

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MAURO DIDOMENICO

Appeal 2008-0662
Application 09/840,868¹
Technology Center 2400

Decided: November 26, 2008

Before JOSEPH F. RUGGIERO, ROBERT E. NAPPI, and
SCOTT R. BOALICK, *Administrative Patent Judges*.

BOALICK, *Administrative Patent Judge*.

¹ Application filed April 25, 2001. Application 09/840,868 claims the benefit under 35 U.S.C. § 119(e) of provisional application 60/259,903, filed January 8, 2001. The real party in interest is eVideo.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) from the final rejection of claims 1, 2, 4-8, 10-17, and 19-32, all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

STATEMENT OF THE CASE

Appellant's invention relates to providing video on demand by using a web site to receive customer requests for video content, locate the requested content on a plurality of video servers, and arrange for the located content to be distributed to the customer's set top box. (Spec. Abstract.)

Claim 1 is exemplary:

1. A system for providing video on demand, comprising:
 - a plurality of video servers storing video content; and
 - a portal hosted at a web site and connected to the video servers via Internet connections, said portal configured for:
 - establishing a communications session with a browser executing on a computer operated by a customer;
 - receiving an Internet Protocol (IP) address of a video decoding device from the browser via the communications session;
 - searching the video servers for the video content via the Internet connections,

receiving a customer's video selection via the communications session,

selecting one of the video servers that stores the video content that corresponds to the customer's video selection, and

communicating the Internet Protocol (IP) address of the video decoding device to the selected video server;

causing the selected video server to download the corresponding video content to the video decoding device for viewing the video content at a customer's premise.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Garfinkle	US 5,400,402	Mar. 21, 1995
Slezak	US 6,006,257	Dec. 21, 1999
Wong et al.	US 6,968,364 B1	Nov. 22, 2005 (filed Aug. 29, 2000)
Franco	US 2002/0046407 A1	Apr. 18, 2002 (priority claims to Feb. 18, 2000 and Feb. 22, 2000)

Claims 1, 2, 7, 8, 13-17, and 19-32 stand rejected under 35 U.S.C. § 103(a) as being obvious over Slezak, Wong, and Franco.

Claims 4-6, and 10-12 stand rejected under 35 U.S.C. § 103(a) as being obvious over Slezak, Wong, Franco, and Garfinkle.

Rather than repeat the arguments of Appellant or the Examiner, we make reference to the Briefs and the Answer for their respective details.

Except as noted in this decision, Appellant has not presented any substantive arguments directed separately to the patentability of the dependent claims or related claims in each group. In the absence of a separate argument with respect to those claims, they stand or fall with the representative independent claim. *See* 37 C.F.R. § 41.37(c)(1)(vii). Only those arguments actually made by Appellant have been considered in this decision. Arguments that Appellant did not make in the Briefs have not been considered and are deemed to be waived. *See id.*

ISSUES

§ 103 Rejection - Slezak / Wong / Franco

With respect to representative claim 1,² Appellant argues that Wong does not have a search capability, as claimed. (Reply Br. 3-4.) Specifically, Appellant argues that the filtering capability taught by Wong does not meet the claimed limitation of "searching the video servers for the video content via the Internet connections." (Reply Br. 3-4.) Appellant also argues that Wong does not address Video on Demand and the Examiner improperly combined Wong with Slezak. (Reply Br. 3-5, 8-10.)

Appellant argues that Franco does not disclose "receiving an Internet Protocol (IP) address of a video decoding device from the browser via the communications session," as claimed. (Reply Br. 5-10.) In particular, Appellant contends that Franco does not disclose selecting a program for viewing and receiving an IP address during the *same* communications

² Appellant argues claims 1, 2, 7, 8, 13-17, and 19-32 together as a group. (App. Br. 8-12.) Accordingly, we select claim 1 as representative. *See* 37 C.F.R. § 41.37(c)(1)(vii).

session. (App. Br. 11; Reply Br. 5-8.) According to what Appellant terms a "causality principal" (Reply Br. 7), Appellant contends that the system of Franco is not capable of registering and obtaining video content during the same communications session because there is no content to view until after a program has been recorded. (Reply Br. 7-8.) Appellant asserts that "Franco requires predetermined subscribers for viewing a recorded video" (Reply Br. 10) and "significantly, the present invention provides a system wherein the user is not a subscriber" (Reply Br. 6). Appellant also argues that, in contrast to the video recording system of Franco, the claims are directed to a Video on Demand system. (Reply Br. 6.) Appellant contends that the claimed Video on Demand system is "fundamentally different" than a video recording system. (Reply Br. 8.)

