

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MOTIONPOINT CORPORATION,
Petitioner,

v.

TRANSPERFECT GLOBAL, INC.,
Patent Owner.

Case CBM2014-00060
Patent 6,857,022 B1

Before THOMAS L. GIANNETTI, BART A. GERSTENBLITH,
and DAVID C. MCKONE, *Administrative Patent Judges*.

GERSTENBLITH, *Administrative Patent Judge*.

DECISION

Institution of Covered Business Method Patent Review
37 C.F.R. § 42.208

I. INTRODUCTION

A. *Background*

MotionPoint Corporation (“Petitioner”) filed a Petition (Paper 1, “Pet.”) to institute a covered business method patent review of claims 1–28 of U.S. Patent No. 6,857,022 B2 (Ex. 1001, “the ’022 patent”).

CBM2014-00060
Patent 6,857,022 B1

See 35 U.S.C. §§ 321–329. TransPerfect Global, Inc. (“Patent Owner”) filed a Preliminary Response (Paper 7, “Prelim. Resp.”).

The standard for instituting a covered business method patent review is set forth in 35 U.S.C. § 324(a), which provides as follows:

THRESHOLD.—The Director may not authorize a post-grant review to be instituted unless the Director determines that the information presented in the petition filed under section 321, if such information is not rebutted, would demonstrate that it is more likely than not that at least 1 of the claims challenged in the petition is unpatentable.

For the reasons given below, we institute covered business method review of claims 1–28 under 35 U.S.C. § 112, first paragraph, on the proposed ground of lack of written description, and of claims 23 and 25–28 under 35 U.S.C. § 112, second paragraph, on the proposed ground of indefiniteness. We do not institute covered business method review of any other ground asserted.

B. Related Cases

Patent Owner has asserted the ’022 patent against Petitioner in *TransPerfect Global, Inc. v. MotionPoint Corp.*, No. 4:10-cv-02590 (N.D. Cal.) and *TransPerfect Global, Inc. v. MotionPoint Corp.*, No. 3:11-cv-04760 (N.D. Cal.). Pet. 12; Paper 6, 2.

The ’022 patent is subject to *inter partes* reexamination, Reexamination Control No. 95/002,372. Pet. 12; Paper 6, 2.

Petitioner also filed two additional petitions for covered business method patent review of the ’022 patent, CBM2014-00066 and CBM2014-00067. Pet. 13; Paper 6, 2.

C. The Asserted Grounds

Petitioner contends that the challenged claims are unpatentable based on the following specific grounds (Pet. 13):

Grounds	Claims Challenged
§ 112, first paragraph (lack of written description and lack of enablement)	1–28
§ 112, second paragraph	17–28

D. The '022 Patent

The '022 patent is directed to a method of ordering a translation of an electronic document, such as a web page or email, using a “one-click” or “single-click” translation component. Ex. 1001, Abstract. The invention is illustrated in Figure 1, reproduced below:

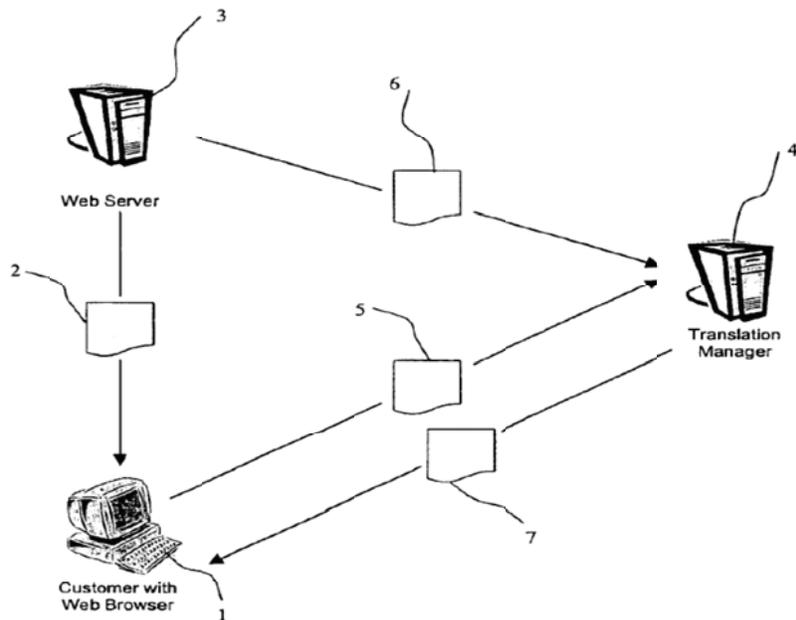


FIG 1

Figure 1 is a schematic of a translation ordering system. Ex. 1001, col. 3, ll. 3–4. Customer 1, at a computer with an Internet browser, requests web page 2 from web server 3, which sends the web page to the customer’s Internet browser. *Id.* at col. 3, ll. 4–6. The customer (also referred to as a “user”) can request a translation of the document from one language (e.g., English) into another (e.g., German) by clicking on a one-click component displayed in the Internet browser, such as a “GO” button displayed in an explorer bar of the Internet browser (shown in Figure 2). *Id.* at col. 3, ll. 47–57.

