

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*.

FINAL WRITTEN DECISION
35 U.S.C. § 328(a); 37 C.F.R. § 42.73

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”).
See 35 U.S.C. §§ 321–329. TransPerfect Global, Inc. (“Patent Owner”) filed

a Preliminary Response (Paper 7, “Prelim. Resp.”). Based on these submissions, we instituted trial as to all claims of the ’022 patent. Paper 8 (“Institution Dec.”).

After institution, Patent Owner filed a Response (Paper 22, “PO Resp.”), and Petitioner filed a Reply (Paper 24, “Pet. Reply”). In addition, Patent Owner relies upon expert testimony of Dr. Paul C. Clark (Ex. 2006, “Clark Decl.”), submitted with its Response.

An oral hearing was held on March 25, 2015. A transcript of the hearing is entered in the record as Paper 40 (“Hearing Tr.”).

We have jurisdiction under 35 U.S.C. § 6(c). This Final Written Decision is entered pursuant to 35 U.S.C. § 328(a). We conclude for the reasons that follow that Petitioner has shown by a preponderance of the evidence that claims 1–28 of the ’022 patent are unpatentable.

B. Related Cases

Patent Owner 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 (“the ’372 Reexam”). 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. Covered business method patent review was not instituted for either of those petitions.

C. The '022 Patent (Ex. 1001)

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, Abs. The invention is illustrated in Figure 1, reproduced below:

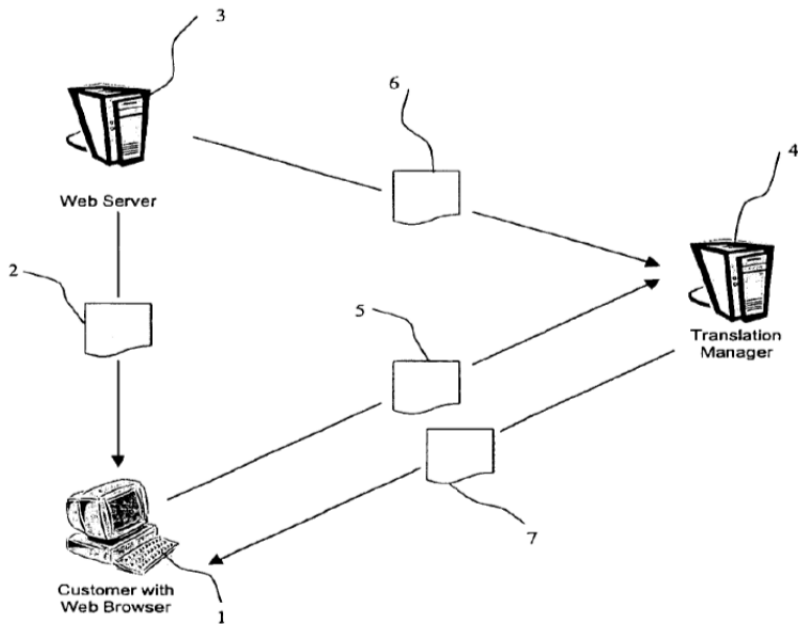


FIG 1

Figure 1 is a schematic of a translation ordering system. Ex. 1001, 3:3–4. 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 3:4–6. 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 3:47–57.

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 3:14–17. 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 3:28–31. 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 3:32–36. 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 3:40. 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 3:36–38. 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 3:38–46. 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 3:38–42.

D. Illustrative Claim

The ’022 patent has 28 claims, all of which are challenged in this proceeding. Claims 1, 17, and 26 are independent. Claim 1 is a method claim and claims 17 and 26 are system claims. Illustrative claim 1 is reproduced below:

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 8:51–9:10.

II. ANALYSIS

A. *The Asserted Grounds*

Trial was instituted on the following grounds advanced by Petitioner:

Grounds	Claims Challenged
§ 112, first paragraph (lack of adequate written description)	1–28
§ 112, second paragraph	23, 25–28

B. *Claim Construction*

We interpret claims of an unexpired patent using the “broadest reasonable construction in light of the specification of the patent in which [they] appear[.]” 37 C.F.R. § 42.300(b); *accord In re Cuozzo Speed Techs. LLC*, 778 F.3d 1271, 1279–82 (Fed. Cir. 2015) (“Congress implicitly adopted the broadest reasonable interpretation standard in enacting the AIA,” and “the standard was properly adopted by PTO regulation”).

In instituting trial, we determined that, at that stage, only two terms required construction. Institution Dec. 6–10. Neither party requests that we construe additional terms. Patent Owner, however, contends that we should modify our construction of the second term we construed, the phrase “said hyperlink.” PO Resp. 9–21. Petitioner argues against modifying our construction of “said hyperlink.” Pet. Reply 1.

1. *“hyperlink”*

In the Decision to Institute, we construed the claim term “hyperlink,” as “a link or connection in a hyperlink document.” Institution Dec. 7. We noted that although the parties put forth slightly different constructions, we interpreted them as nearly identical. *Id.* As the record has developed in this

case, it became evident that our previous construction did not resolve the parties' dispute adequately. Accordingly, we clarify the construction of "hyperlink."

