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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte GREGORY ELLIS

Appeal 2015-001454
Application 12/110,691
Technology Center 2600

Before JOHNNY A. KUMAR, JOHN A. EVANS, and
MATTHEW J. McNEILL, *Administrative Patent Judges*.

KUMAR, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) of the Final Rejection of claims 13, 14, and 16–62.¹ We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ Claims 1–12 and 15 were previously cancelled.

INVENTION

The invention is directed to remote audio/video stream recording, storage, and delivery over the Internet and other networks. (Spec. 1 and 7.)

Claim 13 is illustrative and is reproduced below:

13. An Internet-based recording method for recording audio and video material over an Internet connection established between a user front end and a host back end, the method comprising:

delivering a user interface over the Internet for use in an Internet browser on a receiving device, wherein the user interface is executed through the Internet browser at the user front end and initiates the streaming of audio and video material from the receiving device on the user front end to the host back end over the Internet, the audio and video material streamed over the Internet as it is being captured with the receiving device, not as a complete video file on the user front end;

recording the audio and video material on the host back end and storing the recorded audio and video material as a complete video file;

generating code associated with the recorded and stored audio and video material to facilitate accessing the recorded and stored audio and video material from an additional location, wherein the content of the generated code depends on a type of code supported by the additional location; and

enabling the generated code to be copied and pasted to the additional location, wherein activating the generated code provides access to the recorded audio and video material from the additional location.

REFERENCES

Liu	US 5,794,257	Aug. 11, 1998
Ludwig	US 2001/0044826 A1	Nov. 22, 2001
Liwerant	US 2002/0056123 A1	May 9, 2002
Avrunin	US 6,523,008 B1	Feb. 18, 2003

REJECTIONS AT ISSUE²

- A. Claims 13, 14, and 16–62 are rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. (Final Act. 8; Ans. 2.)
- B. Claims 13, 14, and 16–62 are rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the enablement requirement. (Final Act. 8; Ans. 3.)
- C. Claims 13, 14, 16–21, 23–31, 33–39, 50, 51, and 53–59 are rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Liwerant, Ludwig, and Liu. (Final Act. 11; Ans. 5.)
- D. Claims 22, 32, 40–49, 52, 60, and 61 are rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Liwerant, Ludwig, Liu, and Applicant Admitted Prior Art (“AAPA”). (Final Act. 31; Ans. 25.)
- E. Claims 13, 14, 16–21, 23–31, 33–39, 50, 51, and 53–59 are rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Liwerant, Ludwig, German, and Avrunin. (Final Act. 40; Ans. 34.)
- F. Claims 22, 32, 40–49, 52, 60, and 61 are rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Liwerant, Ludwig, Liu, German, Avrunin, and AAPA. (Final Act. 62; Ans. 56.)

² In the event of further prosecution we leave it to the Examiner to consider whether or not any of the prior art rejections are cumulative. *See* Manual of Patent Examining Procedure (MPEP) § 706.02(I), 9th ed., Rev. 7, Nov. 2015.

- G. Claim 62 is rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Liwerant, Ludwig, Liu, and German or Avrunin. (Final Act. 72; Ans. 66.)

ANALYSIS

Written Description

Issue 1 – *Did the Examiner err in rejecting claims 13, 14, and 16–62 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement?*

Appellant contends:

the specification describes that generated code “is created differently . . . depending on whether the website at which the code is to be posted is a full HTML (hypertext markup language) supported site 142 (such as eBay), or only a limited HTML supported site 144 (such as Yahoo Auction).” *See* page 11, lines 8-13. Moreover, the specification provides further support on pages 12 and 13 for generating different code based on the type of code supported by the additional location.

The Office alleges that these passages of the specification only support that the code is associated with the audio/video content and that the code is created differently. These passages support the claimed language because these passages describe how the code is generate (created) based on the additional location (“depending on whether the website at which the codes is to be posed is a full HTML supported site or only a limited HTML supported site”). [(Spec. 11.)] As stated in MPEP § 2163.02, the subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement.

(App. Br. 14–15.)

Sufficiency of written description requires that the original disclosure reasonably convey to a person having ordinary skill in the art that the inventor had possession of the claimed subject matter at the time of filing.

The exact level of detail required depends upon “the nature and scope of the claims and on the complexity and predictability of the relevant technology.” *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc).

The Examiner finds “[n]owhere in the original specification discloses ‘wherein the content of the generated code depends on the type of [code supported by the] additional location,’ thus, the specification as originally filed does not provide support for the claimed limitation.” (Ans. 67.)

