

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MOTIONPOINT CORPORATION,
Petitioner,

v.

TRANSPERFECT GLOBAL, INC.,
Patent Owner.

Case CBM2014-00067
Patent 6,857,022

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

MCKONE, *Administrative Patent Judge*.

DECISION

Denying 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 B1 (Ex. 1001, “the ’022 patent”). See 35 U.S.C. §§ 321–329. TransPerfect Global, Inc. (“Patent Owner”) filed a Preliminary Response (Paper 6, “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.

We determine that the record before us does not demonstrate that it is more likely than not that at least one of the challenged claims is unpatentable. We consequently deny the Petition and decline to institute a covered business method patent review of the ’022 patent.

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 5 at 2.

The ’022 patent is subject to *inter partes* reexamination, Reexamination Control No. 95/002,372. Pet. 12; Paper 5 at 2.

Petitioner has filed two additional petitions for covered business method patent review of the '022 patent, CBM2014-00060 and CBM2014-00066. Pet. 13; Paper 5 at 2.

C. References Relied Upon

Petitioner relies upon the following prior art references:

JP10056491 A, published February 24, 1998 (“Ito,” Ex. 1009).

Petitioner’s cites are to an English translation;

PCT publication WO 00/46693, published August 10, 2000 (“Lakritz,” Ex. 1011);

U.S. Patent No. 5,944,790, issued August 31, 1999 (“Levy,” Ex. 1012); and

Babylon.com Adds Single-click Currency Conversions, Creating Instant Global E-businesses, BUSINESS WIRE (Jan. 18, 2000), downloaded at <http://www.thefreelibrary.com> (“Babylon,” Ex. 1013).

D. The Asserted Grounds

Petitioner contends that the challenged claims are unpatentable based on the following specific grounds (Pet. 14):

References	Basis	Claims Challenged
Ito	§ 102(a), (b)	1–4, 6–8, 16–18, 21, 22, and 26
Ito and Lakritz	§ 103(a)	9, 11–14, 23, 25, 27, and 28
Ito and Levy	§ 103(a)	9, 11, 23, and 27
Ito and Babylon	§ 103(a)	10 and 24

References	Basis	Claims Challenged
N/A	§ 112, first paragraph (lack of written description)	1-28
N/A	§ 112, first paragraph (lack of enablement)	1-28

E. 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:

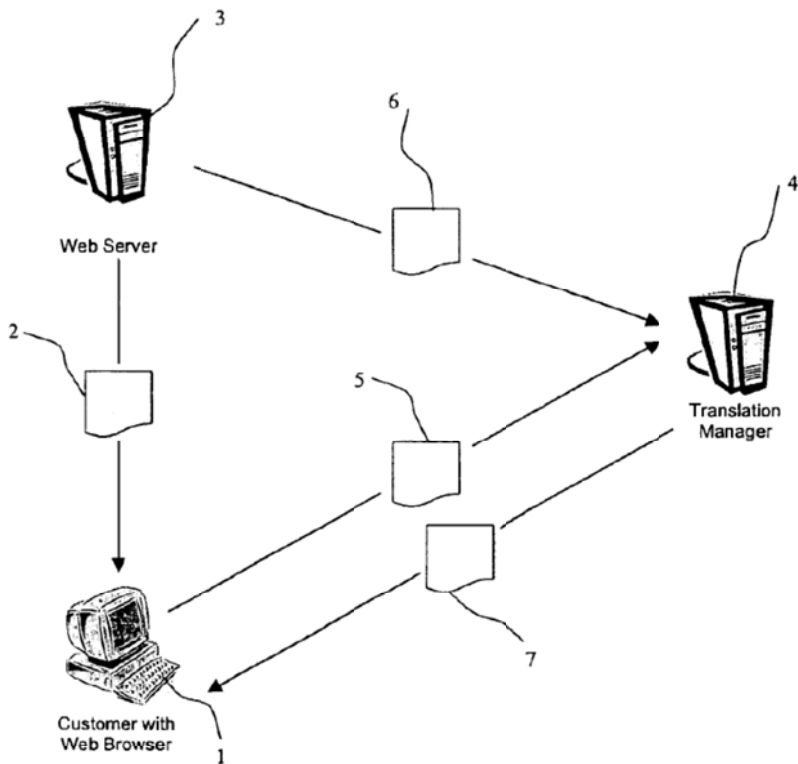


FIG 1

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 sent from the customer’s computer 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 the 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.

