

PATENT
270560-999/2

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: FITZSIMMONS, TODD

Serial No.: 13/279,943

Filed: 03/21/2013

Title: SYSTEM AND METHOD FOR
PROVIDING INFORMATION TO A
RECIPIENT OF A PHYSICAL MAIL OBJECT

Art Unit: 2481

Examiner: TEKLE, DANIEL T.

Confirmation No.: 7094

AMENDMENT

Mail Stop: Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office Action dated July 16, 2014, and in conjunction with a Request for Continued Examination (RCE), please amend the above-identified application as follows:

IN THE CLAIMS:

The following listing of claims will replace all prior versions, and listings, of the claims in the application:

1-20. (Cancelled)

21. (Currently amended) A digital video recorder ("DVR") for time shifting at least a portion of a transmitted video program, comprising:

a tuner for receiving said video program as transmitted, said video program including at least first, second and third portions, wherein said second portion as transmitted is configured to follow said first portion, and said third portion as transmitted is configured to follow said second portion;

a memory device for storing said video program, allowing at least a portion of said video program to be played back at a later time;

a controller configured to receive commands from a user of said DVR, wherein a first command changes said DVR from a first playback state to a second playback state, and a second command initiates playback of said video program from said memory device; and

at least one processor configured to (i) provide said video program in its entirety to a display device in response to receiving said second command regardless of a playback state of said DVR if said second command is received during a first period of time, (ii) provide said video program in its entirety to said display device in response to receiving said second command if said second command is received during a second period of time and said DVR is in said first playback state, and (iii) provide only a portion of said video program to said display device in response to receiving said second command if said second

command is received during said second period of time and said DVR is in said second playback state, said portion of said video program including at least said first and third portions of said video program, wherein said third portion of said video program is provided to said display device immediately following said first portion of said video program if said second command is received during said second period of time and said DVR is in said second playback state;

wherein said second period of time-being is a period of time after said first period of time.

22. (Previously presented) The DVR of Claim 21, wherein said controller is configured to receive said commands from a remote control operated by said user of said DVR.

23. (Previously presented) The DVR of Claim 21, wherein said video program includes at least primary and secondary video content, and said portion of said video program that is provided to said to said display device if said second command is received during said second period of time and said DVR is in said second playback state includes said primary video content and only a portion of said secondary video content.

24. (Previously presented) The DVR of Claim 21, wherein said video program includes at least primary and secondary video content, and said portion of said video program that is provided to said to said display device if said second command is received during said second period of time and said DVR is in said second playback state includes only said primary video content.

25. (Previously presented) The DVR of Claim 24, wherein said memory device is further configured to store at least one time when said secondary video content begins and at least one time when said secondary video content ends.

26. (Previously presented) The DVR of Claim 21, wherein said first period of time is a period of time that is less than one week from said transmission of said video program, and said second period of time is any time after said first period of time.

27. (Cancelled)

28. (Previously presented) The DVR of Claim 24, wherein said secondary video content comprises at least one advertisement.

29. (Previously presented) The DVR of Claim 21, wherein said at least one processor is further configured to (i) retrieve said portion of said video program from said memory device if said second command is received during said second period of time and said DVR is in said second playback state, and (ii) retrieve said video program in its entirety from said memory device if another second command is received at a time thereafter and said DVR is switched to said first playback state at or before said time thereafter.

30. (Currently amended) A method for time shifting at least a portion of a video program transmitted to a digital video recorder ("DVR"), comprising:

receiving said video program, said video program including at least first, second and third portions, wherein said second portion as transmitted is configured to follow said first portion, and said third portion as transmitted is configured to follow said second portion;

storing said video program on a memory device in said DVR;

receiving a first command from at least one user of said DVR, said first command indicating a playback state of said DVR;

receiving a second command from said at least one user of said DVR, said second command indicating a desire to playback at least a portion of said video program; and

providing said at least a portion of said video program to a display device in response to receiving said second command;