In the Petition, Petitioner asserted that the term "hyperlink" should be construed according to its ordinary and customary meaning as 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 Ex. 1003, 176). Petitioner relied upon a definition from Microsoft Press's Computer User's Dictionary for its construction of the term. *Id.* We are persuaded that the Microsoft Computer User's Dictionary reflects the ordinary and customary meaning of "hyperlink."

Patent Owner asserted, in the Preliminary Response, that "hyperlink" should be construed as "links that appear in a hypertext document." Prelim. Resp. 19. Patent Owner's Response does not assert a different construction for the term "hyperlink." Patent Owner's Response, however, relies upon the Declaration of Dr. Clark (Ex. 2006) in explaining how the term "hyperlink" would have been understood by one of ordinary skill in the art. Dr. Clark testifies that a webpage is "composed in Hypertext Markup Language (HTML)" and that "[a] hyperlink allows a viewer to visit additional content, such as other webpages or media, by clicking the hyperlink." Ex. 2006 ¶ 32. Dr. Clark also testifies that "[t]he HTML code for a hyperlink is a tag that includes a label and a Uniform Resource Locator (URL) address, commonly referred to as a 'hypertext reference' or 'href,' that directs the browser to the additional content." *Id.* Dr. Clark opines that one of ordinary skill in the art would have understood the term "hyperlink"

to “refer to both the link viewable by a webpage user, as well as the underlying HTML code containing the link.” Ex. 2006 ¶ 33.

The intrinsic evidence is consistent with the ordinary and customary meaning of “hyperlink,” as outlined above. In examining the intrinsic evidence, claim 1 uses the term in the following context, “the electronic communication comprising . . . one or more hyperlinks to further electronic communications[.]” Ex. 1001, 8:51–54. The written description portion of the specification of the ’022 patent, however, does not use the term “hyperlink.” Instead, the description refers to “links” and “hypertext link[s].” *See, e.g., id.* at 3:37 (“links”), 5:62 (“hypertext link”). The use of “link” and “hypertext link” in the specification does not reveal (and neither party asserts to the contrary) that the patentee acted as his or her own lexicographer with respect to the term “link” or “hypertext link.” Patent Owner asserts that “hypertext link” and “link” “can fairly be called ‘hyperlinks.’” Prelim. Resp. 20. We note further that the Microsoft Computer User’s Dictionary defines “hypertext link” by referring to its definition of “hyperlink” (Ex 1003, 176), reinforcing our conclusion that “hyperlink,” “hypertext link,” and “link” are used interchangeably in the ’022 patent.

The prosecution history reflects that only claim 8, as originally drafted, included the term “link,” and none of the claims included the term “hyperlink.” Ex. 1002, 216–18. In particular, original claim 8, recited “[t]he method of claim 1 further including the step of the translation manager replacing *links* in the selected communication.” *Id.* at 216 (emphasis added). The term “hyperlink” was introduced into the claims by an Examiner’s Amendment accompanying a Notice of Allowability.

Ex. 1002, 32–38. The term “link” no longer appeared in the claims after the amendment. *Id.* No comparable amendments, however, were made to the description portion of the specification either to change the recitations of the term “link” to “hyperlink” or to include the term “hyperlink.” Thus, neither the specification nor the prosecution history reflects that the patentee acted as his or her own lexicographer with respect to the term “hyperlink.”

As discussed above, each party relies upon extrinsic evidence in support of its proposed construction of the term “hyperlink.” Specifically, Petitioner relies upon a technical dictionary and Patent Owner relies upon expert testimony. The Federal Circuit has endorsed reliance upon both of these forms of extrinsic evidence in certain circumstances. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1317–18 (Fed. Cir. 2005) (en banc) (noting that “extrinsic evidence . . . ‘include[es] . . . expert . . . testimony [and] dictionaries”). There is, however, a degree of overlap between Dr. Clark’s testimony and the Microsoft technical dictionary that was not in the record when we construed “hyperlink” in the Decision to Institute.

In particular, the Microsoft Computer User’s Dictionary indicates that a hyperlink is not simply text in the document in which it resides; rather, it also includes a reference to an element or document that is linked. As the Microsoft Computer User’s Dictionary states, it is “a connection between an element in a hypertext document . . . and a different element in the document, another hypertext document, a file or a script.” Ex. 1003, 176 (emphasis added). Petitioner’s proposed construction, of 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 (emphasis added)),

recognizes this fact. In other words, Petitioner's proposed construction captures the concept that a hyperlink includes a connection between an element "A" and an element "B," for example.

Dr. Clark's testimony recognizes that the "HTML code for a hyperlink is a tag that includes a label *and a Uniform Resource Locator (URL) address, commonly referred to as a 'hypertext reference' or 'href,' that directs the browser to the additional content.*" Ex. 2006 ¶ 32 (emphasis added). In other words, the URL address, which Dr. Clark refers to as "href," directs the browser (from element "A" in our example) to "the additional content" (i.e., element "B"). Nevertheless, Dr. Clark testifies that "a POSA would have understood that 'said hyperlink' is the same 'one or more hyperlinks,' where the 'one or more hyperlinks' and its label has been translated and its destination modified to point to a translation of the 'further electronic communications' by the translation manager when the single action translation component has been activated." *Id.* ¶ 33. In other words, as Dr. Clark applies the term, a hypertext reference that includes a different connection (e.g., changing the connection "from document A to document B" to "from document A to document C") is still the same hyperlink.

