

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* HIDEMASA TOKIEDA,  
TADAO MIKAMI, and  
KOJI MORI

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Appeal 2008-4573  
Application 10/149,226  
Technology Center 3600

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Decided: November 24, 2008

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Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and  
ANTON W. FETTING, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

## STATEMENT OF THE CASE

Hidemasa Tokieda, et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1-10. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

## SUMMARY OF DECISION

We AFFIRM.<sup>1</sup>

## THE INVENTION

The invention relates to a method of performing a multilingual market research using a multilingual translation network.

Claim 1, reproduced below, is illustrative of the subject matter on appeal. Claim 1 is the sole independent claim on appeal.

1. A method for performing a multilingual market research through a two-way computer communication network, comprising;
  - a step in which a market research performing side receives a request for a multilingual market research,
  - a step in which the market research performing side invites answerers to the multilingual market research through said communication network,
  - a step in which the market research performing side asks the answerers who have applied for invitation to answer to the market research in many languages through said communication network,
  - a step of translating answer information to the multilingual market research through a multilingual translation network, and
  - a step in which the market research performing side performs a report based on the answer information to the market research from

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<sup>1</sup> Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed Dec. 26, 2007) and Reply Brief ("Reply Br.," filed Feb. 22, 2008), and the Examiner's Answer ("Answer," mailed Jan. 24, 2008).

the answerers to the market research requester side,  
wherein the step of translating answer information comprises:  
a step of changing a master Web site on a basis of a  
multilingual translation,  
a step of automatically selecting language data for  
translation excluding non-language data from, master contents of  
the master Web site,  
a step of translating language data through a multilingual  
translation network where translators performing translation in  
many languages are organized on an extranet, said translation  
being an automatic machine translation or a manual input  
translation,  
a step of reentering language data which have been translated  
and transferred through the multilingual translation network into  
a multilingual market research database apparatus, and  
a step of automatically changing the Web site.

#### THE REJECTIONS

The Examiner relies upon the following as evidence of  
unpatentability:

Bayer	US 6,311,190 B1	Oct. 30, 2001
Hamlin	US 6,754,635 B1	Jun. 22, 2004

The following rejections are before us for review:

1. Claims 1, 2, 9, and 10 are rejected under 35 U.S.C. § 102(e) as being anticipated by Bayer.
2. Claims 4-6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bayer.
3. Claims 3, 7, and 8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bayer and Hamlin.

## ISSUES OF LAW

The first issue before us is whether the Appellant has shown that the Examiner erred in rejecting claims 1, 2, 9, and 10 under 35 U.S.C. § 102(e) as being anticipated by Bayer.

The second issue before us is whether the Appellants have shown that the Examiner erred in rejecting claims 4-6 under 35 U.S.C. § 103(a) as being unpatentable over Bayer.

The third issue before us is whether the Appellants have shown that the Examiner erred in rejecting claims 3, 7, and 8 under 35 U.S.C. § 103(a) as being unpatentable over Bayer and Hamlin.

All these issues turn on whether Bayer describes the step, in claim 1, of “translating answer information to the multilingual market research through a multilingual translation network.” Does the claimed use of “answer information” read on Bayer’s use of response sets?

## FINDINGS OF FACT

We find that the following enumerated findings of fact (FF) are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

### *Claim construction*

1. Claim 1 describes a process involving the obtaining and translation of “answer information.”
2. According to claim 1, “[a] market research performing side invites answerers to [a] multilingual market research” and “the market research performing side asks the answerers who have applied for

invitation to answer to the market research.”

3. Claim 1 does not describe the manner or the form in which the answerers are to answer to the market research.
4. Claim 1 recites a step of “translating answer information to the multilingual market research through a multilingual translation network.”
5. Claim 1 makes no mention of *when* the “answer information” is translated.
6. The method of claim 1 does not require the answerers to answer or to answer the market research with answers that are “answer information.”
7. Claim 1 does not require the steps of “the market research performing side ask[ing] the answerers who have applied for invitation to answer to the market research” and of “translating answer information to the multilingual market research through a multilingual translation network” be conducted in the order listed in the claim.
8. Claim 1 further provides that the “step of translating answer information comprises” steps of (a) “changing a master Web site on a basis of a multilingual translation,” (b) “automatically selecting language data for translation excluding non-language data from master contents of the master Web site,” (c) “translating language data through a multilingual translation network where translators performing translation in many

languages are organized on an extranet,” (d) “reentering language data which have been translated and transferred through the multilingual translation network into a multilingual market research database apparatus,” and (e) “automatically changing the Web site.”

