

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PERSONALIZED MEDIA COMMUNICATIONS, LLC

Appeal 2008-4228
Ex parte Reexamination Control 90/006,536
U.S. Patent 4,965,825
Technology Center 3900

Decided: December 19, 2008

Before LEE E. BARRETT, SCOTT R. BOALICK, and
KEVIN F. TURNER, *Administrative Patent Judges*.

BARRETT, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. §§ 134(b) and 306 from the final rejection of claims 1, 2, and 14-25. The Examiner has confirmed the patentability of claims 3-13.

We affirm-in-part.

STATEMENT OF THE CASE

1. Reexamination proceeding

Reexamination Control 90/006,536 was filed on February 4, 2003, by third party requester Thomson, Inc. (Requester), to request reexamination of claims 1, 2, 14-18, and 20-25 of U.S. Patent 4,965,825 ('825 patent), entitled "Signal Processing Apparatus and Methods," issued October 23, 1990, to John C. Harvey and James W. Cuddihy, based on Application 07/096,096, filed September 11, 1987. The real party in interest is the patent owner, Personalized Media Communications, LLC, New York, NY. The '825 patent is said to be a continuation-in-part (CIP) of Application 06/829,531, filed February 14, 1986, now U.S. Patent 4,704,725 (hereinafter referred to as the 1986 application or '725 patent), which is said to be a continuation of Application 06/317,510, filed November 3, 1981, now U.S. Patent 4,694,490 (hereinafter referred to as the 1981 application or '490 patent).

2. Related proceedings

The '825 patent is part of a chain of patents that includes four additional later issued patents and various pending patent applications. Patents 5,109,414, 5,233,654, 5,335,277, and 5,887,243 are all continuations of the present '825 patent. Each of the seven related patents is involved in reexamination proceedings (Br. 3). Before June 8, 1995, when the patent term was changed from 17 years from the date of issue to 20 years from the filing date of the earliest application relied on under 35 U.S.C. § 120,

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328 applications were filed having the same specification as the '825 patent, except for the claims.

The Board entered a decision on June 30, 2008, in Appeal 2007-4044, Reexamination Controls 90/006,697 and 90/006,841 (merged) for reexamination of Patent 4,704,725, and Appeal 2008-0334, Reexamination Control 90/006,800 for reexamination of Patent 4,694,490 (hereinafter "Appeals 2007-4044 and 2008-0334"). The Board entered a decision on rehearing in Appeals 2007-4044 and 2008-0334 on December 18, 2008. These decisions are partly incorporated by reference as discussed in the claim interpretation section (unambiguous claims in an expired patent in reexamination are not entitled to a narrower interpretation than their ordinary and customary meaning to define over the prior art) and the obviousness rejection over the CBS "Petition for Rulemaking" in view of Tsuboka or Marti (meaning of "user specific").

The Brief identifies (at Br. 3-6) a number of related U.S. Patent and Trademark Office (USPTO), International Trade Commission, and court proceedings.

The '825 patent is asserted in *Pegasus Development Corp. and Personalized Media Comm., LLC v. DIRECTV Inc.*, No. CA 00-1020 (GMS) (D. Del. filed Dec. 4, 2000), which the Brief indicates (at Br. 5) has been stayed, and is also asserted in *Personalized Media Communications, LLC v. Scientific-Atlanta, Inc. et al.*, No. 1:02-CV-824 (CAP) (N.D. Ga. filed Mar. 28, 2002), which has also been stayed.

3. Appellant's inventions

The rejected claims relate to two inventions.

1.

Claims 1, 2, and 14-19 relate to a signal processor apparatus and method for detecting a signal embedded in a carrier transmission (such as a television or radio broadcast) and monitoring its use. Figure 2, reproduced below, shows one embodiment of the signal processor apparatus.

