

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 EDWARD O. CLAPPER

Appeal No. 2006-1598
Application No. 09/409,128

ON BRIEF

Before RUGGIERO, BARRY, and BLANKENSHIP, *Administrative Patent Judges*.
BARRY, *Administrative Patent Judge*.

A patent examiner rejected claims 1-8, 10-17, and 19-25. Under 35 U.S.C. § 134(a), the appellant appeals only the rejection of claims 10 and 19¹. (Reply Br. at 1.) We reverse.

I. BACKGROUND

The invention at issue on appeal concerns linking displayed video data to additional data. A user can select hyperlinks in pages of the World Wide Web ("Web"), to access other documents or Web sites. (Spec. at 1.) Because hyperlinks are hard coded into Web pages, however, changing the hyperlinks is difficult. If a given hyperlink

¹The appeal as to claims 1-8, 11-17, and 20-25 thus stands dismissed.

points to a given source such as a web page, it generally will always point to that source unless the hypertext markup language ("HTML") code is rewritten. (*Id.* at 2.)

In contrast, the appellant's invention enables dynamic linking between a variety of video formats including television broadcasts, web pages, and video displays. Each frame of video data is identified together with a plurality of locations within that frame. Locations selected by a user are used to access associated data. (*Id.* at 24.)

A further understanding of the invention can be achieved by reading the following claims.

1. A method comprising:

selecting other information by accessing a particular location on a frame of video being played back;

automatically pausing the video playback when the other information is accessed by selecting a location on the frame; and

providing the other information while said video playback is paused.

10. The method of claim 1 including automatically resuming the playback of said video when the other information is no longer being accessed.

Claims 10 and 19 stand rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 5,918,012 ("Astiz").

II. OPINION

"Rather than reiterate the positions of the examiner or the appellant *in toto*, we focus on the point of contention therebetween." *Ex parte Kaysen*, No. 2003-0553, 2004 WL 1697755, at *2 (Bd.Pat.App & Int. 2004). The examiner makes the following assertion.

Astiz inherently suggests the steps of "automatically resuming the playback of said video when the other information is no longer being accessed", i.e., the user can set up options such as pause or continue after a click and different looping for the video program to continue (col. 12/lines 39-65) which suggests that when the other information, for instance, the hyperlink information or hot spots, is no longer being accessed, the playback of the video would resume and continue depending on the user's pre-setting at the options.

(Examiner's Answer at 6-7.) The appellant argues, "There is no selector though to select automatic resumption. Thus, presumably, the way that the system would operate would be to require the user to press a button, such as a play button, to initiate playback." (Reply Br. at 1.)

In addressing the point of contention, the Board conducts a two-step analysis. First, we construe the claims at issue to determine their scope. Second, we determine whether the construed claims are anticipated.

A. CLAIM CONSTRUCTION

"Analysis begins with a key legal question — *what is the invention claimed?*" *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987). Here, claim 10 recites in pertinent part the following limitations: "automatically resuming the playback of said video when the other information is no longer being accessed." Claim 19 recites similar limitations. In other words, the claims require automatically resuming the playback of a video when related data are no longer being accessed.

B. ANTICIPATION DETERMINATION

"Having construed the claim limitations at issue, we now compare the claims to the prior art to determine if the prior art anticipates those claims." *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349, 64 USPQ2d 1202, 1206 (Fed. Cir. 2002). "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.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (citing

Structural Rubber Prods. Co. v. Park Rubber Co., 749 F.2d 707, 715, 223 USPQ 1264, 1270 (Fed. Cir. 1984); *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983); *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 771, 218 USPQ 781, 789 (Fed. Cir. 1983)). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (quoting *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991)) "Inherency . . . may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) (citing *Hansgirk v. Kemmer*, 102 F.2d 212, 214, 40 USPQ 665, 667 (1939)).

Here, it is uncontested that Astiz does not expressly describe automatically resuming the playback of video when related data are no longer being accessed. The examiner references two options taught by the reference. The first option "specifies whether the video will pause or continue after a click," (col. 12, ll. 48-49), to access related data but is silent as to whether to resume playback of video when related data are no longer being accessed. The second option "tell[s] the viewer whether and how to

loop the video at the end of a video playing," (*id.* at ll. 59-60), but not whether to resume playback of video when related data are no longer being accessed.

Turning to the question of inherency, the examiner proffers no extrinsic evidence that the reference necessarily resumes playback of video when related data are no longer being accessed. Although Astiz's viewer may possibly do so, it may instead require the user to press a button, such as a play button, to resume playback. The absence of automatically resuming the playback of a video when related data are no longer being accessed negates anticipation. Therefore, we reverse the rejection of claims 10 and 19, which depend therefrom.

* * * * *

Nothing in our opinion should be construed to indicate that it would not have been obvious to automatically resume the playback of a video when related data are no longer being accessed. "The board in an *ex parte* appeal is basically a board of review — we review final rejections made by patent examiners." *Ex parte Gambogi*, 62 USPQ2d 1209, 1211 (Bd.Pat.App. & Int. 2001). Because there is no rejection for obviousness before us, we leave the matter to the examiner and the appellant.

III. CONCLUSION

In summary, the rejection of claims 10 and 19 under § 102(e) is reversed.

REVERSED

JOSEPH F. RUGGIERO
Administrative Patent Judge

LANCE LEONARD BARRY
Administrative Patent Judge

HOWARD B. BLANKENSHIP
Administrative Patent Judge

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