We are not persuaded by Dr. Clark's testimony. Rather, we conclude that "hyperlink" is a well-understood term that the '022 patent uses in accordance with its ordinary meaning. As explained above, the Microsoft Computer User's Dictionary makes clear that a hyperlink includes a connection to another element or document. Patent Owner points to no persuasive evidence that the '022 patent describes a hyperlink as separate from this connection such that the connection can be changed with the

hyperlink remaining the same. Indeed, the '022 patent describes “replac[ing] all links in the translated web page 7 with links that point to the translation manager 4” as part of the translation process. Ex. 1001, 3:37–38. Thus, as described in the patent, changing the connection to point to the translation manager requires a new link. This is consistent with the ordinary meaning of a hyperlink as including a specific connection from one document to another element or document.

Our preliminary construction of “hyperlink” included “a link or connection” but did not include a recitation of the element or document linked. To resolve the parties’ dispute, consistent with the ordinary meaning and the specification, we conclude, on the full record before us, that one of ordinary skill in the art at the time of the invention would have understood “hyperlink” to mean “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.”

2. *“said hyperlink”*

The phrase “said hyperlink” is recited in each of the claims at issue in this proceeding. In the Decision to Institute, we construed “said hyperlink” as referring back to the “one or more hyperlinks,” i.e., the original “one or more hyperlinks” in the original (untranslated) electronic communication that link or connect to the further (untranslated) electronic communications. Institution Dec. 10. In reaching that construction, we recognized that Petitioner and Patent Owner agreed that “said hyperlink” refers back to the previously recited “one or more hyperlinks.” Institution Dec. 7–8 (citing Pet. 19; Prelim. Resp. 24). Patent Owner maintains the same position in the

Patent Owner Response—that the phrase “said hyperlink” refers to the previously recited “one or more hyperlinks.” PO Resp. 3.

The focus of the parties’ dispute regarding this phrase is whether replacement or modification of the “one or more hyperlinks” may occur and yet still constitute the same “one or more hyperlinks.” Patent Owner takes the position that:

Properly construed, “said hyperlink” permits replacement or modification of the “one or more hyperlinks,” so long as “said hyperlink” is the same hyperlink *from the perspective of the user* because this is what a person of ordinary skill in the art would have understood in the context of the entire patent.

PO Resp. 9 (emphasis added). Thus, Patent Owner argues that changing the destination address of a hyperlink does not result in a different hyperlink. PO Resp. 12. Additionally, Patent Owner relies upon Dr. Clark’s testimony that “a website visitor would have recognized hyperlinks in a translated version of the webpage as the same as hyperlinks in the original untranslated webpage because they point to the same content, although in a different language.” PO Resp. 14 (citing Ex. 2006 ¶¶ 31–33). Patent Owner further contends that “a hyperlink in HTML [(Hypertext Markup Language)] code can be uniquely identified even if the URL portion of the hyperlink is modified, because the hyperlink will maintain the same position within the code, as well as other descriptive parameters such as the hyperlink text.” *Id.* at 15 (citing Ex. 2006 ¶ 37). We address each of Patent Owner’s positions.

Claim 1 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:

...

said translation manager:

...

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

Ex. 1001, 8:50–9:5 (emphases added). Independent claims 17 and 26 use the phrases “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.”

Patent Owner’s first argument—that a hyperlink replaced by another hyperlink remains the same hyperlink because a user cannot see that a change was made when viewing a webpage—is not persuasive. Our construction of the term “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.” If a connection between one element (e.g., element A) and a second element (e.g., element B) is replaced with a connection between element A and a new element (e.g., element C), the hyperlink is no longer a connection between A and B—it is now a connection between A and C. In such circumstances, it is a different hyperlink because it connects different

elements. Accordingly, whether a user can tell that a hyperlink has changed is not dispositive of the question as to whether the replacement hyperlink is the same as the hyperlink it replaced.

Even if the perspective of the user were considered, we disagree with Patent Owner's argument that a user would not be able to tell that the original hyperlink was replaced. Specifically, the "one or more hyperlinks" recited in claim 1 are connections to "further electronic communications" that are not translated. Thus, if a user were to click on one of the original hyperlinks, the user would be taken to an untranslated further electronic communication. If a user were to click on a replaced hyperlink, under Patent Owner's theory, the user would not be taken to the *untranslated* further electronic communication; rather, the user would be taken to a *translated* version of the further electronic communication. In such circumstance, the user would be able to tell that the second hyperlink was not the same as the first because the second hyperlink connected to an element different than the element connected to the first hyperlink.¹

Patent Owner's second argument—focusing on the HTML code—also is unpersuasive. Patent Owner asserts that even though portions of the hyperlink—referred to by Patent Owner as the "internal parameters"—may change, it is still the same hyperlink from "the code perspective." PO Resp. 18 (citing Ex. 2006 ¶ 33). Patent Owner's argument is that because

¹ Dr. Clark's testimony regarding the user's perspective presumes that a translated version of a webpage (or other electronic communication) is the same "content" as the untranslated version. *See, e.g.*, Ex. 2006 ¶ 38. We disagree. While the information contained therein may have the same meaning, what a user sees is clearly not the same. Because Dr. Clark's testimony regarding the user's perspective was based largely upon this erroneous position, we give little weight to his testimony on this point.

the position of the hyperlink in the HTML code does not change, and the text of the hyperlink appears in the same position in the translated electronic communication, it is the same hyperlink. *Id.*

The inquiry here, however, is not whether the overall position of the hyperlink in the code changes or whether the text of the hyperlink appears in the same position in the translated electronic communication. Rather, the issue is whether a replacement hyperlink, even if in the same location in the overall code and in the same location in the translated electronic communication, is the *same* hyperlink even though it connects to a different element than the hyperlink it replaced.

