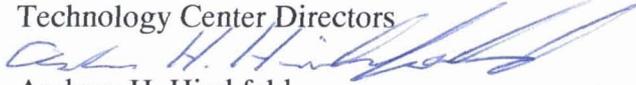




MEMORANDUM

Date: November 17, 2009

To: Technology Center Directors


From: Andrew H. Hirshfeld
Acting Associate Commissioner for Patent Examination Policy

Subject: Machine Translation of a Non-English Document Being Relied Upon by the Examiner in Support of a Rejection in an Examiner's Answer

Effective immediately, a machine translation (or an English language equivalent) of a non-English document being relied upon by the examiner in support of a rejection in an examiner's answer will be deemed to fully comply with the translation requirement of Manual of Patent Examining Procedure (MPEP) § 1207.02. If an appellant challenges the credibility of the machine translation, the Board of Patent Appeals and Interferences (BPAI) will determine the credibility of the machine translation evidence by determining if appellant has met the burden of demonstrating that the translation is not accurate. Thus, a rejection may be reversed by the BPAI if the machine translation evidence is found not credible.

MPEP § 706.02 provides for reliance upon foreign language documents in support of a rejection. If the document is in a language other than English and the examiner seeks to rely on that document, a translation must be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection. *See also* MPEP § 1207.02. Because all patentability determinations are fact dependent, obtaining and considering full text documents at the earliest practicable time in the examination process will yield the fullest available set of facts upon which to determine patentability, thereby improving quality and reducing pendency. Furthermore, the translation should be obtained prior to the appeal conference so that the participants of the appeal conference can consider the translation. The examiner should reference the pertinent portions of the translation at least in the grounds of rejection section of the answer.

Machine translations (or English language equivalents) should typically be used in lieu of hand translations. If applicant timely files a certified translation contesting the reliability of a machine translation, the examiner should consider the certified translation. Furthermore, examiners may order a hand translation from Scientific and Technical Information Center (STIC) in the following situations:

- (1) When applicant contests the machine translation and supplies an uncertified translation (or other evidence) to show that there are material errors in the machine translation to cause it to be unreliable to support the rejection;
- (2) When the examiner has reasons to believe that the machine translation contains material errors to cause it to be unreliable to support the rejection; and

(3) When a machine translation is not available through STIC and it is not readily available elsewhere.

Presently, STIC has the capability of providing machine language translations of documents that are in the following languages: German, Japanese, and Korean. Machine translation of documents in additional languages will be provided as they become available. Requests for translations should be submitted to the Translation Branch of STIC. More information is available at: <http://ptoweb/patents/stic>.

Any previous instructions or memorandums that are inconsistent with the changes regarding machine translations are superseded by this memorandum. The appropriate sections of the MPEP will be revised in accordance with this memorandum in due course.

Any questions concerning this memorandum should be directed to Kery A. Fries (571-272-7757) or Joni Y. Chang (571-272-7720), Senior Legal Advisors, Office of Patent Legal Administration, Office of Deputy Commissioner for Patent Examination Policy, by telephone, or directed to Patent Practice@USPTO.gov by electronic mail.