

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte BEHRAM MARIO DACOSTA

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Appeal No. 2006-2208  
Application No. 10/782,265

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ON BRIEF

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Before THOMAS, SAADAT, and MACDONALD, Administrative Patent Judges.

SAADAT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-17, which constitute all of the claims pending in this application.

We reverse and enter a new rejection pursuant to 37 CFR § 41.50(b).

BACKGROUND

Appellant's invention is directed to a method for obtaining information based on a TV program using the closed captioning

text. According to Appellant, a set of primary words appear differently than the remaining text within the close captioning text which permits the viewer to select at least one word to invoke the display of a list of content related to the selected word (specification, page 2). An understanding of the invention can be derived from a reading of exemplary independent claims 1 and 10 which are reproduced as follows:

1. A method for obtaining information based on a TV program, comprising:

receiving from a head end transmitter, along with the program, closed captioning text;

primary words within the closed captioning text as received from the head end transmitter appearing differently within the closed captioning text than remaining secondary words when the closed captioning text is presented on a display of a TV prior to any user selection of words in the closed captioning text;

permitting a user of a remote control device communicating with the TV to select at least one word to establish a selected word; and

if the selected word is a primary word, displaying a list of content related to the selected word.

10. A system for obtaining information using a TV closed caption display, comprising:

a TV receiving content from a source, the content including closed caption text;

a remote control device configured for wireless communication with the TV; and

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a data structure accessible to a computer associated with at least one of: the source, and the TV, the computer retrieving from the data structure a list of content related to at least one word appearing in the closed caption text and selected by a user manipulating the remote control device, the word appearing within the closed caption text and being selected from the closed caption text by means of the remote control device, the word being made to flash within the closed caption text.

The Examiner relies on the following references in rejecting the claims:

	<u>U.S. Patents</u>	
Wasilewski et al. (Wasilewski)	5,359,601	Oct. 25, 1994
Chang	5,543,851	Aug. 6, 1996
Isoe et al. (Isoe)	5,671,019	Sep. 23, 1997
Brodsky	5,809,471	Sep. 15, 1998
Patterson	5,923,379	Jul. 13, 1999
O'Brien et al. (O'Brien)	6,055,569	Apr. 25, 2000
Allport	6,097,441	Aug. 1, 2000
Sampsell	6,496,122	Dec. 17, 2002

	<u>Other Publications</u>	
Thomsen	US 2002/0067428 A1	Jun. 6, 2002

"Expanding the capabilities of Closed Caption," IBM Technical Disclosure Bulletin (IBM-TDB), Issue No. 452, December 1, 2001, p. 2129.

"Encyclopedia Britannica/Premium Service,"  
[online][retrieved from the Internet Archive (WayBack Machine)]  
using Internet  
<URL:<http://web.archive.org/web/20030201101838/http://www.britannica.com/premium/>>, April 6, 2005.

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Claims 1, 2, 5, 6 and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Wasilewski, Isoe and Brodsky.

Claim 3 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Wasilewski, Isoe and Brodsky in combination with Sampsell.

Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Wasilewski, Isoe and Brodsky in combination with Chang.

Claims 7 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wasilewski, Isoe and Brodsky in combination with Encyclopedia Britannica Online article.

Claims 10 and 14-16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Thomsen and IBM-TDB.

Claim 11 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Thomsen, IBM-TDB and Patterson.

Claim 12 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Thomsen, IBM-TDB and Allport.

Claim 13 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Thomsen, IBM-TDB and Encyclopedia Britannica Online article.

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Claim 17 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Thomsen, IBM-TDB and O'Brien.

We make reference to the briefs and the answer for the respective positions of Appellant and the Examiner.

#### OPINION

The main point of contention is based on whether the words within the closed captioning text of Brodsky appear differently from any other words therein. Appellant asserts that while Brodsky adds words to a dynamically evolving dictionary, the added words appear the same as other words and are selected automatically without being selected by the user from the closed captioning text itself (brief, page 6). Appellant further argues that if every word appears differently from the others in a closed captioning text because they are spelled differently, as argued by the Examiner, every word will become a "primary word" (brief, page 7; reply brief, page 2).

