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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 PETER RAE SHINTANI and
BRANT L. CANDELORE

_____

Appeal 2017-007968
Application 12/655,723
Technology Center 3600

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Before CAROLYN D. THOMAS, JEREMY J. CURCURI, and
MICHAEL M. BARRY, *Administrative Patent Judges*.

CURCURI, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's
rejection of claims 1–5 and 20–27. Final Act. 1. We have jurisdiction under
35 U.S.C. § 6(b).

Claims 1–5 and 20–27 are rejected under pre-AIA 35 U.S.C. § 112,
second paragraph, as indefinite. Final Act. 2.

Claims 1–5 and 20–27 are rejected under 35 U.S.C. § 101 as directed
to a judicial exception without significantly more. Final Act. 3–4.

Claims 1 and 4 are rejected under pre-AIA 35 U.S.C. § 103(a) as obvious over Bill (US 2006/0143647 A1; June 29, 2006), Yuxin (US 2010/0207874 A1; Aug. 19, 2010), and Christoff (US 6,518,998 B1; Feb. 11, 2003). Final Act. 4–6.

Claims 2 and 3 are rejected under pre-AIA 35 U.S.C. § 103(a) as obvious over Bill, Yuxin, Christoff, and Mortensen (US 2009/0153736 A1; Jun. 18, 2009). Final Act. 6–7.

Claim 5 is rejected under pre-AIA 35 U.S.C. § 103(a) as obvious over Bill, Ogawa (US 2008/0037841 A1; Feb. 14, 2008), and Kilner (US 2005/0197923 A1; Sep. 8, 2005). Final Act. 7–8.

Claims 20, 21, and 23–26 are rejected under pre-AIA 35 U.S.C. § 103(a) as obvious over Bill and Yuxin. Final Act. 8–10.

Claim 22 is rejected under pre-AIA 35 U.S.C. § 103(a) as obvious over Bill, Yuxin, and Mortenson. Final Act. 10–11.

Claim 27 is rejected under pre-AIA 35 U.S.C. § 103(a) as obvious over Jung (US 2009/0112617 A1; Apr. 20, 2009), Ogawa, and Tung (US 2010/0268594 A1; Oct. 21, 2010). Final Act. 11–12.

We affirm, and for claim 27 we denominate the affirmance under § 103(a) as a NEW GROUND OF REJECTION pursuant to our authority under 37 C.F.R. § 41.50(b).

STATEMENT OF THE CASE

Appellants' invention relates to a television having demonstration capabilities. Claim 1 is illustrative and reproduced below:

1.   A video display system having demonstration capabilities, comprising:

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at least one computer processor configured for receiving a video image from a camera;

the computer processor having face detection and smile detection programming;

the at least one computer processor configured to access a computer memory; and

the computer memory, comprising instructions executable by the computer processor for:

causing an image to be displayed on a display for a potential customer viewing the display;

the displayed image caused by the computer processor on the display including a prompt that instructs the potential customer to smile if the potential customer wishes to obtain a demonstration relating to a specific feature relating to the video display, the specific feature being specified in the prompt;

capturing the video image from the camera that contains an image of the potential customer's face;

determining if the image of the potential customer's face includes a smile; and

responsive to a determination that the potential customer's face includes a smile, retrieving and playing a demonstration video segment on the display as a response to determining that the potential customer has responded to the prompt by smiling.

PRINCIPLES OF LAW

We review the appealed rejections for error based upon the issues identified by Appellants, and in light of the arguments and evidence produced thereon. *Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential).

ANALYSIS

THE INDEFINITENESS REJECTION OF CLAIMS 1–5 AND 20–27

Contentions

The Examiner concludes

The term "smile" in claim[s] 1, 5, and 20 is a relative term which renders the claim indefinite. The term "smile" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Final Act. 2.

Appellants argue "the specification clearly teaches on the top of page 5 that software exists that can detect smiles." App. Br. 5.

In response, the Examiner explains "The term 'smile['] is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention." Ans. 2.

