

## How critical is the Vietnamese translation of a patent specification for invention protection in Vietnam?

*The patent specification is the most critical document in a patent application. It can be said that the Vietnamese specification is key for an invention's fate when the owner wishes to commercialize the invention or enforce the patent rights, as well as resolve disputes, conflicts or infringements of his/her patent rights. Whether or not an invention is adequately protected and enforceable against patent infringement is contingent upon the quality of the patent specification's Vietnamese translation. Any mistranslation or erroneous translation of the patent specification can render it "useless" or "unusable."*

An invention is an object of industrial property rights. To be protected in Vietnam, an invention must be registered and granted a patent by the Intellectual Property Office of Vietnam (IP Vietnam). Therefore, patent rights are territorial rights, in other words, an invention protected in US, China, Japan, Korea... does not automatically confer rights in Vietnam.

The patent specification is the most critical document in a patent application. All specifications written in a foreign language (often English) must be translated into Vietnamese under Vietnamese law. Although a patent application may include a specification in a foreign language, IP Vietnam's examiner assesses, evaluates, and analyses the invention's patentability only on the basis of the Vietnamese specification (the Vietnamese translation of the specification). The examiner is not required to verify the accuracy of the foreign specification or to compare it to the Vietnamese translation. The granted patent contains only the Vietnamese specification and does not include any foreign specification. The protection scope of an invention is determined by the claims contained in its patent specification, which serve to define the scope of the invention's industrial property rights. The enforcement agency shall take the protection scope or claims of the patent specification as a basis to analyze and evaluate the identity or equivalence between the protected invention and the allegedly infringing product/process.

Therefore, it can be said that the quality of the Vietnamese translation of the patent specification determines whether or not an invention is adequately protected and enforceable against patent infringement. Any mistranslation or erroneous translation of the patent specification can render it "useless" or "unusable."

### Challenges in translating patent specifications in Vietnam

In recent years, foreign capital inflows into Vietnam have gone up significantly. Foreign investors are increasingly interested in and seeking business opportunities in Vietnam. This is a significant factor in the dramatic growth in the number of foreign patent applications filed in Vietnam. However, infrastructure, particularly human resources, does not appear to be keeping up with this growth. Human resources in this industry are frequently in low supply in Vietnam, and/or they lack the necessary qualifications, technical expertise, and experience to comprehend and translate patent specifications adequately.

Additionally, inventions are becoming increasingly associated with new and advanced technical disciplines, with the goal of resolving more complicated challenges. Naturally, the specifications for such inventions contain a large number of complex foreign terms that are almost entirely untranslated in Vietnamese bilingual dictionaries, let alone linguistic differences or jargon used in the original language, which always present numerous difficulties for translators.

Without a strong technical background, translators may misunderstand the technical nature of inventions and misinterpret the terminology used in specifications; as a result, numerous foreign terms are mistranslated or misinterpreted into Vietnamese, or the Vietnamese translation does not accurately reflect the nature of relevant inventions. This reality can make it more difficult for IP Vietnam's examiners to conduct a thorough examination of the application, and more importantly, it can irreversibly damage all of the work and money expended by international applicants and inventors if a protection title is granted. According to Vietnamese law, a patent owner may amend a patent specification by reducing the protection scope of the patent, i.e. by reducing one or more independent or dependent claims of the protection scope (claims) covered by the patent, but correction of errors in the patent specification's Vietnamese translation is not permitted after the patent is granted in Vietnam. Of course, if errors in the Vietnamese translation of the patent specification are unearthed prior to IP Vietnam issuing a refusal notice or a decision to grant a patent for the invention, the applicant may actively request correction of such errors pursuant to Article 17 of Circular 01/2007/TT-BKHCN.

### *Misunderstanding meaning and protection scope of inventions*

The majority of foreign patent specifications include technical terminology or jargon to convey the complexity of the technical challenges addressed by the inventions. Linguistic variation is an inherent issue, all the more so when a foreign word frequently has many meanings, necessitating translators to choose appropriate interpretations for respective use circumstances. Translation of a patent specification or a patent application document into Vietnamese is more challenging because it contains both technical and legal elements. Polysemantic foreign words might make it difficult for translators to choose an equivalent Vietnamese term, let alone the fact that a patent specification may contain jargon for which translators cannot find Vietnamese equivalents. In this situation, translators incur the risk of ambiguously expressing or interpreting or, more gravely, mistranslating patent specifications into Vietnamese, or of completely changing the nature, meaning, and extent of protection of inventions through their Vietnamese translation.

#### *Inappropriately amending, supplementing, or changing translation contents, resulting in refusal of patent applications in Vietnam*

Amendments to patent filing materials, including patent specifications, are permitted, but must adhere to the fundamental concept that such amendments should not enlarge the disclosure scope (volume) of initially filed patent applications. As a result, amending and supplementing a Vietnamese translation in such a way that the original scope is expanded may result in IP Vietnam rejecting relevant patent applications.

