

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* NISSIM CORPORATION  
Appellant

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Appeal 2013-007673  
Reexamination Control No. 90/011,459  
U.S. Patent No. 6,304,715  
Technology Center 3900

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Before KARL D. EASTHOM, STEPHEN C. SIU, and ERIC B. CHEN,  
*Administrative Patent Judges.*

CHEN, *Administrative Patent Judge.*

DECISION ON APPEAL

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This is an appeal under 35 U.S.C. §§ 134(b) and 306 from the final rejection of claims 1-10. An oral hearing was held on September 8, 2013. The record includes a written transcript of the oral hearing. We have jurisdiction under §§ 134(b) and 306. We reverse.

## STATEMENT OF THE CASE

### *Reexamination Proceedings*

A first request for *ex parte* reexamination of U.S. Patent No. 6,304,715 (the '715 patent) was filed on November 19, 2007 and assigned Reexamination Control No. 90/008,933. A reexamination certificate was issued on January 4, 2011, confirming the patentability of claims 1-17.

A second request for *ex parte* reexamination of the '715 patent was filed on January 28, 2011, requesting the reexamination of claims 1-10, and assigned Reexamination Control No. 90/011,459.

The '715 patent, entitled "Disc Having a Code for Preventing an Interference with a Playing of a Video Segment," issued October 16, 2001, to Max Abecassis, based on Application No. 08/988,172, filed December 10, 1997, which is said to be a divisional of Application No. 07/832,335, filed on February 7, 1992, now U.S. Patent No. 6,208,805, issued March 27, 2001, is now expired.

The '715 patent is said to be assigned to Nissim Corporation, said to be the assignee and real party in interest.

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### *Appellant's Invention*

Appellant's invention relates to playing a video provided by an optical disk. The video includes one segment excluded from the playing of the video and one other segment excluded from the playing of the other video. The one segment and the one other segment may be parallel, overlapping, or transitional segments. The one segment or the one other segment is responsive to a viewer's preference with respect to content categories and responsive to segment information, interface, and system control codes provided by the optical disk. (Abstract.)

### *Related Litigation*

The '715 patent has been subject to multiple patent infringement suits, *Nissim Corp. v. Time Warner, Inc.*, No. 2:08-cv-1529 (C.D. Cal. Mar. 5, 2008), *Nissim Corp. v. Time Warner, Inc.*, No. 2:08-cv-742 (C.D. Cal. Feb. 4, 2008), and *Nissim Corp. v. Time Warner, Inc.*, No. 1:07-cv-20624 (S.D. Fla. Mar. 8, 2007).

### *The Claims*

Independent claim 1 is exemplary and is reproduced below with disputed limitations in italics:

1. A laser readable disc for use in conjunction with a playback apparatus having a random access capability and a plurality of control functions for selectively playing separately addressed video segments, said laser readable disc comprising:

at least one spiral track storing a video program comprising a plurality of separately addressable video segments;

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video segment address information directly defining said plurality of separately addressable video segments; and

*at least one segment code, in addition to said address information, for preventing at least one of said control functions of said apparatus from interfering with a playing of at least one of said plurality of separately addressable video segments.*

### *The Rejections*

Claims 1-10 stand rejected under 35 U.S.C. 103(a) as being obvious over Arii (U.S. Patent No. 5,250,787; Oct. 5, 1993) and Yasue (Japan Patent Office Patent Application H3-136485; June 11, 1991).

Claims 1-3, 6, 9, and 10 stand rejected under 35 U.S.C. § 103(a) as obvious over Arii and Nomura (U.S. Patent No. 5,103,317; Apr. 7, 1992).

## ANALYSIS

### *§ 103 Rejection – Arii and Yasue*

We are persuaded by Appellant's arguments (App. Br. 19-23) that the combination of Arii and Yasue would not have rendered obvious independent claim 1, which includes the limitation "at least one segment code, in addition to said address information, for preventing at least one of said control functions of said apparatus from interfering with a playing of at least one of said plurality of separately addressable video segments."

The Examiner found that the secondary information identification code of Yasue corresponds to the claim 1 limitation "at least one segment code, in addition to said address information, for preventing at least one of

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said control functions of said apparatus from interfering with a playing of at least one of said plurality of separately addressable video segments.”

(Ans. 12.) In particular, the Examiner found that “it is stated that the code is superimposed ‘in advance’ on secondary information” that “would seem to suggest something entirely different than ‘throughout’ (i.e., in every frame).”

(Ans. 37.) We do not agree.

The Specification of the ’715 patent states that “[a]s used herein *segments* refers to a *sequence of frames*” (emphases added.) (Col. 6, l. 28.) Accordingly, we interpret the claim limitation “at least one segment code” as a “code” corresponding to a sequence of frames.

Yasue<sup>1</sup> relates to a video disk system having secondary information that prohibits a skip-viewing mode during replay of the secondary information. (P. 629, “Field of Use in Industry.”) For example, Yasue explains that a commercial message can be inserted into the secondary information. (P. 631, “Effect of the Invention.”) Yasue also explains that “[i]n order to achieve this objective, the video disk system with special information . . . having superimposed in advance on secondary information.” (P. 630, “A Means to Solve the Problems.”) Yasue further explains that “[t]he above-stated code detection circuit having the above-stated structure according to the instant invention operates to extract the secondary information identification code that is superimposed on the image signal in the secondary information.” (P. 630, “Operations.”) Figure 3 of Yasue

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<sup>1</sup> Reference is made to the English-language translation accompanying the request for ex parte reexamination by a third-party requester (Exhibit 18), filed January 28, 2011.

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illustrates a secondary information identification code superimposed on line 279.

