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EXAMINER

DASGUPTA, SHOURJO

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DONG LIU and QIRU ZHOU

Appeal 2014-005260
Application 12/608,068
Technology Center 2100

Before JOHN P. PINKERTON, JEFFREY A. STEPHENS, and
CARL L. SILVERMAN, *Administrative Patent Judges*.

STEPHENS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants¹ seek our review under 35 U.S.C. § 134(a) from the Examiner's Final Office Action ("Final Act.") rejecting claims 1–25, which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

¹ The real party in interest is identified as Alcatel Lucent. (App. Br. 1.)

Claimed Subject Matter

The claimed invention generally relates to network-based collaborated telestration² on video, images, or other shared visual content. (Title.) Claim 1, reproduced below, is illustrative:

1. An apparatus comprising:

a telestration server comprising a processor coupled to a memory, the telestration server being configured to communicate with a plurality of telestration clients over a network;

the telestration server being further configured to receive telestration input signals from respective ones of the clients and to send telestration output signals to the respective clients, with the telestration output signal sent to a given one of the clients comprising telestration information derived from the telestration input signal received from at least one other one of the clients, such that each of the clients with support of the telestration server can generate a combined telestration overlay for presentation with associated visual content shared between the clients;

wherein the shared visual content comprises a video signal having a plurality of frames; and

wherein the telestration server sends the telestration output signal to the given client in a format that permits combination in the given client of the combined telestration overlay with the video signal on a frame-by-frame basis, the given client thereby combining frames of the video signal with respective frames of the combined telestration overlay.

² The Specification provides that “[c]onventional telestration techniques include various arrangements in which a freehand sketch drawn by a broadcast television operator is superimposed over live video in a broadcast video signal.” (Spec. 1:10–12.)

Rejections

Claims 14 and 23 stand rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. (Final Act. 2–3.)

Claims 1–9, 12–16, 18–20, and 22–25 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Parmer et al. (WO 03/041033 A1, published May 15, 2003) and Hartung et al. (US 2011/0314511 A1, published Dec. 22, 2011). (Final Act. 4–27.)

Claim 10 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Parmer, Hartung, and Melamed et al. (US 2010/0257282 A1, published Oct. 7, 2010). (Final Act. 28–29.)

Claim 11 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Parmer, Hartung, and Ruths et al. (US 2003/0009603 A1, published Jan. 9, 2003). (Final Act. 29–31.)

Claims 17 and 21 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Parmer, Hartung, and Tomlinson et al. (US 2005/0179702 A1, published Aug. 18, 2005). (Final Act. 31–34.)

ANALYSIS

We have reviewed the Examiner’s rejections in light of Appellants’ arguments the Examiner erred (App. Br. 7–19; Reply Br. 2–7). We are not persuaded by Appellants’ arguments. We adopt as our own the findings and reasons set forth by the Examiner in the action from which this appeal is taken and set forth in the Answer (*see* Ans. 2–9). We highlight and address specific arguments and findings for emphasis as follows.

Section 101 Rejection

Claims 14 and 23 are directed to “[a] computer-readable storage medium” with executable program code that causes a telestration server to perform the steps of method claims 12 and 19, respectively. Appellants argue the Specification does not recite that computer-readable storage media may include transitory signals, and instead describes computer-readable media as being various articles of manufacture such as storage disks and devices, optical media, or magnetic media. (App. Br. 7–8 (citing Spec. 14:11–16).) We agree with the Examiner, however, that the Specification’s reference to “other types of magnetic or optical media” (Spec. 14:16) “may be broadly but reasonably construed to read upon signals, i.e. non-statutory embodiments” (Ans. 3). The Specification provides that disks are an example of computer-readable storage media, but does not describe the “other types” of media as limited to articles of manufacture such as disks.

In addition, the Board has held that “those of ordinary skill in the art would understand the claim term ‘machine-readable storage medium’ would include signals *per se*.” *Ex parte Mewherter*, 107 USPQ2d 1857, 1862 (PTAB 2013) (precedential in relevant part). Because neither the Specification nor the claims have been amended to exclude non-transitory embodiments of such media, we are bound by *Mewherter* to sustain the Examiner’s rejection of claims 14 and 23 under 35 U.S.C. § 101.

Section 103 Rejections

Claims 1–8 and 12–25

Appellants argue “[t]he Examiner has provided no evidence or support for the assertion that the final content in the shared video space in

Parmer is “rendered in per-frame basis” or “that ‘all display devices perform their display feature in such a way.’” (App. Br. 10 (quoting Final Act. 5).)

