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JERRY.SHORMA@HP.COM
ipa.mail@hp.com
brandon.serwan@hp.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte AJAY GUPTA and
CHANDRASEKAR VENKATRAMAN

Appeal 2010-007017
Application 10/954,816
Technology Center 2400

Before JOHN A. JEFFERY, BARBARA A. BENOIT, and
JENNIFER L. McKEOWN, *Administrative Patent Judges*.

BENOIT, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) from the final rejection of claims 1-4, 6-8, 10-16, 18-24, and 26-31, which constitute all the claims pending in the application. Claims 5, 9, 17, and 25 have been canceled. App. Br. 4. We have jurisdiction under 35 U.S.C. § 6(b). We reverse.

STATEMENT OF THE CASE

Appellants' invention relates to providing print-augmented broadcast signals, which provides supplemental program content substantially currently with the program content. *See generally* Abstract; Spec. 1-2. Claim 1 is illustrative and reads as follows, with key disputed limitations emphasized:

1. A method for providing a print-augmented broadcast signal for transmission to one or more conventional broadcast receivers, the method comprising:

receiving a broadcast signal comprising (i) standard content for a particular broadcast program and (ii) a non-content portion;

receiving supplemental content which is associated with the standard content of the particular broadcast program, wherein the *supplemental content comprises a plurality of segments, each of the supplemental content segments corresponding to a segment of standard content of the particular broadcast program*; and

combining the supplemental content onto the non-content portion of the broadcast signal to form a print-augmented broadcast signal, the print augmented broadcast signal comprising the standard content, which can be rendered on a conventional broadcast receiver, and the supplemental content, which is printable on-demand at a destination conventional broadcast receiver substantially concurrently with the rendering of the standard content.

The Examiner relies on the following as evidence of unpatentability:

Von Kohorn	US 4,926,255	May 15, 1990
Mankovitz	US RE38,600 E	Sept. 28, 2004

The Rejections

1. The Examiner rejected claims 1-4, 6-8, 10-16, 18, 19, 22-24, and 26-31 under 35 U.S.C. § 102(b) as anticipated by Mankovitz. Ans. 3-9.¹

¹ Throughout this opinion, we refer to the Appeal Brief filed July 10, 2009

2. The Examiner rejected claims 20 and 21 under 35 U.S.C. § 103(a) as unpatentable over Mankovitz and Von Kohorn. Ans. 9-11.

CONTENTIONS

The Examiner finds that Mankovitz discloses every recited feature of illustrative claim 1. Ans. 3-4 (citing col. 8, l. 40-col. 9, l. 49; col. 23, ll. 20-25; col. 24, ll. 47-62; Figs. 1, 2, 21). The Examiner maps the recited supplemental content to Mankovitz's auxiliary information and the recited non-content portion of the broadcast signal to Mankovitz's VBI or vertical blanking interval. Ans. 3. The Examiner explains that the viewer receives a broadcast signal and also receives auxiliary information about the program. Ans. 4.

Appellants argue, among other things, that Mankovitz discloses auxiliary information that is specific to a program as a whole and so does not equate to the recited supplemental content that includes plural segments in which each segment corresponds to a segment of standard content of the particular broadcast program. App. Br. 13.

ISSUE

Under § 102, has the Examiner erred in rejecting claim 1 by finding Mankovitz discloses the recited supplemental content?

ANALYSIS

This appeal turns on whether Mankovitz's auxiliary information includes plural segments in which each segment corresponds to a segment of

(App. Br.), the Examiner's Answer mailed November 16, 2009 (Ans.), and the Reply Brief filed January 15, 2010 (Reply Br.).

standard content of the particular broadcast program. We therefore begin by construing the term “segment.” A segment is a part of something² and, in the context of claim 1, each supplemental content segment is a part of the supplemental content and corresponds to a part of the standard content of the particular broadcast program. This construction of supplemental content segment is consistent with the Specification. *See* Spec. 9:16-18 (stating “[t]he supplemental content 322 may be parsed into two or more segments, each segment corresponding to different segments of the standard program content.”); Fig. 3A (showing Suppl. Content 322 comprising multiple segments (Seg. 1, Seg. 2, ...)).

