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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte TONY STEPHEN SAILER

Appeal 2010-010041
Application 11/870,505
Technology Center 2600

Before BRUCE R. WINSOR, JEREMY J. CURCURI,
and DAVID C. McKONE, *Administrative Patent Judges*.

McKONE, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134(a) from a Final Rejection of claims 1-19, which constitute all the claims pending in this application. *See* Br. 2.¹ Claim 20 is cancelled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

¹ Throughout this opinion, we refer to the Appeal Brief filed February 9, 2010 (“Br.”) and the Examiner’s Answer mailed March 19, 2010 (“Ans.”).

THE INVENTION

Appellant's invention relates to obtaining translations via a remote device such as a cellular telephone, personal digital assistant ("PDA"), or portable computer. *See* Spec. 4:2-6. Claim 1, which is illustrative of the invention, reads as follows:

1. A method of providing a translation, the method comprising:

performing by a server in communication with a dedicated application on a portable communication device:

(a) receiving, via the dedicated application on the portable communication device, a translation request that includes at least one word in a first language, wherein the dedicated application is dedicated to work in conjunction with the server to provide translations services;

(b) translating the at least one word from the first language to a second language;

(c) identifying an advertisement; and

(d) transmitting the at least one word in the second language and the advertisement.

THE REJECTIONS

The Examiner relies on the following prior art in rejecting the claims:

Gerace	US 5,991,735	Nov. 23, 1999
Franz	US 6,356,865 B1	Mar. 12, 2002
Dietz	US 6,385,586 B1	May 7, 2002
Hutchison	US 6,785,647 B2	Aug. 31, 2004
Chan	US 2006/0129424 A1	June 15, 2006

Isotani Ryosuke Isotani et al., *AN AUTOMATIC SPEECH TRANSLATION SYSTEM ON PDA FOR TRAVEL CONVERSATION*, Proc. Of the 4th IEEE Int'l Conf. on Multimodal Interfaces (ICMI'02), (2002).

Claims 1, 2, 4, 6-8, and 18 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Dietz, Isotani, and Chan. *See* Ans. 3-9.

Claims 3 and 5 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Dietz, Isotani, Chan, and Franz. *See* Ans. 9-10.

Claims 9, 10, 12, and 14-17 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Dietz, Isotani, Chan, and Gerace. *See* Ans. 10-14.

Claims 11 and 13 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Dietz, Isotani, Chan, Gerace, and Franz. *See* Ans. 14-15.

Claim 19 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Dietz, Isotani, Chan, and Hutchison. *See* Ans. 16.

ISSUE

The dispositive issue raised by Appellant's contentions is whether Dietz and Isotani teach or suggest a "dedicated application on a portable communication device" that "is dedicated to work in conjunction with [a] server to provide translations services," as recited in each of independent claims 1, 9, and 18. *See* Br. 4-9.

ANALYSIS

REJECTION OF CLAIMS 1, 2, 4, 6-8, AND 18 UNDER 35 U.S.C. § 103(a)

Appellant argues claims 1 and 18 together. *See* Br. 4-6. Each recites a "dedicated application on a portable communication device" that "is

dedicated to work in conjunction with [a] server to provide translations services.” Regarding the limitation “dedicated to work in conjunction with [a] server to provide translations services,” the Examiner finds that Dietz discloses “a language translation environment” that “may be resident on [a] server,” the language translation environment “capable of translating the human language into the desired language.” Ans. 4 (quoting Dietz, col. 5, l. 65-col. 6, l. 1). The Examiner concludes that because Dietz provides an environment dedicated to language translation on a cellular telephone, it would have been obvious to one of ordinary skill in the art that “the server is serving a dedicated application not through a web browser.” Ans. 4. However, the Examiner also finds that “Dietz fails to specifically teach, but Isotani teaches: wherein the application is a dedicated application.” Ans. 4-5 (citing Isotani, § 2). The Examiner further concludes that it would have been obvious to combine Dietz and Isotani “to provide speech to speech translation for portable devices feasible by reducing computational cost and memory usage.” Ans. 5 (citing Isotani, § 8).

Appellant contends that the Examiner “admitted that Dietz does not teach that the application is a dedicated application on a portable communication device.” Br. 5. Regarding the Examiner’s combination of Dietz and Isotani, Appellant argues that even if they are combined, they still fail to teach a dedicated application that “is dedicated to work in conjunction with the server to provide translation services.” Br. 5.

