UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GARY L. SEXTRO, JOHN R. REDER, ROGER S. CARVER,
TIMOTHY L. RYAN, JAMES F. HEADLEY,
and ANNA ANTOSZKIEWICZ

Appeal 2008-4355
Application 09/829,468[1]
Technology Center 2600

Decided: December 9, 2008

Before JOSEPH F. RUGGIERO, JOHN A. JEFFERY, and KARL D. EASTHOM, *Administrative Patent Judges*.

JEFFERY, *Administrative Patent Judge*.

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[1] This application claims benefit of U.S. Provisional Application 60/195,411 filed Apr. 8, 2000.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134 from the Examiner's rejection of claims 1, 2, 4-18, 24, and 25. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

STATEMENT OF THE CASE

Appellants invented an interactive television system and method that combines video and audio content delivered by traditional broadcast methods with interactive Internet capabilities delivered by existing networks.[2] Claim 1 is illustrative:

1. A method for interactive television, the method comprising:

receiving a terrestrial broadcast signal comprising a video stream;

interpreting commands embedded in the video stream, said embedded commands operable to access interactive features, said embedded commands synchronized and correlated with additional Internet-based content;

receiving said Internet-based content via satellite transmission and sending transmitting information via landline transmission;

providing a digital interactive set-top box coupled to a standard television, said interactive set-top box accessing said additional Internet-based content and superimposing said content on said video stream; and

displaying said additional Internet-based content superimposed on said video stream from said traditional broadcast signal.

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

Smallcomb	US 5,938,737	Aug. 17, 1999

[2] *See generally* Spec. 2.

Butler	US 2002/0007493 A1	Jan. 17, 2002 (filed Jul. 29, 1997)
Ellis	US 2004/0117831 A1	Jun. 17, 2004 (eff. filed Jun. 26, 2000)

1. The Examiner rejected claims 1, 4-10, 12, 13, 15-17, 24, and 25 under 35 U.S.C. § 103(a) as unpatentable over Ellis and Smallcomb (Ans. 3-10).
2. The Examiner rejected claims 2 and 14 under 35 U.S.C. § 103(a) as unpatentable over Ellis, Smallcomb, and Butler (Ans. 10-11).
3. The Examiner rejected claim 18 under 35 U.S.C. § 103(a) as unpatentable over Butler, Smallcomb, and Ellis (Ans. 11-13).
4. The Examiner rejected claim 11 under 35 U.S.C. § 103(a) as unpatentable over Butler and Ellis (Ans. 13-14).

Rather than repeat the arguments of Appellants or the Examiner, we refer to the Briefs and the Answer[3] for their respective details. In this decision, we have considered only those arguments actually made by 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).

[3] Throughout this opinion, we refer to (1) the Appeal Brief filed Feb. 5, 2008; (2) the Examiner's Answer mailed Mar. 7, 2008; and (3) the Reply Brief filed May 7, 2008.

Regarding the Examiner's rejection of representative claim 1,[4] Appellants argue that the Examiner's reliance on Ellis is misplaced. Although Appellants acknowledge that Ellis' provisional application predates Appellants' earliest effective filing date, Appellants nonetheless contend that Ellis' provisional application does not properly support the subject matter relied upon in the rejection, namely the limitation calling for "providing a digital interactive set-top box coupled to a standard television, said interactive set-top box accessing said additional Internet-based content and superimposing said content on said video stream." This deficiency, Appellants argue, is critical since the Ellis' provisional application must be relied upon for Ellis to qualify as prior art with respect to the present application (App. Br. 11-13; Reply Br. 2-3).

The Examiner responds that *Appellant's* underlying provisional application fails to properly support the disputed set-top box limitation of claim 1 and, in any event, the Ellis provisional application incorporates another patent application (No. 09/229,047) in its entirety. According to the Examiner, the incorporated '047 application discloses a set-top box. (Ans. 15).

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[4] Appellants argue claims 1, 2, 4, 5, 8-10, and 12-16, 24, and 25 together as a group. *See* App. Br. 10-13. Although Appellants include claims 24 and 25 in this group, Appellants nonetheless separately argue (1) claim 24 in connection with the arguments presented for claim 6 (App. Br. 4), and (2) claim 25 in connection with the arguments for claim 17 (App. Br. 5). Accordingly, we select claim 1 as representative of a first claim grouping comprising 1, 2, 4, 5, 8-10, and 12-16, and treat claims 24 and 25 in connection with claims 6 and 17, respectively. *See* 37 C.F.R. § 41.37(c)(1)(vii).

