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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte CHRISTOPHER B. FLEIZACH, ERIC T. SEYMOUR, and
GREGORY F. HUGHES

Appeal 2018-001197
Application 14/199,107¹
Technology Center 2100

Before MAHSHID D. SAADAT, CARL L. SILVERMAN, and
LILAN REN, *Administrative Patent Judges*.

SILVERMAN, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 1–11 and 13–24, which constitute all pending claims. We have jurisdiction under 35 U.S.C. § 6(b). An Oral Hearing scheduled for August 15, 2019 was waived by Appellants (6/20/19).

We AFFIRM-IN-PART.

¹ The real party in interest is identified as Apple Inc. App. Br. 3.

STATEMENT OF THE CASE

The invention relates to outputting captions for movies and other video content. Abstract; Spec. ¶¶ 2–7, Figs. 1, 4B, 5A, 5B. Claim 1, reproduced below, is exemplary of the subject matter on appeal (emphasis added):

1. A method, comprising:
at an electronic device:
outputting a first caption of a plurality of captions while a first segment of a video is being played, wherein the first video segment corresponds to the first caption;
while outputting the first caption, receiving a first user input; and,
in response to receiving the first user input:
determining a second caption in the plurality of captions, distinct from the first caption, that meets predefined caption selection criteria;
determining a second segment of the video that corresponds to the second caption;
sending instructions to change from playing the first segment of the video to playing the second segment of the video; and
outputting the second caption.

App. Br. 21 (Claims Appendix).

THE REJECTIONS²

Claims 1–4, 11, 13–16, and 18 are rejected under 35 U.S.C. § 102(e) as being anticipated by Sano et al. (US 2013/0308922 A1; pub. Nov. 21, 2013) (“Sano”). Final Act. 2–5.

² The Final Action states that the rejections of claims 11 and 12 under 35 U.S.C. § 101 are withdrawn. Final Act. 2.

Claims 6–8 and 19–21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sano, in view of Seymour et al. (US 2008/0303645 A1; pub. Dec. 11, 2008) (“Seymour”). Final Act. 5–7.

Claims 9, 10, 22, and 23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sano, Seymour, and Nagaishi et al. (US 2004/0008277 A1; pub. Jan. 15, 2004) (“Nagaishi”). Final Act. 7–8.

Claims 5 and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sano and Nagaishi. Final Act. 9–10.

Claim 24 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Sano in view of Sprague (US 2002/0087974 A1; pub. July 4, 2002). Final Act. 10–11.

ANALYSIS

The § 102 Rejections

Appellants argue that the Examiner errs in finding Sano discloses claim 1 because the Examiner’s findings are based on improper claim interpretation and the Examiner’s Final Action is improper because it raises a new ground of rejection as compared to the prior Office Action, mailed April 26, 2016 (also referred to as “Non-Final Action”). App. Br. 7–14; Reply Br. 4–10. Appellants argue the Examiner also errs in finding Sano discloses dependent claims 2 and 14 (“same location”) and dependent claim 18 (“same speaker”). App. Br. 14–19; Reply Br. 11–16.

In the Non-Final Action, the Examiner finds that Sano (paragraphs 67, 68, Figure 8) discloses “receiving a first user input while the first caption is presenting.” Non-Final Act. 4–5. Although not expressly stated, the Examiner maps the “first user input” to the Sano search of the transcript for the

term “Javascript” (paragraph 67) which results in the search results of three captions that include the term (paragraph 68). *See also* Sano, Fig. 8.

Appellants argue the Examiner errs because Sano discloses, in response to receiving the search term “Javascript,” that the system identifies captions and textual positions, but the selected caption and position are not displayed in response to receiving the search term “Javascript” from the user. App. Br. 9–10. Instead of a response, there is an intervening response (“the user selection of a corresponding position on the first graphical features 806[] must be detected before Sano’s system will display the portion of video 110 and the associated textual caption”). *Id.* at 10–11. Therefore, according to Appellants, Sano does not disclose, “in response to receiving the first user input, . . .” “sending instructions to change from playing the first segment of the video to playing the second segment of the video.” *Id.* Appellants further argue Sano does not disclose a “predefined caption selection criteria” because the search term “Javascript” is based on a user – defined search entered during operation of the Sano system. *Id.* at 11.

