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REISSUE PATENT APPLICATION TRANSMITTAL

Address to: Mail Stop Reissue Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450	Attorney Docket No.	103692.0001US1re
	First Named Inventor	Yaakov MERLIN
	Original Patent Number	8132220
	Original Patent Issue Date (Month/Day/Year)	03/06/2012
	Priority Mail Express® Label No.	

APPLICATION FOR REISSUE OF:

(Check applicable box)



Utility Patent



Design Patent



Plant Patent

APPLICATION ELEMENTS (37 CFR 1.173)

1. ☒ **Fee Transmittal Form** (PTO/SB/56)
2. ☒ **Applicant asserts small entity status.** See 37 CFR 1.27
3. ☐ **Applicant certifies micro entity status.** See 37 CFR 1.29.
Applicant must attach form PTO/SB/15A or B or equivalent.
4. ☒ **Specification and Claims** in double column copy of patent format
(amended, if appropriate)
5. ☒ **Drawing(s)** (proposed amendments, if appropriate)
6. ☒ **Reissue Oath/Declaration or Substitute Statement**
(37 CFR 1.175) (PTO/AIA/05, 06, or 07)
7. ☒ **Application Data Sheet** **NOTE:** Benefit claims under 37 CFR 1.78
and foreign priority claims under 37 CFR 1.55 MUST be set forth in an
Application Data Sheet (ADS).
8. ☒ **Original U.S. Patent currently assigned?** ☒ Yes ☐ No
(If Yes, check applicable box(es))
 - ☒ Written Consent of all Assignees (PTO/AIA/53)
 - ☒ 37 CFR 3.73(c) Statement (PTO/AIA/96)
9. ☐ **CD-ROM or CD-R** in duplicate, Computer Program (Appendix) or large
table
 - ☐ Landscape Table on CD
10. **Nucleotide and/or Amino Acid Sequence Submission**
(if applicable, items a. – c. are required)
 - a. ☐ Computer Readable Form (CRF)
 - b. ☐ Specification Sequence Listing on:
 - i. ☐ CD-ROM (2 copies) or CD-R (2 copies); or
 - ii. ☐ Paper
 - c. ☐ Statements verifying identity of above copies

ACCOMPANYING APPLICATION PARTS

11. ☒ **Statement of status and support for all changes to the
claims.** See 37 CFR 1.173(c).
 12. ☐ **Power of Attorney**
 13. ☐ **Information Disclosure Statement (IDS)**
PTOSB/08 or PTO-1449
☐ Copies of citations attached
 14. ☐ **English translation of Reissue Oath/Declaration**
(if applicable)
 15. ☐ **Return Receipt Postcard** (MPEP § 503)
(Should be specifically itemized)
 16. ☒ **Preliminary Amendment** (37 CFR 1.173; MPEP § 1453)
 17. ☒ **Other:** Notice of related litigation filed in notes
accompanying Preliminary Amendment.

- ☐ This is a continuation reissue or divisional reissue application
(i.e., a second or subsequent reissue application for the same
issued patent). (Check box if applicable.)

18. CORRESPONDENCE ADDRESS

☒ The address associated with Customer Number: 24392					OR ☐ Correspondence address below				
Name									
Address									
City				State		Zip Code			
Country					Telephone				
Email									

Signature	/Robert D. Fish/	Date	April 6, 2022
Name (Print/Type)	Robert D. Fish	Registration No.	33880

This collection of information is required by 37 CFR 1.173. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop Reissue, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

REISSUE APPLICATION FEE TRANSMITTAL FORM							Docket Number (Optional) 103692.0001US1re		
Application as Filed – Part 1									
	(1) Claims in Patent	(2) Claims Filed in Reissue Application	(3) Number Extra	Micro Entity		Small Entity		Undiscounted	
				Rate (\$)	Fee (\$)	Rate (\$)	Fee (\$)	Rate (\$)	Fee (\$)
Total Claims (37 CFR 1.16(i))	(A) 21	(B) 21	* 1 =	x =		x 50 =	50	x =	
Ind. Claims (37 CFR 1.16(h))	(C)	(D)	** =	x =		x =		x =	
Application Size Fee (37 CFR 1.16(s))	If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$420 (\$210 for small entity, \$105 for micro entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).								
	Filing Fee (37 CFR 1.16(e))						160		
	Search Fee (37 CFR 1.16(n))						350		
	Examination Fee (37 CFR 1.16(r))						1160		
	Total Filing Fee						1720		
Application as Amended – Part 2									
	(1) Claims Remaining After Amendment	(2) Highest Number Previously Paid For	(3) Extra Claims Present	Micro Entity		Small Entity		Undiscounted	
				Rate (\$)	Fee (\$)	Rate (\$)	Fee (\$)	Rate (\$)	Fee (\$)
Total Claims (37 CFR 1.16(i))	*** -	****	=	x =		x =		x =	
Ind. Claims (37 CFR 1.16(h))	*** -	*****	=	x =		x =		x =	
Application Size Fee (37 CFR 1.16(s))	If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$420 (\$210 for small entity, \$105 for micro entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).								
Total Additional Fee									
* Enter (B) – 20, or enter "0" if (B) is less than 20. ** Enter (D) – minus 3, or enter "0" if (D) is less than 3. *** After any cancellation of claims. **** If the "Highest Number of Total Claims Previously Paid For" is less than 20, enter "20" in this space. ***** If the "Highest Number of Independent Claims Previously Paid For" is less than 3, enter "3" in this space. ☒ Applicant asserts small entity status. See 37 CFR 1.27. ☐ Applicant certifies micro entity status. See 37 CFR 1.29. Form PTO/SB/15A or B or equivalent must either be enclosed or have been submitted previously. ☒ The Director is hereby authorized to charge any additional fees under 37 CFR 1.16 or 1.17 which may be required, or credit any overpayment to Deposit Account No. <u>500341</u>. ☐ A check in the amount of \$ _____ to cover the filing/additional fee is enclosed. ☒ Payment made via EFS-Web. ☐ Payment by credit card. Form PTO-2038 is attached. WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038. <u>/Robert D. Fish/</u> April 6, 2022 Signature Date <u>Robert D. Fish</u> 33880 Typed or Printed Name Registration Number, if applicable 949-943-8300 Telephone Number									

This collection of information is required by 37 CFR 1.16. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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Privacy Act Statement

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The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Application Data Sheet 37 CFR 1.76		Attorney Docket Number	103692.0001USre1
		Application Number	
Title of Invention	Method And Apparatus For Facilitating Toggling Between Internet And TV Broadcasts		
The application data sheet is part of the provisional or nonprovisional application for which it is being submitted. The following form contains the bibliographic data arranged in a format specified by the United States Patent and Trademark Office as outlined in 37 CFR 1.76. This document may be completed electronically and submitted to the Office in electronic format using the Electronic Filing System (EFS) or the document may be printed and included in a paper filed application.			

Secrecy Order 37 CFR 5.2:

☐	Portions or all of the application associated with this Application Data Sheet may fall under a Secrecy Order pursuant to 37 CFR 5.2 (Paper filers only. Applications that fall under Secrecy Order may not be filed electronically.)
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Inventor Information:

Inventor	1	Remove		
Legal Name				
Prefix	Given Name	Middle Name	Family Name	Suffix
	Yakkov		MERLIN	
Residence Information (Select One) US Residency • Non US Residency Active US Military Service				
City	Raanana	Country of Residence ⁱ	IL	
Mailing Address of Inventor:				
Address 1	9 Haeshel Street			
Address 2				
City	Raanana	State/Province		
Postal Code	43585	Country ⁱ	IL	
All Inventors Must Be Listed - Additional Inventor Information blocks may be generated within this form by selecting the Add button.				

Correspondence Information:

Enter either Customer Number or complete the Correspondence Information section below. For further information see 37 CFR 1.33(a).			
☐ An Address is being provided for the correspondence Information of this application.			
Customer Number	24392		
Email Address	patents@fishiplaw.com	Add Email	Remove Email

Application Information:

Title of the Invention	Method And Apparatus For Facilitating Toggling Between Internet And TV Broadcasts		
Attorney Docket Number	103692.0001USre1	Small Entity Status Claimed	☒
Application Type	Nonprovisional		
Subject Matter	Utility		
Total Number of Drawing Sheets (if any)	7	Suggested Figure for Publication (if any)	

Application Data Sheet 37 CFR 1.76		Attorney Docket Number	103692.0001USre1
		Application Number	
Title of Invention	Method And Apparatus For Facilitating Toggling Between Internet And TV Broadcasts		

Filing By Reference:

Only complete this section when filing an application by reference under 35 U.S.C. 111(c) and 37 CFR 1.57(a). Do not complete this section if application papers including a specification and any drawings are being filed. Any domestic benefit or foreign priority information must be provided in the appropriate section(s) below (i.e., "Domestic Benefit/National Stage Information" and "Foreign Priority Information").

For the purposes of a filing date under 37 CFR 1.53(b), the description and any drawings of the present application are replaced by this reference to the previously filed application, subject to conditions and requirements of 37 CFR 1.57(a).

Application number of the previously filed application	Filing date (YYYY-MM-DD)	Intellectual Property Authority or Country

Publication Information:

☐ Request Early Publication (Fee required at time of Request 37 CFR 1.219)

☐ **Request Not to Publish.** I hereby request that the attached application not be published under 35 U.S.C. 122(b) and certify that the invention disclosed in the attached application **has not and will not** be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication at eighteen months after filing.

Representative Information:

Representative information should be provided for all practitioners having a power of attorney in the application. Providing this information in the Application Data Sheet does not constitute a power of attorney in the application (see 37 CFR 1.32). Either enter Customer Number or complete the Representative Name section below. If both sections are completed the customer Number will be used for the Representative Information during processing.

Please Select One:	☒ Customer Number	☐ US Patent Practitioner	☐ Limited Recognition (37 CFR 11.9)
Customer Number	24392		

Domestic Benefit/National Stage Information:

This section allows for the applicant to either claim benefit under 35 U.S.C. 119(e), 120, 121, 365(c), or 386(c) or indicate National Stage entry from a PCT application. Providing benefit claim information in the Application Data Sheet constitutes the specific reference required by 35 U.S.C. 119(e) or 120, and 37 CFR 1.78.

When referring to the current application, please leave the "Application Number" field blank.

Prior Application Status		Patented	Remove			
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)	Patent Number	Issue Date (YYYY-MM-DD)	
	reissued of	11794825	2007-07-06	8132220	2012-03-06	

Application Data Sheet 37 CFR 1.76		Attorney Docket Number	103692.0001USre1
		Application Number	
Title of Invention	Method And Apparatus For Facilitating Toggling Between Internet And TV Broadcasts		
Prior Application Status	Expired	Remove	
Application Number	Continuity Type	Prior Application Number	Filing or 371(c) Date (YYYY-MM-DD)
11794825	a 371 of international	PCT/IL2005/000035	2005-01-11
Additional Domestic Benefit/National Stage Data may be generated within this form by selecting the Add button.			Add

Foreign Priority Information:

This section allows for the applicant to claim priority to a foreign application. Providing this information in the application data sheet constitutes the claim for priority as required by 35 U.S.C. 119(b) and 37 CFR 1.55. When priority is claimed to a foreign application that is eligible for retrieval under the priority document exchange program (PDX)ⁱ the information will be used by the Office to automatically attempt retrieval pursuant to 37 CFR 1.55(i)(1) and (2). Under the PDX program, applicant bears the ultimate responsibility for ensuring that a copy of the foreign application is received by the Office from the participating foreign intellectual property office, or a certified copy of the foreign priority application is filed, within the time period specified in 37 CFR 1.55(g)(1).

			Remove
Application Number	Country ⁱ	Filing Date (YYYY-MM-DD)	Access Code ⁱ (if applicable)
Additional Foreign Priority Data may be generated within this form by selecting the Add button.			Add

Statement under 37 CFR 1.55 or 1.78 for AIA (First Inventor to File) Transition Applications

This application (1) claims priority to or the benefit of an application filed before March 16, 2013 and (2) also contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013. ☐ NOTE: By providing this statement under 37 CFR 1.55 or 1.78, this application, with a filing date on or after March 16, 2013, will be examined under the first inventor to file provisions of the AIA.
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Application Data Sheet 37 CFR 1.76		Attorney Docket Number	103692.0001USre1
		Application Number	
Title of Invention	Method And Apparatus For Facilitating Toggling Between Internet And TV Broadcasts		

Authorization or Opt-Out of Authorization to Permit Access:

When this Application Data Sheet is properly signed and filed with the application, applicant has provided written authority to permit a participating foreign intellectual property (IP) office access to the instant application-as-filed (see paragraph A in subsection 1 below) and the European Patent Office (EPO) access to any search results from the instant application (see paragraph B in subsection 1 below).