Turning to the cited reference, Mankovitz discloses techniques for accessing information relating to radio and television broadcast programs. *See* col. 1, ll. 28-30. When listening to or watching a broadcast program, a listener or viewer indicates an interest in receiving more information by pressing a key or button on the program receiver. *See* col. 8, ll. 40-50. Identifying information (such as the station or channel broadcasting the program, the day, and the time or “SDT”) is recorded in the memory of the receiver and is transmitted, along with viewer or listener identification information, to a central station, which provides auxiliary information based on the identifying information (such as the SDT) for the program. *See* col. 8, l. 53-col. 9, l. 10. Mankovitz provides various examples of auxiliary information that can be received about a program, including the name, artist,

² AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE 1329 (3d ed. 1992) (defining “segment” as “1. Any of the parts into which something can be divided”); *see also* Ans. 11 (quoting dictionary definition of “segment”).

and label of a song; summary of a drama; a written transcript of a public interest discussion; name and address of store where an advertised product could be purchased; or an infomercial about a product or service. *See* col. 9, ll. 10-21.

Appellants contend that Mankovitz discloses auxiliary information that is specific to a program as a whole and so does not equate to the recited supplemental content that includes plural segments in which each segment corresponds to a segment of standard content of the particular broadcast program. App. Br. 13. We agree. The Examiner's reliance on Mankovitz is erroneous for Mankovitz's auxiliary information does not meet the limitation of claim 1, which requires a particular arrangement of supplemental content – namely, each segment corresponds to a segment of the standard content of the broadcast program.

In response to the Appellants' argument, the Examiner explains that Mankovitz's auxiliary information can be a written transcript of a program, in which case the transcript has segments which correspond to segments of the program. Ans. 12-13. The Examiner uses an example of closed captioning data to further explain how a transcript corresponds to scenes in a broadcast program. Ans. 12; *see also* Final Rejection mailed May 1, 2009, page 3.

As Appellants correctly point out (App. Br. 14-15), Mankovitz's disclosure of a written transcript as an example of auxiliary information is not sufficient to disclose the recited supplemental content under § 102. Mankovitz fails to anticipate claim 1 because the example of the written transcript is not necessarily present in Mankovitz's system for providing

auxiliary information about a broadcast program. *See In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999).

For the first time in the Response to Argument section of the Examiner's Answer, the Examiner asserts that Mankovitz's closed captioning data inserted in the VBI disproves Appellants' contention that Mankovitz does not disclose the recited supplemental content. Ans. 11-12. In so doing, the Examiner appears to shift from the position articulated in the final rejection from which the appeal was taken³ – that is, Mankovitz's auxiliary information equates to the recited supplemental content – to a new position in which Mankovitz's closed captioning data in the VBI equates to the recited supplemental content. *Compare* Ans. 3 (stating “supplemental content (auxiliary information)”) *with* Ans. 12 (stating “closed captioning aspect of Mankovitz disproves [Appellants' argument] for [] closed captioning data is auxiliary or supplemental information”).

Such shifts run counter to notions of fundamental fairness in appellate proceedings and must be designated as a new ground of rejection to give Appellants notice and a fair opportunity to respond to the new position. *See* MPEP § 1207.03; *see also In re Kronig*, 539 F.2d 1300, 1302-03 (CCPA 1976). Although Appellants filed a Reply Brief addressing both positions (Reply Br. 5-8), we decline to review the Examiner's newer position based on Mankovitz's closed captioning data because it is inconsistent with that taken in the rejection – namely, equating auxiliary information to the recited supplemental content.

³ The Board reviews the Examiner's final rejection in appeals under 35 U.S.C. § 134(a). *See In re Webb*, 916 F.2d 1553, 1556 (Fed. Cir. 1990).

We therefore are persuaded that the Examiner erred in rejecting (1) independent claim 1; (2) independent claims 8, 14, 22, 28, and 29 which recite commensurate limitations; and (3) dependent claims 2-4, 6, 7, 10-13, 15, 16, 18, 19, 23, 24, 26, 27, 30, and 31 for similar reasons.

The Obviousness Rejection

Because the Examiner has not shown that Mankovitz, under the obviousness standards of § 103, or Von Kohorn cure the deficiencies noted above, we do not sustain the obviousness rejection of dependent claims 20 and 21 over Mankovitz and Von Kohorn for similar reasons.

CONCLUSION

The Examiner erred in rejecting (1) claims 1-4, 6-8, 10-16, 18, 19, 22-24, and 26-31 under § 102 and (2) claims 20 and 21 under § 103.

ORDER

The Examiner's decision rejecting claims 1-4, 6-8, 10-16, 18-24, and 26-31 is reversed.

REVERSED

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