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EXAMINER
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* MICHAEL WAYNE SHORE

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Appeal 2012-008394  
Application 11/491,269  
Technology Center 2400

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Before ROBERT E. NAPPI, ELENI MANTIS MERCADER, and  
DEBRA K. STEPHENS, *Administrative Patent Judges*.

STEPHENS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134 from a final rejection of claims 1–7, 9–42, and 44–62. We have jurisdiction under 35 U.S.C. § 6(b). Claims 8 and 43 have been cancelled.

We AFFIRM.

INVENTION

According to Appellant, the claims are directed to a method and apparatus for creating and editing video and/or audio tracks to create a

custom track. Abstract. Claim 1, reproduced below, is representative of the claimed subject matter:

1. A method for creating a custom presentation, the method comprising:

providing at least one artist and track available of a live musical performance from a plurality of venues, each live musical performance including at least one complete song for selection;

providing, on a server, a plurality of clips associated with the at least one artist and track for each of the plurality of venues, at least one of the plurality of clips including footage of a predetermined audience location, the predetermined audience location being marked to indicate that presence within the predetermined audience location is captured for inclusion of the at least one of the plurality of clips; and

allowing a user to access the server to create a custom presentation from the clips.

## REFERENCES

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

Freeman	US 2002/0188943 A1	Dec. 12, 2002
Rui	US 2002/0196327 A1	Dec. 26, 2002
Horlander	US 6,507,953 B1	Jan. 14, 2003
Watkins	US 2004/0071321 A1	Apr. 15, 2004
Allen	US 2004/0117427 A1	June 17, 2004
Tinker	US 2006/0064536 A1	Mar. 23, 2006
Abrams	US 2006/0104600 A1	May 18, 2006
Gurvey	US 7,603,321 B2	Oct. 13, 2009

## REJECTIONS

Claims 1–6 and 59–61 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Abrams, Freeman, Gurvey, Rui, and Watkins. Final Rej. 4–13.

Claims 39–42, 44–49, 54–56, and 58 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Abrams, Freeman, Rui, and Watkins. Final Rej. 13–17.

Claim 57 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Abrams, Freeman, Rui, Watkins, and Horlander. Final Rej. 17.

Claims 7, 9–25, 27–33, 35–38, 50–53, and 62 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Abrams, Freeman, Tinker, Rui, and Watkins. Final Rej. 17–24.

Claim 26 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Abrams, Freeman, Tinker, Rui, Watkins, and Allen. Final Rej. 24–25.

Claim 34 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Abrams, Freeman, Tinker, Rui, Watkins, and Horlander. Final Rej. 25.

We have only considered those arguments that Appellant actually raised in the Briefs. Arguments Appellant could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(iv).

ISSUE 1

*35 U.S.C. § 103(a): Claims 1–6 and 59–61*

The issues presented by Appellant’s arguments are:

*Issue 1a:* Has the Examiner erred by finding the combination of Abrams, Freeman, Gurvey, Rui, and Watkins teaches or suggests “at least one of the plurality of clips including footage of a predetermined audience location, the predetermined audience location being marked to indicate that presence within the predetermined audience location is captured for inclusion of the at least one of the plurality of clips,” as recited in claim 1?

*Issue 1b:* Has the Examiner erred by improperly combining the teachings of Abrams, Freeman, Gurvey, Rui, and Watkins?

ANALYSIS

Appellant argues the proposed combination of Rui’s random audience shots of a lecture and Watkin’s indicators for an adult and child to stand on, to prevent child abduction “with the myriad of other prior art references” is improper. App. Br. 16. Appellant further argues an ordinarily skilled artisan would not have modified any live event system or method of Abrams, Freeman, and Gurvey “to allow an audience member later, or a third person to take clips of a marked, predetermined audience location of a live musical performance” because Rui teaches random audience shot(s) of an audience member asking a question. *Id.* at 16–17. Moreover, Appellant argues the entire audience area cannot be a marked, predetermined audience location as this is an unreasonably broad interpretation. Reply Br. 1, 5–7.

We are not persuaded. We agree with the Examiner’s findings and conclusions. Ans. 26–27. We further emphasize the claim does not

preclude the entire audience area from being a marked, predetermined audience location. Nor do we find marking a part of or an entire audience beyond the skill of an ordinarily skilled artisan. Moreover, in light of Rui's teaching of a predetermined audience location being captured for inclusion of the at least one of the plurality of clips and Watkin's teaching of a predetermined location being marked to indicate that presence within the predetermined location is captured for inclusion in a clip, we are not persuaded marking an audience location "to indicate that presence within the predetermined audience location is captured for inclusion" in a clip, would have been uniquely challenging or beyond the skill of an ordinarily skilled artisan. Indeed, we are not persuaded the disputed limitation would not have been obvious to an ordinarily skilled artisan in light of the teachings of the cited references.

