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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DAVID CANORA and ROBERT A. SWIRSKY

Appeal 2015-007807
Application 13/158,887
Technology Center 2600

Before ALLEN R. MacDONALD, MICHAEL M. BARRY and
JOHN R. KENNY, *Administrative Patent Judges*.

MacDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134(a) from a final rejection of claims 1–5 and 7–24. Final Act. 1. Claim 6 has been cancelled. App. Br. 14. We have jurisdiction under 35 U.S.C. § 6(b).

Exemplary Claim

Exemplary claim 1 under appeal reads as follows (emphasis added):

1. A system for adding a creative element to media, the system comprising:

a memory;

a processor;

a media file, stored in the memory, having content and metadata associated with the content;

logic for analyzing the content to determine a presence of a marker, a unique identifier, and at least one of a lighting characteristic and a shadow characteristic associated with the content;

a creative element store configured to store, in the memory, a plurality of creative elements;

a creative element addition module, for execution by the processor, configured *to determine*, using the metadata, the marker, and the unique identifier associated with the content, *which ones of the plurality of creative elements are to be added to the content*;

a rendering engine, for execution by the processor, configured to develop a three dimensional rendering of the ones of the plurality of creative elements to be added to the content, the three dimensional rendering including at least one of the lighting characteristic and the shadow characteristic; and

a compositor, for execution by the processor, configured to add the three dimensional rendering of the ones of the plurality of creative elements into the content.

Rejections¹

The Examiner rejected claims 1–5 and 7–24 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Wells (US 2009/0073164 A1, published Mar. 19, 2009) and Demaine (US 2011/0084983 A1, published Apr. 14, 2011).²

Appellants' Contentions

1. Appellants contend that the Examiner erred in rejecting claim 1 under 35 U.S.C. § 103(a) because:

[B]oth the Final Office Action and the Advisory Action are silent about the how Wells or Demaine disclose the limitations: “determine . . . **which ones** of the plurality of creative elements are to be added to the content.”

App. Br. 8.

Wells is only discussing a determination of the reflection, shadows, transparency, etc., and a determination of a location of the 3D objects in the 3D image, such as in front of or behind other 3D objects. *Id.* Even if, *ad arguendo*, the reflection, transparency, etc., and the location of the 3D objects were considered to be “creative elements,” by any stretch of imagination or construction, the aforementioned determination in Wells still falls short of being a determination of “**which ones** of the plurality of creative elements are to be added to the content,” as recited by independent claim 1.

App. Br. 8–9.

¹ We note that line 8 of claim 8 of record ends with a typographical error (missing the word “content”) which has previously been communicated to Appellants. Notification of Non-Compliant Appeal Brief at page 2. Should there be further prosecution before the Examiner, correction is warranted.

² Separate patentability is not argued for claims 2–5 and 7–24. App. Br. 11. Except for our ultimate decision, these claims are not discussed further herein.

2. Appellants also contend that the Examiner erred in rejecting claim 1 under 35 U.S.C. § 103(a) because:

[J]ust like Wells, Demaine fails to disclose, teach or suggest the limitations “determine . . . *which ones* of the plurality of creative elements are to be added to the content,” as recited by claim 1. Rather, Demaine merely discloses how objects in a non-virtual world can be rendered in a virtual world.

App. Br. 10.

3. Appellants also contend that the Examiner erred in rejecting claim 1 under 35 U.S.C. § 103(a) because:

[T]he Answer asserts that Wells discloses “a creative element store configured to store, in the memory, a plurality of creative elements,” as recited by independent claim 1.

Reply Br. 2 (explaining the Examiner identifies the teaching in Wells of determining hue, saturation, and brightness value (HSV) or red, green, and blue (RGB) pixel values for the “creative elements”).

However, at the same time, when it serves the Answer’s arguments, the Answer considers “reflection, shadows, transparency, and refraction” to be the “creative elements” of independent claim 1.

Reply Br. 3.

Issue on Appeal

Did the Examiner err in rejecting claim 1 as being obvious?

ANALYSIS

We have reviewed the Examiner’s rejections in light of Appellants’ arguments (Appeal Brief and Reply Brief) that the Examiner has erred. We disagree with Appellants’ conclusions. Except as noted below, we adopt as

our own (1) the findings and reasons set forth by the Examiner in the action from which this appeal is taken and (2) the reasons set forth by the Examiner in the Examiner's Answer in response to Appellants' Appeal Brief. We concur with the conclusions reached by the Examiner. We highlight the following additional points.

As to Appellants' above contention 1, we disagree. The Examiner finds Wells at paragraph 41 teaches "a creative element addition module configured to determine, using the metadata associated with the content, which one of the plurality of creative elements are to be added to the content." Final Act. 5. Wells at paragraph 41 states:

Effects such as reflection, shadows, transparency, and refraction on or of the 3D object(s) relative to objects in the frame are automatically determined and added to the composite image.

We agree with the Examiner that "creative element" is reasonably construed to include such effects.³ Further, Wells at paragraphs 114–17 shows that data such as object position is used in the ray-tracing process to determine if inclusion of a creative element in the content is appropriate (e.g., "if the ray intersects the 3D object, a shadow effect is added to the 3D object at that point on the ray" (¶ 116)).

As to Appellants' above contention 2, we disagree. Appellants argue that Demaine does not disclose, teach, or suggest determining "*which ones* of the plurality of creative elements are to be added to the content." We find that Examiner did not cite Demaine for the limitation. Rather, the Examiner

³ For example, Appellants' Specification at page 2 states "[a] rendering engine configured to develop a three dimensional rendering of the creative element, the three dimensional rendering including at least one of the lighting characteristic and the shadow characteristic."

cited Wells. Final Act. 5. We conclude that Appellants' argument does not address the actual findings and reasoning of the Examiner's rejection. Instead Appellants attack the Demaine reference singly for lacking a teaching or suggestion that the Examiner relied on a combination of references to show. It is well established that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *See In re Keller*, 642 F.2d 413 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091 (Fed. Cir. 1986). Appellants argue a finding the Examiner never made. This form of argument is unavailing to show Examiner error.

As to above contention 3, we disagree. Again, we conclude that Appellants' argument does not address the actual reasoning of the Examiner's rejection. The Examiner explicitly stated that Wells only "broadly teaches a creative element store . . ." Final Act. 7. Then, the Examiner turns to Demaine to teach the limitation. *Id* at 7–8. Now Appellants attack the Wells reference singly for lacking a teaching that the Examiner relied on a combination of references to show. Again, Appellants argue a finding the Examiner never made. As above, this form of argument is unavailing to show Examiner error.

CONCLUSIONS

- (1) The Examiner has not erred in rejecting claims 1–5 and 7–24 as being unpatentable under 35 U.S.C. § 103(a).
- (2) Claims 1–5 and 7–24 are not patentable.

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DECISION

The Examiner's rejection of claims 1–5 and 7–24 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