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EXAMINER
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CARLOS, ALVIN LEABRES

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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* PAUL PHILIP THURSFIELD,  
HERJEN MATHIJS OLDENBEUVING, LISA TANIA SMITH, and  
PETER PENNING

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Appeal 2014-008277  
Application 12/442,410<sup>1</sup>  
Technology Center 3700

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Before JOHN C. KERINS, STEFAN STAICOVICI, and  
FREDERICK C. LANEY, *Administrative Patent Judges*.

STAICOVICI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Paul Philip Thursfield et al. (Appellants) appeal under 35 U.S.C. § 134(a) from the Examiner's final decision rejecting claims 1–7. We have jurisdiction over this appeal under 35 U.S.C. § 6(b).

SUMMARY OF DECISION

We REVERSE.

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<sup>1</sup> According to Appellants, the real party in interest is U.S. Philips Corporation. Appeal Br. 3 (filed Mar. 6, 2014).

## INVENTION

Appellants' invention relates to an interactive storyteller system and computer program product. Spec. 1, ll. 2–5.

Claims 1 and 7 are independent. Claim 1 is illustrative of the claimed invention and reads as follows:

1. An interactive storyteller system, comprising electronic circuitry, the electronic circuitry being operative to:
  - allow a user to select data associated with a book, the data comprising:
    - a plurality of words, one or more of said plurality of words being presented to said user as underlined;
    - a plurality of associations, each of the plurality of associations being between said one or more underlined words and an output signal;
  - detect one or more spoken words associated with a corresponding one of said one or more underlined words;
  - look up an association corresponding to said detected one or more spoken words in the plurality of associations; and
  - reproduce the output signal associated with the one or more spoken words.

Appeal Br. 24 (emphasis omitted).

## REJECTIONS

The following rejections are before us for review:

- I. The Examiner rejected claims 1, 2, 6, and 7 under 35 U.S.C. § 103(a) as being unpatentable over Cogliano (US 6,405,167 B1, iss. June 11, 2002).
- II. The Examiner rejected claim 3 under 35 U.S.C. § 103(a) as being unpatentable over Cogliano and Blume (US 6,915,103 B2, iss. July 5, 2005).

- III. The Examiner rejected claims 4 and 5 under 35 U.S.C. § 103(a) as being unpatentable over Cogliano and Spector (US 2002/0031754 A1, pub. Mar. 14, 2002).

## ANALYSIS

### *Rejection I*

Independent claim 1 requires, *inter alia*, “electronic circuitry being operative to . . . allow a user to select data [and] detect one or more spoken words associated with a corresponding one of said one or more underlined words.” Appeal Br. 24 (Claims App.). Claim 1 also recites that “the data compris[es] . . . a plurality of words, one or more of said plurality of words being presented to said user as underlined.” *Id.* (emphasis omitted).

Independent claim 7 is drawn to a computer program product that includes electronic circuitry reciting similar limitations as noted above. *Id.* at 25–26.

The Examiner finds that “Cogliano discloses the claimed invention except for the specific content of indicia such as ‘one or more words are underlined’ (printed matter) set-forth in claim 1.” Final Act. 2–3 (transmitted Oct. 8, 2013) (citing Cogliano, col. 2, ll. 21–44, col. 3, ll. 2–9, 11–15 and 25–39, col. 4, ll. 53–67, col. 5, ll. 1–3, Figs. 1, 5). The Examiner concludes that “it would have been obvious to one having ordinary skill in the art at the time of the invention was made to substitute any indicia to Cogliano’s book, since it would only depend on the intended use of the assembly and the desired information to be displayed.” *Id.* The Examiner further takes the position that the limitation “one or more of said plurality of

words being presented to said user as underlined” constitutes nonfunctional descriptive material and thus cannot impart patentability. *Id.*