Appellant additionally argues that an ordinarily skilled artisan would not have combined the teachings of the cited references. App. Br. 17. According to Appellant, "[t]he Examiner is attempting to attribute a reason to combine references to a teaching from Watkins that is selectively plucked out of context from the disclosure of Watkins." *Id.* Appellant argues the purpose of the indicator in Watkins is different from the indicator recited in their claim.

We are not persuaded and instead, agree with the Examiner's findings and conclusion. Ans. 27–28. We emphasize Appellant is arguing limitations not recited in the claim.

Appellant argues the goal of Watkins is filming to preventing abduction of a child. App. Br. 15. According to Appellant, Watkins must be considered as a whole in a proper obviousness analysis and the indicator

taught by Watkins is not provided for the benefit of the party being photographed. *Id.* at 17.

We are not persuaded by Appellant's arguments. The Examiner is not relying on Watkins' teachings as a whole being incorporated into the combined teachings of Abrams, Freeman, Gurvey, and Rui. Instead, the Examiner is relying on Watkins' teaching of placing signs and indicators at a desired location to mark the particular area that is to be captured by a camera(s). Ans. 28. "To justify combining reference teachings in support of a rejection it is not necessary that a device shown in one reference can be physically inserted into the device shown in the other." *In re Keller*, 642 F.2d 413, 425 (CCPA 1981) (citations omitted).

Appellant continues the Examiner has not demonstrated teaching that a user wants to ensure they are captured by a camera while in the marked, predetermined location. App. Br. 18. Again, Appellant is arguing limitations not recited in the claim -- the claim does not require a person in the predetermined audience location know or be assured that presence within the predetermined audience location is captured. The claim requires only that the location is marked to indicate that presence within the predetermined audience location is captured. Claims Appendix, Claim 1.

Next, Appellant argues the Examiner used impermissible hindsight in combining the teachings of the cited references. App. Br. 19–20; Reply Br. 2–5. We are not persuaded by Appellant's allegation of impermissible hindsight reconstruction. "Common sense teaches [] that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle." *KSR Int'l v. Teleflex Inc.*, 550 U.S. 398,

420 (2007). We determine the teachings relied upon by the Examiner, are simply an arrangement of old elements yielding no more than would one expect. Furthermore,

The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.

*Keller* 642 F.2d at 425. Here, we are *not* persuaded an ordinarily skilled artisan would *not* have found it obvious to combine the teachings of providing footage of a predetermined audience location as taught by Rui. Moreover, we are *not* persuaded an ordinarily skilled artisan would *not* have found it obvious to combine the teachings of the cited references to provide various types of clips, including clips from a predetermined audience location marked to indicate presence within that location is captured for inclusion. Indeed, “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR* 550 U.S. at 416.

Appellant’s additional argument that Rui and Watkins teach away from the combination also is unavailing. App. Br. 20–21. Appellant has not persuaded us Rui and Watkins, taken alone or in combination, criticize, discredit, or otherwise discourage modifying the combination of Abrams, Freeman, and Gurvey. Appellant instead is arguing each of the references has a different purpose. App. Br. 20–21. Therefore, we are not persuaded either Rui and/or Watkins teaches away from the combination of Abrams, Freeman, and Gurvey.



Accordingly, we are not persuaded the Examiner erred in combining the teachings and suggestions of Abrams, Freeman, Gurvey, Rui, and Watkins. Appellant does not separately argue claims 2–6, 60, and 61. Accordingly, we sustain the rejection of claims 1–6 and 59–61.

## ISSUE 2

*35 U.S.C. § 103(a): Claims 39–42, 44–49, 54–56, and 58; Claims 7, 9–25, 27–33, 35–38, 50–53, and 62; Claims 26, 34, and 57*

Appellant asserts their invention as recited in claims 39–42, 44–49, 54–56, and 58 is not obvious over Abrams, Freeman, Rui, and Watkins; and as recited in claims 7, 9–25, 27–33, 35–38, 50–53, and 62 is not obvious over Abrams, Freeman, Tinker, Rui, and Watkins. App. Br. 21–23, 25–26. Appellant argues combining the teachings of Abrams, Freeman, Rui, and Watkins is improper because the Examiner uses improper hindsight reconstruction and Rui and Watkins teach away from the combination for the same reasons described with respect to claims 1 and 59. *Id.* at 22, 25. We are not persuaded for the reasons set forth above with respect to claims 1 and 59 in Issue 1 above.

Appellant further argues Tinker does not provide an apparent reason to modify Abrams, Freeman, Rui, or Watkins to include Tinker’s teaching. *Id.* at 26. The Examiner has articulated reasoning with a rational underpinning and Appellant has not persuaded us this reasoning is in error.