Should applicant choose not to provide an authorization identified in subsection 1 below, applicant **must opt-out** of the authorization by checking the corresponding box A or B or both in subsection 2 below.

NOTE: This section of the Application Data Sheet is **ONLY** reviewed and processed with the **INITIAL** filing of an application. After the initial filing of an application, an Application Data Sheet cannot be used to provide or rescind authorization for access by a foreign IP office(s). Instead, Form PTO/SB/39 or PTO/SB/69 must be used as appropriate.

1. Authorization to Permit Access by a Foreign Intellectual Property Office(s)

A. Priority Document Exchange (PDX) - Unless box A in subsection 2 (opt-out of authorization) is checked, the undersigned hereby **grants the USPTO authority** to provide the European Patent Office (EPO), the Japan Patent Office (JPO), the Korean Intellectual Property Office (KIPO), the State Intellectual Property Office of the People's Republic of China (SIPO), the World Intellectual Property Organization (WIPO), and any other foreign intellectual property office participating with the USPTO in a bilateral or multilateral priority document exchange agreement in which a foreign application claiming priority to the instant patent application is filed, access to: (1) the instant patent application-as-filed and its related bibliographic data, (2) any foreign or domestic application to which priority or benefit is claimed by the instant application and its related bibliographic data, and (3) the date of filing of this Authorization. See 37 CFR 1.14(h) (1).

B. Search Results from U.S. Application to EPO - Unless box B in subsection 2 (opt-out of authorization) is checked, the undersigned hereby **grants the USPTO authority** to provide the EPO access to the bibliographic data and search results from the instant patent application when a European patent application claiming priority to the instant patent application is filed. See 37 CFR 1.14(h)(2).

The applicant is reminded that the EPO's Rule 141(1) EPC (European Patent Convention) requires applicants to submit a copy of search results from the instant application without delay in a European patent application that claims priority to the instant application.

2. Opt-Out of Authorizations to Permit Access by a Foreign Intellectual Property Office(s)

☐ A. Applicant **DOES NOT** authorize the USPTO to permit a participating foreign IP office access to the instant application-as-filed. If this box is checked, the USPTO will not be providing a participating foreign IP office with any documents and information identified in subsection 1A above.

☐ B. Applicant **DOES NOT** authorize the USPTO to transmit to the EPO any search results from the instant patent application. If this box is checked, the USPTO will not be providing the EPO with search results from the instant application.

NOTE: Once the application has published or is otherwise publicly available, the USPTO may provide access to the application in accordance with 37 CFR 1.14.

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Application Data Sheet 37 CFR 1.76		Attorney Docket Number	103692.0001USre1
		Application Number	
Title of Invention	Method And Apparatus For Facilitating Toggling Between Internet And TV Broadcasts		

Applicant Information:

Providing assignment information in this section does not substitute for compliance with any requirement of part 3 of Title 37 of CFR to have an assignment recorded by the Office.			
Applicant	1		Remove
If the applicant is the inventor (or the remaining joint inventor or inventors under 37 CFR 1.45), this section should not be completed. The information to be provided in this section is the name and address of the legal representative who is the applicant under 37 CFR 1.43; or the name and address of the assignee, person to whom the inventor is under an obligation to assign the invention, or person who otherwise shows sufficient proprietary interest in the matter who is the applicant under 37 CFR 1.46. If the applicant is an applicant under 37 CFR 1.46 (assignee, person to whom the inventor is obligated to assign, or person who otherwise shows sufficient proprietary interest) together with one or more joint inventors, then the joint inventor or inventors who are also the applicant should be identified in this section.			
		Clear	
● Assignee	Legal Representative under 35 U.S.C. 117		Joint Inventor
Person to whom the inventor is obligated to assign.		Person who shows sufficient proprietary interest	
If applicant is the legal representative, indicate the authority to file the patent application, the inventor is:			
Name of the Deceased or Legally Incapacitated Inventor:			
If the Applicant is an Organization check here. ☒			
Organization Name	TVNGO LTD. (BVI)		
Mailing Address Information For Applicant:			
Address 1	204 Rappenburger Straat		
Address 2	1011 MN		
City	Amsterdam	State/Province	
Country	NL	Postal Code	
Phone Number		Fax Number	
Email Address			
Additional Applicant Data may be generated within this form by selecting the Add button. Add			

Assignee Information including Non-Applicant Assignee Information:

Providing assignment information in this section does not substitute for compliance with any requirement of part 3 of Title 37 of CFR to have an assignment recorded by the Office.

Application Data Sheet 37 CFR 1.76		Attorney Docket Number	103692.0001USre1
		Application Number	
Title of Invention	Method And Apparatus For Facilitating Toggling Between Internet And TV Broadcasts		

Assignee	1			
Complete this section if assignee information, including non-applicant assignee information, is desired to be included on the patent application publication. An assignee-applicant identified in the "Applicant Information" section will appear on the patent application publication as an applicant. For an assignee-applicant, complete this section only if identification as an assignee is also desired on the patent application publication.				
				Remove
If the Assignee or Non-Applicant Assignee is an Organization check here.				☐
Prefix	Given Name	Middle Name	Family Name	Suffix
Mailing Address Information For Assignee including Non-Applicant Assignee:				
Address 1				
Address 2				
City		State/Province		
Country ⁱ		Postal Code		
Phone Number		Fax Number		
Email Address				
Additional Assignee or Non-Applicant Assignee Data may be generated within this form by selecting the Add button.				Add

Signature:

NOTE: This Application Data Sheet must be signed in accordance with 37 CFR 1.33(b). However, if this Application Data Sheet is submitted with the **INITIAL** filing of the application and either box A or B is not checked in subsection 2 of the "Authorization or Opt-Out of Authorization to Permit Access" section, then this form must also be signed in accordance with 37 CFR 1.14(c).

This Application Data Sheet **must** be signed by a patent practitioner if one or more of the applicants is a **juristic entity** (e.g., corporation or association). If the applicant is two or more joint inventors, this form must be signed by a patent practitioner, **all** joint inventors who are the applicant, or one or more joint inventor-applicants who have been given power of attorney (e.g., see USPTO Form PTO/AIA/81) on behalf of **all** joint inventor-applicants.

See 37 CFR 1.4(d) for the manner of making signatures and certifications.

Signature	/Robert D. Fish/		Date (YYYY-MM-DD)	2022-04-06
First Name	Robert D.	Last Name	Fish	Registration Number
				33880
Additional Signature may be generated within this form by selecting the Add button.				Add

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Application Data Sheet 37 CFR 1.76		Attorney Docket Number	103692.0001USre1
		Application Number	
Title of Invention	Method And Apparatus For Facilitating Toggling Between Internet And TV Broadcasts		

This collection of information is required by 37 CFR 1.76. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 23 minutes to complete, including gathering, preparing, and submitting the completed application data sheet form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450**

Appl No.: **TBD – Reissue of US8,132,220**
Applicant: **TVnGo Ltd. (BVI)**
Filing Date: **July 6, 2007**
Art Unit: **2423**
Examiner: **TBD**
Attorney Docket No.: **103692.0001US1re**

Title **Method And Apparatus For Facilitating Toggling Between Internet
And TV Broadcasts**

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

PRELIMINARY AMENDMENT

Sir:

This paper provides Preliminary Amendments to the Reissue Application for
US8132220, filed herewith. Please enter the amendments shown herein.

- Claim amendments begin on page 2.
- Remarks begin on page 7.

AMENDMENTS TO THE CLAIMS

This listing of claims replaces all prior versions, and listings, of claims in the application:

1. (Amended) A method for generating at a user's premises an overlay using video signals constituting a first data and overlay-enabling digital data constituting a second data, the method comprising:

(a) providing a combiner unit at the user's premises, wherein:

the combiner unit is coupled to a TV set and connected to a separate TV tuner box or TV tuner in the TV set, at the user's premises, and

the combiner unit is also connected through distinct networks to each of a video signal source providing video signals through the TV tuner box or TV tuner in the TV set, and an Internet data source providing overlay-enabling digital data over the Internet,

wherein said video signals and said overlay-enabling digital data originate from unrelated sources and are transmitted to the user's premises by different resources as mutually distinct and independent inputs,

and wherein said overlay-enabling digital data includes at least:

a Web link indicating a website where content that is associated with said overlay-enabling digital data is stored,

an image indicative of the content associated with said overlay-enabling digital data, and

an [overlay activation criterion] event condition; and

(b) processing at the user's premises said overlay-enabling digital data and generating at the user's premises a corresponding overlay only if said [activation criterion] event condition is met, wherein generating [an] the overlay includes:

generating at the user's premises a first display screen including at least a first portion corresponding to said video signals and a second portion overlaid over said first portion and corresponding at least to said image, and

associating the Web link with said second portion of the first display screen thereby allowing a user to cause the combiner unit to retrieve said content, generate a

second video display screen including at least a portion which corresponds to said content, and input the second display screen to said TV set.

2. (Original) The method according to claim 1, wherein said overlay-enabling digital data is received at the user premises according to a pre-stored user profile.
3. (Amended) The method according to claim 1, further including: receiving a command from [a] the user at said user premises; and responsive to said command, resizing said first portion and/or said second portion of said first display screen.
4. (Original) The method according to claim 1, wherein the content stored at said website enables streaming of digital data over the Internet; and
 said method further including: pre-fetching and buffering said digital data stream from
 said website, thereby allowing said digital data stream to be displayed
 substantially without delay upon redirection by the user.
5. (Amended) The method according to claim 1, wherein the overlay-enabling digital data comprises data representative of one or more second images, and for each of said one or more second images said overlay-enabling data comprises respective web site addresses where IP content associated with the respective second image is stored, and wherein said generating [an] the overlay further includes within said first display said one or more second images.
6. (Original) The method according to claim 1, wherein the overlay-enabling digital data is supplementary or complementary to the video signals.
7. (Original) The method according to claim 1, wherein the image includes an icon that indicates to the user that digital data from Internet content is currently being displayed and which provides an indication of a nature of said Internet content.
8. (Original) The method according to claim 1, wherein the image contains textual information advising the user to press a particular button on the remote control unit.
9. (Amended) The method according to claim 1, wherein said [overlay activation criterion] event condition includes at least one of the following: a timing information or[,] data specifying one or more TV subscriber channels[, a user command information].

10. (Amended) The method according to claim 5, further including:

periodically accessing a web server for downloading said overlay-enabling digital data;
extracting from the overlay-enabling digital data said one or more second images and the
respective web sites corresponding to each of said second images;
retrieving and storing digital content from said web sites; and
if the event condition [overlay activation criterion] is met and a user command that is
associated with an image from amongst said one or more second images is
identified, displaying the respective image from amongst the second images,
accessing the respective web site associated with the displayed image and
extracting and buffering content from the website.

11. (Original) The method according to claim 5, further comprising displaying a respective IP
content when a corresponding one of said one or more second images is selected.

12. (Original) The method according to claim 7, including selecting specific Internet content by
pressing a color-coded button on a remote control in accordance with a color of said icon.

13. (Amended) A TV-Internet Integration Box for generating at a user's premises an overlay
using video signals constituting a first data and overlay-enabling digital data constituting a
second data, the TV-Internet Integration Box comprising:

a combiner unit at [a] the user's premises coupled to a separate TV tuner box or TV tuner,
wherein the combiner unit is also connected through distinct networks to each of a video
signal source providing video signals through the TV tuner box or TV tuner, and
an Internet data source providing overlay-enabling digital data over the Internet,
wherein

said video signals and said overlay-enabling digital data originate from unrelated sources
and are transmitted to the user's premises by different resources as mutually
distinct and independent inputs, and

wherein said overlay-enabling digital data includes at least:

a Web link indicating a website where content that is associated with said overlay-
enabling digital data is stored;

an image indicative of the content associated with said overlay-enabling digital data;
 and
 an event condition [overlay activation criterion], wherein
 the combiner unit is responsive to [an] the event condition [overlay activation
 criterion] being met for generating a corresponding overlay, including:
 generating at the user's premises a first display screen including at least a first portion
 corresponding to said video signals and a second portion overlaid over said
 first portion and corresponding at least to said image, and
 associating the Web link with said second portion of the first display screen thereby
 allowing a user to cause the combiner unit to retrieve said content, and
 generate a second video display screen including at least a portion which
 corresponds to said content; and
 a video output interface, coupled to or integrated within the combiner unit and
 configured to be coupled to a video input of said TV set and to display said
 first display screen or said second video display screen.