When a translation is requested, the web page, a selected portion of the web page, or the universal resource locator (“URL”) of the web page is transferred from customer 1 to translation manager 4 (this transfer is shown as reference numeral 5 in Figure 1). *Id.* at col. 3, ll. 14–17. If it received a URL, the translation manager retrieves original web page 2 from web server 3 (this retrieval is shown as reference numeral 6 in Figure 1). *Id.* at col. 3, ll. 28–31. Translation manager 4 translates the text of web page 2 (and possibly other components of the web page) into translated web page 7. *Id.* at col. 3, ll. 32–36. Translated web page 7 is transferred to the customer’s browser and displayed in the requested language. *Id.*

Web page 2 may have links to other web pages. *Id.* at col. 3, l. 40. When translation manager 4 translates web page 2, it may replace the links in translated web page 7 with links that point to the translation manager. *Id.* at col. 3, ll. 36–38. The translation manager may translate automatically the linked web pages, either at the time the customer clicks on the replacement links or in advance, such that the customer does not need to request translation of the additional web pages. *Id.* at col. 3, ll. 38–46. The

'022 patent explains that “[t]his enables the customer to surf an entire web site, or indeed many websites because often the links on a page are to other websites, without the need to separately request translation of each page.”

Id. at col. 3, ll. 38–42.

Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A method of ordering a translation of an electronic communication, the electronic communication comprising at least text of more than one word and one or more hyperlinks to further electronic communications, including the steps of:
 - displaying simultaneously to a user:
 - at least part of said electronic communication; and
 - a single action translation component, said single action translation component comprising an object identified as effecting a translation of said electronic communication in a single action;
 - said user clicking said single action translation component to request translation of at least said text of said electronic communication by transmitting said electronic communication, or an indicator of said electronic communication, to a translation manager; and
 - said translation manager:
 - obtaining a translation of said electronic communication;
 - directing transmission of said translation of said electronic communication to said user; and
 - providing translation of said further electronic communications when said hyperlink is activated:
 - by delivering a translation of said further electronic communications that was translated when said electronic communication was translated; or
 - by obtaining a translation of said further electronic communications when said hyperlink is activated.

Id. at col. 8, l. 51 – col. 9, l. 10.

II. ANALYSIS

A. *Claim Construction*

As a step in our analysis for determining whether to institute a trial, we determine the meaning of the claims. The Board interprets claims using the broadest reasonable construction in light of the specification of the patent in which they appear. *See* 37 C.F.R. § 42.300(b); Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,766 (Aug. 14, 2012). Claim terms generally are given their ordinary and customary meaning, as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *See In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007).

1. “*hyperlink*”

The term “hyperlink” appears in claims 1, 17, and 26 of the ’022 patent, but nowhere else in the specification. Additionally, the term did not appear in the claims of the ’022 patent as originally filed. Ex. 1002, 216–18. The record reflects that the term was introduced by an Examiner’s Amendment. *Id.* at 32–38.

Relying on a dictionary definition, Petitioner asserts that the plain and ordinary meaning of “hyperlink” is “a ‘connection between an element in a hypertext document, such as a word, phrase, symbol, or image, and a different element in the document, another hypertext document, a file, or a script.’” Pet. 15 (quoting Microsoft Press, *COMPUTER USER’S DICTIONARY* 176 (1998) (Ex. 1003)). Petitioner contends that “[h]yperlinks are indicated in a hypertext document through tags in markup languages such as SGML and HTML, are generally not visible to the user, and enable a user to ‘click’

or otherwise ‘select’ the ‘hyperlink’ and then be directed to another object.”¹
Id.

Patent Owner asserts that the term “hyperlink” “should properly be construed as [a] link[] that appear[s] in a hypertext document.” Prelim. Resp. 19. Patent Owner provides what it refers to as a “non-limiting example” of a hyperlink as “a link appearing in a HyperText Markup Language (‘HTML’) document that points to another HTML document.” *Id.*

As reflected above, the parties’ constructions are nearly identical. Thus, we construe the term “hyperlink” in accordance with its ordinary and customary meaning as “a link or connection in a hypertext document.”

2. “*said hyperlink*”

Petitioner and Patent Owner agree that the phrase “said hyperlink” in independent claims 1, 17, and 26 refers back to the previously recited “one or more hyperlinks.” *See* Pet. 19 (“The expression ‘said hyperlink’ that

¹ Petitioner, also relying on dictionary definitions, attempts to draw a distinction between “hyperlink” and “hypertext link,” arguing that “‘hyperlink’ is the underlying functional tag or code that links to another object and it may have associated text (making it a ‘hypertext link’) or non-text images or graphics.” Pet. 18 (citing Exs. 1003–05).

As Petitioner’s own evidence makes clear, “hyperlink,” “hypertext link,” and “link,” as used in the ’022 patent, are synonymous. *See* Ex. 1004 (defining “hypertext link” by reference to the definition of “hyperlink”); Ex. 1005, 5 (“Typically, hypertext consists of a *hyperlink* that appears onscreen as a highlighted word, icon, or graphic. . . . *Hypertext links* are embedded into a Web document using HTML, Hypertext Markup Language. A text *link* usually appears on the screen as an underlined word or phrase and is sometimes rendered in a different color from other text, depending on how your Web browser interprets the HTML codes.” (emphases added)). Accordingly, we decline to draw Petitioner’s distinction among hyperlink, hypertext link, and link.

appears later in each of independent claims 1, 17, and 26 therefore necessarily refers to the previously recited ‘one or more hyperlinks’ included in the ‘electronic communication.’”); *see* Prelim. Resp. 24 (“[S]aid hyperlink’ should properly be construed as a reference back to the ‘one or more hyperlinks’ in each of the claims.”).

We agree. Claim 1, for example, recites:

A method of ordering a translation of an electronic communication, the electronic communication comprising at least text of more than one word and *one or more hyperlinks* to further electronic communications, including the steps of:

...

providing translation of said further electronic communications when *said hyperlink* is activated.

Ex. 1001, col. 8, l. 50 – col. 9, l. 5 (emphases added). Independent claims 17 and 26 use the terms “one or more hyperlinks” and “said hyperlink” similarly.

