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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 NATHAN LESLIE SANDLAND
_____

Appeal 2018-009115
Application 13/623,043
Technology Center 2400
_____

BEFORE JOHN A. JEFFERY, JAMES W. DEJMEK, and
STEPHEN E. BELISLE, *Administrative Patent Judges*.

BELISLE, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant[1] appeals under 35 U.S.C. § 134(a) from a Final Rejection of
claims 1–4, 6, and 9–23. App. Br. 11. We have jurisdiction under
35 U.S.C. § 6(b).

We REVERSE.

STATEMENT OF THE CASE

The Claimed Invention

Appellant's invention generally relates to "systems, methods and devices configured to collect information about a television program playing on a display." Spec. ¶ 1. More specifically, Appellant's invention "determine[s] what a particular consumer is watching on television in order to deliver matched functionality, content and/or services, as a part of an interactive television suite of technologies." Spec. ¶ 15. According to the Specification, an exemplary embodiment includes:

> capturing display data from the media program as it is being presented; evaluating the display data to determine whether or not the display data includes a text overlay including information about the media program; and extracting text from the overlay in response to determining that the display data includes the text overlay, wherein the extracted text is associated with the media program.

Spec. ¶ 5.

Claim 1, reproduced below, is illustrative of the subject matter on appeal:

> 1. A method of identifying a media program, comprising:
>
> at a first electronic device coupled to a display device displaying the media program, the first electronic device including a processor and memory:
>
> without issuing a command to the display:
>
> capturing an image of display data from the media program;
>
> evaluating the image to determine whether or not the display data includes a portion with a text overlay with information about the media program, including evaluating one or more of:

a color of the portion;

a percentage of the image covered by the portion;

an arrangement of text within the portion; and

a contrast between the portion and the media program;

in accordance with a determination that the display data does not include the text overlay, initiating a delay period;

at the end of the delay period and without being prompted by user interaction, repeating the capturing and the evaluating;

in accordance with a determination that the display data does include the text overlay, extracting text from the text overlay; and

obtaining the identity of the media program based on the extracted text.

App. Br. 18 (Claims Appendix).

The Applied References

The Examiner relies on the following references as evidence of unpatentability of the claims on appeal:

| Candelore | US 2008/0244637 A1 | Oct. 2, 2008 |
| King | US 2011/0025842 A1 | Feb. 3, 2011 |

The Examiner's Rejections

The Examiner made the following rejections of the claims on appeal:

Claims 1–4, 6, and 9–23 stand rejected under pre-AIA 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Final Act. 3–4.

Claims 1–4, 6, and 9–23 stand rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Candelore and King. Final Act. 4–9.

ANALYSIS[2]

Section 112 Rejection

Appellant disputes the Examiner's finding that the Specification does not provide written description support for the limitation "without issuing a command to the display," as recited in independent claim 1. App. Br. 13–14; Reply Br. 5; Final Act. 3–4. Appellant argues that the Specification provides support for this limitation at least at Figure 3 and paragraph 37, because it discloses, *inter alia*, "identifying instances during which the primary set-top box provides the overlay *by monitoring the display output* provided by the primary set-top box, and parsing the overlay for the desired information," as well as "detecting when channel identifiers are displayed *without being prompted by user interaction* (i.e., a user pressing a button)." App. Br. 13 (citing Spec. ¶ 37, Fig. 3) (emphasis altered). Appellant argues that the foregoing disclosure is to be distinguished from other methods disclosed in the Specification that do include issuing a command to the display, like "*transmitting* a first infrared (IR) code (or the like) to the primary set-top box *in order to initiate the display of the program information overlay*." App. Br. 13–14 (citing Spec. ¶ 40, Fig. 4) (emphasis altered). We find Appellant's argument persuasive.

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[2]   Throughout this Decision, we have considered Appellant's Appeal Brief filed April 26, 2018 ("App. Br."); Appellant's Reply Brief filed September 25, 2018 ("Reply Br."); the Examiner's Answer mailed August 16, 2018 ("Ans."); the Final Office Action mailed September 25, 2017 ("Final Act."); and Appellant's Specification filed September 19, 2012 ("Spec.").