Appellant further argues that the Examiner improperly combined Franco with Slezak and Wong. (App. Br. 9-12; Reply Br. 5-10.) In particular, Appellant argues that Slezak's pre-populated subscriber database teaches away from Franco's online registration process (App. Br. 9-11; Reply Br. 5-6), that combining Slezak with Franco would change Slezak's principle of operation (App. Br. 11), that the Examiner adopted an unreasonable interpretation of the claimed communications session (App. Br. 11-12), and that there is no motivation to combine the references because of alleged differences between the set top boxes of Slezak and Franco (App. Br. 12).

Appellant's arguments present the following issue:

Has Appellant shown that the Examiner erred in rejecting claims 1, 2, 7, 8, 13-17, and 19-32 under 35 U.S.C. § 103(a)?

The resolution of this issue turns on the following subsidiary issues:

1. Has Appellant shown that the Examiner erred in finding that Wong teaches "searching the video servers for the video content via the Internet connections"?

2. Has Appellant shown that the Examiner erred in finding that Franco teaches "receiving an Internet Protocol (IP) address of a video decoding device from the browser via the communications session"?

3. Has Appellant shown that the Examiner erred by improperly combining Slezak, Wong, and Franco?

§ 103 Rejection - Slezak / Wong / Franco / Garfinkle

With respect to dependent claims 4-6 and 10-12, Appellant summarily alleges that these claims are not unpatentable over the applied references "because *Slezak, Wong et al.*, and *Franco* fail to render obvious independent claims 1 and 7, as argued above" (App. Br. 12) and Garfinkle fails to cure the alleged deficiencies of Slezak, Wong, and Franco (App. Br. 12-13).

Appellant's arguments present the following issue:

Has Appellant shown that the Examiner erred in rejecting claims 4-6 and 10-12 under 35 U.S.C. § 103(a)?

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. Slezak describes a system that provides video on demand programming interleaved with secondary programming such as advertising. (Col. 1, ll. 14-19.) In Slezak, a subscriber's home 500 includes a set-top unit 504 connected to the Internet 530 using a cable modem 506 and a personal computer 508 connected to the Internet. (Col. 4, l. 65 to col. 5, l. 11; Fig. 1.) A series of video servers 520a-520c and a Web server 540 also are connected to the Internet 530. (Col. 5, ll. 11-28; Fig. 1.) The Web server 540 is connected to a subscriber database 542 that includes the subscriber's IP address. (Col. 5, ll. 30-32; Fig. 1.)
2. Slezak teaches that the subscriber accesses the Web server 540 using a Web browser using either the personal computer 508 or set-top unit 504. (Col. 5, ll. 33-36.) With the Web browser, the subscriber selects a program, such as a movie, that the subscriber desires to view from the Web pages displayed by the Web server 540. (Col. 5, ll. 36-39.) The Web server 540 resolves the subscriber's address using the subscriber database 542 and directs the appropriate video server 520 to deliver the selected program. (Col. 5, ll. 39-43.) The appropriate video server may be selected upon various criteria, including the location of the selected programming material. (Col. 5, ll. 43-46.)

The video server 520 delivers the selected program to the set top unit 520. (Col. 5, ll. 46-53.)

3. Wong describes a system that "facilitate[s] the selection of an audio and/or visual program." (Col. 1, ll. 19-20.) Wong teaches that "a conventional EPG running on a PVR system may not provide a completely satisfactory mechanism to sort through and select programs." (Col. 3, ll. 30-32.) Wong's system includes a local computer connected to a server through the Internet. (Col. 6, ll. 14-16.) "The local computer is programmed to search and/or filter through audio and/or visual program information in the searchable database." (Col. 6, ll. 17-19.)

4. In one embodiment, Wong teaches a system 10 with computer 30, client systems 40a-40c, and servers 20 and 50. (Col. 9, ll. 21-39; Fig. 1B.) The "computer 30 may be employed to browse a website and/or search for programs matching selection criteria provided by a user or by a service provider." (Col. 10, ll. 30-32.) "The computer 30 also may utilize other websites and/or functionality 398, such as to provide additional functionality with respect to searching for programs." (Col. 18, ll. 50-52.) "The other functionality 398 further may work in conjunction with Internet browsing software and search engines (local and remote) programmed in the remote computer for searching various websites for programs matching the selection criteria programmed in the filter function." (Col. 18, ll. 59-63.) "The results are provided to the computer 30 as part of an interactive

display from which a user may select one or more programs."

