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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/599,485	08/30/2012	Mark Theophilis	40205/04101	3648
30636	7590	02/23/2018	EXAMINER	
FAY KAPLUN & MARCIN, LLP			MACASIANO, MARILYN G	
150 BROADWAY, SUITE 702			ART UNIT	
NEW YORK, NY 10038			PAPER NUMBER	
			3688	
			MAIL DATE	
			DELIVERY MODE	
			02/23/2018	
			PAPER	

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MARK THEOPHILIS

Appeal 2016-007664
Application 13/599,485
Technology Center 3600

Before MICHAEL J. STRAUSS, SHARON FENICK, and
MICHAEL M. BARRY, *Administrative Patent Judges*.

STRAUSS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from a final rejection of claims 1–21. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

THE INVENTION

The claims are directed to “integration of a fully interactive rich media advertising unit and media content (e.g., digital media content) presented in a media player.” Spec ¶ 5. Claim 1, reproduced below with parenthetical labels added for ease of reference, is representative of the claimed subject matter:

1. A method for dynamic integration and presentation of advertising content and media content, the method comprising:
 - (1)receiving, by a server computing device, a request for media content from a remote computing device;
 - (2)providing, by the server computing device in response to the request, an interactive advertising unit comprising:
 - (a) a first content layer including the requested media content and a media player;
 - (b) a second content layer including the advertising content, wherein the advertising content comprises static content and interactive content; and
 - (c) an integration module configured to:
 - (i) display the requested media content in the media player; and
 - (ii) reveal the advertising content in an area extending from a boundary of a playback window of the media player, wherein revealing the advertising content includes displacing web page content to accommodate the advertising content while keeping the web page content available for viewing and interaction; and

- (3)transmitting, by the server computing device, the interactive advertising unit for presentation on the remote computing device.

REFERENCES

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

McMahon	US 2008/0010076 A1	Jan. 10, 2008
Moonka	US 2008/0066107 A1	Mar. 13, 2008
Wurster	US 2009/0063280 A1	Mar. 5, 2009

REJECTIONS

The Examiner made the following rejections:

Claims 1–12 and 14–21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wurster and Moonka. Final Act. 3–22.

Claim 13 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Wurster, Moonka, and McMahon. Final Act. 22–23.

APPELLANT’S CONTENTION

Appellant contends the prior art fails to teach or suggest the interactive advertisement unit of claim 1 because Wurster discloses performing corresponding functionalities on the server side rather than on the remote computing device. App. Br. 4–7.

ANALYSIS

Appellant’s arguments are not persuasive of reversible Examiner error. In connection with the argued claims, 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 Appellant's Appeal Brief and concur with the conclusions reached by the Examiner. We highlight the following for emphasis.

Appellant does not argue the claimed functionalities are not taught or suggested by the prior art. Specifically with respect to claim 1's limitation (2), that of "providing, by the server computing device in response to the request, an interactive advertising unit . . .", Appellant argues instead "[t]he recited functionalities of the interactive advertising unit of claim 1 are not performed by the mobile device that receives the multimedia message 250 in Wurster" and, instead, are performed on Wurster's server side. App. Br. 5. According to Appellant, because Wurster's server advertisement 210 and content 205 "are merged at the server into a single integrated media file 235 by a media integrator 230, . . . Wurster does not send a . . . module to the [remote computing] device that receives the multimedia message such that the functionalities may be performed thereon as recited." *Id.* Appellant argues, because merging is performed at the server:

[Wurster's] media integrator 230 is never sent to the mobile device as its functions have already been executed on the server-side. Only the completed multimedia message 250 is sent to the mobile device in Wurster. In contrast, the integration module of claim 1 is transmitted to the receiving device. Because Wurster's media integrator 230 is never sent to the receiving device, Wurster does not disclose or suggest providing or transmitting the interactive advertising unit.

App. Br. 6.

The Examiner responds, finding “that [the] ‘Interactive Advertising Unit’ as argued . . . is not positively recited as *performed by the server*¹. What is recited is ‘providing, by the server . . . , an interactive advertising unit.’” Ans. 22. Appellant contends the Examiner’s determination that the claims do not require performance of the interactive advertising unit by the server (as opposed to being performed by the remote computing device) demonstrates a failure to understand Appellant’s argument. Reply Br. 3. According to Appellant, “the claims recite the exact opposite of such a configuration [in which argued functions are performed by the server, i.e., that the] functions of the interactive advertising unit as recited in claim 1 are not performed by the server” and, instead, are performed by the remote computing device. *Id.*

Claim construction is a matter of law that we review de novo. *See In re Donaldson Co., Inc.*, 16 F.3d 1189, 1192 (Fed. Cir. 1994). During examination, claim terms are given their broadest reasonable construction *consistent* with the specification. *In re ICON Health & Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007). In general, words used in a claim are accorded their ordinary and customary meaning. *Honeywell Int’l Inc. v. Universal Avionics Sys. Corp.*, 488 F.3d 982, 992 (Fed. Cir. 2007). Under a broadest reasonable interpretation, words of the claim must be given

¹ In consideration of Appellant’s argument emphasizing the performance of disputed functions by the remote computing device instead of by the server, it is not clear whether the Examiner’s intended response was that the claims fail to positively recite that the Interactive Advertising Unit is performed by the *remote computing device* (rather than by the server). We find the Examiner’s misstatement to be harmless error for the reasons discussed below.

their plain meaning, unless such meaning is inconsistent with the Specification.

