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BEFORE THE PATENT TRIAL AND APPEAL BOARD
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Ex parte ALAN C. CANNISTRARO, GREGORY S. ROBBIN, CASEY M.
DOUGHERTY, RAYMOND WALSH,
and MELISSA BREGLIO HAJJ
_____

Appeal 2018-002673
Application 13/267,749
Technology Center 2600
_____

Before MAHSHID D. SAADAT, ERIC B. CHEN, and
CARL L. SILVERMAN, *Administrative Patent Judges*.

SILVERMAN, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant[1] appeals under 35 U.S.C. § 134(a) from the Examiner's
Final Rejection of claims 1–8 and 21–28, which constitute all pending
claims. We have jurisdiction under 35 U.S.C. § 6(b). Appellant waived an
Oral Hearing that was scheduled for November 5, 2019.

We REVERSE.

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[1] Throughout this Decision, we use the word "Appellant" to refer to
"applicant" as defined in 37 C.F.R. § 1.42(a). Appellant identifies Apple
Inc. as the real party in interest. Appeal Br. 3.

STATEMENT OF THE CASE

The invention relates to mapping audio and text. Abstract; Spec. ¶¶ 8, 23, Figs. 8A, 8B, 5B. Claim 1, reproduced below, is exemplary of the subject matter on appeal (emphases added):

> 1. A method comprising:
> *obtaining an annotation* that comprises text data or voice data input *from a user*;
> *storing an association between the annotation and a specified location within a textual version of a work*;
> *inspecting a mapping between a plurality of audio locations in an audio version of the work and a corresponding plurality of text locations in the textual version of the work, wherein the mapping is based on an audio-to-text analysis of the audio version of the work*, to:
>> *determine a particular text location, of the plurality of text locations, that corresponds to the specified location, and*
>> *based on the particular text location, determine a particular audio location, of the plurality of audio locations, that corresponds to the particular text location*;
>> providing the annotation and the particular audio location to a media player to cause the media player to display or play the annotation during playback of the audio version of the work at a particular time based on the particular audio location;
>> wherein the method is performed by one or more computing devices.

Appeal Br. 25 (Claims App.).

THE REJECTIONS[2]

Claims 1–8 and 21–28 are rejected under pre-AIA 35 U.S.C.
§ 103(a) as being unpatentable over Starmen (US 2010/0324709 A1; pub.
Dec. 23, 2010) ("Starmen") in view of Spielberg et al (US 2006/0143559
A1; pub. Jun. 29, 2006) ("Spielberg") and Murphy US 8,484,027 B1; iss.
Jul. 9, 2013) ("Murphy"). Final Act. 6–24.

REFERENCES

Name	Reference	Date
Spielberg	US 2006/0143559 A1	Jun. 29, 2006
Rosenberg	US 2006/0194181 A1	Aug. 31, 2006
Starmen	US 2010/0324709 A1	Dec. 23, 2010
Murphy	US 8,484,027 B1	Jul. 9, 2013

ANALYSIS

Appellant argues, *inter alia*, that the Examiner errs in finding the
combination of Starmen, Spielberg, and Murphy teaches the claim 1[3]
limitations (also referred to as disputed limitations):

> *inspecting a mapping between a plurality of audio
> locations in an audio version of the work and a corresponding
> plurality of text locations in the textual version of the work,
> wherein the mapping is based on an audio-to-text analysis of
> the audio version of the work*, to:
>> *determine a particular text location, of the
>> plurality of text locations, that corresponds to the
>> specified location, and*
>> *based on the particular text location,
>> determine a particular audio location, of the*

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[2] The 35 U.S.C § 112 rejections of claims 9–20 and 29–40 are withdrawn in
view of Appellant's cancelling these claims. *See* Ans. 2; Advisory Action 2.
[3] Appellant argues claims 1, 3–7, and 21–28 as a group, and we choose claim
1 as representative of the group. *See* 37 C.F.R. § 41.37(c)(1)(iv).

> *plurality of audio locations, that corresponds to*
> *the particular text location.*

Appellant also argues that the Examiner provides insufficient motivation for one of ordinary skill in the art to combine Starmen, Spielberg, and Murphy.

Appeal Br. 5–19; Reply Br. 3–14.