wherein said step of providing said at least a portion of said video program to said display device further comprises (i) providing said video program to said display device in response to receiving said second command regardless of a playback state of said DVR if said second command is received during a first period of time, (ii) providing said video program to said display device in response to receiving said second command if said second command is received during a second period of time and said DVR is in said first playback state, and (iii) providing only a portion of said video program to said display device in response to receiving said second command if said second command is received during said second period of time and said DVR is in said second playback state, said portion of said video program including at least said first and second portions of said video program, wherein said third portion of said video program is provided to said display device immediately following said first portion of said video program if said second command is received during said second period of

time and said DVR is in said second playback state;

wherein said second period of time ~~being~~ is a period of time after said first period of time.

31. (Previously presented) The method of Claim 30, wherein said step of receiving said video program further comprises receiving said video program from a satellite via an antenna.

32. (Currently amended) The method of Claim 30, wherein said step of storing said video program on said memory device in said DVR further comprises storing at least one time of when ~~an omitted portion~~ said second portion of said video program begins and at least one time of when ~~said omitted portion~~ second portion of said video program ends, wherein said portion of said video program provided during said second time and when said DVR is in said second playback state does not ~~includes~~ include at least said ~~omitted~~ second portion.

33. (Currently amended) The method of Claim 30, wherein said video program includes at least primary and secondary video content, and said portion of said video program that is provided to ~~said to said~~ display device if said second command is received during said second period of time and said DVR is in said second playback state includes said primary video content and only a portion of said secondary video content.

34. (Currently amended) The method of Claim 30, wherein said video program includes at least primary and secondary video content, and said portion of said video program that is provided to ~~said to said~~ display device if said second command is received during said second period of time and said DVR is in said second playback state includes only said primary video content.

35. (Previously presented) The method of Claim 30, wherein said first period of time is a first day after said video program has been transmitted, and said second period of time is a time period thereafter.

36. (Previously presented) The method of Claim 30, wherein said first period of time is a period of time that is less than one week from said transmission of said video program, and said second period of time is a time period after said first period of time.

37. (Currently amended) The method of Claim 34, wherein said secondary video content is ~~at least one of a news ticker and~~ at least one advertisement.

38. (Currently amended) The method of Claim 32, wherein said step of receiving said video program further comprises receiving said video program, said at least one time of when said ~~omitted~~ second portion of said video program begins, and said at least one time of when said ~~omitted~~ second portion of said video program ends from a satellite, wherein each one of said at least one times is received by said DVR after said video program is stored on said memory device.

39. (Currently amended) A digital video recorder ("DVR") for time shifting at least a first portion of a video program, said first portion of said video program includes at least program and auxiliary data consists of first, second and third portions, wherein said second portion as transmitted is configured to follow said first portion, and said third portion as transmitted is configured to follow said second portion, comprising:

a tuner for receiving said video program;

a memory device for storing said video program;

a controller for receiving commands including at least a first command for setting a playback state of said DVR and a second command for initiating a playback of said video program from said memory device; and

at least one processor for (i) providing said first portion of said video program in its entirety to a display device in response to receiving said second command during a first period of time, (ii) providing said first portion of said video program in its entirety to said display device in response to receiving said second command during a second period of time if said DVR is in a first playback state, and (iii) providing only a portion said first and third portions of said video program to said display device in response to receiving said second command during said second period of time if said DVR is in a second playback state, wherein said third portion of said video program does not include at least a portion of said auxiliary data is provided to said display device immediately following said first portion of said video program if said second command is received during said second period of time and said DVR is in said second playback state.

40. (Currently amended) The method of Claim 39, wherein ~~said step of providing only a first and third portions of said video program to said display device further comprises providing other auxiliary data to said display device, wherein said other auxiliary data is received after said video program is stored on said memory device~~ include primary content and said second portion includes secondary content.