In the Reply Brief, Appellants further argue "the claim does not recite any words of degree, such as 'large smile' or 'small smile'. The claim recites a well-understood term, 'smile', without any terms of degree." Reply Br. 2.

Our Review

Appellants' Specification discloses "Currently available cameras are equipped with software, hardware or firmware that can detect faces and smiles to aid in focus and timing of a photograph, and similar technology can be applied here." Spec. 5:3–5.

Turning to claim 1, claim 1 recites the term "smile."

Although the term "smile" is not defined by the claim, based on the disclosure in Appellants' Specification, we conclude that an ordinary skilled artisan would have understood what is claimed when the claims are read in light of the Specification, because according to the Specification smile detection technology is currently available.

We also agree with Appellants that words of degree are not recited in the claims, and accordingly, we see no need for any further disclosure in the Specification than provided by Appellants. The Examiner has not provided any additional explanation as to why the Specification is insufficient.

We, therefore, do not sustain the Examiner's indefiniteness rejection of claims 1–5 and 20–27.

THE 35 U.S.C. § 101 REJECTION OF CLAIMS 1–5 AND 20–27

Contentions

The Examiner concludes

Claim 1-5, and 20-27 are directed to the abstract idea of receiving a video image from a camera with a gesture and provide a video segment or content based on the gesture. The claim(s) do not include additional elements that are sufficient to amount to significantly more than the judicial exception because the additional computer elements, which are recited at a high level

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of granularity, provide, conventional computer functions that do
not add meaningful limits to practicing the abstract idea.

Final Act. 3; *see also* Final Act. 3–4 ("Financial: intermediate settlement in

Alice, risk hedging in *Bilksi* or tax-free investing in *Fort Properties*.").

Among other arguments, Appellants present the following principal

argument:

"[N]o Supreme Court case ever has held that a machine prompting for

a smile and presenting a specific type of video in response is 'abstract'."

App. Br. 7. "Applicant can see no plausible manner in which presenting a

demonstration video in response to a prompted-for smile bears any

resemblance whatsoever to risk hedging, intermediate settlement, or tax-free

investing." App. Br. 7–8. "[A]s in *Enfish*, the present claims are not directed

to fundamental economic practices or mathematical equations or well-

known business practices." App. Br. 9.

In response, the Examiner, again, concludes the claims are directed to

an abstract idea. Ans. 2–3 (citing *Electric Power Group*); *see also* Ans. 3–4

("Contrary to *Enfish*, the instant claimed invention includes an abstract

idea.").

In the Reply Brief, Appellants further argue the claims are nothing

like the claims in *Electric Power Group*. *See* Reply Br. 3 ("Providing

demonstration videos, much less in the various, technically explicit ways

recited in the claims, has nothing to do with monitoring power grids.")

Appellants further argue the claims are like the claims in *Enfish*:

> [T]he present application indeed teaches specific technical
> benefits, just as in *Enfish*. On page 4, for example, the
> specification teaches that the "camera can be used for triggering
> a demo, which can be made to be very interactive with the
> potential customer in a retail setting and can be a fun way for a

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user to interact with a TV in a manner *that avoids problems associated with giving the user full access to a TV's controls*" which "could leave the TV in an undesirable mode of operation" (page 5) (emphasis added). Thus, *Enfish* is closer to the instant fact pattern than is *Electric Power Group*.

Reply Br. 5.

Our Review

In *Alice*, the Supreme Court applied the framework as set forth in *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66 (2012) for determining whether the claims are directed to patent-eligible subject matter. *Alice*, 134 S. Ct. at 2355. The first step in the analysis is to "determine whether the claims at issue are directed to one of [the judicially-recognized] patent-ineligible concepts." *Id.* If the claims are directed to a patent-ineligible concept, then the second step in the analysis is to consider the elements of the claims "individually and 'as an ordered combination' to determine whether the additional elements 'transform the nature of the claim' into a patent-eligible application." *Id.* (quoting *Mayo*, 566 U.S. at 78, 79). However, the Federal Circuit has articulated that "the first step in the *Alice* inquiry . . . asks whether the focus of the claims is on the specific asserted improvement in computer capabilities . . . or, instead, on a process that qualifies as an 'abstract idea' for which computers are invoked merely as a tool." *Enfish*, 822 F.3d at 1335–36. Accordingly, the Federal Circuit determined, if "the claims are directed to a specific implementation of a solution to a problem in the software arts," then "the claims at issue are not directed to an abstract idea." *Id.* at 1339.