(Col. 18, ll. 63-65.) The client systems 40 may be "an entertainment appliance programmed and/or configured to receive audio and/or visual programs." (Col. 10, ll. 41-43.) One example of such a system is a Video-on-Demand system. (Col. 10, ll. 45-48, 50.)

5. Franco describes "[a] remotely programmable broadcast content recording system [that] is programmed through a web page to record broadcast content such as television programs." (Abstract.) Franco teaches a host system 102 that hosts a web site 104 that a user 110 uses to program a video recording system 120. (Paragraph [0062]; Fig. 1.) The user 110 accesses the web site 104 by a web browser running on computer 114. (Paragraph [0063]; Fig. 1.)
6. At step 402 of process 400, Franco teaches a registration process through web site 104 where a user is associated with a particular video recording system 120. (Paragraph [0082]; Fig. 4A.) "The user preferably supplies video recording system identification information that allows the host system 102 to transmit programming data 108 to the user's video recording system 120." (Paragraph [0082].) The identification information can be an Internet Protocol (IP) address. (*Id.*) "Once the user 110 has signed up for the service and provided the required information at the step 402, the user 110 can program his remotely programmable video recording system 120." (*Id.*) At step

- 406, the web server 302 receives programming instructions 118 from the user 110. (Paragraph [0085]; Fig. 4A.)
7. Franco teaches a "Program Request Integration" embodiment 1300. (Paragraphs [0134] through [0141]; Fig. 13.) In this embodiment, the user 110 communicates with a host system 102 that hosts a programming web site 104 and also communicates with a scheduling system 1302 that hosts a scheduling web site 1308 and receives programming requests 1310. (Paragraphs [0136] through [0139]; Fig. 13.) The scheduling system 1302 provides scheduling instructions 1306 to a broadcaster that broadcasts to the video recording system 120. (Paragraph [0139]; Fig. 13.) "The features of the scheduling system 1302 . . . can also be combined with the features of Section V (Distribution of Proprietary Content) above [in paragraphs 0113 through 0127] to provide a pseudo-on-demand proprietary content distribution system." (Paragraph [0141].)

PRINCIPLES OF LAW

All timely filed evidence and properly presented arguments are considered by the Board in resolving an obviousness issue on appeal. *See In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984).

In the examination of a patent application, the Examiner bears the initial burden of showing a prima facie case of unpatentability. *Id.* at 1472. When that burden is met, the burden then shifts to the Applicant to rebut. *Id.*; *see also In re Harris*, 409 F.3d 1339, 1343-44 (Fed. Cir. 2005) (finding rebuttal evidence unpersuasive). If the Applicant produces rebuttal evidence

of adequate weight, the prima facie case of unpatentability is dissipated. *In re Piasecki*, 745 F.2d at 1472. Thereafter, patentability is determined in view of the entire record. *Id.* However, on appeal to the Board it is the Appellant's burden to establish that the Examiner did not sustain the necessary burden and to show that the Examiner erred. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006).

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007). In *KSR*, the Supreme Court reaffirmed that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* at 1739. The Court explained:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

Id. at 1740.

"[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d at 988. "To facilitate review, this

analysis should be made explicit." *KSR*, 127 S. Ct. at 1741. However, "the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *Id.* The Supreme Court noted that "[u]nder the correct analysis, any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed." *Id.* at 1742. "A person of ordinary skill is also a person of ordinary creativity, not an automaton." *Id.*

During examination of a patent application, a claim is given its broadest reasonable construction consistent with the specification. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969). "[T]he words of a claim 'are generally given their ordinary and customary meaning.'" *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) (internal citations omitted). The "ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application." *Id.* at 1313.

ANALYSIS

§ 103 Rejection - Slezak / Wong / Franco

Appellant's arguments that the Examiner erred in rejecting representative claim 1 as being obvious over Slezak, Wong, and Franco are not persuasive.

As the Examiner correctly found, Wong teaches a search capability. (Ans. 5-6, 22-23; FF 3, 4.) The claim term "searching" is broad enough to

encompass the filtering capability disclosed by Wong. The relevant plain meaning of the claim term "search" is "to go over or look through for the purpose of finding something; explore." *Webster's New World Dictionary Third College Edition* 1210 (1994). According to Appellant, the filtering capability of Wong is "a **sorting** mechanism used to home in on programs users want to watch." (Reply Br. 3.) In other words, the filtering capability of Wong enables the user to go over or look through programs in order to find programs that the user wants to watch and thus meets the claimed searching limitation. In addition, Wong teaches that "other functionality" may be used in conjunction with Internet browsing software and search engines to search for desired programming. (FF 4.) This also teaches the claimed searching limitation.