The following types of **amendments** are not accepted: (i) The claimed subject matter of the amendment application is not present in the original application; (ii) The claimed subject matter of the amendment application contains a technical sign(s) not adequately illustrated by the specification of the original application; (iii) The nature of the subject matter of the amendment application is different from that of the original application; (iv) The information considered in the amendment application by a person of average knowledge in the respective technical field is different from that described in the original application and such information cannot be clearly and directly defined from the information described in the original application.

The following **supplementations** are not acceptable: (i) Inclusion into the claims and/or the description of technical features that cannot be directly and unambiguously defined from the original description (including drawings) and/or the original claims; (ii) Supplementation of information that cannot be directly and unequivocally defined from the original description (including drawings) and/or the original claims to clearly disclose the invention or fully disclose the claims; (iii) Supplementation of technical signs related to dimension parameters obtained by measuring dimension parameters on the drawings; (iv) Inclusion of additional details/elements which are not mentioned in the original application documents and will lead to special effects not found in the original application; (v) Supplementation of effects (benefits) that cannot be determined by a person with average knowledge of the relevant technical field from the original application.

The following **changes** are not acceptable: (i) Changes to technical signs of the claims that are not disclosed or are not directly and explicitly identified from the original patent specification; (ii) Inclusion of new contents by changing unspecified contents into specific and definite contents; (iii) Combination of distinctive features of the original application into a new sign without disclosing the relationship between them is not disclosed in the original application; (iv) Changes to any technical sign in the description to make such technical sign different from technical signs stated in the original specification.

#### *Burden of translation costs for applicants*

The applicant may incur extra fees if the Vietnamese translation of a patent specification does not comply with Vietnam's regulations. This problem often occurs when the applicant self-translates or employs an organization or individual who is not expert in the field of intellectual property and/or related technical domains to independently translate the patent specification. Then, the applicant uses that translation to file a patent application directly or through an industrial property agent. In many cases, since such translation does not adhere to or comply with the regulations on the form of patent specifications, the applicant has no choice but to retain an industrial property agent to review it, and in certain cases, retranslate the patent specification, incurring additional expenditures.

When translating a patent specification from a foreign language to Vietnamese, some of the following typical errors might occur if the translator lacks competence or experience in the relevant intellectual property and/or technical fields:

- ✓ First, constituent parts or contents of a patent specification are missing. Under Vietnam legislation, a patent specification must include: a description of the invention, the scope of protection (or claims),

an abstract, and drawings (if necessary). The description must include: Title of the invention, Field of the invention, Background of the invention, Summary of the invention, Brief description of the drawings (if any), Detailed description of the preferred embodiments of the invention, and Examples of the invention (if any). Each section of a patent specification must adhere to the required format and content standards. Patent specifications written in other languages frequently lack one or more of these components, or the components themselves lack sufficient information. If the translator is unfamiliar with the regulations and advises the applicant to alter the specification prior to submitting the application, the translation of the patent specification will fail to comply with the regulations, and the application will be rejected as to its formality.

- ✓ Second, words of a translation are not Vietnamized. More particularly, the translator does not translate foreign words into Vietnamese, especially chemical terms, such as “glycine” (which needs to be Vietnamized as “glyxin”, instead of “glycine”), “allyl proline” (which needs to be Vietnamized as “alyl prolin”, instead of “allyl proline”), etc.
- ✓ Third, specialized terminology fails to comply with statutory requirements. Many technical terms need to be precisely used in a patent specification, for example the terms “*a skilled person in the art*”, “*according to claim... or claim...*”, “*... according to any one of claims from... to...*”, “*the invention refers to...*”, “*the invention is related to...*”, “*preferably*”, “*embodiments*”, etc.; headings in a patent specification: “*Field of the invention*”, “*Background of the invention*”, “*Summary of the invention*”, “*Brief description of the drawings*”, “*Detailed description of the embodiments of the invention*”, “*Examples of the invention*”, etc. Such technical terms may be expressed this or that way in foreign languages; however, upon translation into Vietnamese, they must be expressed in accordance with Vietnam’s regulations. Frequently, translators will mistakenly translate those technical terminology due to a lack of awareness of the regulations and knowledge in the relevant field.

#### *Narrowing protection scope of inventions*

The protection scope of an invention is determined according to the claims contained in a patent specification that are supported (explained or clarified) by and consistent with “*Background of the invention*”, “*Summary of the invention*”, “*Detailed description of the preferred embodiments of the invention*” and drawings. Claims are expressed by a set of basic technical features which are necessary and sufficient to identify its subject matters, to achieve the intended purposes, and to distinguish them from the prior art.

When filing a patent application in Vietnam, the foreign applicant must submit a Vietnamese translation of a patent specification attached to his/her patent application. A foreign specification can be attached to the application; nevertheless, this document is intended to serve as a reference and to assist the examiner from IP Vietnam during the examination. The examination results are totally dependent on the Vietnamese translation of the specification attached to the patent application, not on the foreign specification. The patent specification details the invention, the newly created technical solution, how the invention works and the protection scope of the invention. In the Vietnamese translation of the patent specification, the accuracy of the translation is of the utmost importance, since a missed comma, for example, might adversely effect or reduce the scope of protection for the invention.