Because a hyperlink, at its essence, is code, looking at the term “hyperlink” from the code perspective also sheds light on whether a replacement hyperlink with *different* code than the hyperlink it replaced can still be considered the same hyperlink. Dr. Clark testified that “[t]he HTML code for a hyperlink is a tag that includes a label and a Uniform Resource Locator (URL) address, commonly referred to as a ‘hypertext reference’ or ‘href,’ that directs the browser to the additional content.” Ex. 2006 ¶ 32. Dr. Clark gave the following example:

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<a href=http://english.buy.com/stores>Stores<a>
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Id. ¶ 36. In Dr. Clark’s example, the hyperlink quoted above would be the “one or more hyperlinks to further electronic communications” in the “electronic communication,” as recited in claim 1. Dr. Clark testified that after translation of the website (i.e., the electronic communication), the hyperlink code replacing the hyperlink quoted above is the following:

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<a href=http://spanish.buy.com/stores>Tiendas<a>
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Id. ¶ 37.

In Dr. Clark's example, the "href" URL (uniform resource locator) portion of the hyperlink is changed to connect to a different element (i.e., the translated (Spanish) webpage) than the element connected to the hyperlink prior to the change (i.e., the untranslated (English) webpage). In order to link one electronic communication to a further electronic communication the URL address of the further electronic communication must be established. Accordingly, in Dr. Clark's example, because the hyperlink's URL address changes, the replacement link is no longer the same hyperlink that existed previously; the replacement hyperlink now connects to a different element (a translated version of a further electronic communication).

In considering Dr. Clark's testimony, we are guided by the Federal Circuit's statement in *Phillips* that "extrinsic evidence consisting of expert reports and testimony is generated at the time of and for the purpose of litigation and thus can suffer from bias that is not present in intrinsic evidence." *Phillips*, 415 F.3d at 1318. While the Federal Circuit was comparing extrinsic evidence to intrinsic evidence, the Federal Circuit's point regarding caution with respect to expert testimony is relevant here because Dr. Clark's testimony contradicts arguments asserted by Patent Owner in its Response to the Office Action of March 28, 2013, presented in the '372 Reexam.

In the '372 Reexam, Patent Owner argued against the Examiner's rejections of, *inter alia*, claim 1, which the Examiner found anticipated by two references—Lakritz (U.S. Patent No. 6,526,426) and Dunsmoir (U.S. Patent No. 7,016,977). Each of Patent Owner's arguments attempting to distinguish Lakritz and Dunsmoir was supported by declaration testimony submitted by Patent Owner's expert, Dr. Nakhimovsky. *See Ex. 2003*. In

arguing against the Examiner's rejection based on Lakritz, Patent Owner stated the following:

In claim 1, regardless of the usage of a relative or absolute hyperlink, the target of a hyperlink in the original (e.g., English-language) document (“hyperlinks to further electronic communications”) is the same as the target in a document (e.g., Spanish-language document) translated from the source document (“said further electronic communications”; “said hyperlink[”]). That is, in claim 1, the same “hyperlinks” point to the same “further electronic communications” in both the “translation of said electronic communication” and the initial “electronic communication.” In contrast, Lakritz's translated documents do not link to the same “further electronic communications” as the original document. (Nakhimovsky Decl., ¶ 71).

This is understood by considering the alleged “hyperlinks to further electronic communications” in Lakritz. The hyperlink consisting of “” in an English-language page found at <http://www.lai.com/joe/index.html> in Lakritz actually refers to the document <http://www.lai.com/joe/contact.html>. To follow the language of claim 1, the corresponding hyperlink in the corresponding Spanish-language page should also refer to <http://www.lai.com/joe/contact.html>. But that is not the case in Lakritz. In Lakritz, the corresponding hyperlink in the corresponding Spanish-language page <http://www.lai.com/joe/spanish/index.html>, instead refers to the document <http://www.lai.com/joe/spanish/contact.html>. Said another way, no translation of this alleged “further electronic communication” is needed, as it is already in Spanish.

Ex. 2002, 34 (emphases added).

As argued by Patent Owner in the first paragraph quoted above, in claim 1, the target of a hyperlink in the original document *is the same as* the target in a document translated from the source document. *See id.* Patent Owner stated that “the same ‘hyperlinks’ point to the same ‘further

electronic communications’ in both the ‘translation of said electronic communication’ and the initial ‘electronic communication.’” *Id.*

Specifically, Patent Owner asserted that the hyperlink in Lakritz refers to the document <http://www.lai.com/joe/contact.html>, and that “[t]o follow the language of claim 1, the corresponding hyperlink should also refer to” the exact same URL— <http://www.lai.com/joe/contact.html>. *Id.* Patent Owner contended that because Lakritz refers to the document <http://www.lai.com/joe/spanish/contact.html>, Lakritz does not anticipate claim 1. Patent Owner’s position was clearly based on its assertion that, in claim 1, the element connected to the hyperlink (i.e., the *target*) does not change.