As reflected in the claim language above, the first use of the term “hyperlink” specifically identifies the hypertext document that includes the “link or connection” and the objects linked or connected thereto. In other words, the hypertext document that contains the link or connection is “the electronic communication” and the objects linked or connected thereto are the “further electronic communications.”

In the Preliminary Response addressing Petitioner’s Ground 1, discussed in Section II.C.1.a., below, Patent Owner raises an argument relating to the construction of the term “hyperlink” and phrase “said hyperlink,” which we address here. In particular, Patent Owner concedes that “said hyperlink” “refers to the ‘one or more hyperlinks to further

electronic communications' found in the *untranslated* original electronic communication.” Prelim. Resp. 33–34 (emphasis added). Patent Owner, however, asserts that the '022 patent specification discloses that the translation manager “is capable of ‘replac[ing] all links in the translated web page 7 with links that point to the translation manager 4.’” *Id.* at 34 (quoting Ex. 1001, col. 3, ll. 36–38 (alteration in original)). Patent Owner argues that “[t]he link replacement is accomplished by modifying or replacing the pointer or reference portion of the hyperlink -- a *portion* of the hyperlink -- but the hyperlink as a whole is not replaced.” *Id.* at 34–35. Patent Owner’s position is that after the links are replaced by the translation manager, “[t]he user can then click this very hyperlink to go to the further electronic communication, but receive the translated version of the page.” *Id.* at 37. This is because the hyperlink “now point[s] to the translation manager.” *Id.* at 38. Patent Owner asserts that the replaced hyperlink is still the same hyperlink because it “would be in the same location of the web page and would still ultimately link to the same further communication (albeit translated).” *Id.* (“the hyperlink is still present, even though a portion of it (the reference) has been modified (or even replaced) in a manner such that it points to the same content as before but via the translation manager”).

Petitioner asserts that although the specification discloses replacing the links in the original (untranslated) electronic communication, the claims do not recite such replacement. Pet. 27. Thus, Petitioner’s position is that when the claims recite the phrase “said hyperlink,” the phrase refers to the “one or more hyperlinks” in the original (untranslated) electronic communication.

On this record, we agree with Petitioner that the claims do not recite replacement or modification of the “one or more hyperlinks.” Thus, when the claims recite “said hyperlink,” referring back to the “one or more hyperlinks,” the hyperlink recited is the original “one or more hyperlinks” in the original (untranslated) electronic communication that link or connect to the further (untranslated) electronic communications.

B. Covered Business Method Patent

Under § 18(a)(1)(E) of the Leahy-Smith America Invents Act (“AIA”), Pub. Law 112-29, 125 Stat. 284, 330 (Sept. 16, 2011), the Board may institute a transitional proceeding only for a patent that is a covered business method patent. Section 18(d)(1) of the AIA defines the term “covered business method patent” to mean:

a patent that claims a method or corresponding apparatus for performing data processing or other operations used in the practice, administration, or management of a financial product or service, except that the term does not include patents for technological inventions.

AIA, 125 Stat. at 331.

The determination of whether a patent is eligible for covered business method patent review is based on what the patent claims. A patent having even one claim directed to a covered business method is eligible for review, even if the patent includes additional claims. *See Transitional Program for Covered Business Method Patents – Definitions of Covered Business Method Patent and Technological Invention; Final Rule*, 77 Fed. Reg. 48,734, 48,736 (Aug. 14, 2012) (Response to Comment 8).

Petitioner identifies, *inter alia*, claims 13–15 as directed to a financial product or service. Pet. 3. Claim 13 depends from claim 1 and further includes “the step of effecting payment for said translation.” Ex. 1001,

col. 9, ll. 42–43. Claim 14 depends from claim 13 and further recites “wherein payment for said translation is effected by an originator of said communication paying a fee for displaying said single action translation component.” *Id.* at col. 9, ll. 44–47. Claim 15 also depends from claim 13 and further recites “wherein payment for said translation is effected by an originator of said communication selling advertising space to an advertiser for a fee and paying said fee, or part of said fee, for displaying said single action translation component.” *Id.* at col. 9, ll. 48–52.

1. *Financial Product or Service*

The legislative history explains that the definition of a covered business method patent was drafted to encompass patents “claiming activities that are financial in nature, incidental to a financial activity or complementary to a financial activity” and that “financial product or service” should be interpreted broadly. 157 Cong. Rec. S5432 (daily ed. Sept. 8, 2011) (statement of Sen. Schumer). As Senator Schumer observed, “[a]t its most basic, a financial product is an agreement between two parties stipulating movements of money or other consideration now or in the future.” *Id.* Thus, “[a]ny business that sells or purchases goods or services ‘practices’ or ‘administers’ a financial service by conducting such transactions.” *Id.*

Petitioner argues that claims 13–15 are directed to financial products or services because they recite a transfer of money between two entities. Pet. 8. The Preliminary Response does not dispute that claims 13–15 are directed to financial products or services.

We agree with Petitioner. Claim 13 recites “effecting payment” for a translation of an electronic communication. Claim 14 further specifies that

the originator of the electronic communication pays a fee to display a single-action translation component. For example, as described in the specification, “[t]he owner of the web page may pay a fee to be able to place the web translation component on that web page.” Ex. 1001, col. 4, ll. 14–19. Claim 15 specifies that payment for the translation can be effected by the originator of the electronic communication selling advertising space to an advertiser for a fee and paying some, or all, of that fee to display the single-action translation component. For example, an advertiser can pay the owner of a web site to include the translation component on the web site along with the advertisement and the website owner can, in turn, pay at least some of this fee to the translation service that provides the translation component. *Id.* at col. 4, ll. 20–24. These are examples, in the claims of the ’022 patent, of the movement of money between at least two parties. Accordingly, we are persuaded that at least claims 13–15 are directed to financial products or services.

