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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* BUNGO TAMARI

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Appeal 2019-002911  
Application 15/057,492  
Technology Center 2400

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Before ROBERT E. NAPPI, THU A. DANG, and  
JOHN P. PINKERTON, *Administrative Patent Judges*.

PINKERTON, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant<sup>1</sup> appeals under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 1–9, which are all of the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

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<sup>1</sup> We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies Yahoo Japan Corporation as the real party in interest. Appeal Br. 1.

## STATEMENT OF THE CASE

### *Introduction*

Appellant generally describes the disclosed and claimed invention as follows:

A generation apparatus according to the present application includes an acquiring unit that acquires information on usage of a moving image content corresponding to a partial moving image used as a key image of the moving image content in a terminal device that is a distribution destination of the partial moving image, and a generating unit that generates a partial moving image corresponding to the moving image content on the basis of the information acquired by the acquiring unit.

Spec. 3:22–4:5.<sup>2</sup>

The Specification explains that a provider of a moving image distribution service distributes various moving images for a price or fee in accordance with user requests. *Id.* at 1:21–23; 6:25–7:3. The Specification also explains that the generation apparatus “clips out a part of the moving image content to generate a partial moving image (hereinafter, described as a ‘moving image thumbnail’) used as a key image of the moving image content.” *Id.* at 7:5–8. Then, the generation apparatus acquires information on a user who uses the service and “generates a moving image thumbnail on the basis of the acquired information.” *Id.* at 7:9–17.

Claims 1, 8, and 9 are independent claims. Claim 1, which is reproduced below, is illustrative of the subject matter on appeal:

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<sup>2</sup> Our Decision refers to the Final Office Action mailed June 15, 2018 (“Final Act.”), the Appeal Brief filed Nov. 26, 2018 (“Appeal Br.”) and Reply Brief filed Feb. 27, 2019 (“Reply Br.”), the Examiner’s Answer mailed Dec. 31, 2018 (“Ans.”), and the Specification filed Mar. 1, 2016 (“Spec.”).

1. A server that composes moving thumbnails tailored to users, comprising:

a communicator that:

acquires information on usage of a moving image content corresponding to a first thumbnail used as a key image of the moving image content in a terminal device that is a distribution destination of the first thumbnail; and

acquires a time point during the first thumbnail when the moving image content is requested; and

a processor configured to:

select a first portion of the moving image content corresponding to the time point;

select a second portion of the moving image content based on the acquired information, the second portion of the moving image content being absent from the first thumbnail; and

generate a new moving image thumbnail in which the second portion of the moving image content is played, and the first portion of the moving image content is played at a middle point or immediately after a start point of the new moving image thumbnail.

Appeal Br. A-1 (Claims App.).

*Rejections on Appeal*

Claims 1-5, 8, and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Han (US 2015/0163536 A1; published June 11, 2015), Park (US 2010/0083115 A1; published Apr. 1, 2010), and Zhang et al. (US 9,465,435 B1; issued Oct. 11, 2016) (“Zhang”). Final Act. 2-5.

Claims 6 and 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Han, Park, Zhang, and Lee (US 2016/0103561 A1; published Apr. 14, 2016). Final Act. 5-6.

## ANALYSIS

The dispositive<sup>3</sup> issue raised by the arguments in Appellant’s briefs is whether the combination of Han, Park, and Zhang teaches or suggests “a first thumbnail” used as a key image of the moving image content, as recited in claim 1, and as similarly recited in independent claim 8.<sup>4</sup>

The Examiner rejects claim 1 under 35 U.S.C. § 103(a) for obviousness over the combination of Han, Park, and Zhang. Final Act. 2–4. In the Answer, the Examiner states, “Han is not cited to disclose moving image thumbnails. Park and Zhang disclose moving image thumbnails.” Ans. 4. In response to Appellant’s argument that independent claim 1 recites “moving image thumbnail” in the language, “a first thumbnail used as a key image of the moving image content,” and “a communicator that . . . acquires a time point during the first thumbnail when the moving image content is requested,” the Examiner finds that these limitations “recite moving image content and not a moving image thumbnail.” *Id.* The Examiner also finds that “moving image thumbnail” is mentioned only in the limitation, “a processor configured to . . . generate a new moving image thumbnail in which the second portion of the moving image content is played, and the first portion of the moving image content is played.” *Id.* at 5. Moreover, the Examiner notes that the term “moving thumbnails” is used in the preamble of claim 1, but finds that “moving thumbnails is not giv[en]

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<sup>3</sup> Appellant raises other arguments in its briefs, but we do not address them because we determine that this issue is dispositive.