In particular, Appellant argues that the Examiner misconstrues claim 1 and errs in applying the teachings of Spielberg. *Id.* According to Appellant's arguments, the disputed limitations can be considered to require[4]:

> *obtaining an annotation from a user*;
> storing an *association between the annotation and a*
> *specified location within a textual version of a work*;
> *inspecting a mapping between audio locations in an*
> *audio version and corresponding text locations in the textual*
> *version of the work* to:
> (Determination 1)
> *determine a particular text location that corresponds to the*
> *specified location*; and
> (Determination 2)
> *based on the particular text location, determine a particular*
> *audio location that corresponds to the particular text location.*

Id. (Emphasis added; the terms "Determination 1" and "Determination 2" added).

In the Final Action, the Examiner finds that Spielberg teaches mapping between audio locations in an audio version of the work and

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[4] The Examiner refers to Murphy for teaching the limitation, "wherein the mapping is based on an audio-to-text analysis of the audio version of the work." *See, for example,* Final Act. 8–9.

corresponding text locations in a textural version and teaches the disputed

limitations of claim 1:

> inspecting a mapping between a plurality of audio
> locations in an audio version of the work and a corresponding
> plurality of text locations in the textual version of the work to:
> determine a particular text location, of the plurality of text
> locations, that corresponds to the specified location (The server
> computer comprises an annotator that is configured to associate
> the audio comment file with a location in the document that
> corresponds to the portion of the audio file playing when the
> user provided the comment. . . . ., para. [0024]-[0026]; para.
> [0028]-[0030]; para. [0138]; Navigator 1806 uses the line
> ID/audio map 1504 to synchronize the current display line with
> the audio playback . . . ., para. [0158]; In one embodiment,
> selection of an annotation scrolls the display to the line
> associated with the annotation and may initiate playback of the
> audio annotation file . . . . , para. [0165],
> *synchronizing/associating audio comment/annotation with*
> *location in text document of multiple locations that correspond*
> *to audio location in file of multiple audio locations as implying*
> *limitation*), and based on the particular text location, determine
> a particular audio location, of the plurality of audio locations,
> that corresponds to the particular text location (para. [0024];
> para. [0167]); providing the annotation and the particular audio
> location, to a media player to cause the media player to display
> or play the annotation during playback of the audio version of
> the work at a particular time based on the particular audio
> location (para. [0024]; para. [0071]; para. [0167]; para. [0185]).

Final Act. 7–8.

In the Appeal Brief, Appellant argues that, although Spielberg

describes determining a location in document, it does not do so by

"inspecting a mapping" as required by claim 1. Appeal. Br. 9. Appellant

argues that, even assuming Spielberg's "line ID/audio map" is accepted as a

"mapping" of claim 1, Spielberg's "line ID/audio map" is not inspected to

perform the two determinations[5] required by claim 1. Appeal Br. 14 (citing

Spielberg ¶¶ 28, 71, 161, 164, 167, 185, 186). According to Appellant:

> Thus, when a user listens to the audio file and initiates a command to create an annotation, Spielberg's system uses the "line ID/audio map" to determine a document line number to be associated with the annotation. As such, Spielberg at most discloses using its "line ID/audio map" to, based on a location in the audio file, identify a text location (i.e., the document line number) to be associated with the annotation. Spielberg's implementation is therefore **exactly the opposite** of an implementation involving "based on the particular text location, determine a particular audio location," as required by claim 1. Accordingly, Spielberg does not teach or suggest the claimed limitation.
>
> Put another way, Spielberg converts a text file into an audio file and allows the user *to create annotations when consuming the audio file (as opposed to the textual version).* As such, it naturally follows that Spielberg's system first obtains an audio location in the currently-playing audio file and then uses its "line ID/audio map" to identify a text location (i.e., the document line number). It is nonsensical for Spielberg's system to "inspect[] a mapping . . . to: . . . based on the particular text location, determine a particular audio location, of the plurality of audio locations, that corresponds to the particular text location" as recited in claim 1, since Spielberg implements the exact opposite functionality of the claimed method (annotations made in an audio context, rather than a textual context).
>
> Indeed, the Examiner's arguments demonstrate a misunderstanding as to Appellants' position regarding Spielberg. Appellants do not simply argue that Spielberg fails to teach a mapping, or that the mapping is used to "synchronize

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[5] As discussed, *supra*: (Determination 1) *determine a particular text location that corresponds to the specified location*; and (Determination 2) *based on the particular text location, determine a particular audio location that corresponds to the particular text location.*

a current text display line with audio playback." Rather, Appellants argue that Spielberg fails to teach a mapping **in the manner claimed**. Claim 1 explicitly requires, *inter alia*, that inspection of the mapping results in determining "a particular text location" and "*based on the particular text location*," determining "a particular audio location." Such a feature is simply not taught in Spielberg.