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. In CBM2014-00060, Petitioner and Patent Owner put forth the same respective positions on the construction of the term “hyperlink” as they do here. For the reasons given in our institution decision in CBM2014-

00060, which is being issued concurrently with this decision, we construe the term “hyperlink” in accordance with its ordinary and customary meaning as “a link or connection in a hypertext document.” *See Motion Point Corp. v. TransPerfect Global, Inc.*, Case CBM2014-000060, Paper 8 (“’060 Dec.”), slip. op. at 6–7 (PTAB July 23, 2014).

2. “said hyperlink”

The term “said hyperlink” appears in claims 1, 17, and 26. In CBM2014-00060, Petitioner and Patent Owner put forth the same respective positions on the construction of the term “said hyperlink” as they do here. For the reasons given in the institution decision in CBM2014-00060, which is being issued concurrently with this decision, “said hyperlink” is a reference back to “one or more hyperlinks” recited in claims 1, 17, and 26. ’060 Dec. 7–8. Moreover, as explained in the ’060 Decision, the claims do not recite replacement or modification of the “one or more hyperlinks.” ’060 Dec. 8–10. Thus, when the claims recite “said hyperlink,” 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 claims 13, 14, and 15 as directed to a financial product or service. Pet. 2–4. Claim 13 depends from claim 1 and further includes “the step of effecting payment for said translation.” Claim 14 depends from claim 13 and adds “wherein payment for said translation is effected by an originator of said communication paying a fee for displaying said single action translation component.” Claim 15 also depends from claim 13 and adds “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.”

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 website to include the translation component on the website 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. 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 over Ito (asserted in the Petition) and the Murata reference (at issue in CBM2014-

00066), Prelim. Resp. 4–7, and urges that we should make that same finding here. That is not determinative, however, as “[r]eciting the use of known prior art technology to accomplish a process or method, even if that process or method is novel and non-obvious,” 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. 10. 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. *Id.* at 11–14. This feature, while described in the specification, is not recited in the claims. As we explained in the ’060 Decision, referenced in Section II.A.2 above, 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 contends that the claimed translation manager has access to a translation engine that performs the translation. Prelim. Resp. 13. However, as Petitioner points out (Pet. 10), the 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. Asserted Grounds Based on Anticipation by Ito

a. Ito

Petitioner contends that Ito anticipates claims 1–4, 6–8, 16–18, 21, 22, and 26. Pet. 29–30. Ito describes a machine translation system that translates text in documents from websites from one language into another

(e.g., from French to Japanese). Ex. 1009 ¶¶ 24, 34, 41. An example is illustrated in Figure 2, reproduced below:

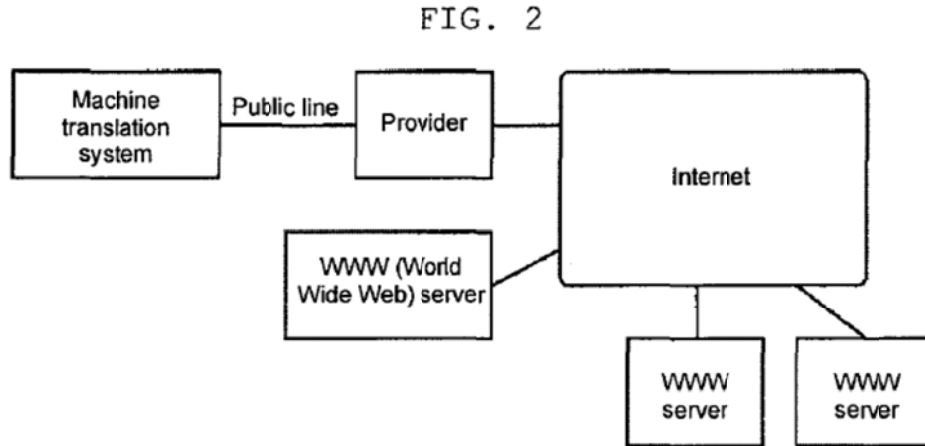


Figure 2 is a block diagram of a method of browsing websites, via the Internet, using a machine translation system. Ex. 1009 ¶ 35.