In the Final Action, for the “first user input,” the Examiner relies on (or maps) Sano user clicking the indicator 808a to select one of the captions resulting from the search for the term “Javascript.” Final Act. 2–3 (citing Sano ¶ 73, Fig. 8).

In the Appeal Brief, Appellants argue the Examiner’s alternative mapping of Sano also fails to satisfy the requirements of Appellants’ claims. According to Appellants:

in response to the user “selecting or clicking on an indication 808a” on the first graphical features 806, Sano’s system does not (1) “determin[e] a second caption in the plurality of captions, distinct from the first caption, that meets predefined

caption selection criteria” and (2) “determin[e] a second segment of the video that corresponds to the second caption,” as required by Appellant’s claims.

App. Br. 12.

Appellants reiterate that the Sano textual captions are determined prior to the user clicking so it is not “in response to” as required by the claim. *Id.* According to Appellants, the search for “Javascript” in Sano is not the “predefined caption selection criteria” because it is defined by the user in Sano while operating. *Id.*

Regarding the second Office Action being made final, Appellants contend that this is improper and unfair because the Examiner’s mapping of claim 1 to Sano is different. *Id.* at 13–14 (citing MPEP § 706.07(a)).

Regarding dependent claims 2 and 14, which recite “wherein the predefined caption selection criteria include that the first caption and the second caption correspond to a same location” on a display (also referred to as “same location”),” Appellants argue there is no disclosure in Sano that supports the Examiner’s finding. *Id.* at 14–16 (citing Sano ¶ 66, Fig. 8). Appellants argue, regarding dependent claim 18, that the Examiner identifies inadequate disclosure in Sano that discloses the “same speaker.” *Id.* at 16 (citing Sano ¶¶ 66, 68).

In the Answer, regarding claim 1, the Examiner adds to the findings in the Final Action and points to the acceptability of presenting a different mapping than the Non-Final Action. Ans. 3–6. According to the Examiner:

First of all, it should be noted that Sano expressly teaches, in general, replaying of video segments along with corresponding captions that have been resulted from performing a search of transcript according to a predefined search term by input, as shown in fig. 8 ([0066]).

Second, Sano expressly teaches in fig. 8 that while replaying a first segment of video with a first caption 818 “it changes what you can do,” in response to user’s selection of a vertical bar indication 808a, 808b, or 808c, it causes to determine a second caption which includes a corresponding caption content 114a, 114c, or 114d that meets predefined caption selection criteria; that is, each of the vertical bar indications 808a, 808b, and 808c is to include a predefined search term “Javascript” as selection criteria for the caption contents of 114a, 114c, and 114d among other caption contents, such as 114b, 114e, and 114f that do not include the predefined search term ([0072]).

Sano states in para. 0072 as follows:

[0072] ... For instance, as shown in FIG. 8, first-third vertical bar indications 808a-808c are shown displayed on first graphical feature 806 to indicate the play times for textual captions 114a, 114c, and 114d, each of which were determined to include the search term “Javascript.”

Third, Sano further expressly teaches that as the user selects the vertical bar indication 808a, it also causes to determine a second segment of the video that corresponds to the second caption ([0073]).

Sano further states in para. 0073 to describe fig. 8 as follow:

[0073] Thus, first graphical feature 806 indicates the locations/play times in a video corresponding to the portions of a transcript of the video that match search criteria. A user can view the indications displayed on first graphical feature 806 to easily ascertain the locations in the video of matching search terms. In an embodiment, the user may be enabled to interact with first graphical feature 806 to cause the display/playing of video 110 to switch to a location of a matching search term. For instance, the user may be enabled to “click” on an indication displayed on first graphical feature 806 to cause play of video 110 to occur at the location of the indication.

Accordingly, Sano clearly teaches, “in response to receiving the first user input: determining a second caption in the plurality of captions, distinct from the first caption, that meets pre-defined caption selection criteria; determining a second segment of the video that corresponds to the second caption,” as recited in claims 1, 11, and 13.