14. (Original) The TV-Internet Integration Box according to claim 13, wherein said overlay-enabling digital data is received at the user premises according to a pre-stored user-profile.

15. (Amended) The TV-Internet Integration Box according to claim 13, further including:
 a command input for receiving a command from [a] the user at said user premises;
 and a frame adjuster for resizing said first portion and/or said second portion of said first
 display screen in response to said command.

16. (Original) The TV-Internet Integration Box according to claim 13, further including:
 a receiver for receiving a digital data stream, wherein the stream of the digital data is
 enabled by the content stored at said website; and
 a processing unit for pre-fetching and buffering said digital data stream from said
 website, thereby allowing said digital data stream to be displayed substantially
 without delay upon redirection by the user.

17. (Amended) The TV-Internet Integration Box according to claim 13, wherein the overlay-enabling digital data comprises data representative of one or more second images, and for each

of said one or more second images said overlay-enabling data comprises respective web site addresses where IP content associated with the respective second image is stored,

and wherein the combiner unit is configured to:

periodically access a web server for downloading said overlay-enabling digital data;

extract from the overlay-enabling digital data said one or more second images and the

respective web sites corresponding to each of said second images;

retrieve and store digital content from said web sites; and

if the event condition [overlay activation criterion] is met, and a user command that is

associated with an image from amongst said one or more second images is

identified, display the respective image from amongst the second images, access

the respective web site associated with the displayed image and extract and buffer

content from the website.

18. (Original) The TV-Internet Integration Box according to claim 13, wherein the image includes an icon that indicates to the user that digital data from Internet content is currently being displayed and which provides an indication of a nature of said Internet content.

19. (Original) The TV-Internet Integration Box according to claim 13, wherein the image contains textual information advising the user to press a particular button on the remote control unit.

20. (Amended) The TV-Internet Integration Box according to claim 13, wherein said event condition [overlay activation criterion] includes at least one of the following: a timing information or[,] data specifying one or more TV subscriber channels[, a user command information].

21. (Original) The TV-Internet Integration Box according to claim 18, wherein the icon is colored so as to allow user selection of a specific Internet content by pressing a color-coded button on a remote control in accordance with a color of said icon.

REMARKS

This Preliminary Amendment is filed with Reissued Application for US8132220, issued March 6, 2012. By way of this amendment, original claims 2, 4, 6-8, 11, 12, 14, 16, 18, 19, and 21 are pending, and claims 1, 3, 5, 9, 10, 13, 15, 17, and 20 are amended. No new matter is added. Applicant respectfully requests the claims as amended be allowed.

Notice of Related Litigation and Request for Expedited “Special” Handling

Patent US8132220 was the subject of litigation in the District of New Jersey as well as an appeal to the Federal Circuit. Orders from both courts rendered claims 1, 9, 10, 13, 17, and 20 of the ‘220 Patent are invalid as indefinite. The District of New Jersey matter is Civil No. 18-10238 (RMB/KMW). The Federal Circuit matter is Case 20-1837. Pursuant to MPEP 1442, Applicant respectfully requests this matter be taken up for action in advance of other reissue applications.

Amended Claims (Claims 1, 3, 5, 9, 10, 13, 15, 17, and 20)

Claims 1, 3, 5, 9, 10, 13, 15, 17, and 20 are amended herein, with no new matter added.

Claims 1, 3, 5, 13, and 15 are amended to address any apparent defects as to antecedent basis, at least in part. Applicant submits that such amendments cure any defects as to antecedent basis that may exist, and otherwise requests allowance.

Claims 1, 9, 10, 13, 17, and 20 are amended to address concerns raised by Federal Court in the District of New Jersey, and affirmed on appeal to the Federal Circuit. While Applicant respectfully disagrees, both courts found they could not construe claims 1, 9, 10, 13, 17, and 20 because the term “overlay activation criterion” was indefinite. To address this concern, the term “overlay activation criterion” is amended to recite “event condition” with support at col. 4, l. 41 of the issued patent (“upon detecting a matching event” with reference to Figure 3 (showing checking events predicate to whether conditions match)). Applicant submits the amended term is supported by the Specification, and requests allowance.

Claims 9 and 20 are further amended to address concerns raised by the New Jersey District court and affirmed by the Federal Circuit. While Applicant respectfully disagrees, both courts found inconsistency between claims 1 and 9, where claim 1 requires the “[overlay

activation criterion] event condition” be provided over the Internet, while claim 9 provides the “[overlay activation criterion] event condition” can include “a user command information”. The courts determined the Specification limited user command information as provided only by a local, IR remote, and found the inconstancy between Internet provided information and local IR provided information rendered the claims indefinite, with the same conclusion as to claims 13 and 20.

Applicant has amended claims 9 and 20 to remove reference to “a user command information” and submits any inconsistency is thereby cured. Applicant respectfully requests the claims be allowed.

Request For Allowance

Claims 2, 4, 6-8, 11, 12, 14, 16, 18, 19, and 21 as originally issued are pending, and claims 1, 3, 5, 9, 10, 13, 15, 17, and 20 are amended and pending in this application. Applicant requests allowance of all pending claims.

Respectfully submitted,
Fish IP Law, LLP

Date: April 6, 2022

By /Robert D. Fish/
Robert D. Fish, Esq.
Reg. No. 33,880

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Fax (949) 943-8358

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REISSUE APPLICATION DECLARATION BY THE ASSIGNEE		Docket Number (optional) 103692.0001US1re	
I hereby declare that: The residence and mailing address of the inventor or joint inventors are stated below. Name of the Assignee: TVnGo Ltd. (BVI) I am authorized to act on behalf of the assignee (if the assignee is a juristic entity). The entire title to the patent identified below is vested in said assignee, or if there are multiple assignees/owners, all assignees/owners have executed a Reissue Application Declaration to account for the entire title of the patent identified below.			
Inventor Yakkov Merlin			
Residence: City Raanana	State -	Country Israel	
Mailing Address 9 Haeshel St			
City Raanana	State -	Zip 43585	Country Israel
☐ Additional Inventors are named on separately numbered sheets attached hereto.			
Patent Number US8132220		Patent Issue Date March 6, 2012	
I believe said inventor(s) to be the original inventor or original joint inventors of the subject matter which is described and claimed in said patent, for which a reissue patent is sought on the invention titled: Method and Apparatus for Facilitating Toggling Between Internet and TV Broadcasts			
the specification of which ☒ is attached hereto. ☐ was filed on _____ as reissue application number _____. The above-identified application was made or authorized to be made by me. I hereby acknowledge that any willful false statement made in this declaration is punishable under 18 U.S.C. 1001 by fine or imprisonment of not more than five (5) years, or both. I believe the original patent to be wholly or partly inoperative or invalid, for the reasons described below. (Check all boxes that apply.) ☐ by reason of a defective specification or drawing. ☐ by reason of the patentee claiming more or less than he had the right to claim in the patent. ☒ by reason of other errors.			

[Page 1 of 2]

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REISSUE APPLICATION DECLARATION BY THE ASSIGNEE

Docket Number (Optional) 103692.0001US1re

At least one error upon which reissue is based is described below. If the reissue is a broadening reissue, a claim that the application seeks to broaden must be identified and the box below must be checked:

One error is a federal court found claims 1, 9, 10, 13, 17, and 20 invalid because the claim term "overlay activation criterion" was not described in the Specification and is otherwise indefinite. A second error is the same court found claims 9 and 20 invalid as inconsistent with parent claims 1 and 13, respectively, because claims 1 and 13 required information be provided via Internet, while dependent claims required the same information may be provided locally without the Internet. A third error is claims 1, 3, 5, 13, and 15 have apparent antecedent basis defects and may be invalid.

[Attach additional sheets, if needed.]

☐ The application for the original patent was filed under 37 CFR 1.46 by the assignee of the entire interest.

I hereby appoint:

☒ Practitioners associated with Customer Number:

24392

OR

☐ Practitioner(s) named below:

Name	Registration Number

as my/our attorney(s) or agent(s) to prosecute the application identified above, and to transact all business in the United States Patent and Trademark Office connected therewith.

Correspondence Address: Direct all communications about the application to:

☒ The address associated with Customer Number:

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OR

☐ Firm or
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Address

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Signature

Date (Optional)

Legal name of person signing

Eliot Harary

Address of Assignee

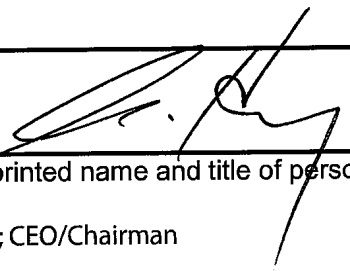
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3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
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6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
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9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

REISSUE APPLICATION: CONSENT OF ASSIGNEE; STATEMENT OF NON-ASSIGNMENT		Docket Number (Optional) 103692.0001US1re
This is part of the application for a reissue patent based on the original patent identified below.		
Name of Patentee(s) TVnGo Ltd.		
Patent Number 8132220	Date Patent Issued March 6, 2012	
Title of Invention Method and Apparatus for Facilitating Toggling Between Internet and TV Broadcasts		
1. ☒ Filed herein is a statement under 37 CFR 3.73(c). (Form PTO/AIA/96) 2. ☐ Ownership of the patent is in the inventor(s), and no assignment of the patent is in effect. One of boxes 1 or 2 above must be checked. If multiple assignees, complete this form for each assignee. If box 2 is checked, skip the next entry and go directly to "Name of Assignee." The written consent of all assignees and inventors owning an undivided interest in the original patent is included in this application for reissue. The assignee(s) owning an undivided interest in said original patent is/are <u>TVnGo Ltd.</u>, and the assignee(s) consents to the accompanying application for reissue.		
Name of assignee/inventor (if not assigned) TVnGo Ltd.		
Signature 	Date 04-05-2022	
Typed or printed name and title of person signing for assignee (if assigned) Eliot Harary; CEO/Chairman		

This collection of information is required by 37 CFR 1.172. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 6 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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STATEMENT UNDER 37 CFR 3.73(c)Applicant/Patent Owner: TVNGO LTD. (BVI)Application No./Patent No.: 8132220Filed/Issue Date: March 6, 2012Titled: METHOD AND APPARATUS FOR FACILITATING TOGGLING BETWEEN INTERNET AND TV BROADCASTSTVNGO LTD. (BVI), a limited company

(Name of Assignee)

(Type of Assignee, e.g., corporation, partnership, university, government agency, etc.)

states that, for the patent application/patent identified above, it is (choose **one** of options 1, 2, 3 or 4 below):

1. ☒ The assignee of the entire right, title, and interest.
2. ☐ An assignee of less than the entire right, title, and interest (check applicable box):
- ☐ The extent (by percentage) of its ownership interest is _____%. Additional Statement(s) by the owners holding the balance of the interest must be submitted to account for 100% of the ownership interest.
- ☐ There are unspecified percentages of ownership. The other parties, including inventors, who together own the entire right, title and interest are:

Additional Statement(s) by the owner(s) holding the balance of the interest must be submitted to account for the entire right, title, and interest.

3. ☐ The assignee of an undivided interest in the entirety (a complete assignment from one of the joint inventors was made). The other parties, including inventors, who together own the entire right, title, and interest are:

Additional Statement(s) by the owner(s) holding the balance of the interest must be submitted to account for the entire right, title, and interest.

4. ☐ The recipient, via a court proceeding or the like (e.g., bankruptcy, probate), of an undivided interest in the entirety (a complete transfer of ownership interest was made). The certified document(s) showing the transfer is attached.

The interest identified in option 1, 2 or 3 above (not option 4) is evidenced by either (choose **one** of options A or B below):

- A. ☒ An assignment from the inventor(s) of the patent application/patent identified above. The assignment was recorded in the United States Patent and Trademark Office at Reel 035417, Frame 0667, or for which a copy thereof is attached.
- B. ☐ A chain of title from the inventor(s), of the patent application/patent identified above, to the current assignee as follows:

1. From: _____ To: _____
The document was recorded in the United States Patent and Trademark Office at
Reel _____, Frame _____, or for which a copy thereof is attached.
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[Page 1 of 2]

This collection of information is required by 37 CFR 3.73(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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STATEMENT UNDER 37 CFR 3.73(c)

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[NOTE: A separate copy (i.e., a true copy of the original assignment document(s)) must be submitted to Assignment Division in accordance with 37 CFR Part 3, to record the assignment in the records of the USPTO. See MPEP 302.08]

The undersigned (whose title is supplied below) is authorized to act on behalf of the assignee.

