

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 MAK ABECASSIS

---

Appeal No. 1998-2602  
Application 08/303,158

---

ON BRIEF

---

Before FLEMING, LALL, and LEVY, Administrative Patent Judges.  
LALL, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the final rejection<sup>1</sup> of claims 1, 7, 10, 14, 16 and 19, the remaining claims having been canceled by the amendment after the final rejection [paper no. 13].

---

<sup>1</sup>An amendment after the final rejection was filed as paper no. 13 whose entry was approved by the Examiner in paper no. 15.

The invention is directed to a video system and method that enables a video provider to select, retrieve, and transmit a video, such as an advertisement, to a viewer in response to a video request received from the viewer, verifying an apparent viewing by the viewer of the transmitted video; and, responsive to verifying, crediting an account of the viewer, the crediting subsidizing services provided to the viewer. The invention is further illustrated by the following claim below.

1. A video system comprising:

storing means for storing a plurality of video advertisements;

communicating means for receiving a request for product information from a viewer;

processing means for selecting a video advertisement from said plurality of video advertisements responsive to said request;

retrieving means for retrieving the selected video advertisement;

transmitting means for transmitting the retrieved video advertisement to said viewer;

verifying means for verifying an apparent viewing, by said viewer, of the transmitted video advertisement; and

crediting means for crediting, responsive to said verifying, an account of said viewer, said crediting subsidizing services provided to said viewer.

Appeal No. 1998-2602  
Application 08/303,158

The Examiner relies on the following references:

Von Kohorn	5,227,874	Jul. 13, 1993
Ushiki et al. (Ushiki) <sup>2</sup>	5,438,356	Aug. 1, 1995 (Filing date: May 19, 1993)

Claims 1, 7, 10, 14, 16 and 19 stand rejected under  
35 U.S.C. § 103 over Ushiki and Von Kohorn.

Rather than repeat in toto the positions and the arguments  
of Appellant or the Examiner, we make reference to the brief and  
the answer for their respective positions.

#### OPINION

We have considered the rejection advanced by the Examiner.  
We have, likewise, reviewed Appellant's arguments against the  
rejection as set forth in the brief.

We affirm.

In rejecting a claim under 35 U.S.C. § 103, an examiner is  
under a burden to make out a prima facie case of obviousness. If  
that burden is met, the burden of going forward then shifts to

---

<sup>2</sup>The instant application was filed on September 8, 1994, and  
is a continuation-in-part of 08/002,998, filed on January 11,  
1993, which was in turn a continuation-in-part of 07/832,335,  
filed on February 7, 1992. Thus, even though the grand parent-  
in-part dates before the filing date of the Ushiki reference,  
Appellant has not raised the issue of the possibility of the  
benefit of the earlier filing date. We assume that the Ushiki  
reference is valid against the claims on appeal in accordance  
with the final rejection on appeal.

Appeal No. 1998-2602  
Application 08/303,158

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 In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); 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).

We are further guided by the precedents of our reviewing court that the limitations from the disclosure are not to be imported into the claims. In re Lundberg, 244 F.2d 543, 548, 113 USPQ 530, 534 (CCPA 1957); In re Queener, 796 F.2d 461, 464, 230 USPQ 438, 440 (Fed. Cir. 1986). We also note that the arguments not made separately for any individual claim or claims are considered waived. See 37 CFR § 1.192 (a) and (c). In re Baxter Travenol Labs., 952 F.2d 388, 391, 21 USPQ2d 1281, 1285 (Fed. Cir. 1991) ("It is not the function of this court to examine the claims in greater detail than argued by an appellant, looking for nonobvious distinctions over the prior art."); In re Wiechert, 370 F.2d 927, 936, 152 USPQ 247, 254 (CCPA 1967) ("This court has uniformly followed the sound rule that an issue raised below which is not argued in this court, even if it has been properly brought here by reason of appeal is regarded as

abandoned and will not be considered. It is our function as a court to decide disputed issues, not to create them.")

We consider claim 1. After discussing each reference individually, the Examiner asserts [answer, page 5] that "[i]t would have been obvious ... to modify Ushiki et al's video advertisement system wherein the accounting means provided thereof would incorporate the capability of compensating the viewer for the apparent viewing of the transmitted video advertisement responsive to a verifying means which verify the apparent viewing of the transmitted video signal in the same conventional manner as shown by Von Kohorn."

Appellant argues [brief, pages 4 to 6] that the suggested combination of the references is improper because "[t]here is no suggestion or motivation provided by Ushiki to interfere with that communication as would be required by a combination with Von Kohorn" [id. at 6]. We disagree. We are of the opinion that Appellant is looking for an explicit teaching for the Examiner-suggested combination. Appellant's view in this regard is misplaced because while there must be some teaching, reason, suggestion, or motivation to combine existing elements to produce the claimed device, it is not necessary that the cited references or prior art specifically suggest making the combination (see B.F. Goodrich Co. v. Aircraft Braking Systems Corp., 72 F.3d

Appeal No. 1998-2602  
Application 08/303,158

1577, 1583, 37 USPQ2d 1314, 1319 (Fed. Cir. 1996) and In re Nilssen, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988)) as Appellant would apparently have us believe. Rather, the test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

Moreover, in evaluating such references it is proper to take into account not only the specific teachings of the references but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968). Here, both Ushiki and Von Kohorn show the means and methods of transmitting additional information from the storage units (i.e., advertisements) to each computer terminal in response to a request. In Ushiki, the accounting part of the system merely measures the amount of such transmission for the purposes of fee calculation, whereas in Von Kohorn, means and method for verifying the viewing of the transmitted advertisement are shown. We agree with the Examiner that it would have been obvious for an artisan to utilize the verifying teachings of Von Kohorn in Ushiki to assess the

effectiveness of the advertisement transmission.

Furthermore, Appellant argues [brief, page 8] that “[i]n Von Kohorn the discount does not result from answering the question, the discount only results from the additional required step of purchasing the product or otherwise surrendering the token. Given the historically low coupon redemption rates, most viewers in Von Kohorn would not in fact receive a discount or value”. The Examiner responds [answer, page 6] that “Von Kohorn does clearly disclose the capability giving to the viewer some rewards upon answering questions related to the advertisement.” We are persuaded by the Examiner’s reasoning. We note that the term “verifying” recited in the claim is not restrictive, especially in view of the disclosure in the specification which, at page 80, lines 8 to 11, states that “[t]he specific technique of establishing that the advertisement is being viewed is secondary. A variety of other active and passive means may be implemented that establish a viewer’s presence during the viewing of the advertisement 1153.” Thus, Von Kohorn does show the broadly claimed verifying means and method.

Therefore, we sustain the obviousness rejection of claim 1 and the grouped claims 7, 10, 14, 16 and 19 (brief, page 4) over

Appeal No. 1998-2602  
Application 08/303,158

Ushiki and Von Kohorn.

Accordingly, the decision of the Examiner rejecting claims 1, 7, 10, 14, 16 and 19 under 35 U.S.C. § 103 is affirmed.

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

AFFIRMED

MICHAEL R. FLEMING	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
PARSHOTAM S. LALL	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
STUART S. LEVY	)	
Administrative Patent Judge	)	

PSL:pgg  
Max Abecassis  
3207 Clint Moore Road #205  
Boca Raton FL. 33496-3938

Appeal No. 1998-2602  
Application 08/303,158