

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN L. MAKOWSKI, JR.
and STEPHEN C. INTLEKOFER

Appeal 2008-0732
Application 10/968,567
Technology Center 2600

Decided: April 22, 2008

Before JOSEPH F. RUGGIERO, JOHN A. JEFFERY, and KEVIN F.
TURNER, *Administrative Patent Judges*.

JEFFERY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134 from the Examiner's rejection of claims 1-27. We have jurisdiction under 35 U.S.C. § 6(b), and we heard the appeal on April 10, 2008. We affirm.

STATEMENT OF THE CASE

Appellants invented a system for incorporating thematic content from a particular program into a product or service advertisement to form a program-integrated advertisement. By integrating thematic content with the advertisement itself, viewers would be more likely to view the advertisement.¹ Claim 1 is illustrative:

1. A method of producing an advertisement with thematic content from a program, comprising:

incorporating thematic content comprising a plot advancing element of the program into a product or service advertisement to form a program-integrated product or service advertisement, wherein the program-integrated product or service advertisement is shown or viewed in between segments of the program, before or after the showing or viewing of the program, wherein the plot advancing element promotes a plan or pattern of events or a main story of the program.

The Examiner relies on the following prior art reference to show unpatentability:

Clanton	US 5,524,195	Jun. 4, 1996
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Claims 1-27 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Clanton.

Rather than repeat the arguments of Appellants or the Examiner, we refer to the Briefs and the Answer² for their respective details. In this decision, we have considered only those arguments actually made by

¹ See generally Spec. 1:14-4:20.

² We refer to (1) the most recent Appeal Brief filed Mar. 22, 2007; (2) the most recent Examiner's Answer mailed July 11, 2007; and (3) the Reply Brief filed February 15, 2007 throughout this opinion.

Appellants. Arguments which Appellants could have made but did not make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

OPINION

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. *RCA Corp. v. Applied Digital Data Systems, Inc.*, 730 F.2d 1440, 1444 (Fed. Cir. 1984); *W.L. Gore and Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554 (Fed. Cir. 1983).

The Examiner has indicated how the claimed invention is deemed to be fully met by the disclosure of Clanton (Ans. 3-7). Regarding representative claim 1,³ Appellants argue that Clanton does not describe a “program-integrated advertisement” as defined in the Specification. Appellants emphasize that a program-integrated advertisement must have a dual message: it must attempt to (1) sell the product or service, and (2) advance the plot of a program and/or promote the program (App. Br. 6; Reply Br. 5).

Based on this interpretation, Appellants argue that the movie poster relied upon by the Examiner is not a “program-integrated advertisement” since the poster’s message is solely an advertisement for a movie -- not

³ Appellants argue all independent claims together as a group. *See* App. Br. 6-7. Accordingly, we select claim 1 as representative. *See* 37 C.F.R. § 41.37(c)(1)(vii).

anything else. As such, Appellants contend, the movie poster in Clanton does not have a dual message and cannot therefore be a “program-integrated advertisement” as claimed (App. Br. 7; Reply Br. 8-9).

The Examiner notes that Clanton’s movie poster not only shows particular characters from a movie (“Love Daze”) to advance a main story of the movie, but also advertises the movie to the viewer in a manner to entice the viewer to rent or order the movie (Ans. 8-9).

The issue before us, then, is whether Clanton’s system of advertising movies from a video-on-demand service reasonably constitutes a “program-integrated advertisement” as the term is interpreted in light of the Specification. For the following reasons, we find that it does.

Clanton discloses a graphical user interface for a video-on-demand service. The graphical interface is displayed on a subscriber’s television and is based upon a “virtual world” through which a user may navigate, specifically a movie studio back lot as shown in Figure 4. A key aspect of this movie studio back lot metaphor is a poster wall 80 that displays posters 82, 84, 86, 88, and 90 of currently available movies. These posters may represent the most popular video rentals for the week, or perhaps the most recent movies available for viewing from the video-on-demand server (Clanton, col. 2, ll. 38-67; col. 8, ll. 19-56; Figs. 4, 5, and 7).