2. *Technological Invention*

The definition of “covered business method patent” in § 18(d)(1) of the AIA does not include patents for “technological inventions.” AIA, 125 Stat. at 331. Section 18(d)(2) provides that “the Director shall issue regulations for determining whether a patent is for a technological invention.” *Id.* The legislative history points out that the regulation for this determination should only exclude “those patents whose novelty turns on a technological innovation over the prior art and are concerned with a technical problem which is solved with a technical solution and which requires the claims to state the technical features which the inventor desires

to protect.” 157 Cong. Rec. S1364 (daily ed. Mar. 8, 2011) (statement of Sen. Schumer).

For the purposes of the Transitional Program for Covered Business Method Patents, we look to 37 C.F.R. § 42.301(b), which defines the term “technological invention” and requires a case-by-case consideration of “whether the claimed subject matter as a whole recites a technological feature that is novel and unobvious over the prior art; and solves a technical problem using a technical solution.” The following claim drafting techniques, for example, typically do not render a patent a “technological invention”:

(a) Mere recitation of known technologies, such as computer hardware, communication or computer networks, software, memory, computer-readable storage medium, scanners, display devices or databases, or specialized machines, such as an ATM or point of sale device.

(b) Reciting the use of known prior art technology to accomplish a process or method, even if that process or method is novel and non-obvious.

(c) Combining prior art structures to achieve the normal, expected, or predictable result of that combination.

Office Patent Trial Practice Guide, 77 Fed. Reg. at 48,763–64. Therefore, to qualify under the “technological invention” exception to covered business method patent review, it is not enough that the invention makes use of technological systems, features, or components.

Petitioner contends that the ’022 patent claims recite only the use of general computer network technology and solve a problem with methods that require no more than conventional software and hardware components. Pet. 10–11. Petitioner points to the ’022 patent’s statements that “[t]he invention can be applied to virtually any software” (Ex. 1001, col. 6, l. 42)

and that “[a] person skilled in the art would be aware of the myriad of ways these revenue sharing schemes can be set up” (*id.* at col. 8, ll. 1–2) to show that no specific hardware or software is needed to carry out the invention. Pet. 10.

Patent Owner contends that the claims of the ’022 patent, as a whole, recite a novel and nonobvious technical feature. Patent Owner argues that, in *TransPerfect Global, Inc. v. MotionPoint Corp.*, No. 4:10-cv-02590 (N.D. Cal.), a jury found several of the claims novel and nonobvious, and urges that we should make that same finding here. Prelim. Resp. 4–11. “Reciting the use of known prior art technology to accomplish a process or method, even if that process or method is novel and non-obvious,” however, typically is not enough to show a technological invention. Office Patent Trial Practice Guide, 77 Fed. Reg. at 48,763–64.

Petitioner characterizes the invention of the ’022 patent as “routing human-made translations over the Internet using unspecified general computer network components.” Pet. 11.

Patent Owner takes issue with this characterization, arguing that it ignores several key features of the claims. Prelim. Resp. 16. Specifically, Patent Owner argues that the claims solve a technical problem using a technical solution because they claim modifying hyperlinks on a translated web page to point back to a translation manager such that when the user clicks on a hyperlink, the translation of the linked web page is requested from the translation manager. Prelim. Resp. 11–14. This feature, although described in the specification, is not recited in the claims. As we explained above, *see* Section II.A.2, the claims recite the user activating “said

hyperlink,” which refers to “one or more hyperlinks to further electronic communications” in the original (untranslated) electronic communication.

Additionally, Patent Owner also contends that the claimed translation manager has access to a translation engine that performs the translation.

Prelim. Resp. 13. As Petitioner points out (Pet. 10), however, the ’022 patent explains that the translation could be performed by a human rather than a translation engine. Ex. 1001, col. 5, ll. 23–25.

Patent Owner argues that a translation manager is not a conventional feature of a general purpose computer. Prelim. Resp. 17. Instead, Patent Owner argues, “the translation manager causes a computer to act differently than it otherwise would, by changing the parties with whom the computer communicates, by changing the operation of how hyperlinks are processed, and by drastically reducing the time it takes to provide translated web pages to a user.” *Id.* As claimed, however, the translation manager merely obtains documents (translations) automatically or upon request and directs them to a user. Patent Owner has pointed to nothing in the claims suggesting that the translation manager changes how hyperlinks are processed. Instead, hyperlinks are used, in a conventional manner, to direct documents from one computer to another. We are persuaded that receiving and sending documents is a conventional feature of a general purpose computer used in Internet communications.

In sum, we are persuaded, on this record, that the invention, as claimed, does not solve a technical problem using a technical solution and, thus, is not a technological invention. Accordingly, the ’022 patent is eligible for covered business method patent review.

C. *Asserted Grounds of Unpatentability*

1. *Unpatentability of Claims 1–28 Under 35 U.S.C. § 112, First Paragraph*

a. *Lack of Written Description Support for Claims 1–28*

Petitioner asserts claims 1–28 lack written description support for the phrase “when said hyperlink is activated” because the written description portion of the ’022 patent fails to disclose providing translation of said further electronic communications when the one or more hyperlinks in the original electronic communication is activated. Pet. 35 (noting the difference between the claim language and the specification).

Patent Owner contends that the claims are adequately supported by the written description because the phrase “said hyperlink” can refer to the “one or more hyperlinks” first recited and yet also refer to replacement hyperlinks that point to a different address. Prelim. Resp. 37–38.

As reflected in our construction of the phrase “said hyperlink,” claims 1, 17, and 26 each refer back to the original recitation of “one or more hyperlinks” in the original (untranslated) electronic communication. Thus, the question before us is “whether the disclosure of the [patent] relied upon reasonably conveys to those skilled in the art that the inventor had possession of [providing translation of said further electronic communications when said hyperlink is activated] as of the filing date.” *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc).

