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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte SCOTT A. ROSENBERG

Appeal 2011-000819
Application 10/033,401
Technology Center 3600

Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and
BIBHU R. MOHANTY, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Scott A. Rosenberg (Appellant) seeks our review under 35 U.S.C. § 134 of the final rejection of claims 1, 7-10, 12, 13, 20, 21, 23, 27-33, and 35-38. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We REVERSE.¹

¹ Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed Apr. 21, 2010) and Reply Brief ("Reply Br.," filed Sep. 16, 2010), and the Examiner's Answer ("Answer," mailed Jul. 20, 2010).

THE INVENTION

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A method of placing an ad into a digital video output stream of a digital video recorder (DVR), the method comprising:

while the digital video output stream of the (DVR) includes an index of programs recorded at the DVR but does not include the ad or video of a program recorded at the DVR, the DVR detecting that the digital video output stream should change from the index of programs recorded at the DVR to the video of the program recorded at the DVR;

the DVR obtaining the ad;

the DVR placing the ad into the digital video output stream so that the digital video output stream simultaneously includes the index of programs recorded at the DVR and the ad but does not include the video of the program recorded at the DVR, wherein the DVR that places the ad into the digital video output stream outputs the digital video output stream to a display device that is connected directly to the DVR, and wherein the ad wipes across a screen of the display device starting from a first side of the screen and ending at a second side of the screen without overlapping any portion of the index of programs recorded at the DVR or any portion of the video of the program recorded at the DVR; and

thereafter, the DVR removing the index of programs recorded at the DVR from the digital video output stream and adding the video of the program recorded at the DVR to the digital video output stream so that the digital video output stream simultaneously includes the video of the program recorded at the DVR and the ad but does not include the index of programs recorded at the DVR.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Borchardt	US 5,272,525	Dec. 21, 1993
Barton	US 2001/0049820 A1	Dec. 6, 2001
Klug	US 2003/0195797 A1	Oct. 16, 2003
Nihei	US 7,337,456 B1	Feb. 26, 2008

“Official Notice is taken that it was well known to enhance video content by including visual transitions between portions of video content. One typical video transition has been traditionally referred to as a "wipe" - much as applicant describes in his figure 3(d) and referred to as a "wipe" in the instant specification and current claims. A long time ago George Lucas used this technique heavily in the Star Wars original trilogy (1977+) whereby a first scene (first video mode) was wiped over by a second scene (second video mode). In the middle stages of this wipe, both scenes were simultaneously on the screen but without overlap. One of ordinary skill has understood that video transitions such as a "wipe" (and others such as "dissolve", "fade", "blinds", etc.) help smooth or create fanciful transitions between different video portions” Answer 4-5 (in discussing claims 1, 20, 21, 27, 28, 33, 35, and 36). [Official Notice I]

“Official Notice is taken that TV commercials have for decades included cartoon animation, such as the Snap, Crackle and Pop characters for Kellogg's Rice Krispies TM.” Answer 6 (in discussing claim 12). [Official Notice II]

“Official Notice is taken that some TV advertising has for years included a still image (for example a textual ad for a business which textually lists the name, address and phone number of the business) which is rendered as video frames for a period of time long enough for a viewer to read the pertinent information. Another example is the ubiquitous FBI warning message text screen that has accompanied purchased/rented movies for many years before applicant's filing date.” Answer 6 (in discussing claim 23). Official Notice III.

The following rejections are before us for review:

1. Claims 1, 7-10, 12, 13, 20, 21, 23, 27, 28, 31, 33, 35, and 36 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Barton and Official Notice I-III.
2. Claims 29 and 30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Barton, Official Notice I-III, and Borchardt.
3. Claim 32 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Barton, Official Notice I-III, and Klug.
4. Claims 37 and 38 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Barton, Official Notice I-III, and Nihei.

ISSUE

Would the cited prior art combination lead one of ordinary skill in the art to a method of placing an ad into a digital video output stream of a digital video recorder (DVR) with, as claimed,

the DVR placing the ad into the digital video output stream so that the digital video output stream simultaneously includes the index of programs recorded at the DVR and the ad but does not include the video of the program recorded at the DVR

(independent claim 1; similar language is used in the other independent claims 20 and 37)?