The Federal Circuit has also found claims directed to "collecting information, analyzing it, and displaying certain results of the collection and

analysis" as directed to a patent-ineligible abstract idea. *Electric Power Group, LLC v. Alstom*, 830 F.3d 1350, 1353 (Fed. Cir. 2016).

Appellants' Specification discloses the following:

> Turning now to **FIGURE 1**, an example of an implementation of a method consistent with the present invention is depicted in flow chart 10, starting at 14. If the TV has been set in a demonstration interactive mode wherein the system is awaiting a customer's appropriate gesture to enable the demo at 18, then the system's camera looks for the appropriate gesture. A suitable and readily implemented gesture is a smile. Currently available cameras are equipped with software, hardware or firmware that can detect faces and smiles to aid in focus and timing of a photograph, and similar technology can be applied here. In the case of detection of a smile, the face is detected at 22 and analyzed for the presence of a smile. If a smile is detected at 26, then the TV can enter a demonstration mode at 30 which pre-empts other video inputs. *Hence, at the prompting or spontaneous occurrence of the pre-determined gesture, the TV enters the demo mode at 30 and a demo can play to completion at 34 without need for the user to interact using a remote controller or other device that could leave the TV in an undesirable mode of operation.* Once the demo is completed, in this implementation, the process can return to await the next occurrence of the specified gesture.

Spec. 4:31–5:13 (emphasis added).

We conclude Appellants' claims are not at all directed to a fundamental economic practice as concluded by the Examiner in the Final Action; we also conclude Appellants' claims are not directed to "collecting information, analyzing it, and displaying certain results of the collection and analysis" as in *Electric Power Group* as concluded by the Examiner in the Examiner's Answer. We conclude the Examiner's analysis is untethered from the actual claim language. Instead, we agree with Appellants that "the present application indeed teaches specific technical benefits, just as in

Enfish." Reply Br. 5. We conclude Appellants' claims provide more than merely displaying results of collection and analysis because the claims provide "responsive to a determination that the potential customer's face includes a smile, retrieving and playing a demonstration video segment on the display as a response to determining that the potential customer has responded to the prompt by smiling." Claim 1. The demonstration video segment is not merely the results of collection and analysis. Rather, the claim as a whole solves the particular industry problem where, upon completion of a demo, "a remote controller or other device [] could leave the TV in an undesirable mode of operation." Spec. 5:10–11.

In short, we conclude the claimed invention is a "specific asserted improvement in computer capabilities" rather than "a process that qualifies as an 'abstract idea' for which computers are invoked merely as a tool." *See Enfish*, 822 F.3d at 1335–36. Accordingly, because "the claims are directed to a specific implementation of a solution to a problem in the software arts," claim 1 is not directed toward an abstract idea. *See id.* at 1339. Therefore, the § 101 inquiry ends here.

Accordingly, we do not sustain the rejection of independent claim 1 under 35 U.S.C. § 101. We also do not sustain the rejection of claims 2–5 and 20–27 for the same reasons discussed with respect to claim 1.

THE OBVIOUSNESS REJECTIONS OF CLAIMS 1–5 AND 20–27

Claims 1 and 4

The Examiner finds Bill, Yuxin, and Christoff teach all limitations of claim 1. Final Act. 4–6.

