

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WEIDONG MAO and WAYNE E. HYATT

Appeal No. 2006-0362
Application No. 09/455,201

ON BRIEF

Before JERRY SMITH, LEVY, and NAPPI, Administrative Patent Judges.
LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-26, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to a system for combining video signals in MPEG digital format with Internet World-Wide Web pages in HTML format (specification, page 1).

Claim 1 is representative of the invention, and is reproduced as follows:

1. In a broadcast communication network including a broadcasting station for transmitting on a broadcast medium, and a set-top decoder coupled to said broadcast medium, said broadcasting station including an Internet access server for retrieving World Wide Web pages, wherein at least a given World Wide Web page contains a given URL corresponding to streaming video in a first data format, said broadcast communications network further including a multi-channel digital television signal, each program channel of said multi-channel digital television signal being identified by a respective program ID, a method for displaying said given World Wide Web page containing said streaming video at said set-top decoder, said method comprising:

receiving digital data in a standard Internet Protocol over the Internet, said digital data being derived from said given World Wide Web page associated with said streaming video;

dividing said digital data in said standard Internet Protocol into a plurality of digital data packets while preserving said standard Internet Protocol;

mapping said plurality of digital data packets to the MPEG data packets of an MPEG data stream;

storing said streaming video in said first data format corresponding to said given URL at said broadcasting station;

transcoding said streaming video from said first data format into an MPEG digital video format at said broadcasting station to form MPEG streaming video;

transmitting said MPEG data packets in said MPEG data stream over said broadcast communication network;

transmitting said MPEG streaming video in said MPEG digital video format in a given program ID of said multi-channel digital television signal over said broadcast communication network; and at said set-top decoder,

receiving said multi-channel digital television signal;

receiving said MPEG data stream containing said MPEG data packets and said plurality of digital data packets at said set-top decoder to recover said digital data in standard Internet Protocol; and

displaying said digital data in standard Internet Protocol at said set-top decoder, said digital data corresponding to said given World Wide Web page containing said given URL;

selecting said given URL;

selecting, responsive to selection of said given URL, said given program ID corresponding to said MPEG streaming video; and

displaying said MPEG streaming video corresponding to said given program ID,

whereby said digital data corresponding to said given World Wide Web page is broadcast in said standard Internet Protocol format, and said streaming video portion corresponding to said given World Wide Web page is broadcast in said MPEG digital video format.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Dureau et al. (Dureau)	6,118,472	Sep. 12, 2000 (filed Jun. 6, 1996)
Namma et al. (Namma)	6,182,116	Jan. 30, 2001 (filed Sep. 14, 1998)
Wang et al. (Wang)	6,266,369	Jul. 24, 2001 (filed Jun. 9, 1998)

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Gratacap et al. (Gratacap) 6,292,490 Sep. 18, 2001
(filed Jan. 14, 1998)
Hodge 2002/0007494 A1 Jan. 17, 2002
(eff. filed Sep. 28, 1998)

Claims 1, 2, 6, 7, 10, 11, 14, 15, 19, 20, 23 and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hodge in view of Dureau.

Claims 3, 4, 8, 12, 16, 17, 21 and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hodge in view of Dureau and Gratacap.

Claims 5, 9, 13, 18, 22 and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hodge in view of Dureau and Wang.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (mailed August 9, 2005) for the examiner's complete reasoning in support of the rejections, and to the revised brief "brief" (filed April 29, 2005) for the appellants' arguments thereagainst.

Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered. See 37 CFR § 41.37(c)(1)(vii) (eff. Sept. 13, 2004).

OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejections advanced by the examiner, and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellants' arguments set forth in the brief along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

Upon consideration of the record before us, we make the determinations which follow. We begin with the rejection of claims 1, 2, 6, 7, 10, 11, 14, 15, 19, 20, 23 and 24 under 35 U.S.C. § 103(a) as being unpatentable over Hodge in view of Dureau, which includes all of the independent claims before us for decision on appeal.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed

invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden 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. See id.; 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).