The machine translation system is implemented on a computer, for example as a computer program. *Id.* ¶ 24. The machine translation system is connected to the Internet through a provider and can download and display documents from websites via the Internet. *Id.* ¶¶ 35–36. As shown in Figures 3 and 5, the documents from the websites can include hypertext documents with links to other documents, including documents on other servers. *Id.* ¶ 37. Figure 5 is reproduced below:

does not translate the new document until the “translation” button is pressed.
Id. ¶ 76; Fig. 8.

b. Claims 1–4, 6–8, 16–18, 21, and 22

Regarding claim 1, Petitioner and Patent Owner dispute whether Ito discloses “said user clicking said single action translation component,” “obtaining a translation of said electronic communication,” and “providing translation of said further electronic communications when said hyperlink is activated,” arranged as in the claim.

Petitioner contends that a user clicking on Ito’s “translation” button to request a translation is a “user clicking said single action translation component to request translation of at least said text of said electronic communication,” and that the subsequent translating of the webpage and displaying the translated document is “obtaining a translation of said electronic communication.” Pet. 36. Petitioner further contends that Ito’s description of automatically translating a linked document when the machine translation system is in a mode of “translation of the whole page is always performed” is a disclosure of “providing translation of said further electronic communications when said hyperlink is activated.” *Id.* at 37–38. Petitioner states that automatically translating an additional page when a hyperlink is activated “is clearly illustrated in FIG. 8 of Ito,” and Petitioner describes Figure 8 as disclosing

to check, at C6, whether the translation mode (parameter) provided by the user is to automatically translate the whole page. If the translation mode is set to translate the whole page, translation is executed at C8 and the translation result is stored in a buffer at C9 and displayed to the user at C10.

Id. at 33–34.

Patent Owner contends that Petitioner points to two separate embodiments of Ito to find the elements of claim 1. According to Patent Owner, Petitioner identifies the “said user clicking said single action translation component” and “obtaining a translation of said electronic communication” limitations in a first embodiment of Ito, in which a user is required to press a “translation” button to initiate a translation. Prelim. Resp. 47–48. On the other hand, Patent Owner argues, Petitioner identifies the “providing translation of said further electronic communications when said hyperlink is activated” limitation in a separate, second embodiment, in which the machine translation system is in the mode where “translation of the whole page is always performed.” *Id.*

It is Patent Owner’s position that these two embodiments are mutually exclusive. Specifically, according to Patent Owner, if the machine translation system *is not* in the second (“translation of the whole page is always performed”) mode, translations of further electronic communications are obtained only after pressing a “translation” button, and not “when said hyperlink is activated,” as required by claim 1. *Id.* at 48. Conversely, Patent Owner argues, if the machine translation system *is* in the second (“translation of the whole page is always performed”) mode, the first document the user downloads will be translated automatically, effectively bypassing the “translation” button and, thus, not meeting the “said user clicking said single action translation component to request translation of at least said text of said electronic communication” limitation of claim 1. *Id.* at 49.

We agree with Patent Owner. A “prior art reference—in order to anticipate under 35 U.S.C. § 102—must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements ‘arranged as in the claim.’” *Net MoneyIN, Inc. v Verisign, Inc.*, 545 F.3d 1359, 1369 (Fed. Cir. 2008) (citation omitted).

Petitioner relies on Ito’s description of the machine translation system’s behavior in the “translation of the whole page is always performed” mode to show “providing translation of said further electronic communications when said hyperlink is activated.” Pet. 32–34. When Ito’s machine translation system waits for the user to press the “translation” button in order to initiate a translation, as it must be to satisfy the “user clicking said single action translation component to request translation of at least said text of said electronic communication,” the system is not in the “translation of the whole page is always performed” mode. Petitioner, however, does not explain where, or even contend that Ito discloses starting out in a first mode, in which a user presses a “translation” button to translate a document, and switching into an automatic translation mode prior to a hyperlink being activated.

Moreover, we have found no such disclosure in Ito. Instead, according to Ito,

although a translation range is specified when the command is given to execute translation in the aforementioned processing of the machine translation, the translation range can be always set in a mode of automatically executing the translation (not in a switching manner for every page, but in a fixed manner) when the website is received by communication. In this case, for example, by setting the whole page as the translation object, the

whole translation result can be always obtained, for the website which is read at the time of displaying a new page (see FIG. 8).

Ex. 1009 ¶ 58. This description suggests that the “translation of the whole page is always performed” mode operates in lieu of, rather than subsequently to, the mode in which a user initiates a translation by pressing a button. In other words, Ito discloses the two modes as mutually exclusive. Accordingly, Petitioner has not shown persuasively that Ito discloses each limitation of claim 1 “arranged as in the claim.” *Net MoneyIN*, 545 F.3d at 1369.