#### *Obstruction or inability to enforce patent rights in Vietnam*

Patent rights are enforceable through administrative and/or civil proceedings in Vietnam. When determining whether an alleged product/process falls within the protection scope of an invention, a court or a verification body must review the protection scope of the invention to determine the protection extent, content and volume of the invention, based on which it compares and analyzes the identity or equivalence between the suspected infringing product/process and the protected invention. In other words, in order to determine whether there is any infringement upon an invention, it is necessary to define the “borderline” between infringement and non-infringement. Many patent experts believe that the wider the protection scope of an invention is, the more likely the invention is to prevent infringement. Meanwhile, the narrower protection scope of the invention means that the patent owner enjoys the extent and scope of protection less than those which he/she should have enjoyed.

Careless or unskillful translation of a patent specification can result in an undesirable narrowing of the protection scope of an invention. A typical example is the use and translation of the English preposition “*in*”, which frequently appears in English patent specifications. The English word “*in*” expresses the situation of something that is or appears to be enclosed or surrounded by something else, but sometimes it means “*at*”. Depending on the circumstances, if the translator translates “*in*” verbatim rather than broadly as “*at*,” this

may narrow or limit the scope of the invention's protection and make it impossible to enforce patent rights against infringement if a particular technical feature of the allegedly infringing product is not enclosed or surrounded by anything else but is placed in other positions, such as "above" or "outside."

### *Risk of patent invalidation in Vietnam*

According to the draft of the amended Intellectual Property Law which is expected to be approved by the National Assembly of Vietnam in 2022, patents may be annulled in whole or in part when *"the scope of a patented invention exceeds the scope disclosed in the original specification of the relevant patent application"*. It is understood that if the Vietnamese translation of the patent specification in a patent is found to have exceeded/broadened the content disclosed in the original specification of the relevant patent application, or to have changed the nature of the subject matter(s) in the patent application, such patent is in danger of being invalidated at the request of a third party.

### **The bottom line**

A patent specification is a document that contains the inventor's knowledge and solutions to technical challenges. The foreign-language patent specification must be translated into Vietnamese, and the patent is awarded exclusively on the basis of the Vietnamese specification. It can be said that the Vietnamese specification is the decisive factor for the fate of an invention when its owner wants to commercialize the invention or enforce the patent rights, and resolve disputes, conflicts or infringements of his/her patent rights. Some errors in the translation of the patent specification appear to be minor, but they become significant when a dispute, conflict, or infringement involving the invention develops.

Translation is the process of converting the meaning of words or texts from one language to another, which requires the translator to be diligent, persistent, and cautious. In the sphere of inventions, translating a patent specification into Vietnamese entails more. The translator of such a specification must not only be trained in specialized technical fields, but also have a thorough understanding of those fields and a command of related languages in order to avoid mistranslation, inaccurate translation, and/or narrowing the scope of the invention's protection. Additionally, the translator must be constantly aware of Vietnam's intellectual property laws to ensure that the Vietnamese translation of the patent specification complies with statutory requirements (for example, requirements regarding the structure of a patent specification and requirements regarding the scope of protection of an invention in comparison to the scope of the original patent specification), allowing the patent owner to enjoy legitimate rights and benefits from his or her protected invention.

To minimize errors in the translation of a patent specification, the translator must, in addition to carefully reviewing the patent specification, take an open approach by discussing and clarifying ambiguous or unclear points with the applicant without hesitation in order to fully and accurately comprehend the nature of the invention for his/her accurate translation.

Patent experts believe that building a database of terms, classifying technical fields of inventions as a reference source for patent specifications of a similar nature, and continuously updating the database are effective ways to ensure the consistency of terms, save efforts, avoid mistakes and improve the quality of the translation. Finally, through these methods, costs associated with translating patent specifications can be reduced, benefiting the applicant, particularly given that costs associated with translating patent specifications account for 60-70%, even 80-90% of total costs associated with invention registration in Vietnam.

### **Brief introduction of our firm**

Our firm, [KENFOX IP & LAW OFFICE](http://www.kenfoxlaw.com), is one of the most recognized and respected IP law firms in Vietnam. We proudly have a team of fully qualified and experienced attorneys and specialists in such various fields as Biology, Biomedical Engineering, Chemical Engineering, Chemistry, Civil Engineering, Computer Science, Electrical Engineering, Mechanical Engineering, Electronics, Pharmacy, Telecommunication. We regularly conduct internal training for our attorneys, agents, paralegals, and other staff members, including mentoring and coaching, on-the-job training, and mini-seminars, to improve their skills and knowledge needed. Furthermore, we use advanced technologies to reduce staffing needs and employ other cost-saving measures to reduce our overhead. We can monitor deadlines, check conflicts, manage clients' cases in an efficient manner, to reduce manual work, etc., thereby to save costs for our clients through a good management system of cases based on our own computerized management.

The honorable experience, knowledge and resources of our firm as well as the proven values we share enable us to provide a wide range of clients around the world with professional and high-quality services, including but not limited to patent translation and filing services. In parallel with translating patent specifications in the most professional manner, we carefully review patent specifications to detect their problems and then free-of-charge advise clients of solutions to those problems so that clients can avoid IP Vietnam's costly and time-consuming office actions.

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