<sup>4</sup> Appellant argues claims 1–5, 8, and 9 as a group focusing on claim 1. *See* Appeal Br. 7–13. Accordingly, we select claim 1 as illustrative, and the remaining claims stand or fall with claim 1. *See* 37 C.F.R. § 41.37(c)(1)(iv).

any weight because it is in the preamble and it is not tied to the ‘moving image thumbnails’ in other parts of the claim.” *Id.*

We are persuaded by Appellant’s arguments that the Examiner erred. Initially, we conclude that the Examiner erred in construing the term “first thumbnail” to mean a “still image.” Appellant argues “[i]t is apparent from the claims that the first thumbnail is a moving image thumbnail.” Appeal Br. 8. In that regard, Appellant argues that claim 1 recites moving image thumbnails in the following language:

“a first thumbnail used as a key image of the moving image content,” and “a communicator that . . . acquires a time point during the first thumbnail when the moving image content is requested,” and “a processor configured to . . . generate a new moving image thumbnail in which the second portion of the moving image content is played, and the first portion of the moving image content is played.”

*Id.* (emphasis added).

Appellant also argues that the “first thumbnail is a moving image thumbnail” because claim 1 recites “acquires a time point during the first thumbnail,” and “[i]t is impossible to ‘acquire a time point during’ a still image.” *Id.* Similarly, Appellant argues that “because a still image does not have a ‘time point,’ the first thumbnail should not be interpreted as a still image.” Reply Br. 2. Although the Examiner states that claim 1 recites “acquires a time point during the first thumbnail when the moving image content is requested” and not “during the duration of the moving image thumbnail” (*see* Ans. 8), Appellant argues there is “little meaningful difference” between “a time point during the first thumbnail,” as recited in claim 1, and a time point “during the duration of the moving image thumbnail.” Reply Br. 2. Appellant further argues:

For there to be a time point during the first thumbnail, the first thumbnail must have a timeline. Because still images do not have timelines, it would be impossible to define the first thumbnail as being a still image.

*Id.*

As mentioned *supra*, the Specification states that the generation apparatus “clips out a part of the moving image content to generate a partial moving image (hereinafter, described as a ‘moving image thumbnail’) used as a key image of the moving image content.” Spec. 7:5–8. The Specification also states that the generation apparatus “generates a moving image thumbnail by clipping out a part (for example, 10 seconds) of a moving image content at an arbitrary position.” *Id.* at 7:21–8:4; *see also* 11:10–12:21 (stating the generation apparatus “learns a model that can optimize a moving image thumbnail”). Thus, when the term “first thumbnail” is viewed in the context of the other limitations of claim 1, and the Specification, we agree with Appellant’s arguments that the first thumbnail is a moving image thumbnail. Accordingly, we conclude that the term “first thumbnail” in claim 1 does not mean a “still image,” but means “first moving image thumbnail.”<sup>5</sup>

We now turn to the dispositive issue of whether the combination of Han, Park, and Zhang teaches or suggests the “first moving image thumbnail” of claim 1. The Examiner states that “Han is not cited to disclose anything about ‘moving image thumbnails’.” Ans. 5; *see also id.* at 4. The Examiner finds that Park teaches “moving image thumbnails”

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<sup>5</sup> In the event of further prosecution of this application, we recommend that Appellant consider amending the claims to be consistent with our construction of the term “first thumbnail” to mean “first moving image thumbnail.”

because Park discloses displaying first thumbnail images from a program, extracting second thumbnail images from the same program, and displaying the second thumbnail images “in different man[ners] and by rolling them, switching their order by a fade out scheme, or by overlapping the second thumbnails or by rotating them into the position of the first thumbnails.” *Id.* at 6–7 (citing Park ¶¶ 20–26). The Examiner also finds that Zhang teaches generating moving image thumbnails because Zhang discloses “a summary video or a trailer for a video can also be generated using segments of the video associated with high user engagement levels.” *Id.* at 7 (citing Zhang 5:25–55; 15:33–65).