In the Answer, however, the Examiner further explains:

To elaborate, the examiner believes the essential nature of any kind of video data or signal is that video constitutes a collection of image frames such that the image frames are shown in succession to create the effect of a moving image. It then logically follows that to modify a video, one must necessarily alter the video’s essential components, i.e. the frames. For example, one could not change the color of a brick wall without affecting the color of all or at least some of the bricks that make up that brick wall. In that same way, one cannot discernibly introduce a new visual quality to a video (e.g., an overlaid image, a timestamp, etc.) without essentially introducing that same visual quality into all or at least some of the image frames that when animated produce the video product. Accordingly, video modification necessarily and therefore inherently requires the modification of image frames that together comprise a video.

(Ans. 4; *see also* Ans. 3–5.) We find the Examiner’s explanation sufficiently provides a basis in fact and/or technical reasoning to reasonably support the determination that the *frame-by-frame basis* limitation of claim 1 necessarily must be present, or the natural result of the combination of elements explicitly disclosed by Parmer and Hartung.

In the Reply Brief, Appellants again assert “[t]he Examiner has not provided sufficient evidence that the combination of Parmer and Hartung unavoidably teaches these features” (Reply Br. 2–3), but Appellants do not challenge the Examiner’s findings directly or persuasively explain any error therein. Accordingly, we are not persuaded the Examiner erred in finding the combined teachings of Parmer and Hartung teach the telestration server sends the telestration output signal in a format that permits combination with the video signal *on a frame-by-frame basis*, as recited in claim 1.

Appellants next contend Parmer teaches away from combining telestration output with a video signal on a frame-by-frame basis. (App. Br. 11–12; Reply Br. 3–4.) In particular, Appellants emphasize portions of Parmer that indicate delays in some circumstances between when freeform drawings or text are input to annotate content and when the annotations appear on other client devices. (See App. Br. 11–12 (citing Parmer 30:14–23, 31:16–20, 32:3–10).) Appellants do not persuasively explain why such a delay indicates that combination of the telestration overlay with the video signal would not be on a *frame-by-frame basis* when combined. To the extent Appellants contend a *frame-by-frame basis*, as recited in claim 1, imposes a requirement that the telestration overlay be combined with the video signal frame-by-frame *in real time*, Appellants’ argument is not commensurate with the broadest reasonable scope of claim 1, which does not impose a real-time requirement.

Appellants also argue Hartung is non-analogous art. (App. Br. 13–14.) In particular, Appellants contend Hartung is not in the same field of endeavor as the claimed invention because claim 1 is directed to an apparatus comprising a telestration server configured for receiving telestration input signals and sending telestration output signals, while Hartung does not disclose telestration. (App. Br. 13.) Appellants also assert Hartung is not reasonably pertinent to the problem with which claim 1 is involved. Appellants state the claimed invention’s problem to be solved is to “provide ‘a telestration system that facilitates collaboration on shared visual content between an arbitrary number of participants connected via a network such as the Internet, without requiring dedicated special-purpose hardware at each site.’” (App. Br. 13–14 (quoting Spec. 2:7–10).)

Appellants state that Hartung is unrelated because it “appears to describe techniques for watermarking content to be distributed to a plurality of end user devices wherein ‘each marked digital signal forms a unique version of the digital signal.’” (App. Br. 14 (quoting Hartung ¶ 10).)

We agree with the Examiner that Hartung is analogous art to the claimed invention. (*See* Ans. 6–7.) Appellants over-emphasize the importance of relating specifically to “telestration” or use of that term. We agree with the Examiner that Hartung teaches a network that allows the sharing of video content with a remotely-situated user, and that a client or near-client device receiving the video signal may combine the video signal with another input signal to create a composite video product. (Ans. 6 (citing Hartung ¶¶ 2–5, 11, 16).) Based on these teachings, we agree Hartung is at least reasonably pertinent to the problem addressed by the present application. An inventor considering how to facilitate collaboration on shared visual content for a number of participants connected via a network such as the Internet, without requiring dedicated special-purpose hardware at each site, would naturally look to Hartung’s teachings directed to using a device close to an end user device to receive digital content and combine that content signal with another signal to present to a user on a standard computer (*see* Hartung ¶¶ 3, 11). Therefore, Appellants’ arguments have not persuaded us that Hartung is not analogous art.

Accordingly, for the reasons discussed above and by the Examiner, we are not persuaded the Examiner erred in rejecting claim 1 under 35 U.S.C. § 103(a) as unpatentable over Parmer and Hartung. Thus, we sustain the rejection of claim 1, and, for the same reasons, the rejection of

claims 2–8, 12–16, 18–20, and 22–25, which are not argued separately (App. Br. 14).

Appellants do not present additional argument in support of claims 17 and 21. Thus, for the same reasons as claim 1, we sustain the rejection of claims 17 and 21 under 35 U.S.C. § 103(a) as unpatentable over Parmer, Hartung, and Tomlinson.