We disagree with the Examiner’s findings and agree with Appellant’s contentions. We disagree with the Examiner because we find a person of ordinary skill in the art would recognize that Appellant’s disclosure provides support for the recited “wherein the content of the generated code depends on a type of code supported by the additional location” as recited in claim 13 and as commensurately recited in each of independent claims 20, 30, 40, and 50. In particular, we find Appellant’s disclosure at Specification pages 12–13 provides adequate disclosure by providing a specific example of HTML code for a full HTML auction and a differing specific example for a limited HTML auction.

Accordingly, Appellant has provided sufficient evidence or argument to persuade us of at least one reversible error in the Examiner’s written description rejection of claim 13. Therefore, for essentially the same reasons argued by Appellant cited above, we reverse the Examiner’s rejection of independent claim 13, and also reverse the rejection of independent claims 20, 30, 40, and 50, which recite the disputed limitation in commensurate form. For the same reasons, we also reverse the rejections under 35 U.S.C.

§ 112, first paragraph, written description, of all dependent claims: 14, 16–19, 21–29, 31–39, 41–49, and 51–62.

Enablement

Issue 2 – *Did the Examiner err in rejecting claims 13, 14, and 16–62 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement?*

Appellant argues:

the delivery of the user interface, where the user interface is executed through the Internet browser at the front end and initiates or allows uploaded of audio and/or video material is supported with sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention. For example, page 7, lines 19–23 of the specification discloses that “a user accesses a web page that includes the user interface of the recording, storage, and delivery system 10,” where “[t]he user interface 40 provides a virtual recording room for the user that is accessed through a web browser.”

(App. Br. 16.)

The Examiner finds:

Nowhere in [Specification page 7] discloses “delivering user interface over the internet for use in Internet browser.” In fact, nowhere in the above portion is “delivering user interface code” implied. At best, the Specification describes accessing a webpage through the use of a web browser but does not require “delivering a user interface over the Internet.”

(Ans. 68.)

The Manual of Patent Examining Procedure (MPEP) guides: “[a] patent need not teach, and preferably omits, what is well known in the art.” MPEP § 2164.01; *see also In re Buchner*, 929 F.2d 660, 661 (Fed. Cir.

1991). Moreover, the scope of enablement is not limited to what is disclosed in the specification; it also includes “what would be known to one of ordinary skill in the art without undue experimentation.” *Abbott Labs v. Andrx Pharmaceuticals, Inc.*, 452 F.3d 1331, 1341 (Fed. Cir. 2006) (citation omitted).

The “enablement requirement is satisfied when one skilled in the art, after reading the specification, could practice the claimed invention without undue experimentation.” *AK Steel Corp. v. Sollac*, 344 F.3d 1234, 1244 (Fed. Cir. 2003) (citation omitted). Whether undue experimentation is required is a legal conclusion reached by weighing several underlying factual inquiries. *See In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988):

Factors to be considered in determining whether a disclosure would require undue experimentation . . . include (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims.

The Examiner has not clearly addressed any of the above *Wands* factors except for the second. (*See* Ans. 67–68; Final Act. 8–11.)

The Examiner specifically finds, “The specification does not disclose how the user interface is delivered to the front [end] and how the code is executed at the front end to initiate up stream or upload material [and] [w]ithout such disclosure the specification is non-enabl[ing].” (Final Act. 10.)

We disagree with the Examiner’s findings and agree with Appellant’s contentions. Specifically, Specification page 7, lines 19–23, discloses “a user accesses a web page that includes the user interface 40 of the recording,

storage, and delivery system 10.” We agree with Appellant that a user accessing a web page that includes the user interface is a delivery of a user interface over the Internet for use in an Internet Browser. (*See* App. Br. 16.) Thus, we agree with Appellant that one skilled in the art, after reading the Specification could practice the claimed invention without undue experimentation. (*See id.*)

Accordingly, Appellant has provided sufficient evidence or argument to persuade us of at least one reversible error in the Examiner’s enablement rejection of claim 13. Therefore, for essentially the same reasons argued by Appellant cited above, we reverse the Examiner’s rejection of independent claim 13, and also reverse the rejection of independent claims 20, 30, 40, and 50, which recite the disputed limitation in commensurate form. For the same reasons, we also reverse the rejections under 35 U.S.C. § 112, first paragraph, enablement, of all dependent claims: 14, 16–19, 21–29, 31–39, 41–49, and 51–62.

