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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte SEAN CHRISTOPHER ENDLER and HIROSHI YASUTOMI

Appeal 2011-005814
Application 10/820,338¹
Technology Center 2600

Before THU A. DANG, JAMES R. HUGHES, and
GREGORY J. GONSALVES, *Administrative Patent Judges*.

HUGHES, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ Application filed Apr. 7, 2004 claiming benefit from Provisional Application 60/484,282 filed Jul. 2, 2003. The real party in interest is Sony Corporation.

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-28, which are all of the remaining claims. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Invention

Appellants' invention relates generally to displaying and rating content and, more particularly, to interactively displaying and rating content. (Spec. 1, ll. 12-13.)²

Representative Claim

Independent claim 1, reproduced below with the key disputed limitations emphasized, further illustrates the invention:

1. A method of interactively displaying and rating at least one string of content, comprising:

receiving at least one string of content, the at least one string of content receiving step comprising streaming the at least one string of content in real-time for viewing while being captured;

separating each at least one string of content into a plurality of segments, each segment of the plurality of segments having a corresponding plurality of original in-and-out points;

creating profile information, in a record, associated with each segment of the plurality of segments of each at least one string of content, *the record identifying a plurality of new in-and-out points within the plurality of original in-and-out points, thereby providing a plurality of in-and-out points within each segment;*

² We refer to Appellants' Specification ("Spec.") and Appeal Brief ("Br.") filed Sep. 2, 2010. We also refer to the Examiner's Answer ("Ans.") mailed Nov. 24, 2010.

showing the at least one string of content on at least one display device;

receiving a vote on each segment of the plurality of segments of each at least one string of content, wherein the vote reflects the quality of each segment of the plurality of segments of each at least one string of content, thereby providing a rating value for establishing a quantifiable significance corresponding to the plurality of in-and-out points of each segment; and

updating the profile information associated with each segment of the plurality of segments of each at least one string of content to reflect the vote using the rating value.

Rejections on Appeal

1. The Examiner rejects claims 1-6 and 8-15 under 35 U.S.C. § 103(a) as being unpatentable over Franken (U.S. Patent No. 7,028,323 B2 issued Apr. 11, 2006 (filed June 15, 2001)), Zilliacus (U.S. Pat. Pub. 2004/0005900 A1 published Jan. 8, 2004 (filed Jul. 5, 2002)), and Taniguchi (U.S. Pat. Pub 2003/0093810 A1 published May 15, 2003).

2. The Examiner rejects claims 7, 16, 17, 20-26, and 28 under 35 U.S.C. § 103(a) as being unpatentable over Franken, Zilliacus, Taniguchi, and Peliotis (U.S. Pat. Pub. 2002/0065678 A1, published May 30, 2002).

3. The Examiner rejects claim 18 and 19³ under 35 U.S.C. § 103(a) as being unpatentable over Franken, Zilliacus, Taniguchi, Peliotis, and Lautzenheiser (U.S. Patent No. 7,054,827 B1 issued May 30, 2006 (filed Sep. 24, 1997)).

³ The Examiner's Grounds of Rejection does not address claim 19. Appellants, with respect to claim 19, do not provide any arguments, nor do they raise any objections. Accordingly, we find the Examiner's omission of claim 19 to be harmless error and amend the statement of rejection to include claim 19 with claim 18 on which it depends.

Grouping of Claims

Based on Appellants' arguments in the Briefs, we will decide the appeal on the basis of representative claim 1. *See* 37 C.F.R. § 41.37(c)(1)(vii).

ISSUES

1. Under § 103, did the Examiner err in finding that Franken, Zilliacus, and Taniguchi would have taught or suggested "record identifying a plurality of new in-and-out points within the plurality of original in-and-out points, thereby providing a plurality of in-and-out points within each segment" within the meaning of independent claim 1 and commensurate language of claim 15?
2. Under 103, did the Examiner err in combining Franken, Zilliacus, and Taniguchi?
3. Did the Examiner err by not making the present application "special"?

ANALYSIS

Providing a Plurality New of In-and-Out Points

Appellants contend, *inter alia*,

The Appellants respectfully submit that Taniguchi does not actually teach, suggest, motivate, or otherwise obviate the following claimed limitation, *inter alia*: "record identifying a plurality of **new in-and-out points within** the plurality of **original in-and-out points**, thereby providing a plurality of **in-and-out points within each segment**" in light of the meaning in the originally filed specification and that the Examiner has

misinterpreted the meaning of "in-and-out points" as described in the Appellants' Specification (p. 9, ll. 13-21).

(App. Br. 16.)

At the outset, we observe that the limitations argued by Appellants ("in-and-out points) are not positively recited and do not alter the steps performed in claim 1. We construe the claimed "in-and-out points" to be data that is used only to update the profile information and, therefore, the argued limitation consists of merely non-functional descriptive material and a statement of intended use (of the record, which is also data). Non-functional descriptive material and statements of intended use are not afforded patentable weight.