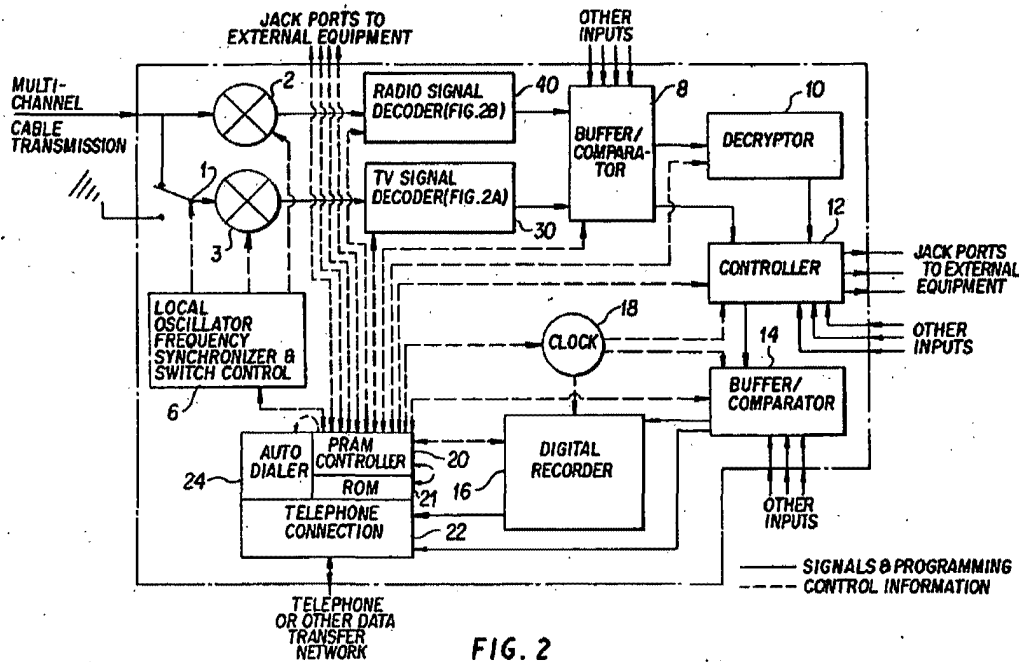


Figure 2 is a block diagram of a signal processor apparatus which, in relevant part, receives a carrier transmission through a cable (upper left); the carrier transmission is demodulated by the local oscillator 6 and mixer 3; the embedded signal is detected and extracted by the TV signal decoder 30; and the signal is passed to a controller 12 (which may be a microprocessor).

Controller 12 determines whether the signals are to be passed to external equipment via the jack ports or to buffer/comparator 14 or both. The buffer/comparator 14 may transmit signal records to a digital recorder 16. Controller 20 may cause a transfer of recorded data to a remote site and may cause the local oscillator to be tuned to a particular channel at a predetermined time. See '825 patent, col. 16, line 7, to col. 19, line 10, and especially col. 17, line 56, to col. 18, line 50.

2.

Claims 20-25 relate to methods of generating "user specific" information for output at a receiver station having a computer. This is referred to as the "Wall Street Week" example.

At the program originating television station a series of control instructions is generated, embedded sequentially in digital form on lines of the vertical interval of the television signal, and transmitted ('825 patent, col. 12, ll. 32-36). The receiver is shown in Figure 1 reproduced below.

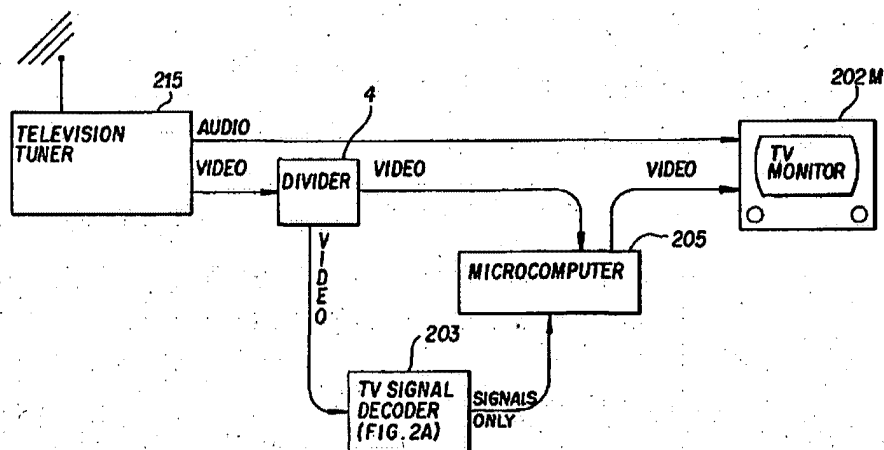


FIG. 1

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