Appeal Br. 14–15.

In the Answer, the Examiner refers to the Specification use of mapping audio to text, audio locations as time offsets, and text locations as including line numbers. Ans. 12–13 (citing Spec. ¶¶ 23, 28, 29, 31, 74). The Examiner finds:

> Spielberg discloses a method of augmenting audio data i.e. audio version of work with text data i.e. textual version of work by the use of a **map**/mapping associating **time codes** for the audio data with **line numbers** of the original text document, where the **line number-time code** information in the audio file is used to navigate within the audio file (Abstract) and where the line numbers for the text in the display are synchronized with audio through the use of the **line identifier-time code map 1504 (or** line code data channel 1505) generated during the text-to-speech conversion process (para. [0138]). Spielberg further discloses enabling a user to add audio/verbal/comment annotations to the textual document (para. [0019]) where an annotator module associates the audio/verbal/comment annotations file with a location in the text document (para. [0023]; para. [0024]), and using the **line number-time code information** to associate bookmark links and captured audio/verbal/comment annotations with line numbers of the original text document (Abstract).
>   Therefore,
> 1). Since Spielberg discloses using the **line number-time code information** (i.e. text location-audio location map/**mapping**) to associate captured audio/verbal/comment annotations with line numbers of the original text document (Abstract), Spielberg

discloses inspecting a mapping to determine a text location/line number among a plurality of text locations that corresponds to the location/**specified** location of the annotation, i.e. limitation "inspecting a mapping between a plurality of audio locations in an audio version of the work and a corresponding plurality of text locations in the textual version of the work . . . . to: determine a particular text location, of the plurality of text locations, that corresponds to the specified location", and 2). Since Spielberg discloses using the **line number-time code information** map/mapping 1504 to associate captured audio/verbal/comment annotations with line numbers of the original text document (Abstract), Spielberg discloses to determine a particular audio location, of the plurality of audio locations, that corresponds to the particular text location, because the "line numbers" location of text in the **line number-time code information map/mapping 1504** include the corresponding/associated "time code" or location of audio (see Spielberg, para. [0135]).

Nevertheless, Spielberg further explicitly states "The audio file 1500 provides the information used to determine the respective audio time code for a given line number" (para. [0158]), where the audio file 1500 (which includes the **line number-time code information** 1504) provides the information used to determine the respective audio time code for a given line number, i.e. based on the particular text location/**given line number**, determine a particular audio location/**audio time code**, of the plurality of audio locations/ audio time codes, that corresponds to the particular text location/ given line number

Therefore, Spielberg discloses ". . . . *and based on the particular text location, determine a particular audio location, of the plurality of audio locations, that corresponds to the particular text location*".

Furthermore, the **line number-time code information map/mapping 1504** used to associate captured audio annotation files with line numbers of the original text document (Spielberg, Abstract) obviates appellant's argument that it is <u>nonsensical</u> for Spielberg's system to inspect a mapping, as the inspected **line number-time code information map/mapping**

> **1504** is used obtain the location where the annotation is stored
> i.e. the particular or specified location, and not the opposite of
> the claim language like appellant is arguing.

Ans. 13–16.

In the Reply Brief, Appellant reiterates arguments presented in the

Appeal Brief and refers to the interpretation of the disputed limitations:

> Claim l requires "determin[ing] a particular text location,
> . . . ., that corresponds to *the* specified location [within a *textual*
> version of the work]"[6] 1 and ""based on *the* particular text
> location, determine a particular audio location, ..., that
> corresponds to the particular text location." Accordingly, claim
> 1 requires "determin[ing] a particular *text location"*
> **corresponding to "the specified *[textual] location"* and then
> "based on the particular *text location [corresponding to the
> specified textual location],* determin[ing] a particular *audio
> location."* Such feature is simply *absent* in the Spielberg
> reference the Examiner relied upon for allegedly teaching the
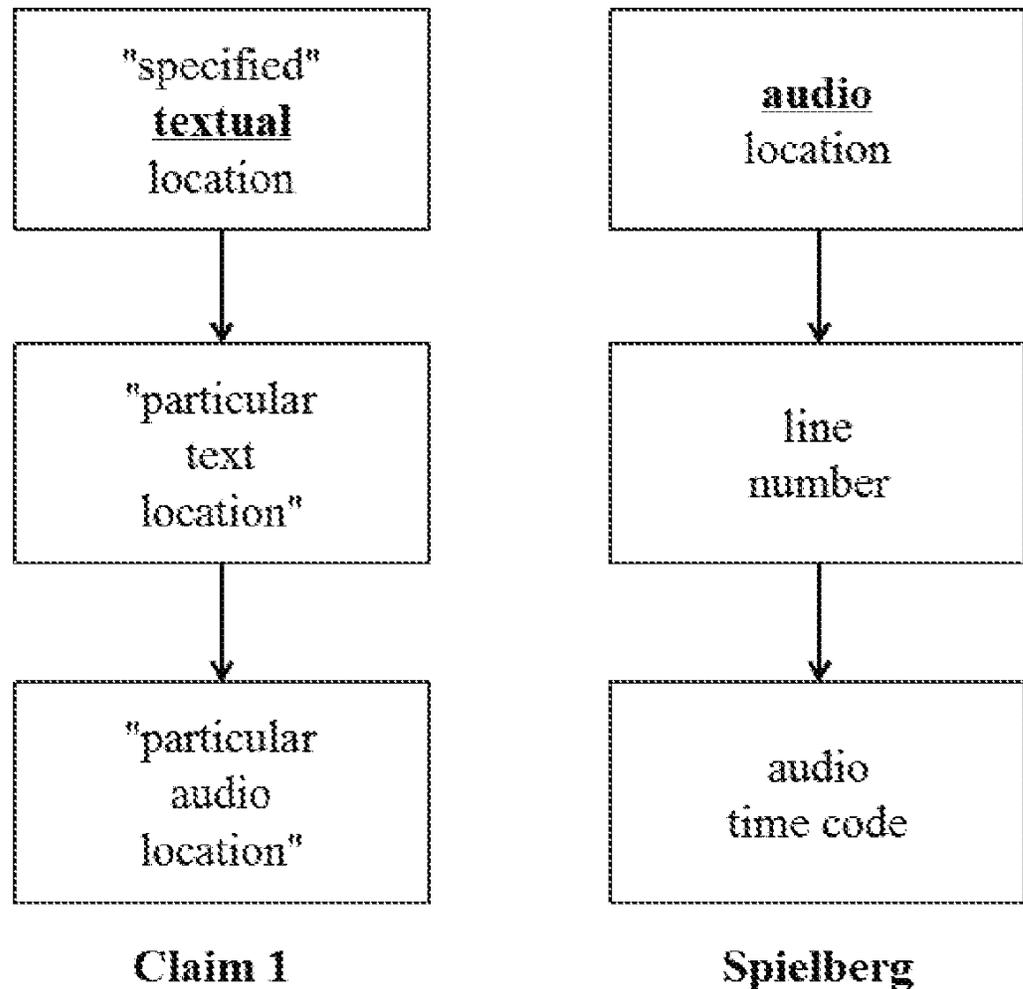> instant claim limitation.

Reply Br. 3.

Appellant argues the Examiner improperly cited additional paragraphs

135 and 158 of Spielberg in the Answer, and the Examiner errs in finding

that the navigator 1806 of these paragraphs determines an audio time code

for a line number using the "lineID audio map" and teaches "based on the

particular text location, determine a particular audio location, of the plurality

of audio locations, that corresponds to the particular text location of claim

1." *Id.* at 6 (citing Spielberg ¶ 158). Appellant argues the Examiner's

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[6] According to Appellant, "[b]y virtue of antecedent basis, '"the specified
location" refers to '"a specified location within a textual version of a work"
in claim l. Reply Br. 3.

findings are based on failure to consider the antecedent basis required by

claim 1. *Id.* According to Appellant:

> As discussed, by virtue of antecedent basis, claim 1 requires that "a particular audio location" is "determin[ed]" "based on *the* particular text location [determined to correspond *the* specified location within a *textual* version of a work]."[7] Simply put, claim 1 requires "determin[ing] a particular *audio location*" "based on" a "*text location*" previously determined to correspond to a "specified" *textual location.* This requirement of claim l is schematically illustrated in the chart below (page 8). In contrast, even if Spielberg's audio time code (corresponding to an annotation) were an "audio location" and if Spielberg's line number were a "text location" (which Appellant does not concede), Spielberg's line number used to determine Spielberg's audio time code was *not* previously determined to correspond to a "specified" *textual location.* Rather, Spielberg's line number was previously determined to correspond to an *audio location* (see the chart below). [The chart below illustrates a flow chart of the method of claim 1 and the teaching of Spielberg]

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[7] Appellant cites "*Digital Biometrics, Inc. v. Identix, Inc.,* 149 F.3d 1335. 1345 (Fed. Cir. 1998). *See also Process Control Corp. v. HydReclaim Corp.,* 190 F.3d 1350, 1356 (Fed. Cir. 1999) (finding that the "identical" claim language "clearly indicates that 'a discharge rate' in clause *[b]* is the same as 'the discharge rate' in clause [d]").