The issues before us, then, are as follows:

ISSUES

Have Appellants shown that the Examiner erred in relying on Ellis in rejecting representative claim 1 under § 103? The issue turns on whether Ellis qualifies as prior art under § 102.

This determination turns on the following subsidiary issues:

(1) Does Appellants' provisional application properly support the subject matter of the disputed set-top box limitation?

(2) If so, does Ellis's provisional application properly support the subject matter relied upon by the Examiner as teaching the disputed set-top box limitation?

FINDINGS OF FACT

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

1. Appellants' present application, filed on April 9, 2001, claims the benefit of U.S. Provisional Patent Application No. 60/195,411, filed April 8, 2000.

2. Ellis, filed June 6, 2003, is a continuation of Application 09/604,470, filed June 26, 2000.

3. Ellis claims the benefit of U.S. Provisional Patent Application 60/141,501, filed June 28, 1999.

4. Appellants' '411 Provisional Application states that "[w]hile it is clear that sort some of internet protocol will most likely be used to implement the interactivity portion [of an interactive television system], it is

also desirable to provide for simultaneous broadcast to traditional and interactive receivers" ('411 Provisional Appl'n 1:5-8).

5. Appellants' '411 Provisional Application indicates that "[o]ne method of enabling a smooth transition is to use traditional broadcasts, with embedded HTML or Java-like commands to access the interactive features of advanced televisions. These embedded commands can enable synchronization and correlation to additional internet-based content that is displayed with the broadcast signals" ('411 Provisional Appl'n 1:9-12).

6. Appellants' '411 Provisional Application does not mention a "set-top box."

7. Appellants' utility application describes two different implementations of the disclosed invention where the interactive features utilize either (1) an advanced television 200, or (2) a standard television 211 retrofitted with an interactive set-top box 210 (Spec. 5:18-20; Fig. 2).

8. Ellis discloses an interactive television program guide system in which various types of data and television signals are transmitted from a television distribution facility 16 to user television equipment 20 (e.g., a set-top box) (Ellis, ¶¶ 0088, 0092-97; Fig. 1A).

9. Each user in Ellis has a set-top box with a memory 25. The set-top box may comprise a WebTV Internet receiver and a memory 25 (Ellis, ¶ 0098).

10. Ellis provides a number of niche hubs including a sports fan hub. This hub includes a variety of options available to the user via main menu screen 350 (Ellis, ¶¶ 0164-69; Fig. 27).

11. In Figure 32, screen 400 displays a list 402 of top news stories related to sports. The text or video of the story selected by the user is

displayed in region 413 of screen 410 (Figure 34). Also, the user can view the text or video of the next story in the list by selecting the "Next Story" option (Ellis, ¶ 0182; Figs. 32, 34).

12. Screen 350 provides options for highlights for a particular past game, including options to display video highlights, statistics, and related stories, etc. (Ellis, ¶ 0184; Fig. 27).

13. One of the specific options indicated on the individual buttons in list 402 indicates that the user can select a story related to two teams battling for the Super Bowl (Ellis, Fig. 32).

14. Members of a family can have their own personal profile that is selectable from a list of profiles 541 displayed on a screen (Ellis, ¶ 0201-02; Figs. 43 and 44).

PRINCIPLES OF LAW

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966).

If the Examiner's burden is met, the burden then shifts to the Appellants to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *See In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

To satisfy the written description requirement, the disclosure must convey with reasonable clarity to skilled artisans that Appellants were in

possession of the claimed invention as of the filing date. *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991).

> The 35 U.S.C. 102(e) critical reference date of a U.S. patent or U.S. application publications . . . entitled to the benefit of the filing date of a provisional application under 35 U.S.C. 119(e) is the filing date of the provisional application with certain exceptions if the provisional application(s) properly supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C. 112, first paragraph.

MPEP § 2136.03(III). *See also Ex Parte Yamaguchi*, No. 2007-4412 (BPAI Aug. 29, 2008) (precedential), *available at* http://www.uspto.gov/web/offices/dcom/bpai/prec/fd074412.pdf.

ANALYSIS

Claims 1, 4, 5, 8-10, 12, 13, 15, and 16

We begin by noting the critical dates at issue in this appeal. First, Ellis is based on a continuation application filed June 26, 2000 (FF 2) which is before the filing date of the present application (April 9, 2001) (FF 1), but after the filing date of the present application's underlying provisional application (FF 3).