In contrast, in this proceeding, Patent Owner and Dr. Clark assert that you can *change* the target URL address and yet still consider the changed hyperlink to be the same hyperlink. In Patent Owner’s argument and Dr. Clark’s testimony here, the target of the original hyperlink and the target of the replaced hyperlink *are different*.

A second example of Patent Owner’s argument in the reexamination proceeding is shown below, in which Patent Owner attempted to distinguish the teachings of Dunsmoir:

Dunsmoir describes the “common method” as providing multiple web sites within a web site. (Dunsmoir, 1:48–50). Thus, for example, a company’s English-language web page may have hyperlinks to home pages in other languages such as Spanish, German, and French. (Dunsmoir, 1:50–53). If the user selects the Spanish hyperlink, the user is directed to a Spanish-only home page. (Dunsmoir, 1:53–56). Links within the Spanish home page lead to other pages of Spanish-only content. (Dunsmoir, 1:56–58). *However, the links within the Spanish home page are different from and point to different content (i.e., have different targets) than links that would be*

present on the English home page that lead to other pages of English-only content. (Nakhimovsky Decl., ¶ 41). This “common method” cannot “provid[e] translation of *said* further electronic communications when *said* hyperlink is activated,” as recited in claim 1.

Ex. 2002, 40 (first emphasis added).

Patent Owner’s argument with respect to Dunsmoir maintained the same position discussed above with respect to Lakritz. Specifically, Patent Owner asserted that Dunsmoir’s hyperlinks in the Spanish home page “are different from and point to different content (i.e., have different targets) than links that would be present on the English home page that lead to other pages of English-only content.” *Id.* Again, Patent Owner distinguished Dunsmoir based on the hyperlinks in the Spanish home page having “different targets” than the hyperlinks in the English home page.

Our determination that Dr. Nakhimovsky’s earlier Declaration conflicts with Dr. Clark’s Declaration in this proceeding on the fundamental claim construction disagreement between the parties adversely affects the creditability of Dr. Clark’s Declaration testimony on this issue. Thus, as shown in our construction of the term “hyperlink,” and as necessarily carried forward to our construction of the phrase “said hyperlink,” we give more weight to the Microsoft Computer User’s Dictionary definition of “hyperlink,” which is consistent with the specification’s use of the terms “link” and “hypertext link,” than to Dr. Clark’s testimony regarding the construction of “said hyperlink.”

Patent Owner raises an additional argument directed to our construction of the phrase “said hyperlink,” in which Patent Owner asserts that our construction is too narrow because it “violates Federal Circuit

precedent by unduly limiting the meaning of the claims to one embodiment of the specification.” PO Resp. 26 (citations omitted). We are not persuaded by this argument. As discussed below, we find no written description support for the challenged claims. In other words, as construed, the challenged claims cover no embodiment described by the ’022 patent.

We acknowledge that, as a general rule, constructions that exclude all embodiments are rarely correct, *see, e.g., Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1583 (Fed. Cir. 1996) (citations omitted). Nevertheless, the Federal Circuit has “repeated and consistently . . . recognized that courts may not redraft claims, whether to make them operable or sustain their validity.” *Chef Am., Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, 1374 (Fed. Cir. 2004) (citation omitted). In the context presented here, we are not faced with a question of whether the claim language is clearly a typographical error or even ambiguous. As explained above, the ordinary and customary meaning of “hyperlink” is straightforward and supported by the intrinsic evidence. In short, the claims recite preserving hyperlinks (e.g., “providing translation of said further electronic communications when said hyperlink is activated,” in claim 1) while the specification describes replacing hyperlinks (e.g., “[t]he translation manager may also replace all links in the translated web page 7 with links that point to the translation manager 4,” Ex. 1001, 3:36–38). Thus, we are not persuaded that our construction is unreasonable or that we should rewrite the claims.

Finally, during the oral hearing, counsel for Patent Owner contended alternatively that claim 1 has “an implicit order” (*see, e.g.,* Hearing Tr. 31:9–10) and an “explicit order” (*see, e.g., id.* at 36:8), and that such order supports Patent Owner’s construction of the phrase “said hyperlink” as

encompassing replaced links. This argument was not raised in Patent Owner's Response and, thus, is deemed waived. *See, e.g.*, Scheduling Order 3 (Paper 9) ("The patent owner is cautioned that any arguments for patentability not raised in the response will be deemed waived.").

Nonetheless, even if we were to assume that claim 1 has a particular order (e.g., by reciting that the translation manager "provid[es] translation of said further electronic communications *when* said hyperlink is activated" (emphasis added), Patent Owner has not explained persuasively how that order necessarily results in "said hyperlink" covering replaced hyperlinks.

In summary, based on the entire record, we maintain our construction of "said hyperlink." In other words, "said hyperlink" refers back to the "one or more hyperlinks" recited previously in each independent claim, i.e., the "one or more hyperlinks" in the original (untranslated) electronic communication that link or connect to the further (untranslated) electronic communications.