Claim 17 recites “obtaining a translation of said electronic communication in response to a user clicking said single action translation component” and “providing translation of said further electronic communications when said hyperlink is activated.” Petitioner and Patent Owner present their arguments and evidence for these features of claim 17 together with the commensurate features of claim 1. Pet. 29–34, 42–43; Prelim. Resp. 47–51. For the same reasons given for claim 1, Petitioner has not shown that Ito discloses each limitation of claim 17 arranged as in the claim. Claims 2–4, 6–8, and 16 depend from claim 1, and claims 18, 21, and 22 depend from claim 17. Thus, Petitioner’s arguments are similarly deficient as applied thereto.

In sum, Petitioner has not demonstrated that it is more likely than not that Ito anticipates claims 1–4, 6–8, 16–18, 21, and 22.

c. Claim 26

Claim 26 recites claim limitations in “means-plus-function” format. “When dealing with a ‘special purpose computer-implemented means-plus-

function limitation,’ we require the specification to disclose the algorithm for performing the function.” *Function Media, L.L.C. v. Google, Inc.*, 708 F.3d 1310, 1318 (Fed. Cir. 2013) (quoting *Noah Sys., Inc. v. Intuit, Inc.*, 675 F.3d 1302, 1312 (Fed. Cir. 2012)). In the institution decision in CBM2014-00060, which is being issued concurrently, we explain that Petitioner has shown that it is more likely than not that claim 26 is indefinite for failure to describe in the specification the algorithms for performing the functions of claim 26’s means-plus-function limitations. ’060 Dec. 24–28.

In the Preliminary Response, at 29–30, Patent Owner identifies the same purported corresponding structure for the means-plus-function limitations of claim 26 as it identifies in its Preliminary Response in CBM2014-00060. Petitioner, contrary to our rules,¹ provides no construction of means-plus-function limitations in the Petition. For the reasons given in the CBM2014-00060 institution decision, we are unable to construe claim 26. Therefore, on this record, we are unable to apply Ito to claim 26. Accordingly, Petitioner has not demonstrated that it is more likely than not that Ito anticipates claim 26.

¹ 37 C.F.R. § 42.204(b)(3) specifies that the petition “must identify . . . [h]ow the challenged claim is to be construed,” and specifically “[w]here the claim to be construed contains a means-plus-function . . . limitation . . . , the construction of the claim must identify the specific portions of the specification that describe the structure, material, or acts corresponding to each claimed function.”

2. Asserted Grounds Based on Obviousness

a. Claims 9–14 and 23–25

Petitioner contends that claims 9, 11–14, 23, and 25 would have been obvious over Ito and Lakritz. Pet. 45–50. Petitioner further contends that claims 9, 11, and 23 would have been obvious over Ito and Levy. Pet. 51–52. Finally, Petitioner contends that claims 10 and 24 would have been obvious over Ito and Babylon. Pet. 52–54.

Claims 9–14 depend from claim 1. Claims 23–25 depend from claim 17. Petitioner does not allege that any of Lakritz, Levy, or Babylon remedies the deficiencies of Ito detailed above for claims 1 and 17. Accordingly, Petitioner has not demonstrated that it is more likely than not that claims 9–14 and 23–25 are unpatentable over Ito and Lakritz, Levy, or Babylon.

b. Claims 27 and 28

Petitioner contends that claims 27 and 28 would have been obvious over Ito and Lakritz. Pet. 45–50. Petitioner further contends that claim 27 would have been obvious over Ito and Levy. Pet. 51–52. Claims 27 and 28 depend from claim 26. As explained above, we are unable to construe claim 26. Therefore, on this record, we are unable to apply Ito, Lakritz, and Levy to claims 27 and 28. Accordingly, Petitioner has not demonstrated that it is more likely than not that claims 27 and 28 would have been obvious over Ito and Lakritz, or that claim 27 would have been obvious over Ito and Levy.

3. *Asserted Ground Based on Lack of Written Description*

Petitioner contends that claims 1–28 are unpatentable, under 35 U.S.C. § 112, first paragraph, for lack of written description. “[T]he test for sufficiency [of the written description] is whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.” *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc).