Obviousness

Issue 3 – *Did the Examiner err in finding that the combination of Liwerant, Ludwig, and Liu teaches or suggests “delivering a user interface over the Internet for use in an Internet browser on a receiving device, wherein the user interface is executed through the Internet browser at the user front end” as recited in claim 13 and similarly recited in claims 20, 30, 40, and 50?*

Appellant argues the VideoShare Producer software taught by Liwerant does not deliver “a user interface over the Internet for use in an Internet browser, *wherein the user interface is executed through the Internet browser* at the user front end.” (App. Br. 19.) Specifically, Appellant argues “the software in Liwerant includes a software application

package may be operated by the user under his control *in the computer system.*” (App. Br. 19.) Appellant contends “Liwerant requires that the user operate software *in* the user’s computer system, which is markedly different form [sic] simply utilizing a user interface *over the Internet in a browser.*” (App. Br. 19–20.)

The Examiner finds Liwerant teaches web browsers such as Microsoft Internet Explorer and teaches delivering/downloading application software to the user front end. (Ans. 69 (citing Liwerant ¶¶ 77, 78, 83, 92, and 97).) Liwerant paragraph 83 teaches “the user can obtain a copy of the VideoShare Producer 20 software by downloading a copy of the software from the Website www.VideoShare.com 50.” We agree with the Examiner that downloading VideoShare Producer software from a website is within the scope of delivering the software over the internet. Liwerant paragraph 90 further teaches “[t]he VideoShare Producer Active X Control can also be embedded into a web page, as is done within the www.VideoShare.com 50 web site.” The VideoShare Producer Active X Control embedded into the web page is within the scope of the claim limitation “wherein the user interface is executed through the internet browser” as recited in claim 13 and similarly recited in claims

Accordingly, we are unpersuaded the Examiner erred in rejecting the above claim limitation of issue 3.

Issue 4 – *Did the Examiner err in finding that the combination of Liwerant, Ludwig, and Liu teaches or suggests “wherein the user interface . . . initiates the streaming of audio and video material from the receiving device on the user front end to the host back end over the Internet, the audio and video material streamed over the Internet as it is being captured with the*

receiving device, not as a complete video file on the user front end” as recited in claim 13 and similarly recited in claims 20, 30, 40, and 50?

Appellant argues for the first time in the Reply Brief that:

In every cited portion, however, Liwerant discloses first **recording** a complete video file (which it calls a “segment”) and storing it on the user's computer, and **then** automatically uploading the file to an Internet server **after it has been recorded** (even though the Examiner asserts that VideoShare Producer is executed at the user computer for uploading or streaming of audio and video material, the Examiner has not cited to a specific portion of Liwerant that discloses streaming as claimed).

(Reply Br. 9.)

This argument does not appear to be responsive to any argument raised in the Examiner’s Answer, and Appellant has not shown good cause as to why this argument could not have been presented earlier. Therefore, this argument will not be considered. 37 C.F.R. § 41.41(b)(2).

However, even if this argument were to be considered, Liwerant figure 1D teaches “Record Directly from Input Device” to record a streaming video file. Liwerant paragraph 78 teaches “transmitting a video segment . . . to a host computer.” A person having ordinary skill in the art would have known that video segments could be transmitted in multiple ways including streaming the video segment(s). Indeed, Liwerant teaches streaming video throughout, for example, Liwerant’s title teaches “sharing a streaming video.” Liwerant paragraph 86 teaches “[t]he video segment and the identifier(s) are transmitted to the host computer 60 for storage and for later distribution. In one embodiment, the video segment is transmitted in a streaming video file format.” Transmitting the video segment to the host computer in a streaming format is an initiation of streaming audio and video

material over “the Internet as it is being captured with the receiving device, not as a complete video file on the user front end” as recited by claim 13 and commensurately recited by claims 20, 30, 40, and 50.

Accordingly, we are unpersuaded the Examiner erred in rejecting the above claim limitation of issue 4.

Issue 5 – *Did the Examiner err in finding that the combination of Liwerant, Ludwig, and Liu teaches or suggests “generating code associated with the recorded and stored audio and video material . . . wherein the content of the generated code depends on a type of code supported by the additional location” as recited in claim 13 and similarly recited in claims 20, 30, 40, and 50?*

Appellant argues,

Liwerant, Ludwig, and Liu do not disclose, “***generating code associated with the recorded and stored audio and video material*** to facilitate accessing the recorded and stored audio and video material from an additional location, wherein the content of the generated code ***depends on a type of code supported by the additional location.***”

(App. Br. 21.)

The Examiner finds “the identification tag, or another identifier of the video, such as the thumbnail and/or the URL, [taught by Liwerant paragraph 48] . . . is sufficient to read on ‘wherein the content of the generated code depends on a type of supported code associated with the additional location.’” (Ans. 70–71.)

Appellant argues there is a difference between creating uniform links and “generating code . . . wherein the content of the generated code depends on a type of code supported by the additional location.” (Reply Br. 11.)