Appellants argue that “as Cogliano discloses marking the wording **AFTER** a spoken word is detected (and pronounced correctly) Cogliano fails to disclose that the spoken word is one of the one or more plurality of words **underlined that had been presented to the user.**” Appeal Br. 14. Thus, according to Appellants, “Cogliano fails to disclose the element of ‘detectin[g] one or more spoken words associated with a corresponding one of the underlined words,’ as Cogliano fails to disclose words that are underlined before they are spoken.” *Id.*

In response, the Examiner sets forth a new ground of rejection by withdrawing both the reasoning<sup>2</sup> set forth in the Final Action to modify the disclosure of Cogliano and the position that the limitation “one or more of said plurality of words being presented to said user as underlined” constitutes nonfunctional descriptive material. *See* Ans. 5–7 (transmitted June 10, 2014). The Examiner further states that

the feature of ‘plurality of words being presented to said user as underlined, ... detecting spoken words that would have relation with corresponding underlined words,’ does not necessarily require specific sequence of operation that present the underline data first to a user before allowing said user to select data based on the presented underline data.

Ans. 9; *see also* Adv. Act 2 (transmitted Dec. 20, 2013).

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<sup>2</sup> We note that the Examiner’s new ground of rejection under 35 U.S.C. § 103(a) fails to include any reasoning with rational underpinnings for modifying the disclosure of Cogliano. *See* Ans. 2–3.

We do not agree with the Examiner's position that independent claims 1 and 7 do not require a sequential order. As noted above, the recited "electronic circuitry" is operative to permit a user to select data that includes one or more underlined words and to detect spoken words "associated with a corresponding one of said one or more underlined words." *See* Appeal Br. 24. As the user selects data that includes underlined words and the detected spoken words are "associated with . . . underlined words," we agree with Appellants that the "spoken words are associated with a corresponding one of the underlined words, which were already presented to the user." Reply Br. 7. Hence Appellants are correct that

contrary to the assertion that the underlining [does] "not necessarily require specific sequence of operation" . . . the claims explicitly recite the order of presenting underlined words to the user and when spoken words associated with the corresponding underlined words is detected, then an action associated with the underlined words is taken.

*Id.* at 8.

In Cogliano, a child speaks into microphone 28 words 18 from pages 14, 16 of book 12 and the audio input is converted into a series of digitized words that are compared to the words on a speech recognition chip. *See* Cogliano, col. 3, ll. 15–19, Fig. 1. The speech recognition chip is in communication with a memory chip that holds the exact page and location of the spoken word such that when the child properly enunciates the word, a light emitting diode 20 associated with the spoken word is illuminated. *Id.* at col. 3, ll. 19–27, col. 5, ll. 58–65, Figs. 1, 5. As such, in Cogliano, the words are highlighted (underlined) after the child has spoken.

We thus agree with Appellants that Cogliano fails to disclose that an “underlined (or highlighted) word exist[s] prior to detection of the word being spoken.” Reply Br. 9. Rather, “Cogliano performs marking (e.g., an underlining) of a spoken word *after* the spoken word is determined to have been spoken correctly.” *Id.* at 8.

Moreover, even assuming *arguendo* that we accept the Examiner’s construction of the term “associated” to mean “related” (*see* Ans. 9), nonetheless, the language of claims 1 and 7 still requires the detection of a spoken word that is “related” (associated) to an underlined (highlighted) word, and for the reasons set forth *supra*, Cogliano fails to disclose such a feature.

In conclusion, for the foregoing reasons, we do not sustain the rejection under 35 U.S.C. § 103(a) of claims 1, 2, 6, and 7 as unpatentable over Cogliano.

### *Rejections II and III*

The Examiner’s use of the Blume and Spector disclosures does not remedy the deficiencies of Cogliano discussed *supra*. *See* Final Act. 5–6; Ans. 4–5. Therefore, for the same reasons, we also do not sustain the rejections under 35 U.S.C. § 103(a) of claim 3 as unpatentable over Cogliano and Blume, and of claims 4 and 5 as unpatentable over Cogliano and Spector.

Appeal 2014-008277  
Application 12/442,410

SUMMARY

The Examiner's decision to reject claims 1-7 is reversed.

REVERSED