Indeed, Appellant has not provided sufficient evidence or argument to persuade us the Examiner improperly combined the respective references by using improper hindsight reconstruction or by using Rui and Watkins which teach away from the combination.

With respect to claims 26, 34, and 57, Appellant argues each of the claims is patentable over the cited prior art because the Examiner improperly combined the references. App. Br. 23–24, 27–29. Appellant summarizes Allen and Horlander, respectively, in a sentence; asserts neither Allen nor Horlander teaches or suggests “the provision of a marked area within a venue for a live performance in which audience members are assured that their presence in the area will be captured by a camera for inclusion in a track” and “a predetermined crowd location being marked to indicate presence within the predetermined crowd location is captured by a video camera,” respectively. *Id.* at 24, 27–28. Appellant next argues neither Horlander nor Allen provides an apparent reason to modify the respective combination to include the relied upon teaching. *Id.*

We are not persuaded. The Examiner has articulated reasoning with a rational underpinning as to why an ordinarily skilled artisan would have been motivated to combine the teachings and suggestions of the cited prior art. Appellant has not proffered sufficient evidence or argument to persuade us the Examiner has erred. Indeed, Appellant has not argued the Examiner’s articulated reasoning is in error.

Accordingly, we are not persuaded the Examiner erred in rejecting claims 39–42, 44–49, 54–56, and 58 and claims 7, 9–25, 27–33, 35–38, 50–53, and 62 under 35 U.S.C. § 103(a) for obviousness.

#### OTHER ISSUES

We further note all of Appellant’s arguments are predicated on the *content* of the plurality of clips. Our reviewing court has held that nonfunctional descriptive material cannot lend patentability to an invention

that would have otherwise been anticipated by the prior art. *In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004). *Cf. In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983) (noting that when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). *King Pharm., Inc. v. Eon Labs, Inc.*, 616 F.3d 1267, 1279 (Fed. Cir. 2010) (“[T]he relevant question is whether ‘there exists any new and unobvious functional relationship between the printed matter and the substrate.’”) (citations omitted).

The specific content of clips being provided on the server is non-functional. Specifically, Appellant is arguing the content of the clips being provided on a server. The content of the clips is not positively recited as affecting the function of being provided on a server or allowing a user to access the server. Instead, the recitation of the clips is directed to clips associated with an artist(s) and track for venues including footage of a predetermined audience location. The recitation continues that the predetermined audience location is from a specific location; however, clips from a predetermined audience location being “marked to indicate that presence within the predetermined audience location is captured for inclusion” in the clip(s) is not positively recited as affecting the recited functions of *providing* clips on a server or *allowing* a user to access the server. Nor do any of these recited specifics of the clips’ contents affect the recited invention structurally. Even if one were to consider such a recitation function, the claimed clips differ only from the prior art in the content of the clips, which is not a patentable distinction.

It has been repeatedly held that an Applicant cannot create a novel product by attaching printed matter to it, even if that printed matter itself is new. *See, e.g., Ngai*. Thus, adding instructions to a kit that describe a method of using it does not make the kit patentable over the same kit with a different set of instructions. There are cases in which the descriptive material can form a functional relationship with the underlying substrate. For example, in *In re Miller*, 418 F.2d 1392, 1396 (CCPA 1969), the addition of printed matter to the outside of a cup permitted an otherwise ordinary cup to be used like a measuring cup for half of the recipes. The printed matter in *Miller* served as a computing or mathematical recipe conversion device permitting a cook to perform calculations automatically with no further thought.

The claim before us is more like the claim in *Ngai* than *Miller*. The clips being footage of a marked predetermined audience location does not change the method of providing clips on a server nor does a video camera recording a marked predetermined audience location change the system of a video camera recording a video track. It merely describes a non-functional feature for a product that already exists (and as set forth above, we determine the feature is taught by the cited prior art).

To agree with Appellant's reasoning would result in each instance of creating a custom presentation or track that includes providing video clips on a server, that are accessible to a user; and each system that captures and stores video clips of an event, that includes video cameras recording various portions of the event, being sufficient to warrant a separate patent based on the content of the clips, even if the remainder of the invention is unchanged. To give effect to Appellant's argument, we would need to ignore our

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reviewing court's concerns with repeated patenting. We decline to do so. Therefore, we agree the prior art references render the recited invention obvious because any argued difference between the cited prior art and the recited invention is a substitution of one clip for another clip, which does not change the functioning or structure of the recited method and system.

#### DECISION

The Examiner's rejection of claims 1–7, 9–42, and 44–62 under 35 U.S.C. § 103(a) as being unpatentable 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). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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