REMARKS

Claims 21-26 and 28-40 are pending in this application, with Claims 1-20 and 27 being cancelled, and Claims 21, 30, 32-34, and 37-40 being amended. The Applicant respectfully requests reconsideration and review of the application in view of the amendments and the following remarks.

The Examiner rejected Claim 32 and 38 under 35 U.S.C. § 112, second paragraph, for being indefinite. Office Action at p. 2. In particular, the Examiner stated that the feature “omitted portion” is not described in the specification. *Id.* The Applicant respectfully disagrees. The specification provides that a video program can include program data (see Fig. 6 at 610, 620, 630) and auxiliary data (see Fig. 6 at 640, 650), and that DVR may be configured to turn off (or omit) the auxiliary data (see, e.g., p. 15, ll. 8-27). For example, if a user is watching a first football game (program data), and does not wish to see updates on a second football game (auxiliary data) (e.g., because the user is recording the second game and plans on watching it later), the DVR can be configured to turn off (or omit) the updates (auxiliary data). To this end, the specification provides:

For example, a user who is recoding a first sporting event and watching a second sporting event, either in real-time or time-shifted, may not want to receive updates (e.g., in the form of news tickers) on the first sporting event. Thus, a user may be able to program the processor 740 to display only program data, and not auxiliary data, or filter the auxiliary data so that only certain information is displayed, or certain information is not displayed.

See p. 15, ll. 19-27. Nonetheless, in an effort to expedite a timely Notice of Allowance, the Applicant has amended Claims 32 and 38 to replace the term “omitted portion” with the term “second portion,” which is supported by the specification and drawings (e.g., Fig. 6). Thus, the rejection of Claims 32 and 38 should be withdrawn.

Prior to addressing the rejections based on prior art, the Applicant provides a

brief overview of the invention. The claimed invention is directed toward a digital video recorder ("DVR") that stores a video program and plays at least a portion of the video program back at a later time (*e.g.*, a time more convenient to the user of the DVR, etc.). Video programs generally include multiple types of data. For example, a video program may include program data (*e.g.*, a movie, a sitcom, etc.) and auxiliary data (*e.g.*, a news ticker, a commercial, etc.), where the auxiliary data is either superimposed over the program data and/or placed between portions of the program data. While the program data may have a relatively long shelf life, the auxiliary data may not. For example, a news ticker or a commercial concerning the evening news may be of no (or limited) value after the evening news has been transmitted. The claimed invention addresses this issue by allowing a user to program the DVR to skip (or omit) at least a portion of the auxiliary data after its value has diminished.

The claimed invention achieves the above advantages by allowing a user of the DVR to set (or program) the DVR into one of two states. In a first state, the DVR is configured to play the program as it was originally recorded (*e.g.*, with both the program and auxiliary data). In a second state, the DVR is configured to play the program data without the auxiliary data (or a portion thereof). In the claimed inventions, the DVR can only be programmed to skip (or omit) auxiliary data once the auxiliary data is no longer of value or is of limited value. To this end, the claimed invention provides that if the video program is being watched within a first period of time (*e.g.*, within a day or two of the video program being transmitted to the DVR, etc.), then the video program will be played back in its entirety (*e.g.*, including both program and auxiliary data). However, if the video program is being watched within a second period of time (*e.g.*, a week after the video program has been transmitted to the DVR, etc.), then the video program will be played back in its entirety (*e.g.*, including both program and auxiliary data, etc.) if the DVR has been programmed to operate in its first playback state, or in portions (*e.g.*, without at least a portion of the auxiliary data, etc.) if the DVR has been programmed to operate in its second playback state. At any time during the second period of time, the

user could also watch the video program with and without auxiliary data (or portions thereof) by watching the video program while the DVR is in a first playback state, and then watching the video program while the DVR is in a second playback state.