The Examiner responds by stating that the words added to the dictionary are derived from the closed captioning text and the user can request additional content pertaining to the topic recently seen or heard (answer, page 16). The Examiner further argues that Appellant's specification does not clearly define how a "primary word" is different from a "secondary word" and merely

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indicates that the different appearance is achieved by virtue of having their associated content (answer, pages 18-21).

As a general proposition, in rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993) and In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). A prima facie case of obviousness is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art. See In re Bell, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993); 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). In considering the question of the obviousness of the claimed invention in view of the prior art relied upon, the Examiner is expected to make the factual determination 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

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art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. See also In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). Such evidence is required in order to establish a prima facie case. In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984).

Contrary to the Examiner's assertion, the limitation of claim 1 related to the primary words appearing differently within the closed captioning text than the remaining secondary words does require that the primary words be displayed in a way that makes them look different from the other words within the closed captioning text. Additionally, the specification provides exemplary means for making some words appear differently such as italicizing, changing font, color and/or size and even animated effects (specification, page 5, second full paragraph). Therefore, the claims require that the primary words have some kind of attribute that makes their appearance different from that of the non-primary words. In that regard, we find the Examiner's broad interpretation that every word appears differently from the other words by the virtue of being merely different words to be unreasonable. We also agree with Appellant (reply brief, page 2) that the words are required to appear differently within the

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closed captioning text, not in a separate list of words or dictionary.

An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. "In reviewing the Examiner's decision on appeal, the Board must necessarily weigh all of the evidence and argument." In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). In this case, as discussed by Appellant (brief, pages 5-8), Brodsky merely adds the word from the closed captioning text to a dictionary (col. 3, lines 60-64) where they remain for the user to select and obtain additional information (col. 5, lines 11-20). Therefore, Brodsky creates a separate list of the words that can be selected outside the closed captioning text. In fact, in terms of primary and secondary words, since Brodsky places every searchable word in the dictionary, there remains no need for modifying the appearance of any remaining part of the closed captioning text.

In view of our analysis above, we find that the Examiner has failed to set forth a prima facie case of obviousness because the necessary teachings and suggestions related to the claimed primary words appearing differently within the text of the closed captioning text, as recited in independent claim 1 is not shown.

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Accordingly, based on the weight of the evidence and the arguments presented by the Examiner and Appellant, we are constrained to reverse the Examiner's decision and not sustain the 35 U.S.C. § 103 rejection of claims 1, 2, 5, 6 and 8 over the combination of Wasilewski, Isoe and Brodsky.

Turning now to the 35 U.S.C. § 103 rejection of claim 10, we note the Examiner's interpretation of the claim as merely requiring that at least one word from the closed captioning text be made to flash within the closed captioning text and that word be selectable (answer, page 25). Apparently, the Examiner takes the position that the particular flashing of the word has nothing to do with the existence of supplemental content since the claim requires that some words flash and be selected (id.).

Appellant argues that the flashing of the word as disclosed by IBM-TDB is based on emotion and has nothing to do with a selected word or retrieving a list of content related to the selected word (brief, page 11). Appellant further asserts that claim 10 does require that the content received from a source include closed caption text from which a word is selected by a user using a remote control and being made to flash (reply brief, page 3).

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Upon a review of IBM-TDB and considering the arguments presented, we find ourselves convinced by Appellant that the claim indeed requires the word selected from the closed caption text, for which a list of related content is retrieved, be made to flash. Contrary to the Examiner's position, the flashing of the words in the closed caption text of IBM-TDB is merely based on the type of emotion associated with how that word is spoken and not on whether the word is selected by a user for receiving information thereabout. As the Examiner has failed to set forth a prima facie case of obviousness, the 35 U.S.C. § 103 rejection of claims 10 and 14-16 over Thomsen and IBM-TDB cannot be sustained.