/Robert D. Fish/

Signature

Robert D. Fish

Printed or Typed Name

April 6, 2022

Date

33880

Title or Registration Number

Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

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Electronic Patent Application Fee Transmittal

Application Number:				
Filing Date:				
Title of Invention:	Method And Apparatus For Facilitating Toggling Between Internet And TV Broadcasts			
First Named Inventor/Applicant Name:	Yaakov MERLIN			
Filer:	Robert Fish/Tammy Lightman			
Attorney Docket Number:	103692.0001US1re			
Filed as Small Entity				
Filing Fees for Reissue (Utility)				
Description	Fee Code	Quantity	Amount	Sub-Total in USD(\$)
Basic Filing:				
UTILITY REISSUE BASIC	2014	1	160	160
REISSUE OR REISSUE DESIGN CPA SEARCH FEE	2114	1	350	350
REISSUE OR REISSUE DESIGN CPA EXAM. FEE	2314	1	1160	1160
Pages:				
Claims:				
REISSUE CLAIMS IN EXCESS OF 20 FOR SMALL	2205	1	50	50
Miscellaneous-Filing:				
Petition:				

Description	Fee Code	Quantity	Amount	Sub-Total in USD(\$)
Patent-Appeals-and-Interference:				
Post-Allowance-and-Post-Issuance:				
Extension-of-Time:				
Miscellaneous:				
Total in USD (\$)				1720

Electronic Acknowledgement Receipt

EFS ID:	45414166
Application Number:	17714917
International Application Number:	
Confirmation Number:	6111
Title of Invention:	Method And Apparatus For Facilitating Toggling Between Internet And TV Broadcasts
First Named Inventor/Applicant Name:	Yaakov MERLIN
Customer Number:	24392
Filer:	Robert Fish/Tammy Lightman
Filer Authorized By:	Robert Fish
Attorney Docket Number:	103692.0001US1re
Receipt Date:	06-APR-2022
Filing Date:	
Time Stamp:	19:25:53
Application Type:	Reissue (Utility)

Payment information:

Submitted with Payment	yes
Payment Type	DA
Payment was successfully received in RAM	\$ 1720
RAM confirmation Number	E202246J26450016
Deposit Account	500341
Authorized User	Tammy Lightman
The Director of the USPTO is hereby authorized to charge indicated fees and credit any overpayment as follows: 37 CFR 1.16 (National application filing, search, and examination fees) 37 CFR 1.17 (Patent application and reexamination processing fees)	

37 CFR 1.19 (Document supply fees)
37 CFR 1.20 (Post Issuance fees)
37 CFR 1.21 (Miscellaneous fees and charges)

File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1	Transmittal Reissue Application	1-aia0050-Reissue-Appl-Transmittal.pdf	325654	no	2
			b33fdc4ee6073ce13d955b0b4add3c5c6749c9b5		
Warnings:					
Information:					
2	Fee Worksheet (SB06)	2-Reissue-fee-transmittal.pdf	269432	no	2
			4b139f4b5636d9f81b894f7d049a353fd0ecf972		
Warnings:					
Information:					
3	Application Data Sheet	3-ADS-aia0014.pdf	1256233	no	8
			656978c639656390bfe1272dc1fd61232245a5e2		
Warnings:					
Information:					
4	Specification	4-US8132220.pdf	1178295	no	14
			021a0a04e6aeca59fd3cee849ec007dce19218cb		
Warnings:					
Information:					
5		5-Preliminary-Amendment-01a_TVnGo1USre1-FILED.pdf	46822	yes	8
			be3eb77bcb2d05ccce2edeb744aeb66ad1d85006		
	Multipart Description/PDF files in .zip description				
	Document Description		Start	End	
	Preliminary Amendment		1	1	
	Claims		2	6	
	Applicant Arguments/Remarks Made in an Amendment		7	8	

Warnings:					
Information:					
6	Reissue Oath or Declaration	6-aia0006-Decl-by-Assignee-SIGNED.pdf	414346 043f69434bb78face83eb780994cadb891f4c550	no	3
Warnings:					
Information:					
7	Consent of Assignee accompanying the declaration	7-aia0053-Consent-of-Assignee-SIGNED.pdf	109421 ac58378bbe4683b3c08aca0779d0d8ff1aa55ee	no	1
Warnings:					
Information:					
8	Assignee showing of ownership per 37 CFR 3.73	8-aia0096-Ownership-Statement.pdf	118230 de8338e7c393dd640f02edbadc70599c02adc1fc	no	3
Warnings:					
Information:					
9	Fee Worksheet (SB06)	fee-info.pdf	46710 42c8bc5754fffd51c0540b4e78fbf5020c59379	no	2
Warnings:					
Information:					
Total Files Size (in bytes):			3765143		
This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503. <u>New Applications Under 35 U.S.C. 111</u> If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application. <u>National Stage of an International Application under 35 U.S.C. 371</u> If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course. <u>New International Application Filed with the USPTO as a Receiving Office</u> If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.					

PATENT APPLICATION FEE DETERMINATION RECORD Substitute for Form PTO-875						Application or Docket Number 17/714,917				
APPLICATION AS FILED - PART I										
(Column 1)		(Column 2)		SMALL ENTITY		OR OTHER THAN SMALL ENTITY				
FOR	NUMBER FILED	NUMBER EXTRA		RATE(\$)	FEE(\$)	RATE(\$)	FEE(\$)			
BASIC FEE (37 CFR 1.16(a), (b), or (c))	N/A	N/A		N/A	160	N/A				
SEARCH FEE (37 CFR 1.16(k), (i), or (m))	N/A	N/A		N/A	350	N/A				
EXAMINATION FEE (37 CFR 1.16(o), (p), or (q))	N/A	N/A		N/A	1160	N/A				
TOTAL CLAIMS (37 CFR 1.16(i))	21 minus 20 =	* 1		x 50 =	50	OR				
INDEPENDENT CLAIMS (37 CFR 1.16(h))	2 minus 3 =	*		x 240 =	0.00					
APPLICATION SIZE FEE (37 CFR 1.16(s))	If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$310 (\$155 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).				0.00					
MULTIPLE DEPENDENT CLAIM PRESENT (37 CFR 1.16(j))					0.00					
* If the difference in column 1 is less than zero, enter "0" in column 2.				TOTAL	1720	TOTAL				
APPLICATION AS AMENDED - PART II										
(Column 1)		(Column 2)		(Column 3)		SMALL ENTITY		OR OTHER THAN SMALL ENTITY		
AMENDMENT A	CLAIMS REMAINING AFTER AMENDMENT	MINUS	HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA		RATE(\$)	ADDITIONAL FEE(\$)	RATE(\$)	ADDITIONAL FEE(\$)	
	Total (37 CFR 1.16(i))	*	Minus	**	=	x =		OR	x =	
	Independent (37 CFR 1.16(h))	*	Minus	***	=	x =		OR	x =	
	Application Size Fee (37 CFR 1.16(s))							OR		
	FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(j))							OR		
TOTAL ADD'L FEE								OR	TOTAL ADD'L FEE	
(Column 1)		(Column 2)		(Column 3)		SMALL ENTITY		OR OTHER THAN SMALL ENTITY		
AMENDMENT B	CLAIMS REMAINING AFTER AMENDMENT	MINUS	HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA		RATE(\$)	ADDITIONAL FEE(\$)	RATE(\$)	ADDITIONAL FEE(\$)	
	Total (37 CFR 1.16(i))	*	Minus	**	=	x =		OR	x =	
	Independent (37 CFR 1.16(h))	*	Minus	***	=	x =		OR	x =	
	Application Size Fee (37 CFR 1.16(s))							OR		
	FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(j))							OR		
TOTAL ADD'L FEE								OR	TOTAL ADD'L FEE	
* If the entry in column 1 is less than the entry in column 2, write "0" in column 3. ** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 20, enter "20". *** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 3, enter "3". The "Highest Number Previously Paid For" (Total or Independent) is the highest found in the appropriate box in column 1.										



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APPLICATION NUMBER	FILING or 371(c) DATE	GRP ART UNIT	FIL FEE REC'D	ATTY. DOCKET NO.	TOT CLAIMS	IND CLAIMS
17/714,917	04/06/2022	2425	1720	103692.0001USre1	21	2

CONFIRMATION NO. 6111

FILING RECEIPT



0000000133019384

24392
FISH IP LAW, LLP
2603 Main Street
Suite 1000
Irvine, CA 92614

Date Mailed: 04/08/2022

Receipt is acknowledged of this reissue patent application. The application will be taken up for examination in due course. Applicant will be notified as to the results of the examination. Any correspondence concerning the application must include the following identification information: the U.S. APPLICATION NUMBER, FILING DATE, NAME OF FIRST INVENTOR, and TITLE OF INVENTION. Fees transmitted by check or draft are subject to collection.

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Inventor(s)

Yakkov MERLIN, Raanana, ISRAEL;

Applicant(s)

TVNGO LTD. (BVI), Amsterdam, NETHERLANDS, Assignee (with 37 CFR 1.172 Interest);

Power of Attorney: The patent practitioners associated with Customer Number 24392

Domestic Priority data as claimed by applicant

This application is a REI of 11/794,825 07/06/2007 PAT 8132220
which is a 371 of PCT/IL2005/000035 01/11/2005

Foreign Applications for which priority is claimed (You may be eligible to benefit from the **Patent Prosecution Highway** program at the USPTO. Please see <http://www.uspto.gov> for more information.) - None.

Foreign application information must be provided in an Application Data Sheet in order to constitute a claim to foreign priority. See 37 CFR 1.55 and 1.76.

Permission to Access Application via Priority Document Exchange: Yes

Permission to Access Search Results: Yes

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The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is **US 17/714,917**

Projected Publication Date: None, application is not eligible for pre-grant publication

Non-Publication Request: No

Early Publication Request: No

**** SMALL ENTITY ****

Title

Method And Apparatus For Facilitating Toggling Between Internet And TV Broadcasts

Preliminary Class

725

Statement under 37 CFR 1.55 or 1.78 for AIA (First Inventor to File) Transition Applications: No

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Applicants may wish to consult the USPTO booklet, "General Information Concerning Patents" (specifically, the section entitled "Treaties and Foreign Patents") for more information on timeframes and deadlines for filing foreign patent applications. The guide is available either by contacting the USPTO Contact Center at 800-786-9199, or it can be viewed on the USPTO website at <http://www.uspto.gov/web/offices/pac/doc/general/index.html>.

For information on preventing theft of your intellectual property (patents, trademarks and copyrights), you may wish to consult the U.S. Government website, <http://www.stopfakes.gov>. Part of a Department of Commerce initiative, this website includes self-help "toolkits" giving innovators guidance on how to protect intellectual property in specific countries such as China, Korea and Mexico. For questions regarding patent enforcement issues, applicants may call the U.S. Government hotline at 1-866-999-HALT (1-866-999-4258).

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Litigation Search Report CRU 3999

Reexamination Control No. 17/714,917

To:	PATEL	From:	MANUEL SALDANA
Location:	REM04D81	Location:	REM04C71
Art Unit:	3992	Phone:	571-272-7740
Date:	<u>11 April 2022</u>	E-mail:	MANUEL.SALDANA@USPTO.GOV

Search Notes

NO LITIGATION FOUND FOR US PAT. 8,132,220

1. Performed a KeyCite Search in Westlaw, which retrieves all history on the patent including any litigation.
2. Performed a search on the patent in Lexis CourtLink for any open dockets or closed cases.
3. Performed a search in Lexis in the Federal Courts and Administrative Materials databases for any cases found.
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5. Performed a search in Lexis in the news databases for any articles about the patent or any articles about litigation on this patent.

User Name: Manuel Saldana

Date and Time: Monday, April 11, 2022 12:41:00 PM EDT

Job Number: 168702828

Document (1)

1. US Patent Issued to Tyngo on March 6 for "Method and Apparatus for Facilitating Toggling Between Internet and TV Broadcasts" (Israeli Inventor)

Client/Matter: -None-

Search Terms: 8132220

Search Type: Natural Language

Narrowed by:

Content Type
News

Narrowed by
-None-

US Patent Issued to Tvngo on March 6 for "Method and Apparatus for Facilitating Toggling Between Internet and TV Broadcasts" (Israeli Inventor)

US Fed News

March 12, 2012 Monday 10:41 AM EST

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Length: 276 words

Dateline: ALEXANDRIA, Va.