9. The Specification does not provide a definition for “answer information” which is inconsistent with its ordinary and customary meaning.
10. In the context of claim 1, the “answer information” referred to in claim 1 is that information obtained from answerers responding to a multilingual market research.

*The prior art*

11. Bayer relates to a network server-based system for conducting surveys in different languages and provides means for a voter “to vote on a survey in the preferred language of the voter.” (col. 5, ll. 48-49).
12. The Bayer survey includes “questions and sets of responses to questions in the preferred language of the voter.... The survey form page enables the voter to answer each question and to submit such answers back to the network server over the network. The network server receives the answers to the questions of the survey and adds those answers representing votes to records in the database tallying totals for each response answered for each question for the country of the voter, and the total number of voters answering each question for the country of the voter.” (col. 2, l. 67

– col. 3, l. 12).

13. According to Bayer, the voting information is stored in a database. (col. 6, l. 66).
14. According to Bayer, the voting information includes records stored in eighteen tables. (col. 6, l. 67- col. 7, l. 1.) See also Figs. 3A-3R.
15. One of the tables is called a “QuestionType table” (element 38 in Fig. 3I) and it “defines the type of response sets for each of the questions.” (col. 7, ll. 13-14).
16. Another table is called the “VoteQuestion table” (element 39 in Fig. 3J) and it “defines the questions in system 10 in the master language.” (col. 7, ll. 14-17).
17. Another table is called the “VoteAnswers table” (element 41 in Fig. 3L) and it “defines the text of each of the responses for each question in the master language.” (col. 7, ll. 17-19).
18. Bayer (col. 9, ll. 44-57) describes the VoteAnswer table as follows:

Referring to FIG. 3L, each record of the VoteAnswer table 41 (referred to as a response record) has the following data fields: AnswerID, a unique identifier for each response for a question in the system 10 [see Fig. 1]; the QuestionID of one of the question records to which the AnswerID of this record relates; Name, text of the response in the master language which is associated with the QuestionID of this record. A response record is provided for each response in the set of responses for each question. For example, if the question is “Do you own or rent you primary residence” and the set of responses is “Rent, Own, or Other,” then three response records would exist for the question, one for each possible response, and each response record linked by QuestionID to the question record in the

VoteQuestion table 39.

19. Another table is called the “Tally table” (element 46 in Fig. 3Q) and it “records a tally of the vote totals for each of the answers to the questions for each survey in each of the different countries defined for a voting campaign.” (col. 7, ll. 26-29).
20. The tables determine the survey. “First, at step 100, a base HTML body is constructed for the survey form page ....” (col. 15, ll. 50-51). “[E]ach question is then constructed by first providing the text of question and the set of responses for the question in the voter’s preferred language.” (col. 16, ll. 6-8).

## PRINCIPLES OF LAW

### *Claim Construction*

During examination of a patent application, a pending claim is given the broadest reasonable construction consistent with the specification and should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1369 (Fed. Cir. 2004). “[W]e look to the specification to see if it provides a definition for claim terms, but otherwise apply a broad interpretation. As this court has discussed, this methodology produces claims with only justifiable breadth. *In re Yamamoto*, 740 F.2d 1569, 1571 (Fed. Cir. 1984). Further, as applicants may amend claims to narrow their scope, a broad construction during prosecution creates no unfairness to the applicant or patentee. *Am. Acad.*, 367 F.3d at 1364.” *In re ICON Health and Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007). Limitations appearing in the

specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003).

*Anticipation*

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987).