In response, the Examiner disagrees that he admitted that Dietz fails to disclose a dedicated application on a portable communication device and explains that he found such an application in Dietz under a broadest reasonable interpretation of “dedicated application.” *See* Ans. 18-19. The

Examiner further explains that his combination of Dietz and Isotani was under a narrower construction. *See* Ans. 19. We need not reach whether the Examiner admitted that Dietz lacks a dedicated application on a portable communication device because we agree with the Examiner’s finding (Ans. 5) that the limitation is taught by the combination of Dietz and Isotani and conclusion that a person of ordinary skill in the art would have had reason to make that combination.²

The Examiner finds that Isotani’s teaching of application software dedicated to automatic translation running on PDAs is a teaching of a dedicated application on a portable communication device. *See* Ans. 5 (citing Isotani, § 2). Appellant does not challenge this finding. *See* Br. 5-6. Rather, Appellant argues that “the ‘dedicated application’ in Isontani [sic] et al. is self-contained and does not communicate with a server to provide translation services.” Br. 5. Appellant highlights Isotani’s teaching that “[a]ny other external devices are not needed,” Br. 6 (quoting Isotani, § 2), and argues that Isotani’s disclosure teaches away from a modification that would have its application communicating with a server, a modification that “would be contrary to the basic operating principle of Isontani [sic] et al., which is to provide a self-contained translation device that does not need an external device, such as a server,” Br. 6. The Examiner responds that

² We note that Dietz teaches that its portable communication device “is equipped with the capabilities to convert the user’s speech into text form” to be transmitted to the server for translation. Dietz, col. 6, ll. 16-18. This at least suggests software resident on the device in communication with a server sending a translation request to the server. Moreover, as Dietz explains, the device “may be designed solely for speech translations” Dietz, col. 5, ll. 53-55. Thus, the software can be dedicated to a single task (speech translation).

Appellant is attacking the references individually rather than addressing the Examiner's combination. *See* Ans. 19. According to the Examiner, Isotani was cited to show that it was well-known to dedicate an application on a portable device to a single task, such as speech translation. *See id.* The Examiner finds that Dietz, not Isotani, shows communication with a server. *See* Ans. 4.

We agree with the Examiner. While Appellant gives a reason why the application of Isotani would not communicate with a server, Appellant does not adequately address why a person of ordinary skill in the art would have failed to appreciate that Isotani's teaching of an application dedicated to a single purpose could be applied to Dietz's teaching of a portable communication device communicating with a server to perform speech translation. *See In re Keller*, 642 F.2d 413, 426 (CCPA 1981) (“[O]ne cannot show non-obviousness by attacking references individually where, as here, the rejections are based on combinations of references.”).

The Examiner also responds that Isotani's teaching that communication with a server is not necessary does not constitute a teaching away from a combination that includes communicating with a server. *See* Ans. 20-21. We agree. “A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994). Although Isotani teaches that communication between an application and a server is not necessary, Appellant does not persuasively explain why such a teaching would have discouraged a person of ordinary skill from pursuing a combination where

an application communicates with a server. Thus, Appellant has not shown error in the Examiner's conclusion of obviousness.

Appellant only nominally argues claims 2, 4, and 6-8 separately. *See* Br. 7.

Accordingly, we sustain the rejection of: (1) independent claims 1 and 18; and (2) claims 2, 4, and 6-8, which depend on claim 1.

REJECTION OF CLAIMS 3 AND 5 UNDER 35 U.S.C. § 103(a)

Claims 3 and 5 depend on claim 1. Appellant only nominally argues claims 3 and 5 separately. *See* Br. 7. Accordingly, we sustain the rejection of claims 3 and 5 for the same reasons as given for claim 1 above.

REJECTION OF CLAIMS 9, 10, 12, AND 14-17 UNDER 35 U.S.C. § 103(a)

Appellant presents essentially the same arguments for independent claim 9 as presented for claim 1. *See* Br. 7-9. Claims 10, 12, and 14-17 depend on claim 9. Appellant only nominally argues claims 10, 12, and 14-17 separately. *See* Br. 9. Accordingly, we sustain the rejection of claims 9, 10, 12, and 14-17 for the same reasons as given for claim 1 above.

REJECTION OF CLAIMS 11 AND 13 UNDER 35 U.S.C. § 103(a)

Claims 11 and 13 depend on claim 9. Appellant only nominally argues claims 11 and 13 separately. *See* Br. 9. Accordingly, we sustain the rejection of claims 11 and 13 for the same reasons as given for claims 1 and 9 above.

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REJECTION OF CLAIM 19 UNDER 35 U.S.C. § 103(a)

Claim 19 depends on claim 18. Appellant only nominally argues claim 19 separately. *See* Br. 10. Accordingly, we sustain the rejection of claim 19 for the same reasons as given for claim 18 above.

ORDER

The decision of the Examiner to reject claims 1-19 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2010).

AFFIRMED

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