Body

ALEXANDRIA, Va., March 12 -- United States Patent no. 8,132,220, issued on March 6, was assigned to Tvngo Ltd. (Raanana, Israel).

"Method and Apparatus for Facilitating Toggling Between Internet and TV Broadcasts" was invented by Yakkov Merlin (Raanana, Israel). According to the abstract released by the U.S. Patent & Trademark Office: "A TV-Internet Integration Box allows display of first data broadcast over a TV subscriber channel simultaneously together with second data broadcast over a digital data communications network has respective first and second inputs for receiving at a user premises the first data and the second data according to a user-profile associated with the second data. A combiner unit combines the first data and second data to form a combined video signal; and a video output coupled to the combiner unit conveys the combined video signal to a TV set in a user premises for displaying a first image corresponding to the first data and having superimposed thereon a second image corresponding to the second data. A user at the user premises may interact with the second image for redirecting to the digital data communications network and displaying a program broadcast thereby in at least a portion of the TV set." The patent was filed on Jan. 11, 2005, under Application No. 11/794,825. For further information please visit:

<http://patft.uspto.gov/netacgi/nph-Parser?Sect1=PTO2&Sect2=HITOFF&p=1&u=%2Fnetacgi/nph-PTO%2Fsearch-bool.html&r=1&f=G&l=50&co1=AND&d=PTXT&s1=8132220&OS=8132220&RS=8132220> For any query with respect to this article or any other content requirement, please contact Editor at htsyndication@hindustantimes.com

Load-Date: March 12, 2012

End of Document

Manuel Saldana

for: 8132220   

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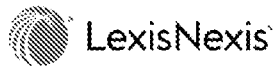
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
17/714,917	04/06/2022	Yakkov MERLIN	103692.0001USre1	6111
24392	7590	09/28/2022		
FISH IP LAW, LLP 2603 Main Street Suite 1000 Irvine, CA 92614			EXAMINER BASEHOAR, ADAM L	
			ART UNIT	PAPER NUMBER
			3992	
			NOTIFICATION DATE	DELIVERY MODE
			09/28/2022	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Patents@fishiplaw.com
rfish@fishiplaw.com

Notice of Pre-AIA or AIA Status

1. The present application is being examined under the pre-AIA first to invent provisions.
2. For reissue applications filed on or after September 16, 2012, all references to 35 U.S.C. 251 and 37 CFR 1.172, 1.175, and 3.73 are to the current provisions.

DETAILED ACTION

3. This is a Non-Final Action responsive to communications: The instant application (i.e., 17/714,917) filed 04/06/2022, which is a reissue of application 11/794,825 (U.S. Patent No. 8,132,220 B2, published 03/06/2012).
4. Claims 1-21 were initially pending in the application. A preliminary amendment to the claims was filed concurrently with the application on 04/06/2022. By way of the preliminary amendment to the claims, claims 1, 3, 5, 9, 10, 13, 15, 17, and 20 have been amended. Said preliminary amendment to the claims has been entered and made of record. Therefore, claims 1-21 are currently pending in the application. Claims 1 and 13 are independent claims.

Reissue

5. Applicant is reminded of the continuing obligation under 37 CFR 1.178(b), to timely apprise the Office of any prior or concurrent proceeding in which Patent No. 8,132,220 B2 is or was involved. These proceedings would include interferences, reissues, reexaminations, and litigation.

Applicant is further reminded of the continuing obligation under 37 CFR 1.56, to timely apprise the Office of any information which is material to patentability of the claims under consideration in this reissue application.

These obligations rest with each individual associated with the filing and prosecution of this application for reissue. See also MPEP §§ 1404, 1442.01 and 1442.04.

6. The patent sought to be reissued by this application has been involved in litigation. Any documents and/or materials which would be material to the patentability of this reissue application are required to be made of record in reply to this action.

7. Applicant is notified that any subsequent amendment to the specification and/or claims must comply with 37 CFR 1.173(b).

Specification

8. The disclosure is objected to because of the following informalities:

Column 4, lines 31 and 40 each recite the “memory 25” in reference to Fig. 5 of the Merlin ‘220 patent. However, Fig. 5 of the Merlin ‘220 patent shows that reference number 25 refers to the “Processing Unit” and it is reference number 26 that properly refers to the “memory.” Therefore, in each instance, “25” should be replaced with “26.”

Appropriate correction is required.

Claim Rejections - 35 USC § 251

9. **Claims 1-21 are rejected** under 35 U.S.C. 251 as being broadened in a reissue application filed outside the two year statutory period.

First, in the instant case, the amendments to independent claims 1 and 13 clearly broaden (see: MPEP 1412.03(I)) said claims by deleting the limitation requiring an “overlay activation criterion” as part of the “overlay-enabling digital data.” The deleted “overlay activation criterion” indicating that it comes from the Internet and simultaneously not from the Internet (i.e., from a user’s premises). After the amendments to independent claims 1 and 13, said claims now merely require an “event condition” and not an “overlay activation criterion.”

A claim is broader in scope than the original claims if it contains within its scope any conceivable product or process which would not have infringed the original patent. A claim would be considered a broadening claim if the Patent Owner would be able to sue any party for infringement who previously could not have been sued for infringement. A claim is broadened if it is broader in any one respect even though it may be narrower in other respects.

Second, in this instance, it is difficult to see how independent claims 1 and 13 of the Merlin ‘220 patent could be compared to a product or process said to infringe the claims. For example, one cannot read the drawing figures (i.e., Figs. 1-8) of the Merlin ‘220 patent onto independent claims 1 and 13 of the Merlin ‘220 patent. This is because independent claims 1 and 13 of the Merlin ‘220 patent, as noted above, present irreconcilable inconsistencies that render their precise meanings not reasonably certain. Presumably, the amendments to independent claims 1 and 13 are supported by the specification of the Merlin ‘220 patent, as argued by Applicant in the Remarks, and therefore the drawing figures (i.e., Figs. 1-8) of the Merlin ‘220 patent can be read onto amended independent claims 1 and 13. Thus, the drawing

figures (i.e., Figs. 1-8) of the Merlin '220 patent—if prior art—would anticipate or if used without Applicant's permission would infringe amended independent claims 1 and 13, but would not anticipate or infringe independent claims 1 and 13 of the Merlin '220 patent. It necessarily follows that amended independent claims 1 and 13 enlarge the scope of independent claims 1 and 13 of the Merlin '220 patent, all contrary to 35 U.S.C. 251(d).

10. **Claims 1-21 are rejected under 35 U.S.C. 251** as being improperly broadened in a reissue application made and sworn to by the assignee. The application for reissue may be made and sworn to by the assignee of the entire interest only if the application does not seek to enlarge the scope of the claims of the original patent or, for reissue applications filed on or after September 16, 2012, the application for the original patent was filed by the assignee of the entire interest under 37 CFR 1.46.

As noted above, independent claims 1 and 13 of the Merlin '220 patent have clearly been broadened by the preliminary amendments to said claims.

11. **Claims 1-21 are rejected** under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Greenliant Systems, Inc. et al v. Xicor LLC*, 692 F.3d 1261, 103 USPQ2d 1951 (Fed. Cir. 2012); *In re Shahram Mostafazadeh and Joseph O. Smith*, 643 F.3d 1353, 98 USPQ2d 1639 (Fed. Cir. 2011); *North American Container, Inc. v. Plastipak Packaging, Inc.*, 415 F.3d 1335, 75 USPQ2d 1545 (Fed. Cir. 2005); *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161

(Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to claimed subject matter that Applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope of claim subject matter surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

It is noted that the following is the three step test for determining recapture in reissue applications (see: MPEP 1412.02(II)):

“(1) first, we determine whether, and in what respect, the reissue claims are broader in scope than the original patent claims;

(2) next, we determine whether the broader aspects of the reissue claims relate to subject matter surrendered in the original prosecution; and

(3) finally, we determine whether the reissue claims were materially narrowed in other respects, so that the claims may not have been enlarged, and hence avoid the recapture rule.”

(Step 1: MPEP 1412.02(II)(A)) In the instant case and by way of the preliminary amendment to the claims, Applicant seeks to broaden independent patent claims 1 and 13 in this reissue at least by deleting/omitting the substantially similar patent claim language that requires “an overlay activation criterion.”

(Step 2: MPEP 1412.02(II)(B)) The record of the prior 11/794,825 application prosecution history indicates that in a Response filed on 09/16/2010 by Applicant, original independent patent claims 19 and 29 (now independent patent claims 1 and 13, respectively) were amended to at least include the substantially similar limitation of “wherein said overlay-enabling digital data includes at least...an overlay activation criterion” in order to overcome an applied prior art rejection in view of Reichardt. Later in the prosecution history, Applicant further argued that “neither Akiyama or Butler teaches receiving the overlay activation criterion and the video TV signal from two separate sources” (e.g., see: Remarks filed 08/23/2011, pp. 11-13) in order to overcome an applied prior art rejection of Akiyama in view of Butler. Subsequently, a Notice of Allowability was mailed on 09/23/2011 wherein claims 19-39 were allowed.

Subject matter is previously surrendered during the prosecution of the original application by reliance on an amendment to the claims and/or an argument/statement made by Applicant that a limitation(s) of the claim(s) defines over the art. Additionally, reissue recapture applies to related family member applications (See *MBO Laboratories, Inc. v. Becton, Dickinson & Co.*, 602 F.3d 1306 USPQ2d 1598 (Fed. Cir. Apr. 12, 2010) (a more limited recapture rule would undercut “the rule against recapture’s public-reliance rationale” and a patent family’s entire prosecution history should be reviewed “when applying both the rule against recapture and prosecution history estoppel.”)). It is noted that a Patent Owner (Reissue Applicant) is bound by the amendment and/or argument that Applicant relied upon to overcome an art rejection in the original application for the patent to be reissued, regardless of whether the Office adopted the amendment and/or argument in allowing the claims. Therefore, due to Applicant’s amendments and arguments during the prior 11/794,825 application prosecution history, at least the claim

limitations requiring “an overlay activation criterion” are considered surrendered subject matter and some of the broadening of independent claims 1 and 13, as noted above, is clearly in the area of the surrendered subject matter.

(Step 3: MPEP 1412.02(II)(C)) First it must be noted that the reissue claims were not materially narrowed in other respects (i.e., the new limitations are not related to the same characteristic or concept as the surrendered subject matter), so that the claims may not have been enlarged, and hence avoid the recapture rule. The added “event condition” limitation is not a new surrender generating limitation (SGL). For instance, as noted above, the intrinsic evidence of the Merlin ‘220 patent indicates that the “overlay activation criterion” limitation comes from the Internet and simultaneously not from the Internet (i.e., from a user’s premises). The added “event condition” limitation does not appear to share this same characteristic or concept as the “overlay activation criterion” limitation.

Second, if a surrender generating limitation (SGL) has been entirely eliminated from a claim present in the reissue application, then a recapture rejection under 35 U.S.C. 251 may be proper. In the instant case, the surrendered subject matter has been entirely eliminated from independent claims 1 and 13.

Therefore, broadened independent reissue claims 1 and 13 (as well as dependent claims 2-12 and 14-21) attempt impermissible recapture of subject matter surrendered during prosecution of the 11/794,825 application. To overcome this rejection, all of the surrendered subject matter must be restored in the independent claims.

12. The Reissue Declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following:

First, the Reissue Declaration does not properly indicate the reasons why the patent is wholly or partially inoperative or invalid. As noted in MPEP 1414(I), “Even though only one error upon which reissue is based needs to be described in the reissue oath/declaration, if PTO/SB/51 or PTO/SB/52 form is used (or PTO/AIA/05 or PTO/AIA/06, for applications filed on or after September 16, 2012), applicant needs to check the appropriate box(es) on the form identifying each of the reasons why the patent is wholly or partly inoperative or invalid. Even if a PTO form is not used, applicant needs to state each of the reasons why the patent is wholly or partly inoperative or invalid in the reissue oath/declaration.” Specifically, the Reissue Declaration incorrectly indicates that “by reason of other errors” as the reason why the patent is wholly or partially inoperative or invalid. This box is usually checked to indicate errors related to inventorship or claims to foreign/domestic priority. Because those types of errors do not appear to be corrected by the instant reissue application, the Reissue Declaration fails to properly indicate that the actual error is based on the scope of the claims. To correct this issue Applicant must uncheck the box for “by reason of other errors” and at least check the box for “by reason of the patentee claiming more or less than he had the right to claim in the patent.”