On the record before us, Petitioner has shown that it is more likely than not that one of ordinary skill in the art would not have understood from the written description of the ’022 patent that the inventors had possession of

this element of the claims as of the filing date. Patent Owner relies upon only one portion of the specification in response to Petitioner's argument—the specification's disclosure with respect to requesting a translation of a web page and the actions of the translation manager. *See* Prelim. Resp. 34 (quoting Ex. 1001, col. 3, ll. 32–45). The specification states:

Once the translation is requested by a single action, the web page, a selected part of the web page, the URL of the web page or other indicator is transferred 5 to a translation manager 4. . . .

The translation manager 4 processes the request by translating the text (and possibly sound, video, graphics etc.) and optionally adding further information. The translated web page 7 is transferred to the customer's browser and displayed in the requested language. *The translation manager may also replace all links in the translated web page 7 with links that point to the translation manager 4.* This enables the customer to surf an entire web site, or indeed many websites because often the links on a page are to other websites, without the need to separately request translation of each page. Once translation of one page is requested, linked pages may be automatically translated (either when the link is clicked or in advance) in anticipation of the customer's needs.

Ex. 1001, col. 3, ll. 14–45 (emphasis added).

Contrary to Patent Owner's assertion, this portion of the specification does not describe the method and systems recited in the claims, which indicate that the translation manager provides translations of the further electronic communications hyperlinked to the original electronic communication. Rather, this portion of the specification indicates that the translation manager may replace all of the links (i.e., hyperlinks) in the translated web page with links that point to the translation manager. These replaced links are in the translated electronic communication (e.g., web

page 7), and not in the original untranslated electronic communication (e.g., web page 2). In other words, this disclosure does not reasonably convey to one of ordinary skill in the art that the inventors had possession of a translation manager that provides translation of further electronic communications when the one or more hyperlinks in the original untranslated electronic communication is activated, as recited in claims 1, 17, and 26.^{2,3}

Accordingly, Petitioner has established on the record before us that it is more likely than not that claims 1–28 of the '022 patent lack adequate written description support and are therefore not patentable.

b. Lack of Enablement of Claims 1–28

Petitioner asserts that the '022 patent lacks an enabling disclosure to support claims 1–28. Pet. 38–40. Petitioner contends that because the specification describes only a single way of obtaining, providing, and returning a translation of “further electronic communications,” and because that single way is not recited in the claims, claims 1–28 are not enabled. *Id.*

² Petitioner notes that claim 8 as originally filed recited “[t]he method of claim 1 further including the step of the translation manager *replacing* links in the selected communication.” Pet. 27, n.3. While Petitioner has not established, and we do not find, that Patent Owner surrendered any subject matter by the claim’s cancellation, we think it informative to show that Patent Owner knew how to claim the replacement of hyperlinks.

³ Patent Owner briefly mentions a “browser plug-in,” which Patent Owner asserts can “automatically determine when it needs to translate text and will present the user with a translated version of the page” without requiring modification of the page. Prelim. Resp. 36–37 (citing Ex. 1001, col. 4, l. 61 – col. 5, l. 3). Patent Owner has not explained persuasively how the description of a “browser plug-in” reasonably would convey to one of ordinary skill in the art that the inventors had possession of the claimed translation manager.

Patent Owner raises similar arguments in response to Petitioner's allegations regarding enablement as reflected above in the discussion of whether claims 1–28 are supported by an adequate written description. Prelim. Resp. 39–40.

It is well settled that a patent specification “must describe the manner and process of making and using the invention so as to enable a person of skill in the art to make and use the full scope of the invention without undue experimentation.” *LizardTech, Inc. v. Earth Res. Mapping, Inc.*, 424 F.3d 1336, 1344–45 (Fed. Cir. 2005) (citations omitted). “The key word is ‘undue,’ not ‘experimentation.’” *In re Wands*, 828 F.2d 731, 737 (Fed. Cir. 1988) (citation omitted) (setting forth several factors that may be considered to determine whether a disclosure would require undue experimentation).

Petitioner fails to analyze any of the *Wands* factors, instead asserting that because the specification discloses a single way to perform the invention—a way different from that recited in the claims (as discussed above)—one of ordinary skill in the art would not be able to make and use the *claimed* invention. *Id.* at 39–40. Although we recognize that the written description and enablement requirements “usually rise and fall together,” *LizardTech*, 424 F.3d at 1345, here Petitioner has failed to put forth any evidence that practicing the claims *as written* would require undue experimentation.⁴ Petitioner, therefore, has not shown that it is more likely than not that claims 1–28 of the '022 patent are not enabled.

⁴ The specification's lack of an example of the invention *as claimed*, does not mean, in and of itself, that undue experimentation would have been required for one of ordinary skill in the art to practice the invention.

c. Additional Lack of Written Description Support for Claim 11

Petitioner asserts that claim 11 lacks adequate written description support for an additional reason. Pet. 40–41. Specifically, Petitioner contends that “claim 11 recites the ‘step of compiling statistical information *about* said translation manager,’ . . . [and the] specification does not describe any embodiment in which statistics are maintained or even compiled ‘about’ the translation manager.” *Id.* Petitioner asserts that even though the specification “includes a database with statistics ‘about’ the user or ‘about’ the translations, . . . no statistics are collected, maintained, or compiled ‘about’ the translation manager.” *Id.* at 41.