C. Patent Owner's Motion to Exclude

Patent Owner moves to exclude Petitioner's Exhibits 1013 and 1014. Paper 32 ("Mot. Exc."). Exhibit 1013 is a Declaration of Dr. Alexander Nakhimovsky, executed September 15, 2014, submitted under 37 C.F.R. § 1.132 in connected with the request for *inter partes* reexamination of the '022 patent (Reexam Control No. 95/002,372). Exhibit 1014 is U.S. Patent No. 7,016,977 B1, which issued March 21, 2006, and was one of the references at issue in the above-referenced reexamination request.

1. Exhibit 1013

Patent Owner contends that Exhibit 1013 should be excluded because (a) it is cumulative and not relevant to the issues in this proceeding because

“prior art is no longer at issue here” (Mot. Exc. 3); (b) it introduces significant risk that outweighs any probative value it provides (*id.* at 5); and (c) it is inadmissible hearsay under Federal Rule of Evidence 801(c) (*id.* at 6–7).

Petitioner filed an opposition to Patent Owner’s Motion to Exclude. Paper 36 (“Opp. Exc.”). Petitioner asserts in response that (a) Exhibit 1013 was offered to support Petitioner’s claim construction position and not to delve into unrelated prior art issues (*id.* at 2); (b) the probative value is not outweighed by the potential prejudice because we will not be confused with respect to the issues at hand and the purpose of the exhibit (*id.* at 8); and (c) Exhibit 1013 is not hearsay at least because (1) Petitioner is not offering it for the truth of what it states; rather, Petitioner offers the exhibit to show that Patent Owner continues to rely upon Dr. Nakhimovsky as an expert and upon Dr. Nakhimovsky’s testimony as of the declaration date, and (2) it constitutes an opposing party’s statement under Federal Rule of Evidence 801(d)(2) (*id.* at 9–11).

Patent Owner filed a reply to Petitioner’s Opposition. Paper 38 (“Reply Exc.”). In its Reply, Patent Owner does not respond to Petitioner’s arguments that Exhibit 1013 is not inadmissible hearsay. *See generally* Reply Exc.

Patent Owner’s attempt to exclude Exhibit 1013 is not persuasive. First, the *inter partes* reexamination of the ’022 patent is relevant to our consideration of the claim construction issues presented here because claim construction was at issue in the reexamination. Second, we see no risk of undue prejudice that would outweigh the probative value of the documents and evidence submitted in the reexamination. Of note, is that this

proceeding is not a jury trial and, thus, the risk of prejudice in this forum is less than what may otherwise exist before a jury. Third, we agree with Petitioner that Exhibit 1013 is not hearsay at least under Federal Rule of Evidence 801(d)(2)(B) because the testimony in Dr. Nakhimovsky's Declaration was submitted by, and on behalf of, Patent Owner to the Patent Office, thus evidencing that Patent Owner manifested a belief that the statements contained therein were true.

Accordingly, Patent Owner's Motion to Exclude as applied to Exhibit 1013 is *denied*.

2. *Exhibit 1014*

Patent Owner asserts that Exhibit 1014 should be excluded because it is not pertinent to the issues in this proceeding (Mot. Exc. 7), and because it "confuses the issues in an attempt to reargue alleged prior art issues unrelated to this trial" (*id.* at 9).

Petitioner argues in response that Dr. Nakhimovsky's testimony from Exhibit 1013 discusses Exhibit 1014 and that therefore Exhibit 1014 is relevant, will not confuse or complicate the issues, and will not waste time or resources. Opp. Exc. 4–5.

Patent Owner's arguments to exclude Exhibit 1014 are not persuasive. Exhibit 1014 provides context for Dr. Nakhimovsky's testimony as embodied in Exhibit 1013. Thus, it is relevant. Further, we see no risk of undue prejudice that would outweigh its probative value.

Accordingly, Patent Owner's Motion to Exclude as applied to Exhibit 1014 is *denied*.

D. Lack of Adequate Written Description Under 35 U.S.C. § 112, First Paragraph

Petitioner asserts that claims 1–28 lack written description support for the phrase providing translation of said further electronic communications “when said hyperlink is activated”² because the written description portion of the ’022 patent fails to disclose providing translation of additional electronic communications when a hyperlink in the *original* electronic communication is activated. Pet. 35. In particular, Petitioner contends that the specification of the ’022 patent describes only one embodiment for translation of “further electronic communications.” *Id.* at 31. Namely, the specification teaches that the “translation manager . . . replace[s] the links to those ‘further electronic communications’ with links that point to the translation manager where translated versions can be obtained.” *Id.* According to Petitioner, “[t]he use of replacement hyperlinks is exactly the solution (and indeed the only solution) the ’022 patent specification discloses to avoid ‘the need to separately request translation of each page.’” *Id.* (citing Ex. 1001, 3:41–42).