Although the Examiner cited to the language of Yasue that the secondary information identification code is “superimposed ‘in advance’ on secondary information” (Ans. 37), the Examiner has provided insufficient evidence that the secondary information identification code corresponds to a sequence of image signals or frames. Accordingly, we are persuaded by Appellant’s arguments that “Yasue’s ‘secondary information identification code’ is a code superimposed on a line of each frame of the secondary information and every frame must contain a ‘secondary information identification code’ to identify the frame as part of the secondary information.” (App. Br. 20.)

Furthermore, claim 1 recites “at least one segment code, *in addition to said address information*, for preventing at least one of said control functions of said apparatus from interfering” (emphasis added). The Examiner had not identified any features of Yasue that correspond to the limitation “address information, for preventing at least one of said control functions of said apparatus from interfering.”

Thus, we do not agree with the Examiner that the combination of Arii and Yasue would have rendered obvious independent claim 1, which includes the limitation “at least one segment code, in addition to said address information, for preventing at least one of said control functions of said apparatus from interfering with a playing of at least one of said plurality of separately addressable video segments.”

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Accordingly, we do not sustain the rejection of independent claim 1 under 35 U.S.C. § 103(a). Claims 2-5 depend from independent claim 1. We do not sustain the rejection of claims 2-5 under 35 U.S.C. § 103(a) for the same reasons discussed with respect to independent claim 1.

Independent claim 6 recites limitations similar to those discussed with respect to independent claim 1. We do not sustain the rejection of claim 6, as well as dependent claims 7-10, for the same reasons discussed with respect to claim 1.

*§ 103 Rejection – Arii and Nomura*

We are also persuaded by Appellant’s arguments (App. Br. 25-26) that the combination of Arii and Nomura would not have rendered obvious independent claim 1, which includes the limitation “at least one segment code, in addition to said address information, for preventing at least one of said control functions of said apparatus from interfering with a playing of at least one of said plurality of separately addressable video segments.”

The Examiner found that the graphic code of Nomura, which inhibits a special reproduction operation, corresponds to the claim 1 limitation “at least one segment code, in addition to said address information, for preventing at least one of said control functions of said apparatus from interfering with a playing of at least one of said plurality of separately addressable video segments.” (Ans. 18.) The Examiner further found that “the claims do not require that the segment code must be ‘related’ to a separately addressable segment, but merely require that there be at least one

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segment code, ‘in addition to’ the address information.” (Ans. 28.) We do not agree.

Claim 1 recites “video segment *address information* directly defining said plurality of separately addressable video segments . . . at least one segment code, *in addition to said address information*, for preventing at least one of said control functions of said apparatus from interfering with a playing of . . . separately addressable video segments.” Accordingly, claim 1 requires a correlation between the “one segment code” and the “separately addressable video segments,” which is defined by the “address information.”

Nomura relates to a recording medium playing apparatus (col. 1, ll. 9-10) for playing a recording medium that includes a coded information signal and picture information, inserted as subcodes into the coded information signal (Abstract). In one example, a caption, a musical score or an explanation of a scene, obtained from the subcode, can be inserted into either a video area or a still picture. (Col. 14, ll. 4-10; *see also* figs. 15A-15C.) Nomura explains that the recording medium playing apparatus includes a device for inhibiting a special reproduction operation (e.g., double speed reproduction operation) when a graphic code detection signal is present to prevent “disorder” during the special reproduction operation. (Col. 3, ll. 34-46; *see also* Abstract). Nomura further explains that a compact disc (CD) 20 includes a CD area 20a and a video area 20b with “index codes relating to the contents recorded in each area, such as first and second code groups formed correspondingly to each area by the repetition of

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index codes which respectively indicate start and end times of small portions which together constitute each area.” (Col. 5, ll. 46-51.)

Although the Examiner cited the inhibition of the special reproduction operation as corresponding to the claimed “one segment code,” the Examiner has provided insufficient evidence to support a finding that the claimed “one segment code” is correlated to a “separately addressable video segments,” as required by claim 1. Accordingly, we are persuaded by Appellant’s argument that “Nomura has ‘video segment address information directly defining said plurality of separately addressable video segments’ [as recited in claim 1] in the ‘index codes’ in the lead-in area” but “the segments of the program during which a play control function are disabled by detection of the graphic code in Nomura are not disclosed or suggested to correspond to the addressable video segments in this table of video segment addresses.” (App. Br. 26.)

Thus, we do not agree with the Examiner that the combination of Arii and Nomura would have rendered obvious independent claim 1, which includes the limitation “at least one segment code, in addition to said address information, for preventing at least one of said control functions of said apparatus from interfering with a playing of at least one of said plurality of separately addressable video segments.”

Accordingly, we do not sustain the rejection of independent claim 1 under 35 U.S.C. § 103(a). Claims 2 and 3 depend from independent claim 1. We do not sustain the rejection of claims 2 and 3 under 35 U.S.C. § 103(a) for the same reasons discussed with respect to independent claim 1.

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Independent claim 6 recites limitations similar to those discussed with respect to independent claim 1. We do not sustain the rejection of claim 6, as well as dependent claims 9 and 10, for the same reasons discussed with respect to claim 1.

*Substantial New Question*

Because we do not sustain the rejections of claims 1-10 under 35 U.S.C. 103(a), Appellant's arguments (App. Br. 9-15) that the substantial new question of patentability determination was improper are rendered moot.

DECISION

The Examiner's decision rejecting claims 1-10 is reversed.

REVERSED

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Third Party Requester:

MORRISON & FOERSTER, LLP  
555 WEST FIFTH STREET  
SUITE 3500  
LOS ANGELES, CA 90013-1024

Patent Owner:

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314