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The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LEE M. E. MORIN

Appeal No. 96-2992
Application 08/200,049¹

ON BRIEF

Before KRASS, JERRY SMITH and LALL, Administrative Patent Judges.
LALL, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the final rejection of claims 1 through 7, all the outstanding claims in the case.

The claimed invention relates to a computer-based device and method for providing spoken translations of a

¹ Application for patent filed February 22, 1994.

predetermined set of questions and phrases, upon the selection of individual questions and phrases. Translations of these questions and phrases are prerecorded by human speakers into a number of languages, and an interviewer/user, in cooperation with the interviewee, chooses into which of these languages the translations are to be made. The interviewer chooses, in the interviewer's language, the questions to be asked, indicates his choice to the device and the device speaks the corresponding questions in the chosen language for the interviewee.

Representative claim 1 is reproduced as follows:

1. A translating machine to enable an operator who is fluent in one language to interview a respondent using a predetermined list of available sentences, which may include questions, where the respondent speaks any one of a plurality of available languages other than the language in which the operator is fluent, and where the respondent need not be literate in any language, comprising:

A. Advance storage means for storage of spoken translations in a form which is convertible into an audio waveform of each of the available sentences in each of the available languages after those translations are spoken and recorded in advance by speakers fluent in each of those languages,

B. Language selection means for selecting which of the available languages is to be used with the respondent,

C. List storage means for storing the predetermined list of available sentences as alphanumeric code,

D. Second selection means for selecting individual desired sentences from the stored predetermined list and displaying them

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to the operator, and

E. Audio play-out means for producing an audio output derived from stored spoken translations into the selected language in the advance storage means corresponding to individual desired sentences selected by the operator with the selection means.

The Examiner relies on the following references:

Hashimoto et al. (Hashimoto)	4,613,944	Sept. 23, 1986
Yamamoto et al. (Yamamoto)	5,056,145	Oct. 8, 1991

Claims 1 through 7 stand rejected under 35 U.S.C.

§ 103. As evidence of obviousness the Examiner offers Yamamoto and Hashimoto.

Rather than repeat the arguments of Appellant or the Examiner, we make reference to the briefs² and the answer for their respective positions.

OPINION

We have considered the rejection advanced by the Examiner. We have, likewise, reviewed the Appellant's arguments against the rejection as set forth in the brief.

It is our view, after consideration of the record before us, that the collective evidence relied upon and the level of skill in the particular art would have suggested, to one of

² A supplemental brief was filed on Feb. 18, 1999, only to meet the formal requirements. Thus, any reference to the brief in this opinion refers to the brief filed on October 19, 1995.

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ordinary skill in the art, the obviousness of the invention as set forth in claims 1 through 7. Accordingly, we affirm.

We consider now the Section 103 rejections as they apply to claims 1 through 7 which are grouped together [brief, pages 9 and 10, and answer, page 2].

As a general proposition in an appeal involving a rejection under 35 U.S.C. § 103, an examiner is under a burden to make out a prima facie case of obviousness. If that burden is met, the burden of going forward then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

With respect to claim 1, the Examiner asserts that Hashimoto teaches everything except for a storage of spoken translations of sentences [questions and phrases] in multiple languages. However, Yamamoto teaches the digitized recording of the spoken foreign language and playing same back upon selection

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by the user. Therefore, the Examiner concludes that it would have been obvious, to one of ordinary skill in the art at the time of the invention, to incorporate this teaching of Yamamoto into Hashimoto [answer, pages 3 to 6].

Appellant argues that the suggested combination of Hashimoto and Yamamoto is unobvious for a number of reasons [brief, page 12]. The "most compelling reason" Appellant offers for said position is that it would not work because the small amount of data that could be recorded on Yamamoto's integrated chip (IC) memory 9 would not suffice for a reasonable amount of available translations for the Hashimoto system [brief, page 12]. Appellant further argues that the combination is unobvious because there is not any teaching of a way to fit these two systems [Hashimoto and Yamamoto] together into a working device [brief, page 13]. For this position Appellant alleges that the Examiner has not suggested any way to do so, and that it is not clear how Yamamoto's integrated circuit could physically be installed in Hashimoto's system without so much modification that a new invention would be called for just for the combination of the two references. Appellant still further argues, with respect to the two references, that it is not obvious [to any one] to want to combine them [brief, pages 13 to 14]. Appellant supports

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this position by noting that it requires a great deal more digital data storage capability to store speech in digital form ... than is found on the ROM chips used by Hashimoto [brief, page 14].