The informational content of the data thus represents non-functional descriptive material, which "does not lend patentability to an otherwise unpatentable computer-implemented product or process." *Ex parte Nehls*, 88 USPQ2d 1883, 1889 (BPAI 2008) (precedential). *See Ex parte Curry*, 84 USPQ2d 1272, 1274 (BPAI 2005) (informative) (Fed. Cir. Appeal No. 2006-1003), *aff'd*, (Rule 36) (June 12, 2006) ("wellness-related" data in databases and communicated on distributed network did not functionally change either the data storage system or the communication system used in the claimed method). *See also In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004); *Nehls*, 88 USPQ2d at 1887-90 (discussing non-functional descriptive material). This reasoning is applicable in the present case. How the string of content is separated into a plurality of segments- i.e., using a plurality of "in-and-out points" does not further limit the claim structurally or functionally. While the ratings of the "in-and-out points" are used to update the profile information, the updated profile information is not positively

recited in claim 1 – that is, the data (updated profile information) is not recited as being utilized in anyway.

Assuming *arguendo* that the claimed “in-and-out points” are afforded patentable weight, we agree with the Examiner that the cited combination of references collectively would have taught or suggested the limitations recited in claim 1. Firstly, we conclude that the Examiner’s construction of the phrase “in-and-out points” was broad and reasonable in light of Appellants’ Specification. We observe that Appellants’ Specification does not specifically define the phrase “in-and-out points”. However, Appellants’ Specification does describe the use of in-and-out points:

Further, the content identification module 320 also separates a group of content containing multiple pieces of content into separate pieces. For example, in video footage, multiple video segments are serially recorded and are separated by the start/stop signal. In one embodiment, the content identification module 320 detects the start/stop signal and separates each video segment as a different piece of content. For example, the start/stop signal corresponds to the use of the video camera record button and is translated into “in and out points”[.]

(Spec. 9, 8-14.)

Accordingly, we agree with and adopt the Examiner’s construction of “in-and-outpoints”. (Ans. 19.) We particularly agree with the Examiner that “. . . the specification does not explicit [sic] define the in-and-out points as corresponding only to the use of a video camera record button nor does it preclude segmentation using predetermined time intervals from being start/stop signals (i.e. start at the beginning of the time interval and stop at the end).” (*Id.*) Therefore, we find the Examiner’s construction of the claimed “in-and-out points” to be broad and reasonable in light of

Appellants' Specification.⁴ Further, we note that Appellants failed to file a Reply Brief to rebut the findings and responsive arguments made by the Examiner in the Answer. Any such arguments are hereby waived.⁵

Based on this construction, we agree with the Examiner's finding that Taniguchi teaches "original in-and-out points" (whole video data) and "a plurality of new in-and-out points" (partial video data within the whole video data), as claimed.

In addition, we agree with the Examiner that the cited references would have taught or suggested "**providing a rating value for establishing a quantifiable significance corresponding to the plurality of in-out points of each segment.**" (See Br. 19, Ans. 5.) The Examiner relied upon Zilliacus to teach or suggest that rating video segments was well-known at the time of Appellants' invention. (Ans. 5.)

Combinability

Appellants contend that the Examiner "fails to explain how Franken et al.'s device may be modified to generate a plurality of new in-and-out points within a plurality of original in-and-out-points using a rating value, *inter*

⁴ "Though understanding the claim language may be aided by explanations contained in the written description, it is important not to import into a claim limitations that are not part of the claim. For example, a particular embodiment appearing in the written description may not be read into a claim when the claim language is broader than the embodiment." *Superguide Corp. v. DirectTV Enterprises, Inc.*, 358 F.3d 870, 875 (Fed. Cir. 2004).

⁵ With respect to all claims before us on appeal, arguments which Appellants could have made but chose not to make have not been considered and are deemed to be waived. *Ex parte Borden*, 93 USPQ2d 1473, 1474 (BPAI 2010) (informative).

alia, i.e., ascertained the differences between the prior art and the claims at issue.” (Br. 22.)

The combined teachings of Franken, Zilliacus, and Taniguchi form a combination of known elements, which render representative claim 1 obvious. “[W]hen a patent ‘simply arranges old elements with each performing the same function it had been known to perform’ and yields no more than one would expect from such an arrangement, the combination is obvious.” *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 417 (2007) (*quoting Sakraida v. Ag Pro, Inc.*, 425 U.S. 273, 282 (1976)). The operative question is “whether the improvement is more than the predictable use of prior art elements according to their established functions.” (*Id.*)

We conclude that the combination of Franken, Zilliacus, and Taniguchi teaches or suggests a plurality of new in-and-out points within a plurality of original in-and-out-points using a rating value as recited in claim 1. Appellants have not shown that the improvements are anything more than a predictable use of known components according to their established functions. Accordingly, we find that the Examiner did not err in rejecting claim 1, and we affirm the Examiner’s § 103 rejection of representative claim 1 as unpatentable over Franken, Zilliacus, and Taniguchi.

