

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT D. NICHOLSON and BARRIE A. SAUNDERS

Appeal 2008-2227
Application 09/753,127
Technology Center 2400

Decided: January 6, 2009

Before KENNETH W. HAIRSTON, JOSEPH F. RUGGIERO, and JOHN
A. JEFFERY, *Administrative Patent Judges*.

JEFFERY, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellants, pursuant to 37 C.F.R. § 41.52, have submitted a timely Request for Rehearing dated September 17, 2008 (hereafter the “Request”), requesting rehearing of our original decision in this appeal dated August 25, 2008. The Examiner rejected (1) claims 9-16 under 35 U.S.C. § 102(b) as being anticipated by Zigmond, and (2) claims 17 and 18 under 35 U.S.C.

§ 103(a) as being unpatentable over Zigmond and Swix. In that decision, we reversed the rejection of claims 9-16, and sustained the rejection of claims 17 and 18. We additionally entered a new grounds of rejection for independent claims 9 and 13 under 35 U.S.C. § 103 as unpatentable over Zigmond and Swix.

We have reconsidered our decision of August 25, 2008 in light of Appellants' comments in the Request, and we find no errors therein. We, therefore, decline to change our prior decision for the following reasons.

Appellants argue that neither Zigmond nor Swix alone or in combination discloses the claimed "download trigger signal" as recited in independent claims 9, 13, and 17 (Request 1-9). Regarding Zigmond, Appellants contend that any trigger signal based on viewer monitoring occurs after an advertisement has been downloaded to the set top box and, thus, is not a "download" trigger signal as recited (Request 1 and 2). This argument is not precisely commensurate with the scope of claims 9, 13, and 17. Claims 9, 13, and 17 recite sending a download trigger signal responsive to a download event from the set top box signaling the readiness of the set top box to receive advertisements (Decision 4). Thus, the combination of Zigmond and Swix must teach sending a download trigger signal responsive to one of the recited download events *signaling the readiness of the set top box to receive advertisements* and not that the download trigger signal happens before an advertisement is downloaded.

We agree with Appellants that Zigmond records viewer responses, including responses to already-downloaded advertisements. However, Appellants have overlooked other portions of Zigmond that teach using the viewer response information to modify future advertisements downloaded to

the set top box or to signal the readiness of the set top box to receive advertisements as claimed. As stated in our decision, Zigmond discloses the viewer responses are periodically sent from the set top box to a clearinghouse and made available to advertisers and the operator of an advertising source (Decision 10 and 11; Zigmond, 6:17-21, 13:25-27, 25:12-16, and 27:30-28:1). Zigmond's step of sending the viewer information to the clearinghouse must include some signal being sent to the advertisers and ad operators. Our decision also indicates the sending of the signal is triggered by a download event involving at least a change of time (Decision 11 and 12; Zigmond, 13:7, 8, and 25-27). In particular, we explained that sending the information at a periodic interval is a change of time download event as recited (Decision 11 and 12). Zigmond, therefore, discloses and teaches sending a trigger signal responsive to a download event as recited in claims 9, 13, and 17.

Similarly and contrary to Appellants' assertions (Request 5 and 6), Swix also teaches, during an interactive session, sending a signal at a *predetermined* interval or triggered by a change of time (Decision 12). As stated in our decision, Swix sends a signal to the head end when new targeted advertisements are to be inserted so that viewers are targeted effectively with appropriate ads (Decision 12; Swix, col. 5, ll. 39-42, col. 7, ll. 7-10, col. 8, ll. 29-38, and col. 10, ll. 52-58). Additionally, Zigmond also discloses the viewer responses sent to the advertisers and ad operators can be used to modify advertisement content that is sent or downloaded to the set top box in the future (Zigmond, 6:21-25) so that viewers are effectively targeted based on interests (Zigmond, 5:18-19). Also, as stated in our decision (Decision 12), one skilled in the art would have recognized based

on these teachings that including the step of sending a download trigger signal from the set top box to a head end in response to a change of time download event would predictably result in the Zigmond system effectively targeting viewers with appropriate ads. *See KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1740 (2007). Thus, the combination of Zigmond and Swix teaches sending the viewer information or a download trigger signal to the head end in order to indicate or signal to the head end the readiness of the set top box to receive new ads that more effectively and appropriately target viewers (Decision 12 and 13).

Appellants argue that the discussion in the decision regarding Zigmond and aggressive channel surfing (Decision 12 and 13) addresses the ad selection process and not a download event (Request 2 and 3). In this context, Zigmond discloses more than selecting the appropriate advertisements. Zigmond explains the viewer's responses periodically sent to the clearinghouse include channel changes during a displayed advertisement (Zigmond, 13:10 and 11), including when an aggressive channel surfer changes the channel (Zigmond, 18:31-19:3). Moreover, Swix also provides a reason to record information about channel changing in order to more efficiently target viewers and spend ad dollars (Decision 12; Swix, col. 3, ll. 29-47 and 56-59). As stated in our decision (Decision 12), one skilled in the art would have recognized these teachings would predictably result in ensuring the aggressive channel surfer viewer will eventually receive the commercial message as Zigmond desires (Zigmond, 18:27-19:6). Thus, the combination of Zigmond and Swix provide ample reason to include a download trigger signal responsive to a channel change in order to ensure the viewer sees a targeted ad.

Additionally, both Zigmond and Swix teach that the advertisements can be downloaded directly from the advertisement source and not necessarily from the set top box (Zigmond, 9:22-10:16 and 11:8-25; Swix, col. 11, ll. 34-38). Thus, in the situation where the future advertisements are downloaded from the advertisement source and a user is aggressively channel surfing, the combination of Zigmond and Swix must send a download trigger signal responsive to the channel change from the set top box to the head end signaling the readiness of the set top box to receive the skipped advertisement from the advertisement source on the new channel.

Moreover, contrary to Appellants' argument (Request 3), the advertisement downloading step in Zigmond is separate and distinct from selecting the advertisements to view. For example, Zigmond discloses the advertisements are downloaded on a periodic basis *in preparation for selection and display of the advertisements* (Zigmond, 14:19-22; emphasis added). As another example, Zigmond discloses in Figure 6 that the downloading of advertisements occurs at steps 100 through 106, and the selection of the advertisement occurs later at steps 110 through 116 (Zigmond, 24:21-25:5; Fig. 6). These examples in Zigmond clearly distinguish the downloading signaling step from the selection signaling step.

Finally, Appellants argue that Swix does not teach "a download trigger signal" (Request 3-6). As explained above, Zigmond alone or in combination with Swix teaches this limitation. Swix was primarily relied upon to teach that it is known to send the trigger signal from the set top box to a cable television operator head end in order to target viewers more efficiently and profitably (Decision 11). Nonetheless, one cannot show nonobviousness by attacking references individually. *In re Merck & Co.*,

Inc., 800 F.2d 1091, 1097 (Fed. Cir. 1986). In addition, based on the above explanation, we also need not further discuss Appellants' contention that the combination of Zigmond and Swix does not teach "a download trigger signal" (Request 6-9).

We have carefully considered the arguments raised by Appellants in the Request, but none of these arguments is persuasive that the original decision was in error. We are still of the view the invention set forth in claims 9, 13, 17, and 18 is unpatentable over the combination of Zigmond and Swix based on the record before us in the original appeal, and the Board's reasoning in the new grounds of rejection.

We have granted the Request to the extent that we have reconsidered our decision of August 25, 2008, but we deny the request with respect to making any changes therein.

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REHEARING DENIED

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