When the user touches a poster on the poster wall, an animation is created that moves the poster to the foreground as shown in Figure 8. With this view, the user can then obtain more information about the video before deciding whether to rent or otherwise order the video from the video-on-demand server 20 (Clanton, col. 9, ll. 36-43, 54-63; Fig. 8).

Based on this functionality, we agree with the Examiner that Clanton's video-on-demand advertisement fully meets a "program-integrated advertisement" as claimed. First, as the Examiner indicates, the enlarged movie poster 93 in Figure 8 depicts two characters (a man and a woman) from the movie "Love Daze" -- a fact readily acknowledged by Appellants.⁴ Furthermore, not only is the title displayed on the poster ("Love Daze") as shown in Figure 8, but these two characters are clearly embracing each other -- an intimate pose which certainly is relevant to the plot of the movie given its title ("Love Daze"). Whether this intimate pose depicts the couple dancing or otherwise embracing, the depiction of this pose nonetheless reasonably constitutes a "plot advancing element" since it at least "promotes a plan or pattern of events or a main story of the program" (i.e., a love story).

In our view, this movie poster fully meets a "program-integrated advertisement" when interpreted in light of the Specification.⁵ Appellants'

⁴ See App. Br., at 7 ("The content found in Poster information area 98 of poster 93 are objects or characters from the movie, *e.g.*, the title of the movie, the names of the actors starring in the movie, and two characters (a man and a woman holding hands)."); see also Reply Br., at 8 ("The content found in the poster 93 via Poster information area 98 is objects/characters from the movie ["Love Daze"].").

⁵ According to the Specification, a "program-integrated advertisement" comprises audio, video and/or printed work containing an element of the program along with audio, video and/or printed work which advertises a product or service." (Spec. 5:18-20). The Specification further notes that "[a] program-advancing element is anything that promotes a program, and/or supplements or uses some existing element of the program to impact any aspect of the program, *e.g.*, the story line. A program-advancing element is a plot-advancing element if it impacts the program and/or a program-promoting element if it promotes the program." Moreover, a "program-

arguments regarding the lack of a dual message in this “program-integrated advertisement” are unavailing. While Appellants are correct that this advertisement promotes the movie “Love Daze,” the services being offered for purchase by the subscriber go well beyond the movie itself. Rather, what is being sold are the *value-added aspects of the video-on-demand service* that promptly and conveniently delivers the movie to the viewer -- not just the movie itself.

That is, the advertisement is not just for the movie itself, but also for the *value-added services* offered by the video-on-demand service, such as, among other things, the convenience and relative promptness of having the movie downloaded directly to the subscriber’s set-top box. Such services would therefore provide a convenient and quick alternative to obtaining the movie from other video rental outlets (e.g., brick-and-mortar video rental services), retail stores, internet merchants, etc. Significantly, these alternative outlets and services would be readily available options for the subscriber even after viewing the enlarged movie poster in Clanton.

At this point, nothing would preclude a user from simply declining to use Clanton’s purchase procedure (Clanton, col. 3, ll. 19-28; col. 10, ll. 43-52) and merely obtain the same movie from an alternative source.

Therefore, the video-on-demand service in Clanton would have a significant interest in promoting the subscriber’s ordering the selected video from the

advancing element is specific to a program or is associated with a program element such that it is capable of being recognized by a viewer. This includes, but is not limited to, *character actions...etc.*” (Spec. 6:11-19; emphasis added). The depiction in the movie poster in Clanton, in our view, amply meets this description.

video-on-demand service in lieu of obtaining the video via these other options.

Therefore, there is, in fact, a dual message offered by Clanton's movie poster in Figure 8: to (1) sell the product or service (i.e., the video-on-demand service), and (2) advance the plot of a program and/or promote the program (i.e., the story of "Love Daze"). The movie poster thus reasonably constitutes a "program-integrated advertisement" when interpreted in light of the Specification.

For the foregoing reasons, we will sustain the Examiner's rejection of representative claim 1 as well as claims 2-27 which fall with claim 1.

DECISION

We have sustained the Examiner's rejection with respect to all claims on appeal. Therefore, the Examiner's decision rejecting claims 1-27 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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