Second, the Reissue Declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because none of the errors which are relied upon to support the reissue application are errors upon which a reissue can be based. The Examiner notes that broadening the claims after two years from the grant of the original patent is not an error correctable by reissue. Similarly, the recapture of surrendered subject matter is not an error correctable by reissue. Thus, as noted above with regard to claims 1-21, two of the errors provided in the

Reissue Declaration (i.e., “One error is a federal court found claims 1, 9, 10, 13, 17, and 20 invalid...A second error is the same court found claims 9 and 20 invalid as inconsistent with parent claims 1 and 13”) to support the reissue application are errors related to broadening the claims after two years and/or the recapture of surrendered subject matter. The third error provided in the Reissue Declaration (i.e., “A third error is claims 1, 3, 5, 13, and 15 have apparent antecedent basis defects and may be invalid”) is not specific and thus it has not been shown to be an actual error in the claims that renders the original patent to be wholly or partly inoperative or invalid. As noted in MPEP 1414(II)(B), “In identifying the error, it is sufficient that the reissue oath/declaration identify a single word, phrase, or expression in the specification or in an original claim, and how it renders the original patent wholly or partly inoperative or invalid.” Additionally, the Examiner notes that “an error under 35 U.S.C. 251 has not been presented where the correction to the patent is one of spelling, or grammar, or a typographical, editorial or clerical error which does not cause the patent to be deemed wholly or partly inoperative or invalid for the reasons specified in 35 U.S.C. 251” (see: MPEP 1402).

Third, the Reissue Declaration fails to identify an original patent claim that the application seeks to broaden (see: MPEP 1414(II)(B) and 37 CFR 1.175(b)). For an application filed on or after September 16, 2012 that seeks to enlarge the scope of the claims of the patent, the reissue oath or declaration must also identify a claim that the application seeks to broaden. The Examiner notes that it does not appear to be Applicant’s intent to broaden the claims. As noted above, Applicant is currently outside the two year statutory period and thus cannot broaden the claims. However, because the claims have indeed been broadened by the preliminary amendment to the claims, the Reissue Declaration is required to conform with 37 CFR 1.175(b).

Appropriate correction is required.

13. **Claims 1-21 are rejected** as being based upon a defective Reissue Declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the Declaration is set forth in the discussion above in this Office action.

Claim Rejections - 35 USC § 112

14. The following is a quotation of 35 U.S.C. 112 (pre-AIA), second paragraph:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

15. **Claims 1-21 are rejected** under 35 U.S.C. 112(b) or 35 U.S.C. 112 (pre-AIA), second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the inventor or a joint inventor, or for pre-AIA the applicant regards as the invention.

Independent claims 1 and 13 each newly recite the substantially similar limitations, “wherein said overly-enabling digital data includes...an event condition...only if said event condition is met” (emphasis added). Claims 1 and 13 are therefore indefinite because the boundaries of the claimed subject matter are not clearly delineated and the scope is unclear. Specifically, “Upon detecting a matching event” is cited in column 4, line 41 of the Merlin ‘220 patent for providing proper support. However, said citation does not clearly state what subject matter is intended to be covered by the broadly recited “event condition” as compared to the original patented claims which required “an overlay activation criterion.” Accordingly, the Merlin ‘220 patent fails to inform a person of ordinary skill in the art of the claimed invention’s

scope with reasonable certainty. Thus, independent claims 1 and 13 are indefinite for not specifically setting forth that which the inventor or a joint inventor regards as the invention.

Dependent claims 2-12 and 14-21 are similarly rejected at least via dependency.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. Please note the relevant cited prior art listed on the accompanying Notice of References Cited (Form PTO-892).

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam L Basehoar whose telephone number is (571)272-4121. The examiner can normally be reached on 8:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kosowski can be reached on 571-272-3744. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ADAM L BASEHOAR/
Primary Examiner, Art Unit 3992

Conferees:

Application/Control Number: 17/714,917
Art Unit: 3992

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/JOSHUA D CAMPBELL/
Primary Examiner, Art Unit 3992

/ALEXANDER J KOSOWSKI/
Supervisory Patent Examiner, Art Unit 3992

<i>Notice of References Cited</i>	Application/Control No. 17/714,917		Applicant(s)/Patent Under Reexamination MERLIN, Yakkov	
	Examiner Adam L Basehoar		Art Unit 3992	Page 1 of 1

U.S. PATENT DOCUMENTS						
*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	CPC Classification	US Classification
*	A	US-5990927-A	11-1999	Hendricks; John S.	H04N21/2389	725/132
*	B	US-6510557-B1	01-2003	Thrift; Philip R.	H04N21/4316	725/111
*	C	US-20020144273-A1	10-2002	Reto, Wettach	H04L65/1101	348/E7.071
*	D	US-20030030652-A1	02-2003	Billmaier, James A.	H04N21/4438	725/135
*	E	US-20050235319-A1	10-2005	Carpenter, Kenneth F.	H04N21/4622	348/E5.103
*	F	US-20100085483-A1	04-2010	Pan; Yang	H04N21/4622	348/E5.103
*	G	US-20130002716-A1	01-2013	Walker; Todd	H04N21/47205	345/629
	H					
	I					
	J					
	K					
	L					
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FOREIGN PATENT DOCUMENTS						
*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	CPC Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

NON-PATENT DOCUMENTS						
*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)				
	U					
	V					
	W					
	X					

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
 Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

<i>Index of Claims</i> 	Application/Control No. 17/714,917	Applicant(s)/Patent Under Reexamination MERLIN, Yakkov
	Examiner Adam L Basehoar	Art Unit 3992

✓	Rejected	-	Cancelled	N	Non-Elected	A	Appeal
=	Allowed	÷	Restricted	I	Interference	O	Objected

CLAIMS										
☐ Claims renumbered in the same order as presented by applicant ☐ CPA ☐ T.D. ☐ R.1.47										
CLAIM		DATE								
Final	Original	08/15/2022								
	1	✓								
	2	✓								
	3	✓								
	4	✓								
	5	✓								
	6	✓								
	7	✓								
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	17	✓								
	18	✓								
	19	✓								
	20	✓								
	21	✓								

<i>Search Notes</i> 	Application/Control No. 17/714,917	Applicant(s)/Patent Under Reexamination MERLIN, Yakkov
	Examiner Adam L Basehoar	Art Unit 3992

CPC - Searched*		
Symbol	Date	Examiner
H04N 21/(44016, 4782, 4316, 4622, 431)	08/15/2022	ALB

CPC Combination Sets - Searched*		
Symbol	Date	Examiner

US Classification - Searched*			
Class	Subclass	Date	Examiner
725	109	08/15/2022	ALB
715	717, 718	08/15/2022	ALB
345	629	08/15/2022	ALB

* See search history printout included with this form or the SEARCH NOTES box below to determine the scope of the search.

Search Notes		
Search Notes	Date	Examiner
Reviewed Prior Application(s) History/Cited Prior Art	08/15/2022	ALB
Inventor Name Search (PE2E)	08/15/2022	ALB
Recapture Review Conducted	08/15/2022	ALB
Litigation Search (04/11/2022)	08/15/2022	ALB
PE2E Text and Classification Search (see attached search history)	08/15/2022	ALB

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Search Notes 	Application/Control No. 17/714,917	Applicant(s)/Patent Under Reexamination MERLIN, Yakkov
	Examiner Adam L Basehoar	Art Unit 3992

Interference Search			
US Class/CPC Symbol	US Subclass/CPC Group	Date	Examiner

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BIB DATA SHEET

CONFIRMATION NO. 6111

SERIAL NUMBER 17/714,917	FILING or 371(c) DATE 04/06/2022 RULE	CLASS 725	GROUP ART UNIT 3992	ATTORNEY DOCKET NO. 103692.0001USre1		
APPLICANTS /ALB/ TVNGO LTD. (BVI), Amsterdam, NETHERLANDS, Assignee (with 37 CFR 1.172 Interest); INVENTORS /ALB/ Yakkov MERLIN, Raanana, ISRAEL; ** CONTINUING DATA ***** /ALB/ This application is a REI of 11/794,825 07/06/2007 PAT 8132220 which is a 371 of PCT/IL2005/000035 01/11/2005 ** FOREIGN APPLICATIONS ***** /ALB/ ** IF REQUIRED, FOREIGN FILING LICENSE GRANTED ** ** SMALL ENTITY ** 04/07/2022						
Foreign Priority claimed ☐ Yes ☒ No 35 USC 119(a-d) conditions met ☐ Yes ☒ No Verified and Acknowledged <u>/ADAM L BASEHOAR/</u> Examiner's Signature		☐ Met after Allowance Initials	STATE OR COUNTRY ISRAEL	SHEETS DRAWINGS 7	TOTAL CLAIMS 21	INDEPENDENT CLAIMS 2
ADDRESS /ALB/ FISH IP LAW, LLP 2603 Main Street Suite 1000 Irvine, CA 92614 UNITED STATES						
TITLE /ALB/ Method And Apparatus For Facilitating Toggling Between Internet And TV Broadcasts						
FILING FEE RECEIVED 1720	FEES: Authority has been given in Paper No. _____ to charge/credit DEPOSIT ACCOUNT No. _____ for following:		☐ All Fees ☐ 1.16 Fees (Filing) ☐ 1.17 Fees (Processing Ext. of time) ☐ 1.18 Fees (Issue) ☐ Other _____ ☐ Credit			

PE2E SEARCH - Search History (Prior Art)

Ref #	Hits	Search Query	DBs	Default Operator	Plurals	British Equivalents	Time Stamp
L1	1	"8132220".pn.	(US-PGPUB; USPAT)	OR	ON	ON	2022/08/15 11:06 AM
L4	6465	725/109;715/717,718;3 45/629.ccls.	(US-PGPUB; USPAT)	OR	ON	ON	2022/08/15 11:55 AM
L6	28067	H04N21/44016,4782,43 16,4622,431.cpc.	(US-PGPUB; USPAT)	OR	ON	ON	2022/08/15 11:56 AM
L7	21	("6130898" "6240555" "6351270" "6501557" "6606746" "6727918" "6760324" "7124430" "7340457" "20020007493" "20020088004" "20020093594" "20040064835" "20040107437" "20040221308").pn. OR ("8132220").urpn. AND (PGPB USPT USOC).dbnm.	(US-PGPUB; USPAT; USOCR)	OR	ON	ON	2022/08/15 11:56 AM
L8	408	725/109;715/717,718;3 45/629.ccls. AND interactive near2 television	(US-PGPUB; USPAT)	OR	ON	ON	2022/08/15 12:01 PM
L9	22	725/109;715/717,718;3 45/629.ccls. AND interactive near2 television SAME overlay\$5	(US-PGPUB; USPAT)	OR	ON	ON	2022/08/15 12:01 PM
L11	6	725/109;715/717,718;3 45/629.ccls. AND interactive near2 television SAME overlay\$5 SAME (condition OR criterion OR tim\$5)	(US-PGPUB; USPAT)	OR	ON	ON	2022/08/15 12:04 PM
L12	10	725/109;715/717,718;3 45/629.ccls. AND (event ADJ condition)	(US-PGPUB; USPAT)	OR	ON	ON	2022/08/15 12:05 PM
L13	2	725/109;715/717,718;3 45/629.ccls. AND (overlay ADJ activation)	(US-PGPUB; USPAT)	OR	ON	ON	2022/08/15 12:05 PM
L14	1	725/109;715/717,718;3 45/629.ccls. AND (overlay ADJ activation ADJ criterion)	(US-PGPUB; USPAT)	OR	ON	ON	2022/08/15 12:05 PM
L15	0	725/109;715/717,718;3 45/629.ccls. AND (event ADJ condition) SAME overlay	(US-PGPUB; USPAT)	OR	ON	ON	2022/08/15 12:09 PM