Official Notice

Appellants also contend;

Alternatively, the Appellants respectfully submit that the Examiner has not sustained the rejection of Claims 4-6 on this basis of obviousness in merely taking Official Notice that “capturing content, **particularly television programs**, using a digital video camera that also records the audio associated with the video” is a well-known concept in the art in a blanket statement without proffering any object evidence to support the

assertion or any evidence to support obviousness for the foregoing limitation in combination with all recited elements and limitations of the base claim and any intervening claims. The Appellants hereby respectfully traverse this Official Notice taken by the Examiner and further respectfully submit that the Examiner has conceded that such Official Notice does **not** constitute admitted prior art for failure to so state in the April 29, 2010, Final Office Action (p. 6, 11. 13-17).

(Br. 22.)

In response to Appellants' arguments with respect to the Examiner's Official Notice, *supra*, the Examiner submitted Kitayama (U.S. Pat. Pub. 2003/0058866 published Mar. 27, 2003), as evidence that a television camera for capturing video and audio content was well-known at the time of Appellants' invention. (Ans. 22.) We agree with and adopt the Examiner's findings with respect to the teachings of Kitayama. (*Id.*) Further, as noted above, Appellants did not traverse the Examiner's findings in a Reply Brief. Based on this record, we conclude that Appellants have not shown the Examiner erred in rejecting dependent claims 4-6.

We also note that Appellants did not present arguments for the patentability of dependent claims 2, 3, and 8-14 with particularity. (Br. 21.) Accordingly, we affirm the Examiner's rejection of claims 2, 3, and 8-14 for the same reasons as claim 1.

Based on this record, we conclude that the Examiner did not err in determining that the cited references would have taught or suggested representative claim 1. Accordingly, we affirm the Examiner's rejection of claims 1-6 and 8-15.

Claims 7, 16, 17, 20-26, and 28

Appellants contend that the cited references fails to teach or suggest various limitations recited in independent claim 1 (fully discussed *supra*), as well as independent claims 16, 21, and 25, and further contend that remaining dependent claims 7, 17, 20, 22-24, 26, and 28, should be allowable for the same reasons as the independent claims from which they depend. (Br. 26 *et seq.*)

We observe that Appellants argue essentially the same issues for claims 16, 21, and 25 that were previously and fully discussed *supra* regarding independent claims 1 and 15. (Br. 27-37.) We adopt the Examiner's findings with respect to claims 16, 21, and 25. (Ans. 11-13, 14-15.) We need not repeat the discussion regarding here.

Appellants also contend:

. . . the rejection on this basis is actually grounded in impermissible hindsight reconstruction by piecing together the cited references (**four**) by using the Appellant's claimed invention as a roadmap. The Examiner has merely made a blanket statement that one of ordinary skill would combine the teachings of Franken et al. (US 7028323), Zilliacus (US 2004/0005900), Taniguchi (US 2003/0093810), and Peliotis (US 2002/0065678) without presenting any evidence thereof.

(Br. 38.) We disagree.

While “rejections on obviousness grounds cannot be sustained by mere conclusory statements” and “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). “[A]ny 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.” *In re ICON Health and Fitness, Inc.*, 496 F.3d 1374, 1380 (Fed. Cir. 2007) (quoting *KSR*, 550 U.S. at 420)

With respect to the issue of hindsight, in *KSR* the U.S. Supreme Court reaffirmed that “[a] factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning.” *KSR*, 127 S. Ct. at 1742. *See also Graham v. John Deere Co.*, 383 U.S. at 36. Nevertheless, in *KSR* the Supreme Court also qualified the issue of hindsight by stating that “[r]igid preventative rules that deny factfinders recourse to common sense, however, are neither necessary under our case law nor consistent with it.” *KSR*, 127 S. Ct. at 1742-43.

As mentioned by Appellants, the Examiner presented a rationale for the combination. (Ans. 5-6.) We conclude that the Examiner provided an articulated reasoning with some rational underpinning for combining the cited references.

Application to Be Made Special

Appellants further contend that the Examiner erred in not making the present application special under MPEP §§ 707.02 and 708.01. (Br. 48-49.) We observe that Appellants have not, prior to the filing of the present Appeal, filed a formal request or petition, or otherwise requested the present application be made special.

We also observe that the failure of the Examiner in not making the present application special, is not subject matter that is appealable before the Patent Trial and Appeal Board (PTAB) (*see* 35 U.S.C. § 134). Petitionable matters, as opposed to appealable matters, do not fall under the jurisdiction of the PTAB and are not properly brought before us. *In re Berger*, 279 F.3d 975, 984-85 (Fed. Cir. 2002). *See* 37 C.F.R. § 1.181. *See also* MPEP

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§ 706.01 (“[T]he Board will not hear or decide issues pertaining to objections and formal matters which are not properly before the Board.”); MPEP § 1201 (“The Board will not ordinarily hear a question that should be decided by the Director on petition . . .”). Accordingly, the issue of whether the Examiner erred in not making the present application “special” is not before us. We note, however, that the Examiner has made an effort to advance disposal of the present application. (Ans. 23.)

CONCLUSIONS OF LAW

Appellants have not shown that the Examiner erred in rejecting claims 1-25 under 35 U.S.C. § 103(a).

DECISION

We affirm the Examiner’s rejection of claims 1-25 under 35 U.S.C. § 103(a).

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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