The Examiner, regarding the size of the memory storage, responds that neither Hashimoto nor Yamamoto is limited to any specific size for its storage capacity, and moreover, no particular boundaries for the storage size are claimed [answer, pages 11 to 14]. Regarding the absence of any teaching of a way to combine the two systems, the Examiner responds that the references [as applied in the suggested combination] rely on the knowledge of those [of ordinary skill] in the art to complement that which is disclosed therein, and a specific teaching does not need to be shown by a reference [answer, pages 15 to 16]. With respect to the "it is not obvious to want to combine them" argument [brief, page 14], the Examiner asserts that digitizing spoken sentences, [rather than using phonemes to create sentences], for clearer reproduction is well known in the art, and moreover the argument of " ...not obvious to want to combine..." is speculative [answer, pages 14 to 15]. Moreover, CD-ROMs are known for large storage of data [answer, page 17].

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We find that Hashimoto does show an advance storage means for storage of sentences and phrases in different languages, means to type in the sentence or phrase desired to be translated, means to select the language into which the phrase is to be translated and the speakers for the synthesized translated phrase [figure 1 and column 2, lines 15 to 21, column 6, lines 33 to 43]. It is not clear whether the advance storage in Hashimoto was done from spoken words. Also, we note that the translated words are synthesized for speech in Hashimoto, rather than digitized. However, we find that Yamamoto teaches the concept of digitally recording spoken words as well as reproducing speech from the digitized recording which could be a foreign language [column 2, lines 35 to 41 and column 3, lines 1 to 21]. We conclude that it would have been obvious, to one of ordinary skill in the art at the time of the invention, to use the teaching of Yamamoto, to record the spoken words in digitized form and to reproduce the digitally recorded words in a spoken form, in Hashimoto as outlined in detail by the Examiner [answer, pages 3 to 10].

With respect to the first argument that the suggested combination would not work due to the size of the storage capacity of Hashimoto and Yamamoto, we believe that it is not

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entirely determinative of the issue of obviousness. In fact, we believe that an artisan would have found it obvious to use Yamamoto's digital means of recording and reproducing spoken words in Hashimoto and to provide an adequate amount of storage for such purposes. Obviousness may sometimes be based on the common knowledge of a person of ordinary skill in the art without a specific suggestion in a particular reference. In re Garrett, 949 F.2d 402, 22 USPQ2d 1077 (Fed. Cir. 1991).

Regarding Appellant's arguments about lack of a specific teaching and not making the combination due to lack of adequate size of storage, we find that a specific teaching is not essential to establish obviousness for this claimed invention. The test for obviousness is whether references would have suggested doing what Appellant has done. In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). Thus, the absence of express suggestion or motivation in the applied art is not alone determinative. The prior art need not suggest solving the same problem set forth by appellants. In re Dillon, 919 F.2d 688, 692-693, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990) (in banc) (overruling in part In re Wright, 848 F.2d 1216, 1220, 6 USPQ2d 1959, 1962 (Fed. Cir. 1988)), cert. denied, 500 U.S. 904 (1991). Thus, it is sufficient for obviousness that the artisan would

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have found it obvious to use digital storage means of adequate size in the form of a CD-ROM in making the suggested combination of Hashimoto and Yamamoto.

Appellant further advances the argument that secondary factors should be considered to decide the issue of obviousness as the suggested combination is not clearly obvious. Appellant offers for such secondary factors: (1) satisfaction of a long-felt need, (2) acclaim by the community, and (3) grant of an award under "Innovations in American Government" program [brief, pages 15 to 18].

The Examiner responds by discussing that there was no direct relationship shown between the criteria used in establishing the grant of a patent and the secondary evidence presented, and in fact the two employed different evaluating criteria [answer, pages 18 to 20].

First of all, we note that, as we found above, this is a situation where obviousness is supported by the applied prior art, thereby making the secondary evidence necessary for determining nonobviousness. We have considered the positions of the parties as to the presented secondary evidence. It is our view that there must be some connection between the industrial market, or community related success, and the patentability of

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the invention. Such demonstrated success in the community recognition and the government award program may be the result of numerous worthwhile criteria, yet very different from the criteria for granting a patent. The purpose of secondary considerations is to elucidate the connection between the invention and some secondary element(s) which alerts the reviewing party that the presumptively obvious invention claimed may not have been obvious. Without a demonstrable connection, this point is lost. Thus, we find that the offered secondary factors are not relevant to the question of obviousness in this case.

For the rationale above, we sustain the rejection of claim 1 under 35 U.S.C. § 103 as being unpatentable over Hashimoto and Yamamoto. Since claims 2 through 7 are in the same grouping, they fall with claim 1. Therefore, the rejection of claims 2 through 7 on the same ground is also sustained.

In conclusion, we affirm the Examiner's final rejection of claims 1 through 7 under 35 U.S.C. § 103 as being unpatentable over Hashimoto and Yamamoto.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

ERROL A. KRASS)	
Administrative Patent Judge)	
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JERRY SMITH)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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)	
PARSHOTAM S. LALL)	
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