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The Examiner finds Yuxin teaches "the computer processor having face detection and smile detection programming"; "the displayed image caused by the computer processor on the display including a prompt that instructs the potential customer to smile if the potential customer wishes to obtain a demonstration relating to a specific feature relating to the video display, the specific feature being specified in the prompt"; "responsive to a determination that the potential customer's face includes a smile, retrieving and playing a demonstration video segment on the display as a response to determining that the potential customer has responded to the prompt by smiling" as recited in claim 1. Final Act. 5 (citing Yuxin ¶¶ 3, 28, 31, 35, 36); *see also* Ans. 5 (citing Yuxin ¶¶ 17, 26, 28, 36).

The Examiner finds Christoff teaches "capturing the video image from the camera that contains an image of the potential customer's face"; "determining if the image of the potential customer's face includes a smile" as recited in claim 1. Final Act. 6 (citing Christoff col. 2, ll. 15–26); *see also* Ans. 5 (citing col. 2, ll. 15–26).

Appellants present the following principal arguments:

i.

> [T]he RUSM [(relied upon subject matter in Yuxin)] generally teaches eliciting responses and providing outputs in response, whereas Claim 1 is quite specific and is not found in the RUSM, e.g., there is zero understanding in the RUSM of prompting a person to smile for the purpose required by the claim.

> Moreover, as paragraph 36 clearly and unambiguously declares, "the response *has to be implemented* by a group of people rather than one single distinct individual" (emphasis added). This statement is not a mere preferred embodiment; it is an imperative.

> In contrast, Claim 1 requires "the" potential customer (singular) to be determined to have smiled, and playing the demo video as a response to determining that "the" potential customer (singular) has responded to the prompt by smiling—precisely what Yuxin says must not be done.

App. Br. 12–13; *see also* Reply Br. 5–6.

ii. The relied upon subject matter in Yuxin "leads the skilled artisan away from a singular customer gesture control." App. Br. 13.

iii. Christoff does not teach "capturing the video image from the camera that contains an image of the potential customer's face"; "determining if the image of the potential customer's face includes a smile" as recited in claim 1. App. Br. 13–14.

iv. "The rejection fails to explain how the PHOSITA would use the information from Yuxin in addition to the information Bill already teaches." App. Br. 15. "[T]he proferred motivation to toss Christoff into the mix… fails to explain how the PHOSITA would use the information from Christoff in addition to the information Bill/Yuxin already teach." App. Br. 15.

We do not see any error in the Examiner's findings. We concur with the Examiner's conclusions.

Regarding Appellants' argument (i), Yuxin discloses "[t]his content can include overt suggestions, requests, or other types of prompts for audience response in the form of some gesture." Yuxin ¶ 28. Yuxin further discloses "the content expressly instructs or requests the audience to make a particular gesture." Yuxin ¶ 28. Yuxin discloses "particular gestures, such as a smile." Thus, we find Yuxin teaches "the computer processor having face detection and smile detection programming"; "the displayed image caused by the computer processor on the display including a prompt that instructs the potential customer to smile if the potential customer wishes to obtain a

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demonstration relating to a specific feature relating to the video display, the specific feature being specified in the prompt" as recited in claim 1 because Yuxin prompts for audience response in the form of a smile. Yuxin ¶ 28. We find a skilled artisan would have understood Yuxin's teachings as readily applicable to any size audience, including an audience consisting of a single person. Yuxin ¶ 28.

Further, we find Yuxin teaches "responsive to a determination that the potential customer's face includes a smile, retrieving and playing a demonstration video segment on the display as a response to determining that the potential customer has responded to the prompt by smiling" as recited in claim 1 because Yuxin discloses "the system can modify the display output based upon the collective behavior (step **58**). This can involve triggering one or more outputs from the display computer (**24** in FIG. **1**) based on the detected gesture." Yuxin ¶ 36. Put another way, Yuxin's modified display output reasonably describes the recited "demonstration video segment" of claim 1. Yuxin ¶ 36.

We emphasize that Yuxin discloses modifying display output based on a gesture; claim 1's recitations describing the content of the prompt and the content of the demonstration are non-functional descriptive material. In short, no functional relationship exists between the recited structures and the content of the data.