Claim 9

Claim 9 depends from claim 1 and recites that the telestration server is configured *to receive from a source of the shared visual content at least one synchronization signal that is utilized by the telestration server in generating the telestration output signals sent to the respective clients*. Appellants argue Parmer’s synchronization tool merely allows a teacher to direct a student’s attention to particular information by repositioning the student’s whiteboard to match the location in the content scrolled to by the teacher, but argue the teacher is not *a source of the shared visual content* as recited in the claim. (App. Br. 14–15.) The antecedent basis for *the shared visual content* in claim 9 is *associated visual content shared between the clients*, as recited in claim 1. Appellants do not persuasively explain why the teacher device in Parmer is not a source of content shared between the clients. The cited portion of Parmer indicates the teacher and student are viewing the same content, and the teacher’s device is the source of any annotations added by the teacher. (*See, e.g.*, Parmer 32:3–10; Final Act. 10.)

Accordingly, for the reasons discussed above and by the Examiner (Final Act. 10–11; Ans. 7), we are not persuaded the Examiner erred in

rejecting claim 9 under 35 U.S.C. § 103(a) as unpatentable over Parmer and Hartung. Thus, we sustain the rejection of claim 9.

Claim 10

Claim 10 depends from claim 1 and recites that *a first one of the telestration output signals sent to a first one of the clients comprises telestration information derived from the telestration input signal received from at least a second one of the clients but no telestration information derived from the telestration input signal received from the first client.* As Appellants point out (App. Br. 16), claim 10 is directed to the instance where the telestration signal sent to the first client does not include its own telestration information because “such local drawing and text commands are supplied directly to the video renderer 322 from the associated drawing client 324” (App. Br. 17 (quoting Spec. 9:4–8)).

Appellants argue Melamed “has nothing to do with telestration,” and, therefore, cannot teach the limitations of claim 10 relating to telestration and is non-analogous art. (App. Br. 16–17; Reply Br. 5–6.) The Examiner clarifies that Parmer and Hartung, relied on to reject underlying claim 1, are relied on for specific aspects related to telestration, and that Melamed was cited relevant to selective communication between nodes in a network. (Ans. 8.) Appellants do not persuasively explain why these teachings in Melamed would not logically commend themselves to an inventor considering how best to share information among multiple clients in a network. In particular, the Examiner finds Melamed teaches excluding particular clients from broadcast messages, and that this optimization requires fewer messages. (Final Act. 28–29 (citing Melamed ¶¶ 43, 49).)

We agree with the Examiner that, in view of these teachings, one of ordinary skill in the art would have had reason to modify the combination of Parmer and Hartung to exclude from the telestration output signal sent to a particular client information received from that client. (*See* Final Act. 28–29.)

Accordingly, for the reasons discussed above and by the Examiner, we are not persuaded the Examiner erred in rejecting claim 10 under 35 U.S.C. § 103(a) as unpatentable over Parmer, Hartung, and Melamed. Thus, we sustain the rejection of claim 10.

Claim 11

Claim 11 depends from claim 1 and recites that *a first one of the telestration output signals sent to a first one of the clients comprises telestration information derived from the telestration input signal received from at least a second one of the clients in addition to telestration information derived from the telestration input signal received from the first client*. Appellants argue Ruths, relied on in rejecting claim 11, is unrelated to telestration and, therefore, cannot teach the limitations of claim 11 relating to telestration and is non-analogous art. (App. Br. 18; Reply Br. 6.) As discussed above, we are not persuaded that failure to recite the term “telestration” renders a reference non-analogous, and the Examiner clarifies in the Answer that Ruths is not relied on for limitations specific to telestration. (*See* Ans. 8–9.)

Accordingly, for the reasons discussed above and by the Examiner, we are not persuaded the Examiner erred in rejecting claim 11 under 35 U.S.C. § 103(a) as unpatentable over Parmer, Hartung, and Ruths. Thus, we sustain the rejection of claim 11.

CONCLUSION

We affirm the Examiner's decision to reject:

- (1) claims 14 and 23 under 35 U.S.C. § 101 as directed to non-statutory subject matter;
- (2) claims 1–9, 12–16, 18–20, and 22–25 under 35 U.S.C. § 103(a) as unpatentable over Parmer and Hartung;
- (3) claim 10 under 35 U.S.C. § 103(a) as unpatentable over Parmer, Hartung, and Melamed;
- (4) claim 11 under 35 U.S.C. § 103(a) as unpatentable over Parmer, Hartung, and Ruths;
- (5) claims 17 and 21 under 35 U.S.C. § 103(a) as unpatentable over Parmer, Hartung, and Tomlinson.

DECISION

We affirm the Examiner's decision to reject claims 1–25.

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