Appellant argues “[e]ven if the URLs included generated code, which they

do not, there is nothing in Liwerant that teaches or suggest that the URLs are generated based on any type of supported code associated with a specific additional location as claimed.” (Reply Br. 12.)

This issue turns on claim construction. The Board “determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction ‘in light of the specification as it would be interpreted by one of ordinary skill in the art.’” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005) (quoting *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004)). The broadest reasonable interpretation of claim 13 covers, *at a minimum*, the corresponding supporting embodiment(s) described in the Specification. We emphasize, however, that under a broad but reasonable interpretation applied by the USPTO (or the more narrow construction applied by the federal courts), the scope of the claims are not limited to the preferred embodiments described in the Specification. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1323 (Fed. Cir. 2005) (en banc) (“although the specification often describes very specific embodiments of the invention, we have repeatedly warned against confining the claims to those embodiments” and “claims may embrace ‘different subject matter than is illustrated in the specific embodiments in the specification.’”) (citations and internal quotation marks omitted).

We find Specification page 12 line 1 to page 13 line 5 provides two examples of generated code content. In the example for limited HTML auctions, Specification page 13 lines 1–5 state content code:

```
<a  
href="http://www.auctionvideo.com/player.htm?applInstance='+  
appInstance+'&streamNumber='+streamNumber+'"></a>
```

This is a link to the URL

“<http://www.auctionvideo.com/player.htm?applInstance='+appInstance+'&streamNumber='+streamNumber+'>.” Therefore the content of the generated code includes at least links to URLs. Liwerant paragraph 48 teaches “the identification tag, such as a link to a URL.” Therefore, we agree with the Examiner that the identification tag is within the scope of the recited “content of the generated code.” (*See Ans. 70–71.*)

Claim 13 further recites that the content of the generated code “depends on a type of code supported by the additional location.” In the example for full HTML auctions, Specification page 12 lines 19–31 provide an example of an embedded FlashPlayer Macromedia object. Liwerant paragraph 48 teaches “[t]he identification tag . . . such as the thumbnail and/or the URL is communicated . . . [and] can provide the identifier to another viewer, for example, by way of a Web page, or by an e-mail.” The identifier is code that is generated in a different format (e.g., thumbnail or URL) depending on whether the identifier is being communicated in an email or embedded in a web page, which support different code. Therefore, we agree with the Examiner that the identification tag is within the scope of the limitation “generating code associated with the recorded and stored audio and video material . . . wherein the content of the generated code depends on a type of code supported by the additional location” as recited by claim 13 and similarly recited by independent claims 20, 30, 40, and 50. (*See Ans. 70–71.*)

Accordingly, we sustain the Examiner's rejection of independent claims 13, 20, 30, 40, and 50. Similarly, we sustain the Examiner's rejection of dependent claims 14, 16–19, 21–29, 31–39, 41–49, and 51–62, which were not argued separately. *See* App. Br. 23–26.

DECISION³

The Examiner's decision to reject claims 13, 14, and 16–62 under 35 U.S.C. §112, first paragraph for lack of written description and enablement is reversed.

³ In the event of further prosecution of this application, we leave it to the Examiner to determine whether independent claim 30 meets the requirements of 35 U.S.C. §§ 101 and 112. We leave the following questions to the Examiner.

(1) Whether or not the phrases “module that” and “generator that” are generic placeholders for “means for” and invoke 35 U.S.C. § 112, sixth paragraph. *See* Manual of Patent Examining Procedure (MPEP) § 2181(I), 9th ed., Rev. 7, Nov. 2015.

(2) If the Examiner determines claim 30 does not invoke 35 U.S.C. § 112, sixth paragraph, whether or not claim 30 is directed to software *per se* and should be rejected under 35 U.S.C. § 101 as not directed to one of the four categories of statutory subject matter. *See* MPEP § 2106(I).

(3) If the Examiner determines claim 30 does invoke 35 U.S.C. § 112, sixth paragraph, whether or not the Specification discloses sufficient corresponding structure linked to the claimed function(s). *See* MPEP § 2181(II)–(IV) (“[I]f there is no corresponding structure disclosed in the specification . . . the limitation should be deemed indefinite . . . and the claim should be rejected under . . . pre-AIA 35 U.S.C. 112, second paragraph” and rejected under 35 U.S.C. § 112, first paragraph for lack of written description.)

Although the Board is authorized to reject claims under 37 C.F.R. § 41.50(b), no inference should be drawn when the Board elects not to do so. *See* MPEP § 1213.02.

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The Examiner's obviousness rejection of claims 13, 14, and 16–62 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)(1)(iv).

AFFIRMED