Regarding Appellants' argument (ii), while an alternative may be inferior to or less desirable than another, that alone is insufficient to teach away from the inferior alternative unless the disclosure criticizes, discredits, or otherwise discourages that alternative. *In re Fulton*, 391 F.3d 1195, 1200–01 (Fed. Cir. 2004). Here, to the extent Yuxin teaches responding to

collective behavior, a mere lack of explicitly stating that the audience may consist of a single person does not criticize, discredit, or otherwise discourage as audience consisting of a single person. Yuxin ¶ 28. Further, as stated above, we find a skilled artisan would have understood Yuxin's teachings as readily applicable to any size audience, including an audience consisting of a single person. Yuxin ¶ 28.

Regarding Appellants' argument (iii), Chirstoff discloses

> As summarized above, the invention in one embodiment allows a video camera system having a fixed and relatively small aperture, such as an intraoral camera having a light source at its distal end, to automatically capture brighter and clear images of the patient's smile and face. In a particular embodiment, the video camera system is configured to raise the black level of the video signal as the camera is removed from the patient's mouth to capture the headshot. The automatic change in the black level is done in response to reduced image brightness which, in this case, is due to the camera light source now being outside the patient's mouth and not sufficiently illuminating the patient's face.

Christoff col. 2, ll. 15–26.

Thus, when the teachings of Christoff are combined with Yuxin, the prior art teaches "capturing the video image from the camera that contains an image of the potential customer's face" (Chirstoff captures an image of a patient's smile and face); "determining if the image of the potential customer's face includes a smile" (Yuxin detects a smile (gesture)) as recited in claim 1. Christoff col. 2, ll. 15–26; Yuxin ¶ 28.

Regarding Appellants' argument (iv), the Examiner provides a reason to combine the teachings of Yuxin with the teachings of Bill that is rational on its face and supported by evidence drawn from the record. *See* Final Act. 5 ("help the merchant to determine if the potential customer is interested in

viewing the content that will be displayed on the screen"); *see also* Bill Abstract ("The image is analyzed to determine a mood for the user so that content may be selected responsive to the mood of the user."). In addition, the Examiner provides a reason to combine the teachings of Christoff with the teachings of Bill and Yuxin that is rational on its face and supported by evidence drawn from the record. *See* Final Act. 6 ("help the merchant identify if the customer face includes a smile before displaying a content on the screen to the viewing customer"); *see also* Yuxin Abstract ("The control system (26) is configured to modify the content in response to the collective gesture."). Appellants do not provide a particularized explanation of why the Examiner's reasoning is incorrect; accordingly, on the record before us, the Examiner's reasoning supported by evidence drawn from the record weighed against Appellants naked arguments leads us to concur with the Examiner's conclusion of obviousness.

We, therefore, sustain the Examiner's obviousness rejection of claim 1. We also sustain the Examiner's obviousness rejection of claim 4, which is not separately argued with particularity.

Claims 2 and 3

The Examiner finds Bill, Yuxin, Christoff, and Mortensen teach all limitations of claims 2 and 3. Final Act. 6–7.

Claim 2 further recites "retrieving the demonstration video segment initiates operation of the video display system in a demonstration mode." Claim 3 further recites "retrieving the demonstration video segment branches an existing demonstration to demonstrate a feature specified by the prompt."

The Examiner finds Mortenson teaches the additional recitations in claims 2 and 3. Final Act. 6–7 (citing Mortenson ¶¶ 4, 24); *see also* Ans. 5–6.

Appellants argue "the complex demonstration mode requirements of Mortensen, paragraph 24 do not lend themselves to the coarse control inherent in the gesture engine of Bill." App. Br. 15; *see also* Reply Br. 6–7. Appellants further argue "[t]he intended detailed control of Mortensen would lead the skilled artisan away from dropping it into Bill using the coarse control afforded by gestures." App. Br. 16.

