U.S. PATENT AND TRADEMARK OFFICE
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BEFORE THE PATENT TRIAL AND APPEAL BOARD
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GOOGLE LLC
Petitioner

v.

SPRING VENTURES LTD.
Patent Owner

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Appeal IPR 2017-01653
Patent 8,661,094 B2

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Record of Oral Hearing
Held: October 18, 2018

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Before MICHAEL R. ZECHER, MINN CHUNG, and SCOTT E. BAIN,
Administrative Patent Judges.

APPEARANCES:

ON BEHALF OF THE PETITIONER:

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ON BEHALF OF THE PATENT OWNER:

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    The above-entitled matter came on for hearing on Friday, October 18, 2018, commencing at 1:00 p.m., at the U.S. Patent and Trademark Office, 600 Dulany Street, Alexandria, Virginia.

1   P R O C E E D I N G S

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3   JUDGE BAIN: Please be seated. This is case IPR 2017-01653.

4 Judge Chung is remote. Judge Zecher is on my right. I am Judge Bain.

5 Counsel, would you like to introduce yourselves?

6   MR. MCKEOWN: Scott McKeown, Ropes and Gray, Your Honor,

7 on behalf of Google. I am joined today by Kenya Chow also of Ropes and

8 Gray and also at the counsel table is Asim Bhansali of Kwun, Bhansali and

9 Lazarus. And client representative of Google, Jimi Sherwood is also here as

10 well.

11   JUDGE BAIN: Okay. Mr. McKeown, I hate to ask you to do it again

12 but Mr. Chung can't hear you or Judge Chung can't hear you unless you turn

13 on the mic.

14   MR. MCKEOWN: Okay.

15   JUDGE BAIN: So. Same with Patent Owner.

16   MR. MCKEOWN: No problem. On behalf of petitioner, Google,

17 Scott McKeown of Ropes and Gray. I'm joined today by Kenya Chow also

18 of Ropes and Gray and at the counsel table Asim Bhansali of Kwan,

19 Bhansali and Lazareth and I'm joined today by the Google representative,

20 Jim Sherwood.

21   JUDGE BAIN: Thank you.

22   MR. OSTROW: Good afternoon, Your Honors. This is Seth Ostrow

23 with the firm of Meister, Seelig and Fein representing the Patent Owner,

24 Spring Ventures. I'm joined today by my colleague, back up counsel

25 Antonio Papageorgiou who will also be doing some of the arguing on behalf

26 of Spring Ventures and also with us today is Sarah Pfeiffer, an attorney with

1   our firm as well.

2   JUDGE BAIN: Thank you. So each party has an hour of time in the

3   hearing. Petitioner, if you would like to proceed please do so and let us

4   know if you would like to reserve any time for rebuttal.

5   MR. MCKEOWN: Good afternoon. I have two copies of the

6   demonstratives if anyone would like them and I may approach?

7   JUDGE BAIN: Yes, please. Thank you.

8   MR. MCKEOWN: I will reserve 15 minutes for rebuttal, Your

9   Honor.

10   JUDGE BAIN: You may proceed.

11   MR. MCKEOWN: Okay. Good afternoon. Again, Scott McKeown

12   of Ropes and Gray on behalf of Google. I would like to start today just by

13   talking a little bit about the '094 patent itself. As the Board pointed out in its

14   decision, page 4 of the decision institute, what this patent is about is

15   providing a translation service for the Internet. So the idea here was that in

16   the early days of the Internet and even today, the vast majority of the URL's

17   are in English and navigating to those URL's is problematic for those that

18   don't speak English or for those that are using keyboards that are in a non-

19   Latin character set. So the '094 patent set out to providing translation

20   service to solve that problem and then once that translation was done, to

21   provide the top hit to the browser without additional user intervention.

22   During the prosecution, it was made clear that that idea was not new.

23   So the Breese reference showed that same top hit translation. The Osaku

24   reference showed that same top hit translation in the context of using the

25   browser address field.

26   So what happened during the prosecution is some amendments were

1   introduced. And the amendments that were introduced were operably

2   linking the translator entity to the translator input window and also enabling

3   the translator input window to the overlay on the browser. So that was the

4   amendment submitted during prosecution. And next we saw a notice of

5   allowance where the Examiner said well, the overlaying window, that's

6   known and here is an additional reference Busey that shows exactly that.

7   But what the Examiner couldn't locate in the art was this concept of

8   operably linking the translator window to a translator entity. So

9   consequently that was the reason that the patent issued.

10   And so now we are here in this IPR record and we know that top hit

11   translation services were known. We also know that providing overlays

12   were not. So it's not surprising that in the IPR record, we also are showing

13   that a top hit translation service is known, that's Belfiore. And what's

14   missing is -- so Belfiore is describing there is a browser, you can go to that

15   address field, you can type in a non URL and you get the top hit that

16   corresponds to that URL as determined by a translation entity.

17   So what is missing from the claims then is this concept of the window

18   not being the URL address entry field. So what we have cited for that is the

19   EchoSearch prior art. So EchoSearch was a standalone application that was

20   designed for use with a browser that provides advance search features. For

21   example a number of drop down menus, you could do Boolean searches, you

22   could do multiples reach engine searches. You could select among the

23   search engines and this was a product that was designed for use with a

24   browser. And one of those drop down menus was selecting the number of

25   hits results that you wanted. So what we are left with here and what has

26   been argued in the briefing is that well, you know, we have demonstrated

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