiarities?

17. In your opinion, how long can you interpret using the consecutive mode before fatigue sets in?

18. Do you have any language teaching experience? If so, explain.

19. Have you had your interpreting skills evaluated? If so explain.

20. Are you certified by the Federal or a state government to interpret in the foreign language? If so, what do you mean by "certified"? If a state, what state?

21. Have you been qualified before by a judge to interpret in court? If so, explain.

22. Have you ever been disqualified from interpreting in any court or administrative agency? If so, explain.

23. Have you had training in Professional Ethics for Court Interpreters? When?

24. Do you belong to a professional interpreters association? If so, which one and for how long?

104,539
cc (via First Class Mail)

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