Although the Examiner's characterization of Appellant's argument is facially incorrect as argued by Appellant (Reply Br. 3), we find such error to be harmless. Whether or not the Examiner appreciated Appellant's argument to be that the claims require certain functionality be provided by the remote computing device rather than provided by the server as disclosed by Wurster, we independently conclude claim 1, when properly construed, does not exclude transmitting an interactive advertising unit wherein the first and second content layers are combined. In particular, Appellant argues "[p]rior to transmitting the multimedia message 250, the advertisement 210 and the content 205 of Wurster are converted into a baseline format and the formats of the advertisement 210 and the content 205 are combined . . . [or] merged at the server into a single integrated media file 235" that is part of multimedia message 250 transmitted to a mobile device. App. Br. 5. Appellant further argues "[b]ecause Wurster's media integrator 230 is never sent to the receiving device, Wurster does not disclose or suggest providing or transmitting the interactive advertising unit." *Id.*

Appellant's argument is not commensurate in scope with claim 1 because claim 1 does not require the claimed interactive advertising unit to perform the argued functions of Wurster's media integrator 230. In particular, the interactive advertising unit includes the following three elements as labeled above: 2(a) a first content layer of media content and a media player; 2(b) a second content layer of advertising content; and 2(c) an integration module. According to claim 1, any functionality required of the disputed interactive advertising unit (element 2) is functionality (A) imputed

to the claimed media player (element 2(a)), and (B) provided by the constituent integration module including to display media content (element 2(c)(i)) and reveal advertising content (element 2(c)(ii)).

The Examiner finds the first layer of media content and the second layer of advertising content is taught or suggested by Wurster's integrated media file 235. Final Act. 3–4. We agree because claim 1 does not require the first and second content layers be maintained separately and, therefore, under a broad but reasonable interpretation, Wurster's integrated media file teaches or suggests the disputed layers. Concerning the media player, the Examiner relies on Moonka for, in addition to providing Wurster's content, providing a video player module or application. Final Act. 6. Thus, the combination of Wurster and Moonka teaches or suggests elements 2(a) and 2(b) of claim 1 as labeled above.

According to claim 1, the integration module (element 2(c)) is configured to provide functionality to (i) display the requested media content in the media player and (ii) reveal the advertising content. As to the latter, element 2(c)(ii), Appellant's Specification discloses "revealing the advertising content includes displacing web page content to accommodate the advertising content while keeping the web page content available for viewing and interaction." Spec. ¶ 8. As explained by the Examiner, Moonka's video player module is capable of playing video and audio formats in addition to other content 208 including advertisements. Final Act. 6. Thus, under a broad but reasonable interpretation of the recited functionality, Moonka's video player module that plays video, audio, and additional content including advertisements teaches or suggests the disputed integration module including claim elements 2(c)(i) and 2(c)(ii).

Furthermore, it would have been obvious to combine Wurster's method of transmitting media and advertising content to a remote client device to include Moonka's video player module for the reasons set forth by the Examiner (Final Act. 6) thereby teaching or suggesting step (3) of transmitting, by the server computing device, the interactive advertising unit for presentation on the remote computing device.

We additionally find Wurster discloses "delivery of data enabling the mobile phone to play the integrated media file to the mobile phone is initiated [at 440]." Spec. ¶ 41. The delivery of this enabling data further teaches or suggests the transmission of a module (e.g., enabling data; transmitting step of element 3) used to display the media content in a media player (element 2(c)(i)) and reveal (e.g., display) advertising content (element 2(c)(ii)) thereby also satisfying the functional requirements of the disputed integration module and its transmission.

For the reasons discussed above, we are unpersuaded the claimed first and second content layers are distinguishable over Wurster's integrated media file or that any argued functionalities required of the interactive advertising unit of claim 1 are absent from either Moonka's video player module or, in the alternative, Wurster's data enabling a mobile phone to play an integrated media file of media and advertising. Accordingly, we sustain the rejection of independent claim 1 and, for the same reasons, the rejection of independent claims 20 and 21 under 35 U.S.C. § 103(a) together with the rejections of dependent claims 2–19 which are not argued separately with particularity.

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DECISION

We affirm the Examiner's decision to reject claims 1–21 under 35 U.S.C. § 103(a).

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). *See* 37 C.F.R. § 41.50(f).

AFFIRMED