In an effort to clarify the claimed invention, the Applicant has amended Claim 21 to provide that the video program includes “at least first, second and third portions, wherein said second portion as transmitted is configured to follow said first portion, and said third portion as transmitted is configured to follow said second portion.” Claim 21 has also been amended to provide that if a second command (initiating playback) is received during a second period of time (e.g., when the auxiliary data has diminished value) and the DVR is in a second playback state (e.g., indicating that the user wants to turn off (or omit) the auxiliary data), then “only a portion of said video program [is provided] to said display device ... [and] said portion of said video program include[es] at least said first and third portions ... [and] said third portion of said video program is provided to said display device immediately following said first portion of said video program.” ***In other words, under these conditions, the second portion is omitted, and the third portion is provided to the display device immediately after the first portion.*** Similar amendments have been made to Claims 30 and 39.

In the current Office Action, the Examiner rejected Claims 21-26, 28-36 and 38-40 under 35 U.S.C. § 103(a) for being unpatentable over Gratton (U.S. Pub. No. 2009/0238536). The Examiner further rejected Claims 27 and 37 under 35 U.S.C. § 103(a) for being unpatentable over Gratton in view of Harris (U.S. Pub. No. 2011/0221964). The Applicant traverses these rejections.

Gratton provides a system and method for replacing audio data in a recorded audio/video stream. The Examiner argues that because the DVR in Gratton replaces the original audio with new audio if the original audio is outdated (see, e.g., Para. 0044), or if the user chooses to play the new audio (see, e.g., Para. 0040), it discloses a processor configured to “provide only a portion of said video program to said display device in response to receiving said second command [initiating playback] if said

second command [initiating playback] is received during said second period of time and said DVR is in said second playback state [indicating a user's desire to omit a portion of the video program]." Assuming that the Examiner is correct, ***Gratton still does not disclose a processor that ignores the user's request to omit a portion of the video program if the second command [initiating playback] is received during a first period of time.*** In other words, it does not disclose a processor configured to "provide said video program in its entirety to a display device in response to receiving said second command [initiating playback] regardless of a playback state of said DVR [regardless of whether the user has chosen to omit a portion of the video program] if said second command [initiating playback] is received during a first period of time." See Claim 21.

Nonetheless, in an effort to expedite a timely Notice of Allowance, the Applicant has amended Claim 21 to further distinguish it over Gratton. Claim 21 now provides that the video program includes "at least first, second and third portions, wherein said second portion as transmitted is configured to follow said first portion, and said third portion as transmitted is configured to follow said second portion." Claim 21 has also been amended to provide that if the second command (initiating playback) is received during the second period of time and the DVR is in the second playback state (indicating the user's desire to omit the auxiliary data) then the processor is configured to "provide only a portion of said video program to said display device ... said portion of said video portion including at least said first and third portions of said video program, wherein said third portion of said video program is provided to said display device immediately following said first portion of said video program." These features are not disclosed in Gratton. In other words, ***Gratton does not omit a second portion of video data, allowing the third portion to play right after the first portion. Instead, Gratton replaces the original audio data with new audio data.***

Because these features are not disclosed in Gratton, the rejection of independent Claim 21, and the rejections of independent Claims 30 and 39, which includes similar

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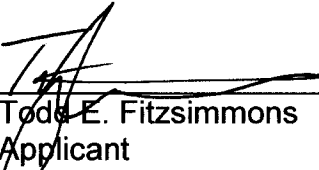
features, should be withdrawn. Further, the rejections of Claims 22-26, 28, 29, 31-38 and 40, which depend from the foregoing independent claims, should also be withdrawn.

In view of the foregoing, the Applicant respectfully submits that Claims 21-26 and 28-40 are in condition for allowance. Reconsideration and withdrawal of the rejections is respectfully requested, and a timely Notice of Allowability is solicited. To the extent it would be helpful to placing this application in condition for allowance, the Applicant encourages the Examiner to contact the undersigned counsel and conduct a telephonic interview.

To the extent necessary, the Commissioner is authorized to charge \$600 for the Request for Continued Examination (RCE), pursuant to 37 C.F.R. § 1.17(e)(1), and any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-6455.

Respectfully submitted,

Date: September 16, 2014



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