L16	3668	H04N21/44016,4782,431,4622,431.cpc. AND interactive near2 television	(US-PGPUB; USPAT)	OR	ON	ON	2022/08/15 12:10 PM
L17	298	H04N21/44016,4782,431,4622,431.cpc. AND interactive near2 television SAME overlay\$5	(US-PGPUB; USPAT)	OR	ON	ON	2022/08/15 12:10 PM
L19	113	H04N21/44016,4782,431,4622,431.cpc. AND interactive near2 television SAME overlay\$5 SAME (condtion OR criterion OR tim\$5)	(US-PGPUB; USPAT)	OR	ON	ON	2022/08/15 12:10 PM
L20	87	H04N21/44016,4782,431,4622,431.cpc. AND (event ADJ condition)	(US-PGPUB; USPAT)	OR	ON	ON	2022/08/15 12:10 PM
L21	10	H04N21/44016,4782,431,4622,431.cpc. AND (overlay ADJ activation)	(US-PGPUB; USPAT)	OR	ON	ON	2022/08/15 12:10 PM
L22	3	H04N21/44016,4782,431,4622,431.cpc. AND (overlay ADJ activation ADJ criterion)	(US-PGPUB; USPAT)	OR	ON	ON	2022/08/15 12:10 PM
L23	6	H04N21/44016,4782,431,4622,431.cpc. AND (event ADJ condition) SAME overlay	(US-PGPUB; USPAT)	OR	ON	ON	2022/08/15 12:11 PM
L24	20	H04N21/44016,4782,431,4622,431.cpc. AND interactive near2 television SAME overlay\$5 SAME (condtion OR criterion OR tim\$5) SAME (icon OR hyperlink)	(US-PGPUB; USPAT)	OR	ON	ON	2022/08/15 12:12 PM
L25	220	H04N21/44016,4782,431,4622,431.cpc. AND interactive near2 television SAME overlay\$5 AND remote SAME button\$1	(US-PGPUB; USPAT)	OR	ON	ON	2022/08/15 12:14 PM
L26	96	H04N21/44016,4782,431,4622,431.cpc. AND interactive near2 television SAME overlay\$5 AND remote SAME button\$1 SAME (dedicat\$5 OR color ADJ cod\$4)	(US-PGPUB; USPAT)	OR	ON	ON	2022/08/15 12:14 PM
L27	2	H04N21/44016,4782,431,4622,431.cpc. AND interactive near2	(US-PGPUB; USPAT)	OR	ON	ON	2022/08/15 12:14 PM

L28	3073	television SAME overlay\$5 AND remote SAME button\$1 SAME (color ADJ cod\$4)	(US-PGPUB; USPAT)	OR	ON	ON	2022/08/15 12:14 PM
L29	149	interactive near2 television SAME (broadcast AND internet)	(US-PGPUB; USPAT)	OR	ON	ON	2022/08/15 12:15 PM
L31	0	interactive near2 television SAME (broadcast AND internet) same2 overlay	(US-PGPUB; USPAT)	OR	ON	ON	2022/08/15 12:15 PM
L32	3073	interactive near2 television SAME (broadcast AND internet) same2 event ADJ condition	(US-PGPUB; USPAT)	OR	ON	ON	2022/08/15 12:16 PM
L33	1110	interactive near2 television SAME (broadcast AND internet) AND overlay	(US-PGPUB; USPAT)	OR	ON	ON	2022/08/15 12:16 PM
L34	101	interactive near2 television SAME (broadcast AND internet) AND overlay SAME (trigger\$1 OR condition\$1 OR activation OR criterion)	(US-PGPUB; USPAT)	OR	ON	ON	2022/08/15 12:16 PM
L35	3	interactive near2 television SAME (broadcast AND internet) AND overlay SAME (trigger\$1 OR condition\$1 OR activation OR criterion) SAME (icon)	(US-PGPUB; USPAT)	OR	ON	ON	2022/08/15 12:17 PM
L36	124	television SAME (broadcast AND internet) AND overlay SAME (trigger\$1 OR condition\$1 OR activation OR criterion) SAME (icon)	(US-PGPUB; USPAT)	OR	ON	ON	2022/08/15 12:19 PM
L37	13286	television SAME overlay	(US-PGPUB; USPAT)	OR	ON	ON	2022/08/15 12:19 PM
L38	1215	television SAME overlay SAME (event condition OR activation ADJ criterion)	(US-PGPUB; USPAT)	OR	ON	ON	2022/08/15 12:19 PM
L39	349	television SAME	(US-PGPUB; USPAT)	OR	ON	ON	2022/08/15

L40	28	overlay near10 (event condition OR activation ADJ criterion) television SAME overlay near10 (event condition OR activation ADJ criterion) SAME (icon OR link OR timing)	(US-PGPUB; USPAT)	OR	ON	ON	12:19 PM 2022/08/15 12:20 PM
L42	124	television SAME overlay near10 (event condition OR activation ADJ criterion) SAME (tim\$3)	(US-PGPUB; USPAT)	OR	ON	ON	2022/08/15 12:22 PM
L43	12	television SAME overlay near10 (event condition OR activation ADJ criterion) SAME (start near2 tim\$3)	(US-PGPUB; USPAT)	OR	ON	ON	2022/08/15 12:22 PM
L44	1	725/109;715/717,718;345/629.ccls. AND interactive near2 television SAME overlay\$5 SAME (condition OR criterion)	(US-PGPUB; USPAT)	OR	ON	ON	2022/08/15 12:26 PM
L45	11	H04N21/44016,4782,4316,4622,431.cpc. AND interactive near2 television SAME overlay\$5 SAME (condition OR criterion)	(US-PGPUB; USPAT)	OR	ON	ON	2022/08/15 12:27 PM

PE2E SEARCH - Search History (Interference)

There are no Interference searches to show.

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REISSUE APPLICATION DECLARATION BY THE ASSIGNEE		Docket Number (optional) 103692.0001US1re	
I hereby declare that: The residence and mailing address of the inventor or joint inventors are stated below.			
Name of the Assignee: TVnGo Ltd. (BVI)			
I am authorized to act on behalf of the assignee (if the assignee is a juristic entity). The entire title to the patent identified below is vested in said assignee, or if there are multiple assignees/owners, all assignees/owners have executed a Reissue Application Declaration to account for the entire title of the patent identified below.			
Inventor Yakkov Merlin			
Residence: City Raanana	State -	Country Israel	
Mailing Address 9 Haeshel St			
City Raanana	State -	Zip 43585	Country Israel
☐ Additional Inventors are named on separately numbered sheets attached hereto.			
Patent Number US8132220		Patent Issue Date March 6, 2012	
I believe said inventor(s) to be the original inventor or original joint inventors of the subject matter which is described and claimed in said patent, for which a reissue patent is sought on the invention titled:			
Method and Apparatus for Facilitating Toggling Between Internet and TV Broadcasts			
the specification of which			
☒ is attached hereto.			
☐ was filed on _____ as reissue application number _____.			
The above-identified application was made or authorized to be made by me.			
I hereby acknowledge that any willful false statement made in this declaration is punishable under 18 U.S.C. 1001 by fine or imprisonment of not more than five (5) years, or both.			
I believe the original patent to be wholly or partly inoperative or invalid, for the reasons described below. (Check all boxes that apply.)			
☐ by reason of a defective specification or drawing.			
☒ by reason of the patentee claiming more or less than he had the right to claim in the patent.			
☐ by reason of other errors.			

[Page 1 of 2]

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REISSUE APPLICATION DECLARATION BY THE ASSIGNEE

Docket Number (Optional) 103692.0001US1re

At least one error upon which reissue is based is described below. If the reissue is a broadening reissue, a claim that the application seeks to broaden must be identified and the box below must be checked:

One error is a federal court found claims 1, 9, 10, 13, 17, and 20 invalid because the claim term "overlay activation criterion" was not described in the Specification and is otherwise indefinite. As such, patentee claimed more than he had a right to claim in the patent. A second error is the same court found claims 9 and 20 invalid as inconsistent with parent claims 1 and 13, respectively, because claims 1 and 13 required information be provided via Internet, while dependent claims required the same information may be provided locally without the Internet. As such, patentee claimed more than he had a right to claim in the patent as to claims 9 and 20. A third error is claims 1, 3, 5, 13, and 15 have apparent antecedent basis defects and may be invalid. For example, claim 1 at col. 9, l. 12 improperly recites "an overlay" as opposed to "the overlay". Claim 13 at col. 10, l. 21 also improperly recites "a user's" as opposed to "the user's". As such, patentee claimed a broader right than he was entitled to.

[Attach additional sheets, if needed.]

☐ The application for the original patent was filed under 37 CFR 1.46 by the assignee of the entire interest.

I hereby appoint:

☒ Practitioners associated with Customer Number:

24392

OR

☐ Practitioner(s) named below:

Name	Registration Number

as my/our attorney(s) or agent(s) to prosecute the application identified above, and to transact all business in the United States Patent and Trademark Office connected therewith.

Correspondence Address: Direct all communications about the application to:

☒ The address associated with Customer Number:

24392

OR

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Signature

Date (Optional)

Legal name of person signing

Eliot Harary

Address of Assignee

912 1st Court, Brooklyn, NY 11223

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5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
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7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
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Electronic Patent Application Fee Transmittal

Application Number:	17714917			
Filing Date:	06-Apr-2022			
Title of Invention:	Method And Apparatus For Facilitating Toggling Between Internet And TV Broadcasts			
First Named Inventor/Applicant Name:	Yakkov MERLIN			
Filer:	Robert Fish/Jack Reihl			
Attorney Docket Number:	103692.0001USre1			
Filed as Small Entity				
Filing Fees for Utility under 35 USC 111(a)				
Description	Fee Code	Quantity	Amount	Sub-Total in USD(\$)
Basic Filing:				
Pages:				
Claims:				
Miscellaneous-Filing:				
Petition:				
Patent-Appeals-and-Interference:				
Post-Allowance-and-Post-Issuance:				
Extension-of-Time:				

Description	Fee Code	Quantity	Amount	Sub-Total in USD(\$)
Extension - 1 month with \$0 paid	2251	1	88	88
Miscellaneous:				
Total in USD (\$)				88

Electronic Acknowledgement Receipt

EFS ID:	47451499
Application Number:	17714917
International Application Number:	
Confirmation Number:	6111
Title of Invention:	Method And Apparatus For Facilitating Toggling Between Internet And TV Broadcasts
First Named Inventor/Applicant Name:	Yakkov MERLIN
Customer Number:	24392
Filer:	Robert Fish/Jack Reihl
Filer Authorized By:	Robert Fish
Attorney Docket Number:	103692.0001USre1
Receipt Date:	30-JAN-2023
Filing Date:	06-APR-2022
Time Stamp:	18:57:48
Application Type:	Utility under 35 USC 111(a)

Payment information:

Submitted with Payment	yes
Payment Type	DA
Payment was successfully received in RAM	\$88
RAM confirmation Number	E20231TI58244649
Deposit Account	500341
Authorized User	Jack Reihl
The Director of the USPTO is hereby authorized to charge indicated fees and credit any overpayment as follows: 37 CFR 1.16 (National application filing, search, and examination fees) 37 CFR 1.17 (Patent application and reexamination processing fees)	

37 CFR 1.19 (Document supply fees)
 37 CFR 1.20 (Post Issuance fees)
 37 CFR 1.21 (Miscellaneous fees and charges)

File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1	Amendment/Request for Reconsideration-After Non-Final Rejection	Response-01h_to_2022-09-28_OA_TVnGo_1US1re.pdf	59157	no	12
			58464a39a3c7c7442c1f2dfe04d00da6536645e3		

Warnings:

Information:

2	Oath or Declaration filed	Decl-by-Assignee-SIGNED-cutePDF.pdf	500923	no	3
			fd18f231922bbebaaa5cd4b4dd6c4082c1c9c65a90		

Warnings:

Information:

3	Fee Worksheet (SB06)	fee-info.pdf	38364	no	2
			170ede81e6b3ee5a2f6442da43f2e6c661241194		

Warnings:

Information:

Total Files Size (in bytes):			598444
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If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

National Stage of an International Application under 35 U.S.C. 371

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

New International Application Filed with the USPTO as a Receiving Office

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450**

Appl No.: 17/714,917
Inventor: Yakkov Merlin
Filing Date: April 6, 2022
Art Unit: 3992
Examiner: Basehoar, Adam L.
Attorney Docket No.: 103692.0001USre1

Title Method and Apparatus for Facilitating Toggling
Between Internet and TV Broadcasts

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

RESPONSE TO OFFICE ACTION

Sir:

This paper responds to the Office Action dated September 28, 2022, filed with 1 month extension. Please enter the amendments shown herein.

- Claim Amendments begin on page 2.
- Specification Amendments begin on page 8.
- Remarks begin on page 9.

