

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAKOB NIELSEN

Appeal No. 2000-0962
Application 08/885,801

ON BRIEF

Before JERRY SMITH, FLEMING and BARRY, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-15, 17-22 and 26. Claims 16 and 23 have been cancelled. Claims 24 and 25 were indicated to contain allowable subject matter. An amendment after final rejection was filed on June 23, 1999 but was denied entry by the examiner. Appellant has withdrawn the appeal with respect to claims 1, 6, 7, 12 and 17 [brief, page 2]. Therefore, this appeal is now directed to the rejection of claims 2-5, 8-11,

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13-15, 18-22 and 26.

The disclosed invention pertains to a method and apparatus for automatically capturing network addresses, such as Internet addresses, from live broadcast video such as television.

Representative claim 20 is reproduced as follows:

20. A system for retrieving information, comprising:

- a. a network;
- b. at least one server connected to said network having information stored thereon; and
- c. computer apparatus, connected to said network, configured to receive an image from a video signal, to automatically identify a network address contained in said image and to use said address to retrieve information from a server over said network.

The examiner relies on the following references:

Fitzpatrick et al. (Fitzpatrick)	5,262,860	Nov. 16, 1993
Hidary et al. (Hidary)	5,774,664	June 30, 1998
		(filed Mar. 25, 1996)

Claims 2, 4, 8, 13-15 and 18-22 stand rejected under 35 U.S.C. § 102(b) as being anticipated by the disclosure of Fitzpatrick. Claims 3, 5, 9-11 and 26 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Fitzpatrick and Hidary.

Rather than repeat the arguments of appellant or the examiner, we make reference to the briefs and the answer for the

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respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of anticipation and obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon supports each of the rejections made by the examiner. Accordingly, we affirm.

We consider first the rejection of claims 2, 4, 8, 13-15 and 18-22 under 35 U.S.C. § 102(b) as being anticipated by the disclosure of Fitzpatrick. Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L.

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Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

The basis for this rejection of the claims is set forth on pages 2-5 of the final rejection which has been incorporated into the examiner's answer [answer, page 4]. Before arguing each of the claims individually, appellant makes several general observations about Fitzpatrick. Specifically, appellant argues that Fitzpatrick does not disclose how to identify an address automatically because Fitzpatrick requires a manual user input of a template, and because Fitzpatrick requires the user to manually assure that a telephone number has been captured [brief, pages 5-7]. The examiner responds that the manual operations in Fitzpatrick are optional, and the optical character recognition process in Fitzpatrick automatically identifies or recognizes the network address from the video image [answer, pages 5-6].

With respect to these general observations, we agree with the examiner that Fitzpatrick discloses the step of automatically identifying at least one network address contained in the image. The information read by the optical character recognition device in Fitzpatrick is automatically analyzed and stored in computer

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processor 66 [steps 94, 102 and 112]. As noted by the examiner, the manual use of a template and the manual verification of the data are both optional steps as indicated by a negative template defines response and a negative verification display response in Figure 3 of Fitzpatrick.

With respect to claim 2, appellant argues that Fitzpatrick only stores data in a separate step after a user has selected the option of storing the data, and does not unconditionally store the text as part of storing the image [brief, page 7]. The examiner responds by explaining how the Fitzpatrick device meets the language of claim 2 [answer, pages 6-7].

We agree with the examiner. As shown in Figure 3 of Fitzpatrick, the step of "store data with image" (step 112) is always performed as long as there is text or number information found within the image and the user wishes to have such information stored. The invention of claim 2 is, therefore, met by Fitzpatrick at the option of the user. We sustain the rejection of claim 2.

With respect to claim 4, appellant argues that Fitzpatrick does not teach or suggest a parser [brief, page 7]. The examiner responds that the step of reading text and numbers

in Fitzpatrick constitutes a parsing of the text or data to identify one or more network addresses [answer, page 7].

This argument appears to hinge on the definition of parsing. We agree with the examiner that the step of reading text and numbers in Fitzpatrick constitutes a parsing of the items of data to identify one or more network addresses. Therefore, we sustain the rejection of claim 4.