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┌──────────────────┐              ┌──────────────────┐
│    "specified"   │              │      audio       │
│     textual      │              │     location     │
│     location     │              │                  │
└──────────────────┘              └──────────────────┘
          │                                 │
          ▼                                 ▼
┌──────────────────┐              ┌──────────────────┐
│    "particular   │              │       line       │
│       text       │              │      number      │
│    location"     │              │                  │
└──────────────────┘              └──────────────────┘
          │                                 │
          ▼                                 ▼
┌──────────────────┐              ┌──────────────────┐
│    "particular   │              │      audio       │
│       audio      │              │    time code     │
│    location"     │              │                  │
└──────────────────┘              └──────────────────┘

      Claim 1                         Spielberg
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[The chart above illustrates a flow chart of the method of claim 1 and the teaching of Spielberg]

This is because, as established in the Appeal Brief, Spielberg teaches that a user *creates annotations while listening to an audio file.* Thus, Spielberg discloses first using an *audio file location* to identify a *line number* associated with the annotation.[8] Accordingly, the **line number** associated with the annotation in Spielberg **is previously determined to correspond to an audio location, not to a text location**. It follows that when Spielberg subsequently determines the annotation audio location (e.g., the audio time code) based on the line number

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[8] Appellant cites Appeal Brief at page 15.

> associated with the annotation,[9] ***the annotation audio location
> is determined based on a line number previously determined
> to correspond to an audio location***. This **is *exactly the opposite***
> of claim 1, which requires that the "particular audio location" is
> "determin[ed]" "based on *the* particular text location"
> previously determined to "correspond to the specified *[textual]
> location."*
>
> Thus, as explained in Appellant's opening brief:
> Spielberg fails to disclose or suggest "based on ***the*** particular
> text location, determine a particular audio location."
> Accordingly, the rejection of the Group A claims should be
> reversed.

Reply Br. 7–8.

We are persuaded by Appellant's arguments because, on the record
before us, the Examiner presents insufficient evidence that Spielberg teaches
the disputed limitation.

During prosecution, claims must be given their broadest reasonable
interpretation when reading claim language in light of the Specification as it
would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of
Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). While we interpret
claims broadly but reasonably in light of the Specification, we nonetheless
must not import limitations from the Specification into the claims. *See In re
Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993). 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*

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[9] Appellant cites Spielberg at ¶ 138.

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)).

Here, the Examiner's claim interpretation of the disputed limitation is unreasonably broad, and fails to address the antecedent basis for the "specified location." Instead, we agree with the Appellant's claim interpretation that requires "a particular text location that corresponds to the *specified location*" (Determination 1) to be the "specified location" recited in "storing an association between the annotation and a *specified location* within a textural version of a work."

Although Spielberg teaches mapping audio and text, on the record before us, the Examiner has not sufficiently shown that Spielberg teaches the disputed limitation. We agree that the Examiner has not shown that Spielberg teaches the claimed relationship between the *specified location* in "storing an association between the annotation and a *specified location* within a textural version of a work" and "a particular text location that corresponds to the *specified location*" (Determination 1). In particular, Spielberg's annotation is determined to correspond to a line number associated with an audio location, not to a text location, and the annotation audio location is determined based on a line number previously determined to correspond to an audio location. *See* Spielberg ¶ 138; Reply Br. 7–8.

In view of the above, we do not sustain the rejection of claim 1, and dependent claims 2–18, and 21–28. *Cf. In re Fritch*, 972 F.2d 1260, 1266

(Fed. Cir. 1992) ("[D]ependent claims are nonobvious if the independent claims from which they depend are nonobvious . . . .").

Because our decision with regard to the disputed limitation is dispositive of the rejections, we do not address additional arguments raised by Appellant.

DECISION

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1–8, 21–28	103(a)	Starmen, Spielberg, Murphy		1–8, 21–28
Overall Outcome				1–8, 21–28

REVERSED