



Serial No. 08/470,571
Docket No. 05634.0261

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : John C. HARVEY and
James W. Cuddihy

Serial No. : 08/470,571

Filed : June 6, 1995

For : SIGNAL PROCESSING APPARATUS AND METHODS

Group Art Unit : 2614

Examiner : HARVEY, David E.

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313

APPEAL BRIEF

In accordance with 37 C.F.R. § 41.37, appellants submit this appeal brief in the above captioned application. Appellants appeal the final rejection of claims 56-58, 60-63, 65-74, 80, 81, 84, 85, 87, 89-91, 93-95, 98, 100, 102, 103, 106-109, and 183-197 set forth in the Office action mailed April 28, 2004 (the "Final Office Action"). A Notice of Appeal was filed in accordance with 37 C.F.R. § 41.31 on September 20, 2004. Attached hereto is a check for \$1520.00 covering the fee set forth in 37 C.F.R. 41.20(b)(2) and the three-month extension fee under 37 C.F.R. § 1.136. Any additional fees that may be due but are not attached may be charged to Deposit Account No. 06-1075.

This application must be treated as special by the Office. This application has been pending for over nine years (having been filed on June 6, 1995) and, by claim of priority to Application No. 06/317,519 filed November 3, 1981, has an effective pendency of more than 23 years. The Office treats as special "[a]pplications pending more than 5 years, including those which, by relation to a prior United States application, have an effective pendency of more than 5 years." M.P.E.P. §§ 707.02 and 708.01(I). Accordingly, this application should be advanced out of turn and acted upon expediently.

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Real Party In Interest

The real party in interest is Personalized Media Communications, LLC (“PMC”) having a place of business at 708 Third Ave., New York, New York, 10017.

Related Appeals And Interferences

The application is a continuation of Ser. No. 08/113,329, filed August 30, 1993, which remains pending and is a continuation of Ser. No. 56,501, filed May 3, 1993, now Pat. No. 5,335,277, which is a continuation of Ser. No. 849,226, filed March 10, 1992, now Pat. No. 5,233,654, which is a continuation of Ser. No. 588,126, filed September 25, 1990, now Pat. No. 5,109,414, which is a continuation of Ser. No. 96,096, filed September 11, 1987, now Pat. No. 4,965,825, which is a continuation-in-part of Ser. No. 829,531, filed February 14, 1986, now Pat. No. 4,704,725, which is a continuation of Ser. No. 317,510, filed November 3, 1981, now Pat. No. 4,694,490. Additionally, U.S. Patent 5,887,243 has issued from an application with an identical disclosure to the instant application and a claim of priority to the above chain of applications. These applications and patents have been involved in the following appeals and judicial proceedings.

Pat. Nos. 4,965,825; 5,109,414 and 5,335,277 were asserted in the U.S. District Court, Eastern District of Virginia in the case styled *Personalized Mass Media Corp. v. The Weather Channel, Inc. et al.*, Doc. No. 2:95cv242. The case was settled prior to any substantive decision by the Court, although one procedural decision was published at 899 F.Supp. 239 (E.D.Va. 1995).

Pat. No. 5,335,277 was involved in the matter of *Certain Digital Satellite System (DDS) Receivers and Components Thereof* before the United States International Trade Commission (“Commission”), Investigation No. 337-TA-392. The Administrative Law Judge (“ALJ”) issued an “Initial Determination Granting Motion for Summary Determination of Invalidity of Claim 35 of the ‘277 Patent” on May 16, 1997. This determination was appealed to the U.S. Court of Appeals for the Federal Circuit (“Federal Circuit”), which affirmed the Commission decision in a

decision decided January 7, 1999. The ALJ issued “Initial and Recommended Determinations” on October 31, 1997. The Commission adopted certain of the ALJ’s findings and took no position on certain other issues in a “Notice Of Final Commission Determination Of No Violation Of Section 337 Of The Tariff Act Of 1930,” dated December 4, 1997. This determination was appealed to the Federal Circuit, which affirmed-in-part, reversed-in-part, vacated-in-part, and remanded in a decision decided November 24, 1998 published at 161 F.3d 696, 48 U.S.P.Q.2d 1880. On remand, the complainant moved to terminate the investigation. The Commission issued a “Notice Of Commission Decision To Terminate The Investigation And To Vacate Portions Of The Initial Determination” on May 13, 1999.

Pat. Nos. 4,965,825; 5,109,414 and 5,335,277 were asserted in the U.S. District Court, Northern District of California in the case styled *Personalized Media Communications, LLC v. Thomson Consumer Electronics et al.*, Doc. No. C-96 20957 SW (EAI). The case was stayed during the Commission proceedings and was thereafter voluntarily dismissed by the plaintiffs. The Court issued no substantive decisions.