ANALYSIS

*The rejection of claims 1, 2, 9, and 10 under § 102(e) as being anticipated by Bayer.*

The Appellants argued claims 1, 2, 9, and 10 as a group (App. Br. 4). We select claim 1 as the representative claim for this group, and the remaining claims 2, 9, and 10 stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

The Appellants argued that “Bayer fails to disclose, teach or suggest at least” (App. Br. 5) the step of “translating answer information to the multilingual market research through a multilingual translation network” (claim 1). According to the Appellants, “Bayer appears to only disclose a system for conducting voter surveys in multiple different languages (see Abstract)... [U]nlike Appellants’ method that performs a translation on received survey answers,” Bayer appears to only perform translation on questions at the time of survey generation... [N]owhere does Bayer disclose, teach, or suggest wherein the answers, provided by the answerer to the survey, are translated.” (App. Br. 5) (emphasis original). Finally, the Appellants argued that “Appellants’ method ... is distinguished from Bayer

that appears to only disclose a system for translating survey questions into multiple languages to be presented to answerers.” (App. Br. 6) (emphasis original). In reliance on these arguments, the Appellants argued that Bayer also does not describe the claimed steps that comprise the step of “translating answer information to the multilingual market research through a multilingual translation network.” (See FF 8). (App. Br. 6).

The Examiner took the position that “Bayer teaches translating answer information for multiple languages (see Abstract: teaching how Bayer “dynamically constructs survey page in voter’s language ... enables voter to answer each question and submit answers,” especially Figure 18 Items 198g and 198h showing Response Set (answer information) Translated), ... .”(Answer 5). As to the Appellants argument, the Examiner responded:

Examiner respectfully disagrees: Bayer expressly teaches a step of translating answer information to multiple languages (see Abstract: teaching how Bayer "dynamically constructs survey page in voter's language ... enables voter to answer each question and submit answers"; especially Figure 18 Items 198g and 198h showing a step of translating the Response Set (answer information) to a selected language), wherein the step of translating answer information includes changing a master website on a basis of a multilingual translation through a multilingual translation network (see at least Abstract and Figures 1 and 18 and column 5 from line 42; column 7 from line 17). Bayer teaches *a step of translating answer information* in at least that the survey administrator enters the translated response text for each possible response to each survey question.

As to Applicant's remarks that the present invention "performs translation on *received* survey answers...wherein the answers provided by the answerer to the survey are translated," (Remarks, page 5, emphasis added), these limitations are not claimed and cannot be read into the claims. Rather, Applicant claims only *a step of translating answer information...* Notwithstanding, even if positively claimed, a step of translating answer information on *received* answers may be found inherent (or obvious) in view of Bayer's teaching of presenting survey information to the client (see Figure 14A Item 152 and Figure 14B, the survey results report), the survey having been conducted in the multiple languages of the respondents, with the received answers translated and summarized in the language of the client (such as English) using the same or reverse mechanisms provided by Bayer's answer translation tables.

(Answer 11-12).

The Appellants replied that the "Appellants submit that the Examiner has misconstrued the wording of the claim so as to suggest that the claim may be interpreted in a manner inconsistent with an ordinary parsing of the claim." (Reply Br. 2). "[ ], Appellants respectfully submits [sic] that, notwithstanding the assertions of the Examiner, the claims define wherein the disclosed invention performs translation on received survey answers and NOT on a set of survey questions/answers provided to the answerer." (Reply Br. 3) (emphasis original). The Appellants contend that the Examiner is relying on a theory of inherency but provides no factual support for the "inherency assertion regarding translating answers from an answerer;" i.e., that translation on received survey answers necessarily flows from Bayer. (Reply Br. 4) (emphasis original).

We have carefully reviewed the record and find the evidence favors the Examiner's position.

We do not find that the Examiner has relied on an inherency theory in reaching the conclusion that Bayer anticipates the claimed subject matter. Rather, the Examiner found that Bayer expressly describes the claimed subject matter in light of its broadest reasonable construction.

Anticipation is a question of fact. *Finisar Corp. v. DirecTV Group, Inc.*, 523 F.3d 1323, 1334 (Fed. Cir. 2008). "A determination that a claim is anticipated under 35 U.S.C. § 102(b) involves two analytical steps. First, the Board must interpret the claim language, where necessary.... Secondly, the Board must compare the construed claim to a prior art reference and make factual findings that "each and every limitation is found either expressly or inherently in [that] single prior art reference." *Celeritas Techs. Ltd. v. Rockwell Int'l Corp.*, 150 F.3d 1354, 1360 (Fed. Cir. 1998)." *In re Crush*, 393 F.3d 1253, 1256 (Fed. Cir. 2004).

The Appellants have argued that the claimed method that performs a translation on received survey answers from answerers as opposed to Bayer's response sets which are provided *to* the answerers. This argument presumes that the claimed method calls for survey answerers to respond with translatable answers which, once received, are then translated. We agree with the Examiner that claim 1 is not so limited.