We are persuaded by Appellant’s arguments that the Examiner erred. In regard to Park, Appellant argues that the Examiner’s reliance on Park’s use of special effects to display still image thumbnails does not teach or suggest “moving image thumbnails.” Reply Br. 3. Appellant notes that the portions of Park relied on by the Examiner describe that “the still image thumbnails can be displayed using special effects such as fade-outs, overlapping, rolling, and that the first still image thumbnail can be replaced by the second still image thumbnail when displayed.” *Id.* (citing Park ¶¶ 20–26). Appellant also argues, and we agree, that the Specification “defines a ‘moving image thumbnail’ as a part of the moving image content clipped to generate a partial moving image.” *Id.* (citing Spec. 7: 5–8). Thus, we agree with Appellant’s argument that Park does not teach or suggest “moving image thumbnails” as claimed, and described in the Specification, because “Park’s still images with special effects are not moving image clips of the original moving image content.” *Id.* at 3–4.



In regard to Zhang, Appellant argues, and we agree, that the Examiner’s newly cited portion of Zhang discloses “automatically generating a trailer or recommending engaging segments in, e.g., a search.” *Id.* at 4 (citing Zhang 3:25–55; *see also id.* 15:33–64). Appellant argues that “[n]either a trailer nor a segment recommendation would be considered a ‘thumbnail’ by one skilled in the art” because a person of ordinary skill “would consider a thumbnail to be a reduced-size image containing a link to larger content.” *Id.* (citing <https://www.techopedia.com/definition/479/thumbnail>). The cited definition from Techopedia Dictionary defines “thumbnail” as “a reduced-size representation of a picture.” *Id.* Thus, we agree with Appellant’s argument that “[b]ecause a trailer is normally played at the same size as the underlying content, and the recommended segments are not even defined as being pictorially represented, Zhang does not disclose a ‘thumbnail’ in the cited passages.” *Id.* We also agree with Appellant’s argument that “[w]hen Zhang does refer to thumbnails, it describes them as ‘static media (e.g., pictures, thumbnails).’” *Id.* (citing Zhang 5:25). Lastly, we agree with Appellant’s argument that:

In summary, Zhang separately discloses trailers and search results (which may or may not be moving), and still image thumbnails. Zhang does not combine these concepts to result in a moving image thumbnail. Thus, Zhang does not disclose generating moving image thumbnails.

*Id.*

Accordingly, we find the preponderance of the evidence establishes that the cited portions of Park and Zhang, individually or collectively, do not teach or suggest a “first thumbnail,” as recited in claim 1, which we construe

to mean a “first moving image thumbnail.” The Examiner does not rely on Han to teach this limitation. Thus, we do not sustain the Examiner’s rejection of claim 1. For the same reasons, we do not sustain the Examiner’s rejection of independent claims 8 and 9, and dependent claims 2–7, which stand together with claim 1. *See* 37 C.F.R. § 41.37(c)(1)(iv).

DECISION

We reverse the Examiner’s rejection of claims 1–5, 8, and 9 under 35 U.S.C. § 103(a) as being unpatentable over Han, Park, and Zhang.

We reverse the Examiner’s rejection of claims 6 and 7 under 35 U.S.C. § 103(a) as being unpatentable over Han, Park, Zhang, and Lee.

DECISION SUMMARY

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
1–5, 8, 9	103(a)	Han, Park, Zhang		1–5, 8, 9
6, 7	103(a)	Han, Park, Zhang, Lee		6, 7
<b>Overall Outcome</b>				1–9

REVERSED