Each of the issued patents with the exception of Pat. No. 4,704,725 is also asserted in the U.S. District Court, District of Delaware in the case styled *Pegasus Development Corp. v. DIRECTV Inc.*, Doc. No. CA 00-1020 (“Delaware Action”). Special Master Robert L. Harmon has issued a “Report And Recommendation Of Special Master Regarding Claim Construction.” The Court has taken no further action in this case as it has been stayed pending the reexamination proceedings discussed below.

Each of the issued patents is asserted in a suit pending in the U.S. District Court, Northern District of Georgia in the case styled *Personalized Media Communications, LLC v. Scientific-Atlanta, Inc. et al.*, Doc. No. 1:02-CV-824 (CAP) (“Atlanta Action”). This suit is proceeding, as it has not been stayed pending the reexamination proceedings.

The Defendants in the Delaware Action and the Atlanta Action have submitted requests for reexamination for each of the issued patents. Each of the reexamination requests have been granted. The pending reexamination proceedings are as follows:

Pat. No. 4,694,490 Control No. 90/006,800,
Pat. No. 4,704,725 Control Nos. 90/006,697 and 90/006,841,
Pat. No. 4,965,825 Control No. 90/006,536,
Pat. No. 5,109,414 Control No. 90/006,838,
Pat. No. 5,233,654 Control Nos. 90/006,606, 90/006,703 and 90/006,839,
Pat. No. 5,335,277 Control Nos. 90/006,563 and 90/006,698, and
Pat. No. 5,887,243 Control No. 90/006,688.

The Office has not yet issued a substantive action in any of these proceedings.

In pending Application No. 08/113,329 to which this application claims priority, an appeal was noticed on August 20, 1996, and briefed September 13, 1996. Prosecution was reopened without consideration and the disputed rejection withdrawn in an Office action mailed October 10, 1997.

An appeal was noticed on October 7, 2004, in copending Application No. 08/487,526, which includes an identical disclosure to the instant application and a claim of priority to the same chain of applications set forth above.

Status Of Claims

Claims 56-58, 60-63, 65-74, 80, 81, 84, 85, 87, 89-91, 93-95, 98, 100, 102, 103, 106-109, and 183-197 are pending and stand rejected. The rejections of each of these claims are appealed. Claims 1-55, 59, 64, 75-79, 82, 83, 86, 88, 92, 96, 97, 99, 101, 104, 105, and 110-182 have been cancelled.

Status Of Amendments

No amendments to the claims have been entered or proposed subsequent to final rejection.

Summary Of The Invention

The claims are generally directed to telecommunications methods in which an image generated locally at a receiver station is presented with images transmitted to the receiver station.

The locally generated images are based on user specific subscriber data, thereby permitting a broadcast to be personalized for a particular user. The initial embodiment described in the description of the preferred embodiments (Spec. pp. 19-28) provides general support for these claims. In this embodiment, a television viewer watching the well-known program on stock market investing, “Wall Street Week,” sees a presentation including general graphics regarding generic market performance, e.g., performance of the Dow Jones Industrial Average, combined with locally generated images regarding the performance of the specific user’s portfolio. Claims 56, 80, 84, 93 and 187 are the independent claims that remain pending and are involved in this appeal. A concise explanation of the subject matter of each of these claims is set forth below.

1. Claim 56

Claim 56 is directed to a method for presenting a video presentation at a video apparatus, where the video presentation includes a remotely originated image and a locally generated image. The remotely originated image comes from a remote video source. The locally generated image is generated by processing remotely originated data received from a remote data source and user specific data. The remotely originated data is received based on a step of contacting the remote data source. The user specific data received at the video apparatus is specific to a user of the video apparatus. The remotely originated image and the locally generated image are displayed simultaneously.

The specification describes, for example, a method for presenting the “Wall Street Week” television program including a studio-generated graphic of generic market performance and a locally generated image of the performance of the user’s portfolio. (Spec. p. 25, l. 23 to p. 26, l. 12.) The studio-generated image is transmitted from the television station, which in turn receives the image from a remote television studio. (Spec. p. 20, ll. 21-29.) The locally generated image is generated by processing stock price data received from a remote data service, and a user’s portfolio data. (Spec. p. 24, l. 22 to p. 25, l. 8.) The stock price data is received based on telephoning a remote data service. (Spec. p. 449, ll. 26-35. The section of the specification

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