Based on the broadest reasonable construction of claim 1, the method claimed requires only that "answer information" be translated. The claimed method makes no mention of *when* the "answer information" is translated. (FF 5). Nor does the claim make any mention of a survey or the source or form of the "answer information." (FF 3). According to claim 1, the market

research performing side asks the answerers to answer. The claim then recites a step of translating “answer information.” The claimed method does not require the answerers to answer or to answer the market research with answers that are “answer information.” (FF 6). All that the claimed method requires is that answerers are asked to answer and that “answer information” be translated. Furthermore, there is no requirement that these steps be conducted in the order listed in the claim. (FF 7). Claimed steps are not ordinarily construed to require an order unless the steps of the method claim actually recite an order or the listed order is implicitly required to practice the method. *Altiris Inc. v. Symantec Corp.*, 318 F.3d 1363, 1369 (Fed. Cir. 2003); *Interactive Gift Express, Inc. v. CompuServe Inc.*, 256 F.3d 1323, 1342-43 (Fed. Cir. 2000). *See also Loral Fairchild Corp. v. Sony Corp.*, 181 F.3d 1313, 1322 (Fed. Cir. 1999). Here claim 1 broadly encompasses a method whereby “answer information” is translated and the answerers are invited to answer the market research. Nothing in the claim limits the translating to the particular information the answerers provide to the market research.

As to the phrase “answer information,” the Specification provides no definition. (FF 9). Accordingly, it must be given “the meaning that the [phrase] would have to a person of ordinary skill in the art in question at the time of the invention.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005) (en banc). We take “answer information” to mean information corresponding to a response to a question. (FF 10). Given this meaning, we see little if any difference between the claimed “answer information” and Bayer’s response sets, which are also answers to questions.

In light of this claim construction, we now turn to Bayer and determine whether it anticipates the claimed subject matter.

Bayer describes a method whereby questions and response sets are provided on a survey which is delivered to a voter, who then votes, and the votes are tallied. (FF 11-19). Bayer's process involves translating the questions and response sets before the survey is presented. (FF 20). Bayer indicates that the survey answerers (i.e., "voters") vote according to the response sets provided on the survey but there is no indication that the compiled votes are translated after they are received. Accordingly, we agree with the Appellants' analysis of Bayer.

Nevertheless, in light of the broadest reasonable construction of claim 1, we find that, notwithstanding that Bayer provides the survey answerers with translated response sets, claim 1 reads on Bayer's process. "The law of anticipation does not require that the reference "teach" what the subject patent teaches. Assuming that a reference is properly "prior art," it is only necessary that the claims under attack, as construed by the court, "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or "fully met" by it." *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 772 (Fed. Cir. 1983).

We find that the Examiner has established a prima facie case of anticipation of claim 1 and that the Appellants' arguments to the contrary are unpersuasive as to error in the prima facie case. We reach the same finding for claims 2, 9, and 10, which claims fall with claim 1.

*The rejection of claims 4-6 under § 103(a) as being unpatentable over Bayer.*

The Appellants relied on the arguments raised against the rejection of claim 1 to challenge the rejection of claims 4-6. (App. Br. 7). For the foregoing reasons, we find those arguments unpersuasive as to error in the rejection of claim 1 and thus reach the same conclusion as to the rejection of claims 4-6.

*The rejection of claims 3, 7, and 8 under § 103(a) as being unpatentable over Bayer and Hamlin.*

The Appellants relied on the arguments raised against the rejection of claim 1 to challenge the rejection of claims 3, 7, and 8. (App. Br. 7). For the foregoing reasons, we find those arguments unpersuasive as to error in the rejection of claim 1 and thus reach the same conclusion as to the rejection of claims 3, 7, and 8.

#### CONCLUSIONS OF LAW

We conclude that the Appellants have not shown that the Examiner erred in rejecting claims 1, 2, 9, and 10 under 35 U.S.C. § 102(e) as being anticipated by Bayer; claims 4-6 under 35 U.S.C. § 103(a) as being unpatentable over Bayer; and, claims 3, 7, and 8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bayer and Hamlin.

Appeal 2008-4573  
Application 10/149,226

DECISION

The decision of the Examiner to reject claims 1-10 is affirmed.

AFFIRMED

JRG

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