The examiner's position (answer, page 4) is that Hodge does not teach that the Web page has a URL corresponding to a video in a first format. The examiner takes Official Notice that a web page with a URL corresponding to video is well known in the art,

and cites the reference to Namma (answer, page 17) to support the taking of Official Notice¹. The examiner additionally asserts (id.) that although Hodge teaches receiving Internet data from a web page, and that a web site can stream video, that Hodge is silent on the data being associated with said streaming video. The examiner additionally asserts (answer, pages 4 and 5) that Hodge teaches storing video data in a first format (Internet protocol) and encoding (transcoding) the data, into an MPEG data format to form an MPEG streaming video, but that Hodge is silent on using the MPEG digital video format. To overcome these deficiencies of Hodge, the examiner turns to Dureau for a teaching of using an MPEG encoder for Internet video thereby creating an MPEG digital video format.

Appellants' position (brief, page 10) is that neither Hodge nor Dureau mention Internet streaming video and that the combination would not result in the special treatment of Internet streaming video as claimed. It is asserted (id.) that "[n]one of

¹ It is unclear as to why the examiner has not listed the Namma reference in the statement of the rejection.

the references identify the special problems of Internet streaming video or indicate that Internet streaming video should be treated differently from Web page data. Therefore even if the cited references were combined, the resulting system would not treat Internet streaming video and Web page data differently as in the method and apparatus of claims 1, 6, 10, 14, 19 and 23."

Appellants add (id.) that "[s]pecifically, the combination of the references would not result in the headend method and apparatus of claims, 1, 6, 14 and 19 where a 'World Wide Web page contains a given URL corresponding to streaming video' and both the Web page and the streaming video are treated differently."

From our review of the record, we find, for the reasons which follow, that the combined teachings of Hodge and Dureau fail to establish a prima facie case of obviousness of claims 1, 2, 6, 7, 10, 11, 14, 15, 19, 20, 23 and 24.

As shown by Hodge in figure 4, data 107 in Ethernet data frame 101 is mapped into payload 130 of MPEG bit stream frame 121 (page 2, paragraph 22 and page 4, paragraph 32). It is disclosed (page 4, para 31) that the payload section 130 is copied from the data section 107 of the Ethernet frame. As shown in figure 5

(page 4, para. 33) band 163 has eight digital channels. Hodge further discloses (id.) that among the digital channels, two could be Internet protocol channels 167 and 168 which would be fed to encoders to produce MPEG bit streams which would fit within the frequency allocation of the digital channel. It is additionally disclosed (page 4, para. 36) that the Internet Protocol of the Ethernet packets are converted to MPEG2 compliant encapsulation packets, and that the invention converts the return Ethernet data to MPEG bit-streams which can be interlaced with video program material and separated by a decoder in the set-top box. Each set-top box has a decoder which separates audio from video and can separate Internet data for display or presentation in an appropriate format.

From the disclosure of Hodge, we are in agreement with the examiner (answer, page 4) that "Hodge teaches dividing the Internet protocol packets into MPEG-2 signals wherein the process utilizes the 23 least significant bits, which equates to preserving the standard Internet protocol." We further agree with the examiner (answer, page 5) that Hodge is silent on using the MPEG digital format. Additionally, as noted by the examiner (answer, page 11), Hodge discloses Internet Protocol (IP) over MPEG.

Turning to Dureau, we find (col. 5, lines 2-8) that

"The headend 110 transfers the Internet data 114 to port 74 where the high speed line 76 transfers the Internet data 114 to the encoder and multiplexer 25 for encoding. The Internet data 114 includes spatial and temporal correlation encoded data such as rendered MPEG encoded audio and video data. The MPEG encoder 130 and renderer 140 provides the rendered MPEG graphical data."

Dureau discloses (col. 5, lines 13-16) that "[g]iven that the MPEG encoder 130 and render[er] 140 process the Internet data 114, the decoder 45 does not require high processing power to render the graphical data from the Internet data 114." From this disclosure of Dureau, we find that the incoming Internet 114 is encoded and rendered into MPEG data by encoder 130 and renderer 140. We further find that as a result of the MPEG encoder 130 and renderer processing of the Internet data, the decoder 45 does not require high processing power to render the graphical data from the Internet data 114. It is further disclosed (col. 5, lines 41-52) that headend 110 receives Internet data 114 and that parser 114 parses the internet data into wide-band data such as graphical data (audio and video) and narrow band data (textual data). The headend determines routing of the parsed Internet

data between the wide-band links and the narrow-band links based on size of data, type of data, etc. For example, small-sized data may be transferred using the slower low bit rate link. On the other hand, real time data such as video data is transferred using the faster wide-band network.