Ans. 4–5.

The Examiner points out that it is acceptable to refer to different portions of the Sano reference for purposes of the anticipation rejection. *Id.* at 5–6. Regarding claims 2 and 14, the Examiner finds that the first and second caption correspond to the “same location on a display.” *Id.* at 6–7 (citing Sano, Fig. 8, caption location 818). Regarding dependent claim 18, the Examiner refers to Sano as disclosing that the first and second captions correspond to the same (device) speaker. *Id.* at 7 (citing Sano ¶ 66, Fig. 8).

In the Reply Brief, Appellants reiterate prior arguments and argue that the Examiner’s reliance on Sano, paragraph 72, contradicts the Examiner’s findings, as explained below:

In particular, the quoted portion of Sano’s paragraph [0072] teaches that “vertical bar indications 808a-808c” “indicate the play times for textual captions 114a, 114c, and 114d, each of which were determined to include the search term ‘Javascript.’” (Emphasis added.) Importantly, because “were” is in the *past tense*, Sano’s paragraph [0072] expressly teaches that determining the textual captions 114a, 114c, and 114d to include the search term “Javascript” occurs *prior to* the display of vertical bar indications 808a-808c on first graphical feature 806. It thus follows that determining the textual captions 114a, 114c, and 114d in Sano must also occur *prior to* and not “*in response to*” any user selection of a displayed vertical bar indication 808a, 808b, or 808c. Therefore, in contrast to “determining a second caption” “in response to receiving the first user input,” as required by Appellant’s claims, Sano teaches determining textual

captions 114a, 114c, and 114d *prior to* user selection of displayed vertical bar indication 808a, 808b, or 808c on first graphical features 806.

Reply Br. 6.

Appellants reiterate that Sano does not teach “pre-defined caption selection criteria.” *Id.* Regarding the asserted new ground, Appellants reiterate their previous arguments. *Id.*

Regarding dependent claims 2 and 14 (“same location on display”), Appellants argue that Figure 8 of Sano does not disclose that they are on the same location. *Id.* at 11–13. Appellants note that it is not clear that they are on the same location and the disclosure does not necessarily require that interpretation. *Id.* (citing Sano, Fig. 8). Regarding claim 18 (“same speaker”), Appellants argue this is an unreasonable interpretation because the Sano speaker referred to is a *device* speaker whereas the speaker in the claim is a *human* speaker. Reply Br. 13–16. According to Appellants, the Examiner’s interpretation is unreasonable and inconsistent with the Specification. *Id.* (citing Spec. ¶¶ 66, 144, 157, 158).

A claim is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently described in a single prior art reference, and arranged as required by the claim. *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987).

Claim terms in a patent application are given the broadest reasonable interpretation consistent with the Specification, as understood by one of ordinary skill in the art. *In re Crush*, 393 F.3d 1253, 1256 (Fed. Cir. 2004). Our reviewing court states that “the words of a claim ‘are generally given their ordinary and customary meaning.’” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) (citations omitted). However, the

broadest *reasonable* interpretation differs from the broadest *possible* interpretation. *In re Smith Int'l, Inc.*, 871 F.3d 1375, 1383 (Fed. Cir. 2017). The correct inquiry in giving a claim term its broadest reasonable interpretation in light of the specification is “an interpretation that corresponds with what and how the inventor describes his invention in the specification, *i.e.*, an interpretation that is ‘consistent with the specification.’” *Id.* at 1382–83 (*quoting In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997)).

We are not persuaded by Appellants’ arguments that the Examiner’s claim interpretations are improper or unreasonably broad (except as discussed below regarding dependent claim 18). Instead, we agree with the Examiner’s claim interpretations and findings that Sano discloses the limitations of claim 1.