We not see any error in the Examiner's findings. We concur with the Examiner's conclusions.

Regarding claim 2, Mortenson discloses "[i]f the operator selects the 'demo' feature in the 'setup' menu **312**, the operator is presented with a decision **314** of turning the 'demo' mode 'On' or 'Off'." Mortenson ¶ 24. Thus, Mortenson teaches "initiat[ing] operation of the video display system in a demonstration mode." Thus, when combined with Bill, Yuxin, and Christoff, the prior art teaches "retrieving the demonstration video segment initiates operation of the video display system in a demonstration mode."

The Examiner provides a reason to combine the teachings of Mortenson with the teachings of Bill, Yuxin, and Christoff that is rational on its face and supported by evidence drawn from the record. *See* Final Act. 7 ("content will be played automatically by itself"); *see also* Yuxin ¶ 36 ("triggering one or more outputs from the display computer (24 in FIG. 1) based on the detected gesture"). Regarding Appellants' arguments, Mortenson is not relied upon for any complex requirements; rather, Mortenson is relied on for teaching "initiat[ing] operation of the video

display system in a demonstration mode." Therefore, Mortenson's teachings are readily applicable to Yuxin such that a detected gesture may trigger the demonstration mode.

Regarding claim 3, Mortenson discloses "[w]hen the embedded video is set to play… the television's on-screen-display (OSD) controller blocks a primary video… from being displayed on the television's screen." Mortenson ¶ 4. Thus, Mortenson teaches "branch[ing] an existing demonstration to demonstrate a feature specified by the prompt." Thus, when combined with Bill, Yuxin, and Christoff, the prior art teaches "retrieving the demonstration video segment branches an existing demonstration to demonstrate a feature specified by the prompt."

The Examiner provides a reason to combine the teachings of Mortenson with the teachings of Bill, Yuxin, and Christoff that is rational on its face and supported by evidence drawn from the record. *See* Final Act. 7 ("help the merchant to display a preloaded content that will demonstrate to users by the prompt"); *see also* Yuxin ¶ 36 ("triggering one or more outputs from the display computer (24 in FIG. 1) based on the detected gesture"). Regarding Appellants' arguments, again, Mortenson is not relied upon for any complex requirements; rather, Mortenson is relied on for teaching "branch[ing] an existing demonstration to demonstrate a feature specified by the prompt." Therefore, Mortenson's teachings are readily applicable to Yuxin such that a detected gesture may trigger branching to demonstrate a feature.

We, therefore, sustain the Examiner's obviousness rejection of claims 2 and 3.

Claim 5

The Examiner finds Bill, Ogawa, and Kilner teach all limitations of claim 5. Final Act. 7–8; *see also* Ans. 6–8. Claim 5 is an independent claim directed to a video demonstration system. In particular, claim 5 recites "responsive to a determination that the potential customer is a child, retrieving and playing a children's video." The Examiner finds Kilner teaches "responsive to a determination that the potential customer is a child, retrieving and playing a children's video" as recited in claim 5. Final Act. 8 (citing Kilner ¶ 59); *see also* Kilner ¶ 59 ("At a stage **420** the face detection/recognition module determines if the detected face is the face of a child and, if so, displays a promotion for a cartoon digital video disc (DVD) offer.").

Appellants argue that, "contrary to the Office Action, paragraph 59 does not in fact teach retrieving and playing a children's video. It teaches displaying *a promotion* for a DVD. That promotion is not said to be a video, much less of the genre claimed. A promotion for a DVD of a video is not the video itself. App. Br. 16–17; *see also* Reply Br. 7.

We not see any error in the Examiner's findings. We concur with the Examiner's conclusions.

We find Kilner teaches "responsive to a determination that the potential customer is a child, retrieving and playing a children's video" as recited in claim 5 because we find Kilner's promotion for a cartoon DVD offer reasonably describes a children's video. First, we find that the cartoon DVD is a children's video; then, we further find that the promotion is also a children's video. Kilner ¶ 59.

