

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JUNZO IKUTA, MASAKO YOSHIMURA, and KUNIKO AKIYAMA

Appeal No. 2000-1515
Application No. 08/687,195

HEARD: Apr. 25, 2002¹

Before RUGGIERO, LALL, and BARRY, *Administrative Patent Judges*.
BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

The patent examiner rejected claims 1, 4, 6-10, 12-18, 21-23 and 26-29. The appellants appeal therefrom under 35 U.S.C. § 134(a). We affirm.

BACKGROUND

The appellants' invention concerns the translation of languages. Computer users desire to understand the meanings of foreign languages that they read. Accordingly, the invention

¹ Although the examiner requested an "opportunity to present arguments at the oral hearing," (Paper No. 18 at 2), he declined an invitation to appear.

comprises a three-step translation. First, a sentence to be translated is divided into "word trains." Second, the original sentence is converted into a translated sentence for each divided word train; a symbol is inserted at partition positions of the divided original and translated sentences to facilitate correspondence between the sentences. Third, the original sentence and the translated sentence are displayed in a one-to-one word train correspondence. A further understanding of the invention can be achieved by reading the following claim:

1. A mechanical translation method comprising:

(a) dividing an input laterally written original sentence into a plurality of word trains in accordance with a predetermined division rule;

(b) converting the original sentence into a translated sentence for each divided word train, the translated sentence being divided into word trains; and

(c) displaying the original sentence and the translated sentence so that the divided original sentence and the divided translated sentence are arranged at vertically juxtaposed positions, wherein the division rule is a rule of dividing the original sentence into one of phrases and clauses.

The prior art applied by the examiner in rejecting the claims follows:

Adachi et al. ("Adachi")

4,866,670

Sep. 12, 1989

Fujisawa et al. ("Fujisawa")	5,729,618	Mar. 17, 1998 (filed Mar. 17, 1995)
Suzuki et al. ("Suzuki")	4,894,779	Jan. 16, 1990
Morgan et al. ("Morgan")	5,689,724	Nov. 18, 1997 (filed Oct. 11, 1995).

Claims 1, 4, 9, 10, 15, 17, 21, 22 and 26 stand rejected under 35 U.S.C. § 103(a) as obvious over Adachi in view of Fujisawa.

Claims 6, 7, 8, 12, 13, 14, 27, 28 and 29 stand rejected under § 103(a) as obvious over Adachi in view of Fujisawa further in view of Suzuki. Claims 16, 18, and 23 stand rejected under § 103(a) as obvious over Adachi in view of Fujisawa further in view of Morgan.

OPINION

After considering the record, we are persuaded that the examiner did not err in rejecting claims 1, 4, 6-10, 12-18, 21-23 and 26-29. Accordingly, we affirm.

Rather than reiterate the positions of the examiner or appellants *in toto*, we address the two points of contention therebetween. First, the examiner asserts, "[i]t would have been obvious to one of ordinary skill in the art at the time of the

invention to vertically juxtapose the original text and the translated text, because, as Fujisawa points out, in column 13 lines 35-36, this creates a clear and easy to read format."

(Examiner's Answer at 4.) The appellants allege, "[t]he references contain no suggestion for combining their teachings together to obtain the claimed invention" (Appeal Br. at 8.)

"Whether motivation to combine the references was shown [is] a question of fact." *Winner Int'l Royalty Corp. v. Wang*, 202 F.3d 1340, 1348, 53 USPQ2d 1580, 1586 (Fed. Cir. 2000) (citing *In re Dembiczak*, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999); *Monarch Knitting Mach. Corp. v. Sulzer Morat GMBH*, 139 F.3d 877, 881-83, 886, 45 USPQ2d 1977, 1982, 1985 (Fed. Cir. 1998)). "[T]he question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.'" *In re Beattie*, 974 F.2d 1309, 1311-12, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992) (quoting *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984)). "[E]vidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases,

from the nature of the problem to be solved. . . ." *Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617 (citing *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996); *Para-Ordnance Mfg. v. SGS Imports Int'l, Inc.*, 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995)).