As shown in figure 3, gateway 70 receives wide-band Internet data 116 and transfers the wide-band Internet data 116 to the encoder and multiplexer 25 for encoding. After encoding the wide-band Internet data 116, the satellite broadcasts the encoded Internet data to the wide-band network. In response to narrow-band data 118, the gateway 70:

transfers the narrow-band Internet data 118 to port 68 where the communication channel 59 transfers the narrow-band Internet data 118 to the decoder 45. The decoder 45 receives the encoded wide-band Internet data 116 from the wide-band network and the narrow-band Internet data on communication channel 59. 25 After decoding the encoded wide-band Internet data 116, the decoder 45 includes circuitry which recombines the wide-band Internet data 116 with the narrow-band Internet data 118 to provide display data for display by TV 50.
(col. 5, line 60 to col. 6, line 2).

We find from this disclosure of Dureau that in the alternate embodiment of figure 3, the video data is transferred using the faster wide-band network through satellite 35, whereas the narrow-band data such as text data is transferred over the communication channel 59, which is a low bit-rate link. We note that in the alternative embodiment of figure 3, Dureau states that the wide-band Internet data is encoded by encoder and multiplexer 25, whereas the narrow-band data is transferred over communication channel 59. Dureau does not state that the narrow-band Internet data is sent to encoder 25 before transmission to the decoder. Thus, at first blush, it would appear that Dureau encodes the wide-band video data but does not encode and multiplex the narrow-band data. However, careful review of Dureau reveals that there are in fact two decoders, namely decoder 130, which works with renderer 140 to convert the received Internet data to MPEG, and decoder 25 which decodes and multiplexes the Internet data, converted to MPEG by decoder 130 and renderer 140, for transmission over the wide-band network. We therefore find that since all of the Internet data is encoded into MPEG by decoder 130 and renderer 140, that Dureau encodes all of the Internet data, and does not encode the wide-band data to MPEG, while leaving the narrow-band data such as text in the

Internet format. As Dureau encodes all of the Internet data to MPEG and Hodge maps all of the Internet data to the MPEG bit stream, we find that the teachings of Hodge and Dureau, even if combined, would not have suggested to an artisan to convert the video data to MPEG while leaving the text data in the Internet format, absent appellants' disclosure. In other words, nothing in the prior art would have suggested taking from Dureau the encoding of video or wide-band data into MPEG and combining it with the IP over MPEG of Hodge for the text data, other than by using appellants' specification as a template for arriving at the claimed invention. "Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor." Para-Ordnance Mfg. v. SGS Importers Int'l, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995) (citing W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1551, 1553, 220 USPQ 303, 311, 312-13 (Fed. Cir. 1983)). "It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992) (citing In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991)).

We are not persuaded by the examiner's assertion (answer, pages 13 and 14) that Dureau teaches treating the wide-band (video) and the narrow-band Internet data (text) differently. The examiner is correct in that in the embodiment of figure 3, the wide-band and narrow-band data are routed differently. However, both the wide-band and narrow-band data are encoded and rendered into MPEG by encoder 130 and renderer 140, before separate routing to the decoder 45. Thus, although Dureau teaches routing the Internet data differently, Dureau does not teach or suggest encoding the different types Internet data differently. From all of the above, we find that the examiner is picking and choosing parts of the prior art in an attempt to arrive at the claimed invention, in the absence of any teaching or suggestion that would have led an artisan to the claimed invention. Accordingly, we find that the examiner has failed to establish a prima facie case of obviousness of the claimed invention. The examiner fails to establish a prima facie case of obviousness. The rejection of claims 1, 2, 6, 7, 10, 11, 14, 15, 19, 20, 23 and 24 under 35 U.S.C. § 103(a) as obvious over Hodge in view of Dureau is reversed.

We turn next to the rejection of claims 3, 4, 8, 12, 16, 17, 21 and 25 under 35 U.S.C. § 103(a) as being unpatentable

over Hodge in view of Dureau and Gratacap. We reverse the rejection of claims 3, 4, 8, 12, 16, 17, 21 and 25 as Gratacap fails to make up for the deficiencies of the basic combination of Hodge and Dureau.

We turn next to the rejection of claims 5, 9, 13, 18, 22 and 26 under 35 U.S.C. § 103(a) as being unpatentable over Hodge in view of Dureau and Wang. We reverse the rejection of claims 5, 9, 13, 18, 22 and 26 as Wang fails to make up for the deficiencies of the basic combination of Hodge and Dureau.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-26 under 35 U.S.C. § 103 is reversed.

REVERSED

JERRY SMITH)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
STUART S. LEVY)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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