Petitioner asserts that the ’022 patent claims “recite something entirely different.” *Id.* at 35. Petitioner contends that the use of the phrase “said hyperlink,” “means that the translation . . . will be returned in the translated language, but with the original hyperlinks that were embedded in it *before translation.*” *Id.* Thus, when a user clicks on one of the hyperlinks embedded in the returned translation, “the user will not link to a translated page on the translation manager, but rather will be linked to the original

² Claims 26–28 contain a similar phrase—“means for returning a translation of said further electronic communications when said hyperlink is activated” (Ex. 1001, 10:57–58)—that the parties address with the same arguments.

linked page . . . which was not translated and remains in the original English language.” *Id.* at 36. Accordingly, Petitioner contends that because the “only method disclosed in the ’022 patent specification that arguably describes obtaining translations of ‘said further electronic communications’ by clicking on a single action translation component is NOT recited in the claims,” “the claims recite an entirely different invention – one that is not disclosed.” *Id.* at 38.

Patent Owner contends that the claims are supported adequately by the written description for two reasons. We address each. First, Patent Owner asserts that because the phrase “said hyperlink” can refer to replacement hyperlinks that point to a different destination address, one of ordinary skill in the art would have understood that the inventor had possession of “providing translation of said further electronic communications when said hyperlink is activated[.]” PO Resp. 22. In accordance with Patent Owner’s construction, Patent Owner points to the specification’s disclosure that the translation manager may replace all links in the translated webpage with links that point to the translation manager. *See* PO Resp. 22 (quoting Ex. 1001, 3:36–38) (“The translation manager may also *replace* all links in the translated web page 7 with links that point to the translation manager 4.” (emphasis added)).

Patent Owner’s first argument is contrary to our constructions of the term “hyperlink” and the phrase “said hyperlink.” As reflected in our construction, “said hyperlink” in each of independent claims 1, 17, and 26, refers back to the original recitation of “one or more hyperlinks” in the original (untranslated) electronic communication. The portion of the specification relied upon by Patent Owner does not disclose providing

translation of said further electronic communications when the *original* one or more hyperlink is activated. Rather, this disclosure 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). Thus, 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 (i.e., one or more hyperlinks with unmodified destination addresses). *See Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc).

Second, Patent Owner asserts that, under our construction of the phrase “said hyperlink,” “the skilled artisan would also have understood, from reading the specification, how to provide the same functionality without modifying the destination address.” PO Resp. 22. In this regard, Patent Owner relies upon the following disclosure from the specification:

As mentioned above, and as will be appreciated by persons skilled in the use and programming of web pages and/or software, the described functions can be provided by plug-in applications or stand alone programs that interact either actively or passively with the viewed web pages (or data containers in software applications e.g. fields, memo fields, Blobs, documents, workbooks, windows, dialog boxes, record, etc.) and communicate with the translation manager via the Internet to request translation in response to a keystroke, mouse action, voice command, or other method by the customer.

Ex. 1001, 6:20–30 *quoted in* PO Resp. 23. Patent Owner points to Dr. Clark’s testimony and asserts that “a browser plug-in could recognize that a user desires a translated version of the destination of ‘said hyperlink,’ and could redirect the user to the translation manager ‘when said hyperlink is activated.’” PO Resp. 23 (citing Ex. 2006 ¶ 42). Patent Owner explains that “[i]n this manner, the translation manager could provide a translation of the hyperlink’s destination without the webpage’s hyperlink being modified.” *Id.* (citing Ex. 2006 ¶ 42).

Patent Owner also points to the ’022 patent’s discussion of the explorer bar implemented as a browser plug-in:

The explorer bar 11 is implemented as an Internet browser plug-in and therefore integrates with the users browser, such as Microsoft’s Internet Explorer® or Netscape’s Navigator®. Compared to prior art solutions, the explorer bar 11 has the unique ability to communicate with the web browser to gain access to the required details of the current web page. It can also allow saving options and preferences on the customer’s local computer as well as supporting the translation of web pages or text selections by just one mouse click.

Ex. 1001, 4:62–5:3. Patent Owner asserts that because the plug-in is capable of communicating with the web browser, “it could be used to redirect users to a translation manager when the user clicks on an unmodified hyperlink.” PO Resp. 24 (citing Ex. 2006 ¶ 42).

Patent Owner also asserts that Dr. Clark’s testimony further explains how one of ordinary skill in the art allegedly would have understood a plug-in implementation to work. *Id.* at 24–25. Dr. Clark testifies that when a user activates the single-action translation component, the browser plug-in can record the user’s preference for the desired language. Ex. 2006 ¶ 43. Dr. Clark explains that after the user receives a translated webpage, which

may contain the same unmodified hyperlinks, the browser plug-in can modify the URL for the hyperlink after a user activates the hyperlink in the translated webpage. *Id.* According to Dr. Clark, the user “can then receive a translated version of ‘said hyperlink’s’ destination, without the webpage’s hyperlink being modified.” *Id.*

Petitioner’s Reply asserts that Dr. Clark’s testimony speaks to what might be obvious in light of the ’022 patent disclosure, rather than what is actually disclosed. Pet. Reply 11–12. Petitioner contends that the ’022 patent and, in particular, Figure 2, show that the plug-in can be a tool bar included in an Internet Explorer® window where the user can select a language for translation. *Id.* at 13. Petitioner asserts, however, that nothing in this description of the tool bar indicates that the browser plug-in has any role in “managing, changing, or doing anything to or with the hyperlinks in the translated document.” *Id.* Nor, according to Petitioner, does the ’022 patent disclose that the plug-in performs the function of the translation manager. *Id.* at 14. Additionally, Petitioner contends that even if the ’022 patent’s disclosure of the plug-in performing the “described functions” were interpreted as “including the translation manager’s functionality . . . that functionality would be what is actually ‘described,’ i.e., the hyperlink replacement approach which still is not covered by ‘said hyperlink[.]’” *Id.*

We are persuaded that one of ordinary skill in the art would not have understood from the written description of the ’022 patent that the inventors possessed and described a browser plug-in that could perform the tasks Patent Owner and Dr. Clark allege. First, claim 1 specifically recites that the translation manager performs the step of “providing translation of said

further electronic communications when said hyperlink is activated” and does not refer to a browser plug-in.