To satisfy the written description requirement, the disclosure must reasonably convey to skilled artisans that Appellant possessed the claimed invention as of the filing date. *See Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc). Specifically, the description must "clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed" and

> the test requires an objective inquiry into the four corners of the specification from the perspective of a person of ordinary skill in the art. Based on that inquiry, the specification must describe an invention understandable to that skilled artisan and show that the inventor actually invented the invention claimed.

Ariad Pharms., Inc., 598 F.3d at 1351 (internal quotations and citations omitted). Additionally, the Examiner has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims. *In re Wertheim*, 541 F.2d 257, 265 (CCPA 1976).

Here, the Examiner finds "the specification does not describe 'without issuing a command to the display' in combination with 'text overlay' and 'delay time'." Ans. 4; Final Act. 4. The Examiner bases this finding on an observation that a command to the display must occur to cause the display to show certain information or the text overlay, as it does not appear by default. *See* Ans. 5 ("[T]he information or the text overlay does not display[] in the media program presentation by default, a user can set preferences or actively send a command to display the text overlay."). But Appellant argues "[t]he Examiner appears to be conflating 'a user issuing a command' with 'the first electronic device issuing a command.'" Reply Br. 5. We agree.

Claim 1 requires, *inter alia*, that a *first electronic device* coupled to a display device capture an image of display data from a media program and

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determine whether the display data includes a text overlay "*without issuing a command to the display*," not that the display data and text overlay appear without a user issuing a command to the display. As discussed above, the Specification discloses a first electronic device "monitoring the display output provided by the primary set-top box, and parsing the overlay for the desired information," as well as "detecting when channel identifiers are displayed without being prompted by user interaction (i.e., a user pressing a button)." App. Br. 13 (citing Spec. ¶ 37, Fig. 3) (emphasis omitted). Based on the foregoing and our review of the Specification and Briefs, we find the Examiner has not shown by a preponderance of the evidence that Appellant's Specification would not reasonably convey to skilled artisans that Appellant possessed the claimed feature of "without issuing a command to the display." *See Inphi Corp. v. Netlist, Inc.*, 805 F.3d 1350, 1355 (Fed. Cir. 2015) (noting that negative limitations are adequately supported when the specification describes a reason to exclude the relevant limitation).

Accordingly, we do not sustain the Examiner's rejection under pre-AIA 35 U.S.C. § 112 of independent claim 1. For similar reasons, we do not sustain the Examiner's rejection under pre-AIA 35 U.S.C. § 112 of independent claims 9 and 14, which each recite the same challenged limitation. Additionally, we do not sustain the Examiner's rejection under pre-AIA 35 U.S.C. § 112 of claims 2–4, 6, 10–13, and 15–23, which depend therefrom.

Section 103 Rejection

Appellant disputes the Examiner's finding that the combination of Candelore and King renders obvious claims 1–4, 6, and 9–23, including independent claims 1, 9, and 14. *See* App. Br. 14–17; Reply Br. 6–7.

Appellant argues the appealed claims as a group. *See* App. Br. 12 ("Claim 1 is representative."). Thus, for purposes of our analysis, we select independent claim 1 as the representative claim, and any claim not argued separately will stand or fall with our analysis of the rejection of claim 1. *See* 37 C.F.R. § 41.37(c)(1)(iv).

Appellant argues, *inter alia*, the combination of Candelore and King does not teach "evaluating [an] image to determine whether or not the display data includes a portion with *a text overlay with information about the media program*," as recited in independent claim 1. Reply Br. 6 (emphasis altered); *see* App. Br. 14–15. We provide a brief review of these references below.