Each of claims 1, 17, and 26 recites an “electronic communication comprising at least text of more than one word and one or more hyperlinks.” Petitioner argues that this language defines an electronic communication as including one or more hyperlinks. Pet. 62. Claims 1 and 17 also recite “obtaining a translation of said electronic communication” and claim 26 recites “one or more translation engines translating said electronic communication.” Petitioner argues that the ’022 patent’s specification does not describe translating the hyperlinks within an electronic communication. *Id.* at 63. Instead, Petitioner contends that the specification only describes replacing hyperlinks within a translated document with links pointing to a translation manager. *Id.* at 63–65.

Petitioner’s argument depends on the proposition that “translat[ion/ing] said electronic communication,” as recited in claims 1, 17, and 26, “require[s] a translation of not just the at least text of more than one word, but also a translation of the one or more hyperlinks, as well as translation of anything else that might be contained in the electronic communication (e.g., sound, graphics, video).” *Id.* at 62. Petitioner made substantially the same argument in CBM2014-00066, contending that the

specification of the '022 patent fails to describe requesting translation of “at least said text of said electronic communication” while “obtaining a translation of said electronic communication.” For the reasons given in our institution decision in CBM2014-00066, which is being issued concurrently with this decision, the claim language “translat[ion/ing] of said electronic communication” does not require translation of every element of the electronic communication, including the hyperlinks. *See Motion Point Corp. v. TransPerfect Global, Inc.*, Case CBM2014-00066, Paper 8, slip. op. at 27–29 (PTAB July 23, 2014).

Because Petitioner has not shown that claims 1, 17, and 26 require translating hyperlinks, we are not persuaded that these claims lack written descriptive support. Rather, we are persuaded that the '022 patent's specification reasonably conveys that the inventor had possession of translating at least the text of an electronic communication. For example, the specification provides that, in response to a request for a translation of a document, “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.” Ex. 1001, col. 3, ll. 32–36. In this example, a translated web page includes translated text, but need not include translation of other elements (although it might).

Claims 2–16 depend from claim 1. Claims 18–25 depend from claim 17. Claims 27 and 28 depend from claim 26. Petitioner and Patent Owner do not argue the dependent claims separately. Accordingly, on this record, Petitioner has not demonstrated that it is more likely than not that

claims 1–28 are unpatentable under 35 U.S.C. § 112, first paragraph, for failure to satisfy the written description requirement.

4. Asserted Ground Based on Lack of Enablement

Petitioner contends that claims 1–28 are unpatentable for lack of enablement under 35 U.S.C. § 112, first paragraph. Petitioner again argues that claims 1–28 require translation of the hyperlinks within an electronic document and contends that the specification of the '022 patent does not enable translation of hyperlinks. Pet. 67–68. As explained above, the claims of the '022 patent do not require translating hyperlinks. Accordingly, on this record, Petitioner has not demonstrated that it is more likely than not that claims 1–28 are unpatentable under 35 U.S.C. § 112, first paragraph, for failure to satisfy the enablement requirement.

III. CONCLUSION

Petitioner has not demonstrated that it is more likely than not that claims 1–4, 6–8, 16–18, 21, and 22 are anticipated by Ito or that claims 9–14 and 23–25 would have been obvious over Ito and Lakritz, Levy, or Babylon.

We are unable to construe claim 26 or claims 27 and 28, which depend from claim 26. Thus, Petitioner has not demonstrated that it is more likely than not that claim 26 is anticipated by Ito, claim 27 would have been obvious over Ito and Levy, or claims 27 and 28 would have been obvious over Ito and Lakritz.

Petitioner has not demonstrated that it is more likely than not claims 1–28 are unpatentable for lack of written description or enablement under 35 U.S.C. § 112, first paragraph.

In sum, Petitioner has not demonstrated that it is more likely than not that at least one of the claims challenged in the Petition is unpatentable.

IV. ORDER

For the reasons given, it is

ORDERED that the Petition challenging the patentability of claims 1–28 is *denied*.

FURTHER ORDERED that no covered business method patent review is instituted.

CBM2014-00067

Patent 6,857,022

For PETITIONER:

Bryan P. Collins

Patrick A. Doody

PILLSBURY WINTHROP SHAW PITTMAN LLP

bryan.collins@pillsburylaw.com

patrick.doody@pillsbury.com

For PATENT OWNER:

Robert Greene Sterne

Donald R. Banowit

Michelle K. Holoubek

Salvador M. Bezos

Jonathan M. Strang

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

rsterne-PTAB@skgf.com

dbanowit-PTAB@skgf.com

mholoubek-PTAB@skgf.com

sbezos-PTAB@skgf.com

jstrang-PTAB@skgf.com