UNITED STATES PATENT AND TRADEMARK OFFICE

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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 LEWIS S. OSTROVER

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Appeal 2018-003670
Application 12/950,213[1]
Technology Center 2100

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Before ERIC S. FRAHM, DENISE M. POTHIER, and
JUSTIN BUSCH, *Administrative Patent Judges.*

FRAHM, *Administrative Patent Judge.*

DECISION ON APPEAL

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[1] According to Appellant, Warner Brothers Home Entertainment Inc. is the
real party in interest (Br. 2).

STATEMENT OF THE CASE

This is a decision on appeal under 35 U.S.C. § 134(a) from the Final
Rejection of claims 1, 5, 6, 23–28, and 35–40. Claims 2–4, 7–22, and 29–34
have been canceled.

We reverse.

The Examiner rejected claims 1, 5, 6, 23–28, and 35–40 under
35 U.S.C. § 103(a) as being unpatentable over Mercer (US 7,136,874 B2;
issued Nov. 14, 2006) and Swart (US 2003/0028890 A1; published Feb. 6,
2003) (Final Act. 6–16; Ans. 2–7).

We have reviewed Appellant's arguments in the Brief (Br. 6–11), the
Examiner's rejection (Final Act. 6–16), and the Examiner's response (Ans.
2–7) to Appellant's arguments. We agree with Appellant's argument that
Swart, and thus the combination of Mercer and Swart, fails to teach or
suggest a mediator adapted to reject a program as recited in all of the claims
on appeal (*see, e.g.*, independent claims 1, 24, 40).

Claim 1 is illustrative, and is reprinted below with emphasis added to
the disputed and dispositive portion of the claim:

> 1. A user device providing content to one or more users as
> one of an audio, audio/visual or text program, via a rendering
> system, said rendering system including a plurality of rendering
> devices, each rendering device being associated with a
> respective set of rendering device characteristics defining the
> presentation format in which content is presented to a user by
> each said rendering device, said user device comprising:
>> a receiver receiving a program having a program format;
>> a mediator connected to said receiver and said rendering
> system and being responsive to a user command to select at
> least one of said rendering devices of said rendering system,
> *wherein said mediator is adapted to reject said program if*

> *said program is incompatible with the respective presentation*
> *format of said one of said rendering devices* ; and
>   an output receiving said program from said mediator, and
> providing said program to said one rendering device.

The Examiner relies upon Swart (*see* Final Act. 7 (citing Swart ¶¶ 47, 80–83, Figs. 9a–9c); *see also* Ans. 6 (citing Swart, Figs. 9b, 9c, steps 811–814, 819–822)) as teaching "wherein said mediator is adapted to *reject* said program if said program is incompatible," as recited in each of independent claims 1, 24, and 40 (emphasis added). However, for the reasons that follow, we find no teaching or suggestion in Swart of any *rejection* of a program, as recited in independent claims 1, 24, and 40, and as similarly recited in dependent claims 5, 6, 23, 25–28, and 35–39.

Swart teaches the opposite of what Appellant claims, namely *keeping* the information for further processing (e.g., reformatting to make the information compatible), not rejecting, discarding, or ignoring the information when it is found to be incompatible. This is evident from Figures 9b and 9c of Swart, which "show a flowchart describing programming content delivery" (Swart ¶ 32). As shown in steps 811–814 of Figure 9b, as well as steps 819–822 of Figure 9c, programming content is analyzed to determine compatibility of the format and coding scheme (Swart ¶¶ 80, 82).

> If the content is determined to meet the format requirements for
> delivery to the user, processing moves to routine 814. If the
> content does not meet the format criteria, the content stream
> and/or files are routed to the decoder and content formatter 252
> by (routine 812) along with the required formatting and coding
> parameters. At routine 813, the decoder and content formatter
> 252 decodes the incoming data . . . and its metadata. The
> decoder and content formatter 252 then reformats the content

> into the required formats and coding schemes for delivery to the
> user. Processing then moves to routine 823 for delivery . . . .

Swart ¶ 80 (describing Fig. 9b); *see also* Swart ¶ 82 (describing Fig. 9c
similarly). In other words, when the content is incompatible, Swart teaches
sending the content to content formatter 252 which then keeps the
information and further processes the information, namely
reformatting/recoding (*see* Swart, Figs. 9b, 9c, ¶¶ 80, 82).