Here, a motivation to combine the Adachi and Fujisawa flows from the references themselves. "[T]he screen of the display unit 28 [of Adachi's machine translator processor] consists, as shown in FIG. 3, of . . . an original sentence display region 36, and a translated sentence display region 38." Col. 3, ll. 20-23. Although the original and translated sentences are displayed side-by-side in a "preferred embodiment," col. 2, l. 30, the primary reference invites "[v]arious modifications. . . ." Col. 6, l. 41.

Fujisawa would have suggested such a modification. Specifically, "[t]he image generating means outputs the [translation] equivalent of the [original] word under the [original] word." Col. 13, ll. 32-33. The secondary reference also discloses advantages flowing from displaying a translated word under an original word. Specifically, "the present invention

provides an image forming apparatus which intelligibly positions the equivalents of words included in a document image, outputs an image in an easy-to-see layout even when the equivalents noticeably change the contents of the image, and promotes high speed processing." *Id.* at 11. 53-58. Because using Fujisawa's over-and-under layout to display Adachi's translated sentence under the latter's original sentence would have provided intelligible positioning of the sentences and an easy-to-see layout and would have promoted high speed processing, we find that the prior art as a whole would have suggested combining teachings of the references.

Second, the examiner asserts, "Adachi discloses . . . dividing sentences into word trains, in the abstract as dividing into phrases. . . ." (Examiner's Answer at 3.) He adds, "Fujisawa discloses . . . vertical juxtaposition, in column 11 lines 17-19. . . ." (*Id.* at 4.) The appellants argue, "these references do not disclose or suggest displaying a divided original sentence and the divided translated sentence at vertically juxtaposed positions." (Reply Br. at 4.)

"Analysis begins with a key legal question -- *what is the invention claimed?*" *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987). Claims that are not argued separately stand or fall together. *In re Kaslow*, 707 F.2d 1366, 1376, 217 USPQ 1089, 1096 (Fed. Cir. 1983) (citing *In re Burckel*, 592 F.2d 1175, 201 USPQ 67 (CCPA 1979)). When the patentability of a dependent claim is not argued separately, in particular, the claim stands or falls with the claim from which it depends. *In re King*, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986) (citing *In re Sernaker*, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983); *In re Burckel*, 592 F.2d 1175, 1178-79, 201 USPQ 67, 70 (CCPA 1979)).

"[T]he Board must give claims their broadest reasonable construction. . . ." *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1668 (Fed. Cir. 2000). "Moreover, limitations are not to be read into the claims from the specification." *In re Van Geuns*, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)).²

² "The PTO broadly interprets claims during examination of a patent application since the applicant may 'amend his claims to

Here, the appellants stipulate, "[c]laims 1-4, [sic] 6-8, 15 and 16 stand or fall together;" (Reply Br. at 2), "[c]laims 9, 10, 12-14 and 16-18 stand or fall together and . . . [c]laims 21-23 and 26-29 stand or fall together." (Reply Br. at 2.) In the appeal brief, they do not argue separately the patentability of claims 16, 18, and 23. To the contrary, the appellants stipulate, "[c]laims 4-8, 11-18, 21-23 and 26-29 stand or fall together with claims 1, 9 and 21, respectively." (Appeal Br. at 6.) In the reply brief, however, the appellants includes a new argument for the separate patentability of claims 16, 18, and 23. (Reply Br. at 5.)

"We generally will not entertain arguments omitted from an appellant's opening brief and raised initially in his reply brief Considering an argument advanced for the first

obtain protection commensurate with his actual contribution to the art.'" *In re Yamamoto*, 740 F.2d 1569, 1571, 222 USPQ 934, 936 (Fed. Cir. 1984) (quoting *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550 (CCPA 1969)). "This approach serves the public interest by reducing the possibility that claims, finally allowed, will be given broader scope than is justified. Applicants' interests are not impaired since they are not foreclosed from obtaining appropriate coverage for their invention with express claim language." *Id.* at 1571-72, 222 USPQ at 936 (citing *Prater*, 415 F.2d at 1405 n.31, 162 USPQ at 550 n.31).

time in a reply brief, then, is not only unfair . . . but also entails the risk of an improvident or ill-advised opinion. . . ." *McBride v Merrell Dow and Pharms., Inc.*, 800 F.2d 1208, 1210-11 (D.C. Cir. 1986).