With respect to claim 8, appellant argues that Fitzpatrick teaches to store a single frame when a user issues a command and not more than one sequential frame [brief, page 7]. The examiner responds by explaining how sequential frames are disclosed by Fitzpatrick [answer, page 8]. We agree with the examiner for reasons explained by the examiner in the answer. Therefore, we sustain the rejection of claim 8.

With respect to claim 13, appellant makes the same argument we considered above with respect to claim 2. Therefore, we sustain the rejection of claim 13 for the same reasons discussed above.

With respect to claim 14, appellant argues that Fitzpatrick does not teach or suggest that the apparatus downloads, uses or otherwise accesses the information at the other site [brief, page 8]. The examiner responds by explaining

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how the connection in Fitzpatrick meets the language of claim 14 [answer, pages 9-10]. We agree with the examiner for reasons stated in the answer. Therefore, we sustain the rejection of claim 14.

With respect to claim 15, appellant argues that Fitzpatrick does not teach deriving a second image from the first image or storing the second image [brief, page 8]. The examiner responds by explaining how the language of claim 15 reads on the disclosure of Fitzpatrick [answer, pages 10-11]. We agree with the examiner as explained in the answer. Therefore, we sustain the rejection of claim 15.

With respect to claims 18-22, appellant makes arguments that were considered above with respect to previously considered claims. Therefore, we sustain the rejection of claims 18-22 for reasons discussed above.

Appellant has requested that we make a recommendation under 37 CFR § 1.196(c) that claims 1, 12, 17 and 20 would be allowable if amended by inserting the phrase "arbitrarily long" before the first occurrence of "network address" in each of these claims [brief, page 9]. We decline to make such a recommendation because the factual findings relevant to such a recommendation are not present on this record.

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We now consider the rejection of claims 3, 5, 9-11 and 26 under 35 U.S.C. § 103 based on Fitzpatrick and Hidary. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re

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Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived by appellant [see 37 CFR § 1.192(a)].

The examiner's rejection is set forth on pages 5-8 of the final rejection which has been incorporated into the examiner's answer. Appellant argues that although Hidary teaches obtaining a uniform resource locator (URL) network address from a video program signal, the URL is not located in a portion of the image which is perceptible to the human eye, and is therefore, opposite to the claimed invention. Appellant also argues that the examiner has not provided a proper technical reason or motivation to combine the teachings of Fitzpatrick and Hidary [brief, pages

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9-11]. The examiner responds that Fitzpatrick teaches using data such as a telephone number, address, or other textual or numerical information. Hidary is cited to teach that it was known to search for URL addresses in a video signal. We agree with the examiner that it would have been obvious to the artisan to extend the teachings of Fitzpatrick to identify URL addresses transmitted as part of the image. We also note that Fitzpatrick searches for any text or numbers in the video image. Thus, Fitzpatrick would already detect the presence of URL addresses which are included within a video image.

With respect to claim 3, appellant argues that neither Fitzpatrick nor Hidary performs the validity check as recited in claim 3 [brief, page 11]. The examiner responds that the checking of the spelling of a network address in Hidary broadly constitutes a step of checking the validity of the network address. We agree with the examiner that the invention as broadly recited in claim 3 would have been obvious over the teachings of Fitzpatrick and Hidary. Therefore, we sustain the rejection of claim 3.

With respect to claims 5, 9-11 and 26, appellant argues features which were discussed above and that Hidary does not teach URL addresses taken from the image [brief, pages 11-12].

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In addition to the responses discussed above, the examiner responds that appellant is improperly attacking the references individually [answer, pages 16-18].

We agree with the position argued by the examiner. When video images include URL addresses, the apparatus of Fitzpatrick will automatically read this information as noted above. We agree with the examiner that the artisan would have been motivated to look for URL addresses for reasons taught by Hidary. Therefore, we sustain the rejection of claims 5, 9-11 and 26.

In summary, we have sustained each of the examiner's rejections of the claims on appeal. Therefore, the decision of the examiner rejecting claims 2-5, 8-11, 13-15, 18-22 and 26 is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

JERRY SMITH)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
MICHAEL R. FLEMING)	
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