With respect to the rejection of the remaining claims, we note that the Examiner further relies on other prior art references for the additional features recited in the dependent claims. However, the Examiner has not pointed to any convincing rationale in modifying the combination of Wasilewski, Isoe and Brodsky or the combination of Thomsen and IBM-TDB with the teachings of these references that would have overcome the deficiencies of the applied prior art as discussed above with respect to claims 1 and 10. Accordingly, we do not sustain the 35 U.S.C. § 103 rejection of claims 3, 4, 7 and 9 over

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Wasilewski, Isoe and Brodsky in combination with Sampsell, Chang and Encyclopedia Britannica Online article nor of claims 10-17 over Thomsen and IBM-TDB in combination with Patterson, Allport, Encyclopedia Britannica Online article and O'Brien.

#### CONCLUSION

In view of the foregoing, the decision of the Examiner rejecting claims 1-17 under 35 U.S.C. § 103 is reversed.

We make the following new ground of rejection for claim 1 under 35 U.S.C. § 102 as being anticipated by Yen<sup>1</sup> pursuant to 37 CFR § 41.50(b). We only consider this claim, but encourage the Examiner to further consider the remaining claims for other possible rejections over Yen alone or in combination with other prior art references.

Claim 1 is rejected under 35 U.S.C. § 102(b) **as being anticipated by Yen.**

**Yen relates to a method and system for receiving information from multiple sources and interactively presenting the information to a recipient (abstract; col. 3, lines**

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<sup>1</sup> Yen et al. (Yen), U.S. Patent No. 5,991,799, issued Nov. 23, 1999, a copy of which accompanies this decision.

6-9). As depicted in Figure 1, the system of Yen describes receiving from a transmitter closed captioning text in an output device such as television monitor 131 (col. 4, lines 14-22) which receives signals from a variety of information sources through a passive tuner 111 (col. 4, lines 34-36). The output device is further described as a television monitor and a speaker with such a high resolution screen so as to promote viewing of at least one primary image and a plurality of secondary images (col. 6, lines 12-15). In addition to traditional broadcast sources, displayed images of Yen may come from other passive sources such as closed-captioning and other type of subcarrier embedded into the broadcast signal (col. 8, lines 25-34). Additionally, Yen provides for crosslinking each information item from both passive and active information sources so that other information items may be referenced by multiplexer 120, whether the items are from the same source or different ones (col. 8, lines 57-61). Among the secondary information sources, the information items that may be crossed linked are websites displayed in the broadcast show using a hypertext link displayed in closed caption text or other annotation information (col. 11, lines 4-16).

As described above, Yen teaches the claimed primary words within the close captioning text as the hypertext link which appear differently from the secondary words made of the remaining regular text within the close captioning text. The claimed step of permitting the user of a remote control to select at least a word is also described by Yen as the recipient of information selects the particular information using input device 132

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(col. 6, lines 31-43). Yen further describes displaying a list of content related to a selected word when a primary word is selected by allowing the user to select a particular crosslinked information element such as an Internet service (col. 6, lines 44-52) when the cross linked information is represented as hypertext links displayed in the closed caption text (col. 11, lines 4-16).

In view of the discussion above, we find that as all the elements recited in claim 1 are taught in the reference, Yen anticipates the claimed subject matter. Accordingly, claim 1 is unpatentable under 35 U.S.C. § 102.

In addition to reversing the Examiner's decision with respect to the 35 U.S.C. § 103, this decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b). 37 CFR § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered

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by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .37  
CFR § 1.196(b) provides that "[a] new ground of rejection shall not be considered final for purposes of judicial review."

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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)(1)(iv).

REVERSED  
37 CFR § 41.50(b)

JAMES D. THOMAS	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
MAHSHID D. SAADAT	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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	)	
	)	
ALLEN R. MACDONALD	)	
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