Patent Owner explains in response that the specification provides written description support for claim 11: “Statistical information about web pages that have been translated is the same as statistical information about the translation manager. . . . [because] [t]he translation manager is responsible for the translation.” Prelim. Resp. 40. Thus, “statistical information ‘about’ [the translation manager’s] output is statistical information ‘about’ the translation manager itself.” *Id.*

The ’022 patent discloses that “translation manager 4 maintains a database of statistical information about the requested translations.” Ex. 1001, col. 6, ll. 56–58. Even if we were to adopt Petitioner’s proposed construction of “about” as meaning “pertaining to or concerning” (Pet. 40 (citing Ex. 1006, 2)), because the translation manager manages the translation requests, a database of statistical information pertaining to or concerning the requested translations, also pertains to or concerns the translation manager. Thus, Petitioner has not shown that it is more likely

than not that claim 11 lacks written description support in the specification for this additional reason.

2. *Unpatentability of Claims 17–28 Under 35 U.S.C. § 112, Second Paragraph*

a. *Whether Claims 17–28 are Unpatentable for Claiming Process Limitations in an Apparatus Claim*

Petitioner contends that claims 17–28 of the '022 patent are indefinite because a potential infringer cannot ascertain when infringement occurs. Pet. 41. Specifically, Petitioner asserts that independent claims 17 and 26, and hence the claims that depend therefrom, are indefinite because they recite a system, yet also include alleged method steps to be performed by the recited translation manager. *Id.* at 42–44. Thus, Petitioner contends that one of ordinary skill in the art cannot ascertain whether infringement occurs by creating a system that includes a translation manager capable of performing the method steps or whether infringement requires a created system to actually perform the recited steps. *Id.*

Patent Owner asserts in response that the claim language describes the manner in which the translation manager (for claim 17) and the one or more translation engines (for claim 26) are configured to function. Prelim. Resp. 41. Thus, Patent Owner contends that “[o]ne skilled in the art would not . . . construe this language as separate method steps.” *Id.* at 41–42.

In *IPXL Holdings, L.L.C. v. Amazon.com, Inc.*, the Federal Circuit addressed a claim to a “system” that also recited “wherein . . . and *the user uses the input means* to either change the predicted transaction information or accept the displayed transaction type and transaction parameters.”

430 F.3d 1377, 1384 (Fed. Cir. 2005) (emphasis added). The Federal Circuit concluded that such language was indefinite because it was

unclear whether infringement of the claim occurs when one creates a system that allows the user to change the predicted transaction information or accept the displayed transaction, or whether infringement occurs when the user actually uses the input means to change transaction information or uses the input means to accept a displayed transaction.

Id.

In *In re Katz Interactive Call Processing Patent Litig.*, the Federal Circuit considered claims to a system with “an ‘interface means for providing automated voice messages . . . to certain of said individual callers, wherein *said certain of said individual callers digitally enter data.*’” 639 F.3d 1303, 1318 (Fed. Cir. 2011) (emphasis added). The Federal Circuit concluded that the claims were similarly indefinite because they “create confusion as to when direct infringement occurs because they are directed both to systems and to actions performed by ‘individual callers.’” *Id.*

In *Biosig Instruments, Inc. v. Nautilus, Inc.*, 715 F.3d 891, 904 (Fed. Cir. 2013), *vacated and remanded on other grounds by Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120 (2014), however, the Federal Circuit reached a different result with respect to a claim to a system that also recited, “*said elongate member is held by said user with one hand of the user on said first half contacting said first live electrode and said first common electrode, and with the other hand of the user on said second half contacting said second live electrode and said second common electrode.*” U.S. Patent No. 5,337,753, col. 5, ll. 17–47 (emphases added). The Federal Circuit determined that this language constituted “functional limitations that describe the capability” of the system. *Biosig*, 715 F.3d at 904.

Claim 17, in relevant part, recites:

17. A single-action translation ordering system comprising:

. . .

a translation manager . . .

said translation manager:

obtaining a translation of said electronic communication in response to a user clicking said single action translation component

Ex. 1001, col. 9, l. 56 – col. 10, l. 8. Similar to the claims in *Biosig*, claims 17–28 recite systems in which the translation manager and translation engines, respectively, are capable of performing the functions recited. Accordingly, on the record before us, Petitioner has not established that it is more likely than not that claims 17–28 are indefinite.⁵

b. Whether Claims 23–28 are Unpatentable for Failing to Disclose Sufficient Structure for Performing the Claimed Means

Petitioner asserts that claims 23–28 of the '022 patent are drafted in means-plus-function format, but the specification does not disclose algorithms to perform the claimed functions. Pet. 44–56.

Patent Owner generally asserts that the specification, and, in particular, many portions of the specification cited by Petitioner, “do convey an algorithm to a person skilled in the art.” Prelim. Resp. 43.

Although the specific arguments with respect to each claim are discussed in detail below, Patent Owner raises a general argument that we

⁵ Claim 26 also recites the capability of a translation engine, namely “one or more translation engines translating said electronic communication and said further electronic communications according to parameters.” Ex. 1001, col. 10, ll. 52–54.

address here. In particular, Patent Owner asserts that “[a] person with sufficient understanding of the relevant communication protocols, such as HTTP, would glean sufficient algorithmic structure from the ’022 patent in order to design and build the claimed invention.” Prelim. Resp. 44.