Second, although the ’022 patent describes an explorer bar, which may be implemented as a browser plug-in, as an embodiment that implements a “one-click translation component,” Ex. 1001, 3:46–50, Patent Owner has not identified any description of the browser plug-in expressly performing the functions attributed to the translation manager.

Third, column six’s disclosure that “the described functions can be provided by plug-in applications” is not specific as to which functions are invoked. The description states that the plug-in applications or stand alone programs “interact either actively or passively with the viewed web pages . . . and communicate with the translation manager via the Internet to request translation in response to a keystroke, mouse action, voice command, or other method by the customer.” Ex. 1001, 6:20–30. The most reasonable interpretation of the phrase “the described functions” is that it refers to the functions of the one-click translation component, and not the functions of the translation manager. At least several portions of the surrounding disclosure support this interpretation, including: (1) the immediately preceding discussion of embodiments in which the one-click translation component may be implemented (*see id.* at 5:32–6:19); (2) the phrase “[a]s mentioned above” (*id.* at 6:20), which most likely refers to the preceding discussion of the explorer bar implemented as a browser plug-in; and (3) the description that the plug-in application or stand alone program “communicate[s] with the translation manager . . . to request translation” (*id.* at 6:27–30), which indicates that the translation manager is still involved

and hence the “described functions” are not all of the functions attributed to the translation manager.

Fourth, we agree with Petitioner that even if we were to interpret “the described functions” as referring to the described functions performed by the translation manager, that would invoke column three’s disclosure of the translation manager “replac[ing] all links in the translated web page.”

Ex. 1001, 3:36–38. Thus, whether the translation manager replaces all links in the translated webpage, as discussed in the context of Patent Owner’s first argument, or the plug-in does so, we are led to the same conclusion because neither describes or provides support for the translation manager providing translation of said further electronic communications when the one or more hyperlinks in the original untranslated electronic communication is activated.

Finally, Dr. Clark’s testimony regarding how a plug-in implementation “*could work*” (Ex. 1006 ¶ 43 (emphasis added)), does not answer the question whether one of ordinary skill in the art would have understood from the ’022 patent disclosure that the inventors had possession of the claims as of the filing date. *See Ariad*, 598 F.3d at 1352 (“[A] description that merely renders the invention obvious does not satisfy the [written description] requirement.”).

Accordingly, Petitioner has shown by a preponderance of the evidence 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 providing or returning a translation of said further electronic communications “when said hyperlink is activated,” as recited in claims 1–26, as of the filing date.

E. Indefiniteness of Claims 23 and 25–28 Under 35 U.S.C. § 112, Second Paragraph

Our determination that each challenged claim is unpatentable for lack of an adequate written description renders it unnecessary to reach Petitioner’s contentions that claims 23 and 25–28 of the ’022 patent are indefinite.

F. Contingent Motion to Amend

Patent Owner filed a Contingent Motion to Amend in which it proposes to substitute new claim 29 for claim 25 and new claim 30 for claim 28, if claims 25 and 28 are found indefinite under 35 U.S.C. § 112, second paragraph. Paper 23, 1–2. Because we do not reach Petitioner’s challenge based on § 112, second paragraph, Patent Owner’s Motion to Amend is *denied* as moot.

III. CONCLUSION

We determine that Petitioner has demonstrated, by a preponderance of the evidence, that claims 1–28 of the ’022 patent are unpatentable under 35 U.S.C. § 112, first paragraph, for lack of an adequate written description.

IV. ORDER

Accordingly, it is

ORDERED that, based on a preponderance of the evidence, claims 1–28 of U.S. Patent No. 6,857,022 B1 are held to be unpatentable;

FURTHER ORDERED that Patent Owner’s Motion to Exclude is *denied*;

FURTHER ORDERED that Patent Owner’s Contingent Motion to Amend is *denied* as moot; and

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FURTHER ORDERED that, because this is a final written decision, parties to this proceeding seeking judicial review of this Decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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For PETITIONER:

Bryan Collins
Patrick A. Doody
PILLSBURY WINTHROP SHAW PITTMAN LLP
bryan.collins@pillsburylaw.com
patrick.doody@pillsburylaw.com

For PATENT OWNER:

Michelle K. Holoubek
Donald R. Banowit
Salvador M. Bezos
Robert G. Sterne
Jonathan M. Strang
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
mholoubek-PTAB@skgf.com
dbanowit-PTAB@skgf.com
sbezos-PTAB@skgf.com
rsterne-PTAB@skgf.com
jstrang-PTAB@skgf.com