Here, because an examiner is no longer permitted to file *sua sponte* a supplemental examiner's answer in response to a reply brief, 37 C.F.R. § 1.193(b)(1) (1998), we do not have the benefit of the examiner's response to the appellants' new argument. Considering the new argument would not only be unfair but would entail the risk of an improvident or ill-advised opinion. Accordingly, we will not consider the new argument. *Cf. Kaufman Co. v Lantech Inc.*, 807 F.2d 970, 973 n.*, 1 USPQ2d 1202, 1204 n.* (Fed. Cir. 1986). Therefore, claims 4, 6-8, 15, and 16 stand or fall with representative claim 1; claims 10, 12-14, and 16-18 stand or fall with representative claim 9; and claims 22, 23, and 26-29 stand or fall with representative claim 21.

For its part, claim 1 specifies in pertinent part the following limitations: "displaying the original sentence and the translated sentence so that the divided original sentence and the divided translated sentence are arranged at vertically juxtaposed

positions, wherein the division rule is a rule of dividing the original sentence into one of phrases and clauses." Similarly, claim 9 specifies in pertinent part the following limitations: "division means for dividing the original sentence into word trains in accordance with a predetermined division rule, wherein the division rule is a rule of dividing the original sentence into one of phrases and clauses . . . and display means for displaying the original sentence and the translated sentence so that the divided original sentence and the divided translated sentence are arranged at vertically juxtaposed positions." Also similarly, claim 21 specifies in pertinent part the following limitations: "(a) dividing an input laterally written original sentence into a plurality of word trains in accordance with a predetermined division rule wherein the division rule is a rule of dividing the original sentence into one of phrases and clauses . . . and (c) displaying the original sentence and the translated sentence so that the divided original sentence and the divided translated sentence are arranged at vertically juxtaposed positions." Giving the representative claims their broadest reasonable interpretation, the limitations merely require dividing an original sentence into either phrases or clauses and

then displaying the divided, original sentence and a divided, translated sentence in vertically juxtaposed positions.

Having determined what subject matter is being claimed, the next inquiry is whether the subject matter is obvious. "'A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.'" *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)).

Here, Adachi's translator divides an original sentence into phrases, viz., "the original is divided into phrases by said dividing means and the phrases are translated by said translation processing means." Col. 2, ll. 25-27. More specifically, the original sentence is divided "in accordance with a predetermined rule for division. . . ." *Id.* at ll. 21-22. "The original sentence division unit 24 performs division processing by the use of the division grammar. (step 108) Namely, when an example of English sentence as shown in FIG. 5A is input, it is divided into elemental units of the sentence. . . ." Col. 4, ll. 52-57.

"Then, those three [resultant] phrases are sent to the translation unit 18," *id.* at ll. 59-60, for translation.

As mentioned regarding the first point of contention, the primary reference then displays the original sentence and a translated sentence. Figure 5B of Adachi shows that the original and translated sentences are displayed as divided. When Fujisawa's over-and-under layout was used to display Adachi's divided, translated sentence under its divided, original sentence, the combination of teachings would have suggested displaying the divided, original sentence and the divided, translated sentence in vertically juxtaposed positions. Therefore, we affirm the rejection of representative claim 1; claims 4, 6-8, 15, and 16, which fall therewith; representative claim 9; claims 10, 12-14, and 16-18, which fall therewith; representative claim 21; and claims 22, 23, and 26-29, which fall therewith.

CONCLUSION

In summary, the rejection of claims 1, 4, 6-10, 12-18, 21-23 and 26-29 under § 103(a) is affirmed. Our affirmance is based

only on the arguments made in the briefs. Arguments not made therein are neither before us nor at issue but are considered waived.

No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

JOSEPH F. RUGGIERO)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
PARSHOTAM S. LALL)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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Appeal No. 2000-1515
Application No. 08/687,195

Page 14

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