Whether one of ordinary skill in the art “*could* devise some method to perform the function is not the proper inquiry as to definiteness—that inquiry goes to enablement.” *Function Media, L.L.C. v. Google, Inc.*, 708 F.3d 1310, 1319 (Fed. Cir. 2013) (citing *Blackboard, Inc. v. Desire2Learn, Inc.*, 574 F.3d 1371, 1385 (Fed. Cir. 2009)). As explained by the Federal Circuit, a “patentee cannot avoid providing specificity as to structure simply because someone of ordinary skill in the art would be able to devise a means to perform the claimed function. . . . that . . . would allow the patentee to claim all possible means of achieving a function.” *Blackboard*, 574 F.3d at 1385.

i. Claim 26

Petitioner asserts that claim 26 contains three means-plus-function limitations, each of which is indefinite because the ’022 patent specification “fails to disclose any linked structure in support of the recited functions.” Pet. 46. We address each.

a) “means for receiving an electronic communication in response to clicking a single action translation component displayed simultaneously with at least part of said electronic communication”

Petitioner asserts that the specification appears to require the translation manager to “receiv[e] an electronic communication” as recited in claim 26. Pet. 46–47. Petitioner, however, contends that the only

disclosures in the specification pertaining to this limitation are functional (*id.* at 47), and that it appears from testimony by Patent Owner’s expert during trial in *TransPerfect Global, Inc. v. MotionPoint Corp.*, No. 4:10-cv-02590 (N.D. Cal.), “that the translation manager is *software* or *code*” (*id.* at 49 (citing Ex. 1007, 458:4–16)). Petitioner asserts that because the structure (i.e., translation manager) that performs the function of “receiving an electronic communication” requires software, “there must be some disclosure of the *algorithm* performed by this software to satisfy the recited function. Here, there is none.” *Id.*

In response, Patent Owner contends that one of ordinary skill in the art would understand that when a user of a browser selects one of the replacement hyperlinks that link to the translation manager, “the translation manager can receive this electronic communication as any web server would.” Prelim. Resp. 43. Thus, according to Patent Owner, “[i]t is unclear what further algorithm [Petitioner] believes a skilled artisan would need.” *Id.*

The “means for receiving” is a computer-implemented means-plus-function limitation. “Thus, to meet the definiteness requirements of 35 U.S.C. § 112, second paragraph, the specification must disclose an algorithm for performing the claimed function.” *Augme Techs., Inc. v. Yahoo! Inc.*, No. 2013-1121, -1195, slip op. at 18 (Fed. Cir. June 20, 2014) (citing *NetMoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1367 (Fed. Cir. 2008)); accord *Triton Tech of Texas, LLC v. Nintendo of Am., Inc.*, No. 2013-1476, slip op. at 5 (Fed. Cir. June 10, 2014) (citing *Aristocrat Techs. Austr. Pty Ltd. v. Int’l Gaming Tech.*, 521 F.3d 1328, 1333 (Fed. Cir. 2008)). “[T]he algorithm may be expressed in ‘any

understandable terms including as a mathematical formula, in prose, or as a flow chart, or in any other manner that provides sufficient structure.”

Augme Techs., slip op. at 18 (quoting *Finisar Corp. v. DirectTV Grp., Inc.*, 523 F.3d 1323, 1340 (Fed. Cir. 2008)). “But, it must disclose *some* algorithm; it cannot merely restate the function recited in the claim.”

Id. (quoting *Finisar Corp.*, 523 F.3d at 1340).

We agree with Petitioner that the structure described as performing the function of “receiving an electronic communication in response to clicking a single action translation component” is the translation manager, some component of the translation manager, or some algorithm for performing the recited function. The ’022 patent specification, however, does not disclose a structure or an algorithm for performing this function. Rather, we agree with Petitioner that the ’022 patent, at best, simply restates the function recited in the claim. *See, e.g.*, Ex. 1001, col. 3, ll. 14–17 (“Once the translation is requested by a single action, the web page, a selected part of the web page, the URL of the web page or other indicator is transferred 5 to a translation manager 4.”); col. 3, ll. 28–31 (“Rather than transferring the web page, the URL or other indicator may be provided instead. In this case, the translation manager 4 will retrieve the original web page 6 from the web server 3.”).

Accordingly, on the record before us, Petitioner has shown that it is more likely than not that the ’022 patent specification does not disclose sufficient structure for performing the function of “receiving an electronic communication in response to clicking a single action translation component” as recited in claim 26.

*b) “means for returning a translation of
said electronic communication”*

Petitioner contends that the '022 patent specification does not disclose sufficient structure for performing the function of “returning a translation of said electronic communication.” Pet. 51. Petitioner asserts that the entirety of the disclosure in the '022 patent specification consists of the following two statements: (1) “The translated web page 7 is transferred to the customer’s browser and displayed in the requested language”; and (2) “[i]n this case the translated communication may be returned to the translation manager for transmission to the user.” *Id.* (quoting Ex. 1001, col. 3, ll. 34–36, col. 5, ll. 17–22).

Patent Owner asserts that the portions of the specification cited by Petitioner provide sufficient disclosure of an algorithm. Prelim. Resp. 43–44. Patent Owner further contends that one of ordinary skill in the art “would appreciate that the translation manager responds to requests made over HTTP in the same manner as any web server would, as clearly described in the '022 patent at 1:17–37.” *Id.* at 44.

The portions of the specification cited by Petitioner and Patent Owner simply restate the function of “returning a translation of said electronic communication.” Accordingly, on the record before us, Petitioner has shown that it is more likely than not that the '022 patent specification does not disclose sufficient structure for performing the function of “returning a translation of said electronic communication” as recited in claim 26.

c) “means for returning a translation of said further electronic communications when said hyperlink is activated”

Petitioner raises the same arguments with respect to the above-quoted, third means-plus-function element of claim 26. Pet. 52–54 (identifying column 3, lines 36–45, of the ’022 patent specification as the only disclosure addressing the return of “further” electronic communications). Patent Owner raises the same argument and evidence in response. Prelim. Resp. 44 (citing Ex. 1001, col. 3, ll. 36–45).