Accordingly, we first must determine whether the disputed set-top box limitation of claim 1 is supported by the present application's provisional application. If it is not, then the Ellis reference would then qualify as prior art irrespective of the content of its provisional application. If, however, we find the requisite support in Appellants' provisional application for the disputed set-top box limitation, we must then determine whether Ellis'

provisional application supports the subject matter relied upon by the Examiner for this limitation.

Turning to Appellants' provisional application, we note at the outset that it is only one page of text and contains no drawings. Nowhere in this brief disclosure is a set-top box mentioned (FF 6), let alone a digital interactive set-top box coupled to a standard television that accesses additional Internet-based content and superimposes that content on a video stream of a terrestrial broadcast signal as claimed.

Appellants concede that the phrase "set-top box" is not used in Appellants' provisional application (Reply Br. 3), but nevertheless point to two passages within this application that are said to provide the requisite support for the disputed set-top box limitation of claim 1 under § 112, first paragraph. Specifically, Appellants contend that the first quoted passage (FF 4) would allegedly inform skilled artisans how to make and use the element which recites "providing a digital interactive set-top box coupled to a standard television" (Reply Br. 3). The second passage, Appellants argue, would enable skilled artisans to make and use the element of claim 1 reciting "accessing additional internet-based content and superimposing that content on a video stream without undue experimentation" (*Id.* at 4).

We disagree. The first passage merely generally indicates that it is desirable to provide for simultaneous broadcast to traditional and interactive receivers in an interactive television system (FF 4). This brief statement simply does not indicate *how* such simultaneous broadcast would occur in an interactive television environment, let alone that a set-top box would be used to achieve that end.

The second quoted passage likewise fails to support the disputed set-top box limitation of claim 1. This passage does indicate that traditional broadcasts contain embedded HMTL or Java-like commands to access the interactive features of advanced televisions (FF 5). But nothing in this passage indicates *how* this desired result is achieved or the particular system components used, let alone that a set-top box accesses Internet-based content and superimposes that content on a video stream. Even if we assume, without deciding, that interactive digital set-top boxes were known at the time of the invention, there is simply nothing in Appellants' provisional application to convey to skilled artisans with reasonable clarity that these set-top boxes would be used to superimpose Internet content on a digital video stream as claimed in lieu of other system components.

In contrast, Appellants' utility application describes two different implementations of the disclosed invention where the interactive features utilize either (1) an advanced television 200, or (2) a standard television 211 retrofitted with an *interactive set-top box 210* (FF 7). Significantly, claim 1 on appeal is directed to this second alternative.

But neither of these alternatives appears in Appellants' single-page provisional application. At best, skilled artisans would have to infer the specific recited set-top box structure and functionality of claim 1 from one sentence from Appellants' provisional application indicating that it would be "desirable to provide for simultaneous broadcast to traditional and interactive receivers." ('411 Provisional Appl'n 1:7-8). This brief statement, considered with the disclosure as a whole, falls well short of conveying with reasonable clarity to skilled artisans that Appellants had possession of the specific digital interactive set-top box functionality of

claim 1 as of the filing date of the provisional application. *See Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991).

Since the disclosure of Appellants' provisional application does not reasonably support the disputed set-top box limitation of claim 1 under § 112, first paragraph, the effective filing date of the subject matter of claim 1 on appeal is not the filing date of Appellants' provisional application, but rather the filing date of Appellants' utility application (April 9, 2001). As such, Ellis qualifies as prior art under § 102(e) since its effective filing date (June 26, 2000) (FF 2) is before the filing date of the present application. We therefore need not address Appellants' arguments pertaining to the content of Ellis' provisional application, as the content of that application is irrelevant to our analysis which focuses on the teachings of the Ellis reference itself.

Turning to Ellis, the Examiner relied on Paragraph 0098 as teaching a digital interactive set-top box with the recited functionality of claim 1 (Ans. 3, 15). Appellants do not dispute this particular finding, but rather focus their arguments on whether Ellis' underlying provisional application supports this relied-upon subject matter—arguments that are simply inapposite as we noted above. Moreover, we find that the Examiner's reliance on Paragraph 0098 has at least a rational basis since Ellis indicates that the set-top box can have a WebTV Internet receiver and a memory (FF 9).