ANALYSIS

With respect to the claim limitation at issue, as part of establishing a prima facie case of obviousness, the Examiner found that “it is unstated in Barton whether or not there is any simultaneous display of 1st mode (the

index/menu) with the ad or whether or not there is any simultaneous display of the ad with the 2nd mode (the requested program). However it is clear that Barton teaches a sequence of 1st mode (index/menu),... advertising... 2nd mode (the requested program).” Answer 4. In response the Appeal Brief, the Examiner elaborates:

Examiner is aware of the claim language, but merely was summarizing that Barton fails to teach displaying the advertising simultaneously with either the index of programs or with the recorded program. The action should however make it clear that Barton indeed teaches transitioning from an Index of programs TO an advertisement AND THEN from the advertisement TO the recorded program. Barton fails to describe the nature of the transitions *Examiner agrees that Barton fails to teach "outputs simultaneously includes the index of programs recorded at the DVR (e.g., the list 201) and the ad but does not include the video of the program recorded at the DVR".* The silence on the simultaneous display of two adjacent video segments was reason to bring in the Official Notice (wipe transition) in an obvious rejection. Barton is assumed by the examiner to provide a DVR which places a stream displayed on the viewers TV screen which includes the index_of_programs --> advertising --> recorded_program. Therefore the claim language is met, save for the nature of the transitions (the arrows: -->.

Answer 9-10. Emphasis added.

We understand from the record (reproduced above) that the Examiner found that Barton does not disclose the claim limitation at issue. It appears that the Examiner is relying on Official Notice I as evidence that this subject matter that is missing from Barton was known in the art at the time of the invention. The Examiner’s position appears to be that the combination of Barton and Official Notice I would lead one of ordinary skill in the art to

the method as claimed, with “the DVR placing the ad into the digital video output stream so that the digital video output stream simultaneously includes the index of programs recorded at the DVR and the ad but does not include the video of the program recorded at the DVR” (claim 1).

The difficulty with the Examiner’s position is the reliance on Official Notice I as teaching the subject matter of the claim limitation at issue said to be missing from Barton. We do not see it. We do not see how a “typical video transition [such as] has been traditionally referred to as a “wipe”” (Answer 4) reasonably suggests placing an ad into a digital video output stream so that the digital video output stream simultaneously includes an index of programs recorded at the DVR and the ad but does not include the video of the program recorded at the DVR. To one of ordinary skill in the art a “wipe” is a type of video transition whereby an image is displaced by another. This does not provide one of ordinary skill with sufficient knowledge about (a) placing an ad into a digital video output stream, (b) providing a digital video output stream that simultaneously includes an index of programs recorded at the DVR and the ad; (c) providing such a stream but not including the video of the program recorded at the DVR; and (d) the DVR placing the ad into a digital video output stream so that (c) and (d) are accomplished. Given nothing else, we do not find that the cited prior art combination art would not lead one of ordinary skill in the art to a method of placing an ad into a digital video output stream of a digital video recorder (DVR) with, as claimed,

the DVR placing the ad into the digital video output stream so that the digital video output stream simultaneously includes the index of programs recorded at the DVR and the ad but does not include the

video of the program recorded at the DVR
(independent claim 1; similar language is used in the other independent
claims 20 and 37).

For the foregoing reasons, the rejections are not sustained.

CONCLUSIONS

The rejections of claims 1, 7-10, 12, 13, 20, 21, 23, 27, 28, 31, 33, 35,
and 36 as being unpatentable over Barton and Official Notice I-III; claims
29 and 30 as being unpatentable over Barton, Official Notice I-III, and
Borchardt; claim 32 as being unpatentable over Barton, Official Notice I-III,
and Klug; and, claims 37 and 38 as being unpatentable over Barton, Official
Notice I-III, and Nihei, are reversed.

DECISION

The decision of the Examiner to reject claims 1, 7-10, 12, 13, 20, 21,
23, 27-33, and 35-38 is reversed.

REVERSED

JRG