Accordingly, Appellant has not shown that the Examiner erred in finding that Wong teaches "searching the video servers for the video content via the Internet connections."

The Examiner interpreted the claim term "'communications session'[]" to be from the time a user initiates communication from a PC to a server in order to register with the video system, to the time the user has finished viewing a program he/she has selected/requested." (Ans. 28.) Although Appellant complains that this interpretation is unreasonable (App. Br. 11-12), Appellant has not pointed to any special definition of "communications session" in the Specification or otherwise shown that the Examiner's interpretation is inconsistent with the Specification. Thus, we consider the Examiner's interpretation of this claim limitation to be reasonable and not inconsistent with the Specification.

Under this definition of communications session, the Examiner has shown how Franco teaches receiving an IP address of a video device from a browser in the *same* communications session as the one in which the customer's video selection is received. (Ans. 6-9, 24-30; FF 5-7.) In particular, Franco teaches a registration process (Ans. 6-7, 24-25; FF 6) that occurs during a communications session and also teaches (Ans. 7, 27; FF 6) that the user may continue in the same communications session and program the remotely programmable video recording system.

The Examiner is not proposing to bodily incorporate Franco into the system of Slezak. Instead, the Examiner proposes to modify Slezak and Wong by using the registration process of Franco to allow the user to provide identification information, such as the IP address of the set top box, to the web portal. (Ans. 8, 24-25.) Therefore, Appellant's arguments regarding the so-called "causality principal" are not convincing.

Accordingly, Appellant has not shown that the Examiner erred in finding that Franco teaches "receiving an Internet Protocol (IP) address of a video decoding device from the browser via the communications session."

Although Appellant argues that the invention is directed to a system where the user is not a subscriber (Reply Br. 6), representative claim 1 merely recites a "customer" and is silent as to whether a customer is or is not a subscriber. Appellant has not shown error in the Examiner's findings (Ans. 6-9) that one of ordinary skill in the art would have used the registration process of Franco to populate the subscriber database of Slezak. We do not find that the pre-populated subscriber database of Slezak teaches away from the online registration process of Franco. Instead, the Examiner has set forth a convincing rationale as to why one of ordinary skill in the art would have

used the registration process of Franco to populate the database of Slezak. Populating the database of Slezak using the registration process of Franco would not change Slezak's principle of operation. Therefore, Appellant's arguments regarding predetermined subscribers are not convincing.

Contrary to Appellant's arguments, Wong and Franco address video-on-demand or capabilities similar to video-on-demand. (FF 4, 7.) Also, the Examiner has correctly explained (Ans. 30-31) how the set-top boxes of Slezak and Franco are similar. Furthermore, the Examiner has articulated reasons with rational underpinnings for combining the teachings of Slezak, Wong, and Franco. (Ans. 6, 8-9, 23, 24-25.)

Therefore, Appellant has not shown that the Examiner erred by improperly combining Slezak, Wong, and Franco.

Accordingly, we conclude that Appellant has not shown that the Examiner erred in rejecting representative claim 1 under 35 U.S.C. § 103(a). Claims 2, 7, 8, 13-17, and 19-32 were not argued separately and fall together with claim 1.

§ 103 Rejection - Slezak / Wong / Franco / Garfinkle

Because Appellant has not provided any arguments regarding Garfinkle or any additional arguments for claims 1 and 7, we will sustain this rejection for the reasons discussed with respect to independent claims 1 and 7, from which claims 4-6 and 10-12 depend.

CONCLUSION

Appellant has not shown that the Examiner erred in rejecting claims 1, 2, 7, 8, 13-17, and 19-32³ under 35 U.S.C. § 103(a).

Appellant has not shown that the Examiner erred in rejecting claims 4-6 and 10-12 under 35 U.S.C. § 103(a).

DECISION

The rejection of claims 1, 2, 4-8, 10-17, and 19-32 for obviousness under 35 U.S.C. § 103 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

rvb

DITTHAVONG MORI & STEINER, P.C.
918 PRINCE STREET
ALEXANDRIA, VA 22314

³ We note that dependent claim 23 erroneously depends from "claim 9 7" and dependent claim 29 erroneously depends from cancelled claim 3. These apparent typographical errors require correction should there be further prosecution of these claims.