This process differs from the process Appellant discloses in the
Specification and claims, which specifically calls for *ignoring, discarding,
or rejecting* incompatible programs/content (*see* Br. 4–5 (citing Fig. 3, step
312 (ignoring the content)); Fig. 5, step 518 (discarding the content); *see
also* Fig. 6, step 356 ("ignore/discard"); Spec. 13 (describing an embodiment
where "incompatible content may be filtered out or rejected"); Spec. 26
("[i]f there is no match then in one embodiment the content is discarded or
ignored (step 514)"); Spec. 27 ("the content is discarded (step 518) or
ignored"); Spec. 28 ("[i]f the content is not proper subject matter, then [sic]
it is discarded or ignored in step 356")). Although the Specification also
discloses alternative embodiments including transformations and
conversions (Spec. 9, 27), these embodiments do not include "rejecting" the
content. Rather, these alternative embodiments receive the content, but
transform the content into a format compatible with the respective
presentation format before storing or present the content to the user (Spec. 9,
26–27). Thus, embodiments that do not initially accept the content, but
accept the content after it has been transformed (or otherwise changed) into
a format compatible with the respective presentation format are not within
the scope of Appellant's claims.

Thus, the key issue in the case before us is how to interpret "reject" as the term is used in claims 1, 24, and 40.

During examination of a patent application, a claim is given its broadest reasonable construction "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) (citation omitted). We presume that claim terms have their ordinary and customary meaning. *See In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007) ("The ordinary and customary meaning 'is the meaning that the term would have to a person of ordinary skill in the art in question.'" (citation omitted)).

The plain meaning of "reject" is "to discard as useless or unsatisfactory."[2] This interpretation of "reject" used in claims 1, 24, and 40 is bolstered by Appellant's Specification, which describes "rejecting" as analogous to "ignoring/discarding" (*see* Fig. 3, step 312 (ignoring the content), Fig. 5, step 518 (discarding the content), Fig. 6, step 356 ("ignore/discard"); *see also* Spec. 13, 26, 27, 28).

In this light, we do not agree with the Examiner (*see* Ans. 5–6), and the Examiner has not sufficiently articulated how or why one of ordinary skill in the art at the time of Appellant's invention would have understood, that the claim language does not exclude the process of Swart (Swart ¶¶ 80, 82), which keeps incompatible information for further processing. Moreover, the Examiner's determination that "even if Swart did not provide

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[2] DICTIONARY.COM, https://www.dictionary.com/browse/reject (last visited Nov. 4, 2018) (defining "reject" as: "4. to discard as useless or unsatisfactory").

a teaching, suggestion, or motivation for this limitation . . . the art is replete with examples that clearly do" (Ans. 6 citing three new references for support), does not cure Swart's (or Mercer's) failure to teach or suggest rejecting incompatible programming. We have not considered these references since they are not part of the rejection. "Where a reference is relied on to support a rejection, whether or not in a 'minor capacity,' there would appear to be no excuse for not positively including the reference in the statement of the rejection." *In re Hoch*, 428 F.2d 1341, 1342 n.3 (CCPA 1970).

Thus, we conclude the Examiner's interpretation that "the claims do not preclude action occurring after the rejection of content" (Ans. 6), and thus, the term "reject" can be interpreted as "keeping for further processing," is unreasonably broad in light of Appellant's Specification. As a result, we concur with Appellant's arguments (Br. 7–11) that the Examiner erred in finding that Swart, and thus the combination of Mercer and Swart, teaches or suggests "wherein said mediator is adapted to reject said program if said program is incompatible" as recited in independent claim 1, and as similarly recited in independent claims 24[3] and 40.

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[3] We note that claim 24 recites "wherein said mediator is adapted to reject said program if said program is incompatible [sic] said rendering devices: operating in said one of said operating modes" (Br. 13, Claims Appendix). Based on our review of claims 1 and 40 which contain similar limitations, we understand claim 24 to recite "wherein said mediator is adapted to reject said program if said program is incompatible *with the respective representation format* of said rendering device operating in said one of said operating modes" (claim 24 (emphasis added)). We consider this harmless error. However, Appellant and/or the Examiner should consider correcting this issue with claim 24 upon further prosecution or allowance of this application.

Accordingly, we do not sustain the Examiner's obviousness rejection of claims 1, 5, 6, 23–28, and 35–40.

CONCLUSION

Appellant has persuaded us of error in the Examiner's obviousness rejection of claims 1, 5, 6, 23–28, and 35–40.

DECISION

The decision of the Examiner to reject claims 1, 5, 6, 23–28, and 35–40 is reversed.

REVERSED