Candelore is generally directed to "a method and apparatus for obtaining metadata program information during [television] channel changes." Candelore, Abstract. Candelore's method includes "the capture of an on-screen display that is rendered by a rendering device such as, for example, a digital television system," where "[t]he on-screen display may be generated by an access device such as a set-top box in response to a program selection event." *Id.* "Once captured, the on-screen display may be decoded to determine metadata for a program selected by the program selection event," where the "decoding may be provided using pattern matching, optical code recognition (OCR) or other like decoding technique." *Id.*

King is generally directed to "[a] system and method for automatically changing the operation of a mobile device in response to a presence of information." King, Abstract. King's system "determines an information capture device is proximate to text, automatically changes operation of the capture device to a certain mode, captures the text, and performs an action

associated with the captured text." *Id.* King's system is "'text aware' in that at any time it can determine whether it is in the presence of text" (*Id.* ¶ 234), and "[o]nce the system determines that text is present, the system may begin the extraction process" (*Id.* ¶ 235).

The Examiner agrees with Appellant that Candelore alone "does not teach nor suggest evaluating an image to determine whether or not the display data includes a text overlay," but finds King "could be utilized to make such a determination" (Ans. 6):

> Candelore teaches displaying an [on-screen display (OSD)] or image overlay to be captured, King's system . . . is able to capture the OSD or image overlay in proximity to Candelore's display device, King's system is able to process image overlay by markup analysis. . . . Therefore, in combination, Candelore and King disclose [evaluating an image to determine whether the display data includes a text overlay].

Ans. 8. Appellant disagrees, and argues "King discloses looking for text, any type of text, not a text overlay with information about the media program." Reply Br. 7; App. Br. 14–15. Appellant also argues "King would not distinguish between text that is part of the media program itself (e.g., a letter being displayed to the audience) and text that is part of a text overlay with information about the media program." Reply Br. 7. Appellant further argues "a combination of the teachings of King and Candelore would result in Candelore's system attempting to extract text from a text overlay each time King's system detects any text whatsoever." Reply Br. 7. We find Appellant's argument persuasive.

Claim 1 recites evaluating an image of display data from a media program to determine whether the display data includes a portion with a text overlay with information about the media program. That is, claim 1 requires

determining that display data includes a text overlay.[3] Although we agree

with the Examiner that Candelore discloses capturing an on-screen display

(Ans. 8), and that King discloses determining the presence of text and

extracting such text (*id.*), we find the Examiner has not sufficiently shown

that Candelore and King teach determining whether display data includes a

text overlay. More specifically, the Examiner does not provide sufficient

evidence or technical reasoning as to how King (or the combination of

Candelore and King) teaches distinguishing between text that is part of the

media program itself, and text that is part of a text overlay with information

about the media program, i.e., "determin[ing] *whether or not* the display data

includes a portion with a text overlay with information about the media

program" as recited in claim 1. Because we find this issue dispositive here,

we do not address Appellant's other arguments.

Accordingly, constrained by the present record, we do not sustain the

Examiner's rejection under pre-AIA 35 U.S.C. § 103(a) of independent

claim 1. For similar reasons, we do not sustain the Examiner's rejection

under pre-AIA 35 U.S.C. § 103(a) of independent claims 9 and 14, which

recite commensurate limitations. Additionally, we do not sustain the

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[3]   We note that independent method claim 1, for example, includes
conditional limitations to be performed depending on whether display data
includes a text overlay. As the prior art need only teach one or the other of
such yes-no conditional limitations, the Examiner should take this into
consideration in any further prosecution in this case, to the extent not already
done. *See Ex parte Schulhauser*, Appeal 2013-007847 (PTAB Apr. 28,
2016) (precedential) (noting that the broadest reasonable interpretation of a
method claim having contingent limitations requires only those steps that
must be performed and does not include steps that are not required to be
performed because the condition(s) precedent are not met).

Examiner's rejection under pre-AIA 35 U.S.C. § 103(a) of claims 2–4, 6,

10–13, and 15–23, which depend therefrom.

DECISION SUMMARY

Claims Rejected	35 U.S.C. §	Reference(s)/ Basis	Affirmed	Reversed
1–4, 6, 9–23	112	Written Description		1–4, 6, 9–23
1–4, 6, 9–23	103	Candelore, King		1–4, 6, 9–23
Overall Outcome				1–4, 6, 9–23

REVERSED