We, therefore, sustain the Examiner's obvious rejection of claim 5.

Claims 20, 21, and 23–26

The Examiner finds Bill and Yuxin teach all limitations of claim 20. Final Act. 8–9; *see also* Ans. 8–10. In particular, claim 20 recites "where the prompt asks the potential customer to make the gesture in response to the prompt in the event the potential customer wishes to see a specified video segment demonstrating operation of a function of the television."

Appellants present the following principal arguments:

i.   Yuxin does not teach "prompting a person to make a gesture for the purpose required by the claim." App. Br. 17; *see also* Reply Br. 7–8.

ii.   Yuxin requires a group of people and teaches away from a single individual. App. Br. 17; *see also* Reply Br. 8.

We not see any error in the Examiner's findings. We concur with the Examiner's conclusions.

Regarding Appellants' argument (i) and (ii), these arguments with respect to Yuxin are the same as arguments presented with respect to Yuxin for claim 1. For the same reasons discussed above when addressing claim 1, the arguments do not show any error in the Examiner's findings.

We, therefore, sustain the Examiner's obviousness rejection of claim 20. We also sustain the Examiner's obviousness rejection of claims 21 and 23–26, which are not separately argued with particularity.

Claim 22

The Examiner finds Bill, Yuxin, and Mortenson teach all limitations of claim 22. Final Act. 10–11; *see also* Ans. 10–11. Claim 22 further recites

"retrieving the specified video segment initiates operation in a demonstration mode."

The Examiner finds Mortenson teaches the additional recitations in claim 22. Final Act. 10–11 (citing Mortenson ¶ 24); *see also* Ans. 10–11.

Appellants argue the following.

> The allegation is clear reversible error that a suggestion exists to use the menu-driven demo mode concept of Mortensen altered in an untaught way to be driven by the gesture engine of Bill. Bill, as admitted in the rejection, fails to teach application of its concept to demonstration modes, and the complex demonstration mode requirements of Mortensen, paragraph 24 do not lend themselves to the coarse control inherent in the gesture engine of Bill. The rationale for reversal expressed above in relation to Claims 2 and 3 is incorporated herein.

App. Br. 18; *see also* Reply Br. 8.

We do not see any error in the Examiner's findings. We concur with the Examiner's conclusions.

Regarding Appellants' arguments, these arguments with respect to Mortenson are the same as arguments presented with respect to Mortenson for claims 2 and 3. For the same reasons discussed above when addressing claims 2 and 3, the arguments do not show any error in the Examiner's findings.

We, therefore, sustain the Examiner's obviousness rejection of claim 22.

Claim 27

The Examiner finds Jung, Ogawa, and Tung teach all limitations of claim 27. Final Act. 11–12; *see also* Ans. 11–12.

In particular, the Examiner finds Tung teaches "determining whether or not the potential customer makes the predetermined gesture; and retrieving and playing a specified video segment on the display associated with the predetermined gesture in response to determining that the viewer has made the predetermined gesture" as recited in claim 27. Final Act. 11–12 (citing Tung ¶ 41); *see also* Ans. 12.

Appellants present the following principal argument:

> The allegation is clear reversible error that Tung, paragraph 41 teaches what Jung and Ogawa admittedly lack, namely, determining whether or not the potential customer makes the predetermined gesture, and retrieving and playing a specified video segment on the display associated with the predetermined gesture in response to determining that the viewer has made the predetermined gesture. Paragraph 41 teaches playing advertising in an elevator responsive to the door opening or the elevator moving up and down. Nothing to do with gestures of people. The door can open or the elevator can move up and down without any people, much less people making gestures.

App. Br. 18; *see also* Reply Br. 8–9.

Tung discloses

> In FIG. 7, if the advertising site **4** is an elevator **40**, the advertising device **41** will be installed in the elevator **40**, and a sensor **431** for detecting an opened or closed elevator door or a gravity sensor **432** for detecting an up-and-down movement of the elevator is installed on the advertising device **41**, such that if the elevator door is opened to allow passengers to enter into the elevator or the elevator is moving up or down, the advertising device **41** will play the advertising content.