For the same reasons we discussed with respect to the first two means-plus-function elements of claim 26, on the record before us, Petitioner has shown that it is more likely than not that the ’022 patent specification does not disclose sufficient structure for performing the function of “returning a translation of said further electronic communications when said hyperlink is activated” as recited in claim 26.

ii. Claims 23 and 27

Petitioner asserts that the ’022 patent specification fails to disclose a structure or structures that perform the functions of the two means-plus-function limitations of claims 23 and 27: “means for compiling statistics about said system” (claim 23) and “means for compiling translation statistics.” Pet. 54–55. Petitioner identifies Figure 11 of the ’022 patent and the description thereof, which in turn point to database 23, but Petitioner asserts that “there is no disclosure as to how the statistics are compiled, much less what these statistics may be.” *Id.* at 55. Petitioner contends that the specification fails to provide any structure for compiling the statistics and that “[t]he structure for the database therefore must be software.” *Id.* Petitioner asserts that the specification “discloses no algorithm, much less a

flow chart or any other structure that might be capable of carrying out the function of the software” (Pet. 55) thus rendering claims 23 and 27 indefinite (*id.* at 54).

Patent Owner asserts that “[a]mple supporting structure is described in the ’022 patent at 8:40–43 and FIG. 11.” Prelim. Resp. 44. Patent Owner contends that Figure 11 illustrates a database (database 23) for storing statistics, thus, “[t]he relevant structure is a database, which one skilled in the art would understand is capable of compiling statistics.” *Id.* at 44–45.

Figure 11 of the ’022 patent discloses the translation manager as a box, within which is shown, *inter alia*, three database boxes—translation server database 21, customer database 22, and translation stats database 23. Ex. 1001, Fig. 11. This disclosure is analogous to that in *Augme Techs, Inc. v. Yahoo! Inc.*, where the Federal Circuit explained that “[s]imply disclosing a black box that performs the recited function is not a sufficient explanation of the algorithm required to render the means-plus-function term definite.” Slip op. at 19 (Fed. Cir. June 20, 2014) (citation omitted). Further, Patent Owner’s reliance upon column 8, lines 40–43, which state that “[s]tatistics on translations performed are maintained in another database 23 for internal management and affiliate program purposes,” fares no better because that disclosure “merely restates the recited function.” *Id.*

Accordingly, on the record before us, Petitioner has shown that it is more likely than not that the ’022 patent specification does not disclose sufficient structure(s) for performing the functions of “compiling statistics about said system” and “compiling translation statistics” as recited in claims 23 and 27, respectively.

iii. Claim 24

Petitioner similarly asserts that the '022 patent specification fails to disclose sufficient structure corresponding to the recited “means for translating currency amounts to equivalent amounts in a user currency” of claim 24. Pet. 55–56.

Patent Owner contends that the specification discloses sufficient structure by indicating that “translation manager 4 may access current or historical currency exchange rates to convert fees and charges to a currency suitable for the user.” Prelim. Resp. 45 (quoting Ex. 1001, col. 7, ll. 37–39). Patent Owner asserts that “[t]he algorithm is readily apparent to a skilled artisan – communicate with a source of current or historical currency exchange rates, and perform the conversion.” *Id.*

The above description provides more explanation of the algorithm than simply reciting the function of the means-plus-function limitation. Accordingly, on the record before us, Petitioner has failed to show that it is more likely than not that the '022 patent specification does not disclose sufficient structure in the form of an algorithm for performing the function of “translating currency amounts to equivalent amounts in a user currency” as recited in claim 24.

iv. Claims 25 and 28

Claim 25 depends from claim 17 and recites: “The system of claim 17 further comprising means for maintaining user information.” Ex. 1001, col. 10, ll. 39–40. Claim 28 depends from claim 26 and recites: “The translation manager of claim 26 further comprising means for maintaining user information.” *Id.* at col. 10, ll. 61–62. Petitioner contends that the '022 patent specification fails to disclose sufficient structure

corresponding to the recited “means for maintaining user information” of claims 25 and 28. Pet. 56.

Patent Owner asserts that column 4 of the ’022 patent provides sufficient support and that “[a] skilled artisan would readily understand the algorithm needed to collect the user information as described in col. 4.” Prelim. Resp. 45.

The function recited by the means-plus-function limitation is “maintaining user information.” The ’022 patent specification discloses that “[i]t is also necessary for the translation manager 4 to maintain a customer database 22 for accounting purposes.” Ex. 1001, col. 8, ll. 38–40; *see also* Pet. 56 (identifying customer database 22). Similar to translation stats database 23, the specification fails to provide sufficient structure in the form of an algorithm to disclose how the user information is *maintained* in customer database 22. Unlike Patent Owner’s argument with respect to claim 24, Patent Owner has not pointed to a specific disclosure in the specification containing such an algorithm.

Accordingly, on the record before us, Petitioner has shown that it is more likely than not that the ’022 patent specification does not disclose sufficient structure for performing the function of “maintaining user information” as recited in claims 25 and 28.

III. CONCLUSION

For the foregoing reasons, we determine that the information presented in the Petition establishes that it is more likely than not that claims 1–28 of the ’022 patent are unpatentable.

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The Board, however, has not made a final determination under 35 U.S.C. § 328(a) with respect to claim construction or the patentability of the challenged claims.

IV. ORDER

For the reasons given, it is

ORDERED that pursuant to 35 U.S.C. § 324 and § 18(a) of the AIA, a covered business method patent review is hereby instituted as to claims 1–28 of the '022 patent for the following grounds:

- A. Claims 1–28 under 35 U.S.C. § 112, first paragraph, as lacking an adequate written description; and
- B. Claims 23 and 25–28 under 35 U.S.C. § 112, second paragraph, as indefinite.

We do not institute covered business method review on any other grounds asserted.

FURTHER ORDERED that pursuant to 35 U.S.C. § 324(d) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial; the trial commencing on the entry date of this Decision.

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