Here, the use of the term “predefined caption selection criteria” in claim 1 includes the search for “Javascript” as disclosed by Sano. The interpretation of the term “predefined caption selection criteria” to include a search that may or may not be performed by the user is consistent with the Specification. *See Spec.* ¶¶ 153–157. With the “first user input” referring to the selection of one (“second caption”) of the search results, this selection is in response to the first user input, and the second caption meets the predefined caption selection criteria (contains “Javascript”). Sano discloses “determining a second segment of the video that corresponds to the second caption (selecting appropriate vertical bar); sending instructions to change from playing the first segment of the video to playing the second segment of the video (selecting appropriate vertical bar or); and outputting the second caption.” Sano ¶¶ 66, 72, 73, Fig. 8.

Moreover, the term “in response to” includes directly in response to as well as in response through an intervening step. Here, for example, even if the “first user input” is considered the search for “Javascript,” the selection of a particular text caption is an intervening step which is based on the first selection of the use of the term “JavaScript” and may be considered as part of the “first user input.”

Insofar as Appellants protest a failure to designate a new ground of rejection, they present their protest to an inappropriate entity. The *Manual of Patent Examining Procedure (MPEP)* explains that 37 C.F.R. § 41.40 provides the “exclusive procedure” for requesting review of a failure to designate a new ground of rejection, i.e., through a petition to the Director under 37 C.F.R. § 1.181. *MPEP* § 1207.03(b) (9th ed. Rev. 07.2015 Nov. 2015). The *MPEP* also explains that “[t]his procedure should be used if an appellant feels an answer includes a new ground of rejection that has not been designated as such and wishes to reopen prosecution” *Id.*

Appellants apparently have not submitted a petition to the Director. The “[f]ailure of [an] appellant to timely file such a petition will constitute a waiver of any arguments that a rejection must be designated as a new ground of rejection.” 37 C.F.R. § 41.40(a).

Moreover, as discussed, *supra*, the Examiner’s mapping of the “first user input” to Sano’s search for the term “Javascript” also discloses the limitations of claim 1, and independent claims 11 and 13.

In view of the above we sustain the rejection of claim 1, independent claims 11 and 13 which are argued together with claim 1, and dependent claims 3, 5–10, 15–17, and 19–24 as these claims are not argued separately. *See* 37 C.F.R. § 41.37(c)(1)(iv).

Regarding dependent claims 2 and 4 (“wherein . . . the first caption and the second caption correspond to a same location on a display”), the Examiner has provided sufficient evidence that the location set in Figure 8 of Sano is the same location for the captions. Sano explains that “[f]urthermore, video display region 104 *may display a textual caption 818 (e.g., overlaid on video 110, or elsewhere)* that corresponds to audio currently being played synchronously with video 110 (e.g., via one or more speakers).” Sano ¶ 66, referring to Fig. 8 (emphasis added). The claim does not recite a specific location on the display and the description of “overlaid on video 110” and the specific location of the textual caption 818 constitutes (“wherein . . . the first caption and the second caption correspond to a same location on a display”). Therefore, we sustain the rejection of claims 2 and 4.

Regarding dependent claim 18 (“wherein the predefined caption selection criteria include that the first caption and the second caption correspond to a same speaker”), although the claim does not expressly recite that the speaker is a human speaker, here the Examiner’s interpretation to include a device speaker of Sano is unreasonably broad. The context of the Specification describing the claimed “speaker” is clearly contemplating a human speaker, and the Examiner’s interpretation is inconsistent with the Specification. *See* Spec. ¶¶ 27, 37, 43, 127, 157, 158; Figs. 5A, 5B, 6A–6C. Therefore, we do not sustain the rejection of claim 18.

The § 103 Rejections of dependent claims 5–10, 17, and 19–24

Appellants present no arguments specifically directed to the § 103 rejections. Because the Examiner’s findings and conclusions regarding the obviousness rejections are reasonable, and in view of our findings regarding

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the anticipation rejection of the independent claims over Sano, discussed *supra*, we sustain the rejection of claims 5–10, 17, and 19–24.

DECISION

We sustain the Examiner’s decision rejecting claims 1–4, 11, and 13–16 under 35 U.S.C. § 102.

We reverse the Examiner’s decision rejecting claim 18 under 35 U.S.C. § 102.

We sustain the Examiner’s decision rejecting claims and 5–10, 17, and 19–24 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-IN-PART