For the foregoing reasons, Appellants have not persuaded us of error in the Examiner's obviousness rejection of representative claim 1 based on the collective teachings of Ellis and Smallcomb. Therefore, we will sustain

the Examiner's rejection of that claim, and claims 4, 5, 8-10, 12, 13, 15, and 16 which fall with claim 1.

Claims 6, 7, and 24

We will also sustain the Examiner's rejection of representative claim 6 which calls for, in pertinent part, (1) storing one or more video clips of selected plays; (2) summarizing the stored video clips with a graphic summary included coded indicators denoting types of plays; and (3) replaying one of the video clips upon viewer selection of a corresponding coded indicator. The sports hub functionality of Ellis relied upon by the Examiner (Ans. 5), in our view, reasonably teaches or suggests these limitations.

At the outset, we note that the limitations calling for the specific content of the video clips, namely that the clips comprise a segment of a sporting event and selected plays, essentially constitutes non-functional descriptive material as these limitations do not further limit the claimed invention either functionally or structurally. Such non-functional descriptive material does not patentably distinguish over prior art that otherwise renders the claims unpatentable.[5]

In any event, Ellis's sports hub functionality (FF 10-12) at least suggests these limitations. Specifically, the user can select specific sports-related stories and the corresponding video pertaining to that story can be displayed on a screen (FF 11). Clearly, these video clips would have been

[5] *See In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004); *see also Ex Parte Nehls*, No. 2007-1823, 2008 WL 258370 (BPAI 2008) (precedential), at *6-10 (discussing cases pertaining to non-functional descriptive material).

stored to enable retrieval of the clips for display. Moreover, one of the specific options indicated on the individual buttons in list 402 indicates that the user can select a story related to two teams battling for the Super Bowl (FF 13). Skilled artisans, in our view, would readily understand that this story could at least involve various plays from that sporting event, particularly in view of the sports hub's ability to provide the option to display highlights from a particular past game, including video highlights (FF 12). Moreover, skilled artisans would also readily understand that a wide variety of sporting events, as well as various aspects of the same sporting event, could be displayed as selectable options on this list. Furthermore, the buttons themselves and their associated indicia in list 402 (FF 11) reasonably teach the recited graphic summary including coded indicators denoting types of plays, given the scope and breadth of this limitation.

Appellants' arguments pertaining to whether Ellis' provisional application or documents incorporated by reference in that application disclose these limitations (App. Br. 14; Reply Br. 4) are inapposite to our findings regarding Ellis, since the reference qualifies as prior art as we noted above.

For the foregoing reasons, Appellants have not persuaded us of error in the Examiner's rejection of representative claim 6. Therefore, we will sustain the Examiner's rejection of that claim, and claims 7 and 24 which fall with claim 6.

Claims 17 and 25

We will also sustain the Examiner's rejection of representative claim 17 which calls for, in pertinent part, providing taskbars displaying various accounts in the home. The Examiner's reliance on the various user profiles as teaching this feature (Ans. 9), in our view, is reasonable.

As shown in Figures 43 and 44 of Ellis, each member of a family can select a distinct personal profile from a list of profiles displayed on a screen (FF 14). The individual bar-shaped buttons in the displayed list that correspond to respective user profiles fully meet "taskbars" that display various accounts in the home, namely those of each family member. Appellants' arguments pertaining to Ellis' provisional application (App. Br. 14-15; Reply Br. 5) are irrelevant regarding this disclosure from Ellis and are therefore unpersuasive.

For the foregoing reasons, Appellants have not persuaded us of error in the Examiner's rejection of representative claim 17. Therefore, we will sustain the Examiner's rejection of that claim, and claim 25 which falls with claim 6.

Other Rejections

Likewise, we will sustain the Examiner's obviousness rejections of (1) claims 2 and 14 over Ellis, Smallcomb, and Butler (Ans. 10-11); (2) claim 18 over Butler, Smallcomb, and Ellis (Ans. 11-13); and (3) claim 11 over Butler and Ellis (Ans. 13-14). We find that (1) the Examiner has established at least a prima facie case of obviousness for these claims, and (2) Appellants have not particularly pointed out errors in the Examiner's

reasoning to persuasively rebut the Examiner's prima facie case. The rejection is therefore sustained.

CONCLUSION OF LAW

Appellants have not shown that the Examiner erred in rejecting claims 1, 2, 4-18, 24, and 25 under § 103.

ORDER

The Examiner's decision rejecting claims 1, 2, 4-18, 24, and 25 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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