Tung ¶ 41.

Based on the record before us, we determine the Examiner erred in finding Tung teaches "determining whether or not the potential customer makes the predetermined gesture; and retrieving and playing a specified

video segment on the display associated with the predetermined gesture in response to determining that the viewer has made the predetermined gesture" as recited in claim 27.

We agree with Appellants that "Paragraph 41 [of Tung] teaches playing advertising in an elevator responsive to the door opening or the elevator moving up and down" and does not teach the argued limitation. App. Br. 18.

We, therefore, do not sustain the Examiner's obviousness rejection of claim 27.

New Ground of Rejection for Claim 27

Claim 27 is reproduced below:

27. A computer memory that is not a transitory signal and that comprises instructions executable by one or more programmed processors for:

causing an image to be displayed on a video display, where display of the image on the display provides a prompt for a potential customer that instructs the potential customer to make a predetermined gesture if the potential customer wishes to obtain a demonstration relating to the video display;

receiving a video image from a camera;

capturing the video image from the camera to determine if the potential customer makes the predetermined gesture;

determining whether or not the potential customer makes the predetermined gesture; and

retrieving and playing a specified video segment on the display associated with the predetermined gesture in response to determining that the viewer has made the predetermined gesture.

We adopt as our own the Examiner's uncontested findings based on Jung and Ogawa. *See* Final Act. 11–12.

We find Yuxin teaches "determining whether or not the potential customer makes the predetermined gesture" as recited in claim 27 because Yuxin discloses"[t]his content can include overt suggestions, requests, or other types of prompts for audience response in the form of some gesture… the content expressly instructs or requests the audience to make a particular gesture." Yuxin ¶ 28.

We further find Yuxin teaches "retrieving and playing a specified video segment on the display associated with the predetermined gesture in response to determining that the viewer has made the predetermined gesture" as recited in claim 27 because Yuxin discloses "the system can modify the display output based upon the collective behavior (step **58**). This can involve triggering one or more outputs from the display computer (**24** in FIG. **1**) based on the detected gesture." Yuxin ¶ 36. Put another way, Yuxin's modified display output reasonably describes the recited "specified video segment" of claim 27. Yuxin ¶ 36. Further, we find a skilled artisan would understand Yuxin's teachings as readily applicable to any size audience, including an audience consisting of a single person. Yuxin ¶ 28.

We emphasize that Yuxin discloses modifying display output based on a gesture; claim 27's recitations describing the content of the prompt and the content of the demonstration are non-functional descriptive material. In

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short, no functional relationship exists between the recited structures and the content of the data.

We conclude it would have been obvious to one of ordinary skill in the art to combine the teachings of Yuxin with the teachings of Jung and Ogawa to "help the merchant to determine if the potential customer is interested in viewing the content that will be displayed on the screen." Final Act. 12; *see also* Yuxin Abstract ("The control system (26) is configured to modify the content in response to the collective gesture."), Jung Abstract ("specifying at least one of a plurality of user-health test functions responsive to an interaction between a user and at least one advertiser-specified attribute").

We, therefore, reject claim 27 under 35 U.S.C. § 103(a) as obvious over Jung, Ogawa, and Yuxin. This is a new ground of rejection.

ORDER

The Examiner's decision rejecting claims 1–5 and 20–27 is affirmed.

We denominate the affirmance as involving a new ground of rejection under 37 C.F.R. § 41.50(b) for claim 27 because we now reject claim 27 under 35 U.S.C. § 103(a) as obvious over Jung, Ogawa, and Yuxin, instead of over Jung, Ogawa, and Tung.

Rule 37 C.F.R. § 41.50(b) states that "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review." Furthermore, 37 C.F.R. § 41.50 (b) also provides that Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

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(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

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).

<u>AFFIRMED</u>
<u>37 C.F.R. § 41.50(b)</u>