AMENDMENTS TO THE CLAIMS

This listing of claims represents the current version of claims before the Office with amendments to be entered:

1. (twice amended) A method for generating at a user's premises an overlay using video signals constituting a first data and overlay-enabling digital data constituting a second data, the method comprising:

(a) providing a combiner unit at the user's premises, wherein:

the combiner unit is coupled to a TV set and connected to a separate TV tuner box or TV tuner in the TV set, at the user's premises, and

the combiner unit is also connected through distinct networks to each of a video signal source providing video signals through the TV tuner box or TV tuner in the TV set, and an Internet data source providing overlay-enabling digital data over the Internet,

wherein said video signals and said overlay-enabling digital data originate from unrelated sources and are transmitted to the user's premises by different resources as mutually distinct and independent inputs,

and wherein said overlay-enabling digital data includes at least:

a Web link indicating a website where content that is associated with said overlay-enabling digital data is stored,

an image indicative of the content associated with said overlay-enabling digital data, and

an overlay activation criterion, wherein the overlay activation criterion is a matching event; and

(b) processing at the user's premises said overlay-enabling digital data and generating at the user's premises a corresponding overlay only if said overlay activation criterion is met, wherein generating [an] the overlay includes:

generating at the user's premises a first display screen including at least a first portion corresponding to said video signals and a second portion overlaid over said first portion and corresponding at least to said image, and

associating the Web link with said second portion of the first display screen thereby allowing a user to cause the combiner unit to retrieve said content, generate a second video display screen including at least a portion which corresponds to said content, and input the second display screen to said TV set.

2. (original) The method according to claim 1, wherein said overlay-enabling digital data is received at the user premises according to a pre-stored user profile.

3. (amended) The method according to claim 1, further including: receiving a command from [a] the user at said user premises; and responsive to said command, resizing said first portion and/or said second portion of said first display screen.

4. (original) The method according to claim 1, wherein the content stored at said website enables streaming of digital data over the Internet; and

said method further including: pre-fetching and buffering said digital data stream from said website, thereby allowing said digital data stream to be displayed substantially without delay upon redirection by the user.

5. (amended) The method according to claim 1, wherein the overlay-enabling digital data comprises data representative of one or more second images, and for each of said one or more second images said overlay-enabling data comprises respective web site addresses where IP content associated with the respective second image is stored, and wherein said generating [an] the overlay further includes within said first display said one or more second images.

6. (original) The method according to claim 1, wherein the overlay-enabling digital data is supplementary or complementary to the video signals.

7. (original) The method according to claim 1, wherein the image includes an icon that indicates to the user that digital data from Internet content is currently being displayed and which provides an indication of a nature of said Internet content.

8. (original) The method according to claim 1, wherein the image contains textual information advising the user to press a particular button on the remote control unit.

9. (twice amended) The method according to claim 1, wherein said overlay activation criterion includes at least one of the following: a timing information or[,] data specifying one or more TV subscriber channels[, a user command information].

10. (original) The method according to claim 5, further including:

periodically accessing a web server for downloading said overlay-enabling digital data;
extracting from the overlay-enabling digital data said one or more second images and the respective web sites corresponding to each of said second images;
retrieving and storing digital content from said web sites; and
if the overlay activation criterion is met and a user command that is associated with an image from amongst said one or more second images is identified, displaying the respective image from amongst the second images, accessing the respective web site associated with the displayed image and extracting and buffering content from the website.

11. (original) The method according to claim 5, further comprising displaying a respective IP content when a corresponding one of said one or more second images is selected.

12. (original) The method according to claim 7, including selecting specific Internet content by pressing a color-coded button on a remote control in accordance with a color of said icon.

13. (twice amended) A TV-Internet Integration Box for generating at a user's premises an overlay using video signals constituting a first data and overlay-enabling digital data constituting a second data, the TV-Internet Integration Box comprising:

a combiner unit at [a] the user's premises coupled to a separate TV tuner box or TV tuner,

wherein the combiner unit is also connected through distinct networks to each of a video signal source providing video signals through the TV tuner box or TV tuner, and an Internet data source providing overlay-enabling digital data over the Internet, wherein

said video signals and said overlay-enabling digital data originate from unrelated sources and are transmitted to the user's premises by different resources as mutually distinct and independent inputs, and

wherein said overlay-enabling digital data includes at least:

- a Web link indicating a website where content that is associated with said overlay-enabling digital data is stored;
 - an image indicative of the content associated with said overlay-enabling digital data;
 - and
 - an overlay activation criterion, wherein the overlay activation criterion is a matching event, wherein
- the combiner unit is responsive to an overlay activation criterion being met for generating a corresponding overlay, including:
- generating at the user's premises a first display screen including at least a first portion corresponding to said video signals and a second portion overlaid over said first portion and corresponding at least to said image, and
 - associating the Web link with said second portion of the first display screen thereby allowing a user to cause the combiner unit to retrieve said content, and
 - generate a second video display screen including at least a portion which corresponds to said content; and
- a video output interface, coupled to or integrated within the combiner unit and configured to be coupled to a video input of said TV set and to display said first display screen or said second video display screen.

14. (original) The TV-Internet Integration Box according to claim 13, wherein said overlay-enabling digital data is received at the user premises according to a pre-stored user-profile.

15. (amended) The TV-Internet Integration Box according to claim 13, further including:

- a command input for receiving a command from [a] the user at said user premises;
- and a frame adjuster for resizing said first portion and/or said second portion of said first display screen in response to said command.

16. (original) The TV-Internet Integration Box according to claim 13, further including:

- a receiver for receiving a digital data stream, wherein the stream of the digital data is enabled by the content stored at said website; and

a processing unit for pre-fetching and buffering said digital data stream from said website, thereby allowing said digital data stream to be displayed substantially without delay upon redirection by the user.

17. (original) The TV-Internet Integration Box according to claim 13, wherein the overlay-enabling digital data comprises data representative of one or more second images, and for each of said one or more second images said overlay-enabling data comprises respective web site addresses where IP content associated with the respective second image is stored,

and wherein the combiner unit is configured to:

periodically access a web server for downloading said overlay-enabling digital data;

extract from the overlay-enabling digital data said one or more second images and the respective web sites corresponding to each of said second images;

retrieve and store digital content from said web sites; and

if the overlay activation criterion is met, and a user command that is associated with an image from amongst said one or more second images is identified, display the respective image from amongst the second images, access the respective web site associated with the displayed image and extract and buffer content from the website.

18. (original) The TV-Internet Integration Box according to claim 13, wherein the image includes an icon that indicates to the user that digital data from Internet content is currently being displayed and which provides an indication of a nature of said Internet content.

19. (original) The TV-Internet Integration Box according to claim 13, wherein the image contains textual information advising the user to press a particular button on the remote control unit.

20. (twice amended) The TV-Internet Integration Box according to claim 13, wherein said overlay activation criterion includes at least one of the following: a timing information or[,] data specifying one or more TV subscriber channels[, a user command information].

21. (original) The TV-Internet Integration Box according to claim 18, wherein the icon is colored so as to allow user selection of a specific Internet content by pressing a color-coded button on a remote control in accordance with a color of said icon.

AMENDMENTS TO THE SPECIFICATION

Please replace the paragraph beginning at column 4, line 19 with the following:

FIG. 3 is a flow diagram showing the principal actions carried out by the TV-Internet Integration Box 16. In accordance with one embodiment of the invention, the subscriber selects what kind of IP content he wishes to receive and in respect of which program details, such as icons and/or textual data, are to be displayed together with the TV broadcast data. For example, a subscriber may wish to block certain types of program material or may wish to receives details thereof only during limited hours, for example when the children are asleep. To this end, the subscriber is able to program the TV-Internet Integration Box 16 in much the same way that a video cassette recorder is programmed so as to store in the memory [25] 26 a timetable indicating what type of IP data is to be displayed and when. The timetable is updated as and when required by the subscriber. The TV-Internet Integration Box 16 is adapted to check the timetable periodically and to filter out incoming IP content that is either of a type that is not required or that is broadcast during an unauthorized time window. By such means, an additional layer of authorization may be provided to that stored in the database 19 for access by the web server 14, thus allowing pre-fetching of IP content and storage in the memory [25] 26 of the TV-Internet Integration Box 16. Upon detecting a matching event, corresponding to received IP content that is of interest to the subscriber, the TV-Internet Integration Box 16 overlays the matched IP content with the current broadcast and displays the new integrated video on the subscriber's TV set 17. For example, the matched information may be an icon that indicates to the subscriber that an Internet movie is currently being broadcast; or it may be an advertisement or information related to the TV program being broadcast.

REMARKS/ARGUMENTS

The Non-Final Office Action of September 28, 2022 has been carefully considered. In response claims 2, 4, 6-8, 10-12, 14, 16-19, and 21 are original relative to the subject patent to be reissued. Claims 10 and 17 are amended to return to their original state relative to the subject patent to be reissued. Claims 3, 5, 15 are amended as submitted in the preliminary amendment relative to the subject patent to be reissued. Claims 1, 9, 13, and 20 are twice amended. No new matter is added.

Status of the Claims

Claims 2, 4, 6-8, 10-12, 14, 16-19, and 21 are original relative to the subject patent to be reissued. Claims 10 and 17 are amended to return to their original state relative to the subject patent to be reissued. Claims 3, 5, 15 are amended as previously submitted in the preliminary amendment relative to the subject patent to be reissued. Claims 1, 9, 13, and 20 are twice amended. No new matter is added.

The further amendments to previously submitted claims 1, 9, 13, and 20 are supported by the paragraph beginning col. 4, l. 21 and Fig. 3, with particular reference to col. 4, ll. 41-45 and elements of Fig. 3, for example the step of “check timetable and programmed events”, followed by logic branch of “do conditions match”, followed by action of “overlay the data”. No new matter is added.

Objection to the Specification

The Office objected to col. 4, ll. 31 and 40 for reciting an incorrect reference to the memory element of Fig. 3. Enclosed above are amendments to the Specification that align with comments from the Office and are intended to cure the noted issues. Applicant requests the objections be withdrawn.

Claim Rejection – 35 USC § 251

The Office rejected claims 1-21 under 35 USC § 251 as being broadened in a reissue application filed outside the two year statutory period. The Office noted amendments to independent claims 1 and 13 broaden the claims by deleting the limitation requiring an “overlay

activation criterion” as part of the “overlay-enabling digital data.” While Applicant respectfully disagrees, claims 1 and 13 are amended to return the limitation of an “overlay activation criterion,” and clarify the scope of the overlay activation criterion is further limited to be a “matching event,” with support at col. 4, l. 41.

As originally recited, the term “overlay activation criterion” is arguably quite broad, with the claims only requiring it be included in the overlay-enabling digital data that is provided over the internet (*see* claims 1 and 13), and further that it may include a timing information or data specifying a TV subscriber channel (*see* claims 9 and 20). Thus, the current amendments further narrow the scope of the claims by requiring the overlay activation criterion further be a matching event without otherwise broadening the meaning of overlay activation criterion.

Further, as the currently amended claims do not broaden the scope of the issued claims of the subject patent, and rather narrow the scope of “overlay activation criterion,” the Office’s rejections regarding amendments sworn to by an assignee appear to be resolved.

Regarding improper recapture of surrendered subject matter, Applicant submits the currently amended claims comport with and do not include subject matter surrendered during prosecution under the three step analysis of MPEP 1412.02(II). Under step (1), the currently amended claims do not delete the term “an overlay activation criterion,” but rather further narrow the term. Under step 2, the current amendments to the claims further requiring the overlay activation criterion be a matching event are confined within the same bounds as those argued and relied upon at prosecution as noted by the Office: the matching event, as the overlay activation criterion, is received from a source separate from the video TV signal. *See*, col. 4, ll. 41-45, *in part* “Upon detecting a matching event, corresponding to received IP content that is of interest to the subscriber, the TV-Internet Integration Box 16 overlays the matched IP . . .”.

In these respects, Applicant has amended the claims in response to the Office’s comments, and requests the rejection be withdrawn.

Reissue Declaration

The Office found the Reissue Declaration defective as (1) not properly indicating why the patent is wholly or partially inoperative or invalid, (2) not reciting errors upon which a reissue

can be based, and (3) failing to identify an original patent claim to be broadened. In response, a new Reissue Declaration is submitted indicating the original patent claimed more than patentee had a right to, and the recitation of “overlay activation criterion” without limitation claimed more than the patentee had a right to. As no original patent claims are sought to be broadened by this reissue, no such broadened claim is identified.

Claim Rejection – 35 USC § 112(b)

The Office rejected claims 1-21 under 35 USC § 112(b) as indefinite for reciting “event condition.” While Applicant respectfully disagrees, the currently amended claims removes the recitation of “event condition” and instead returns to the original recitation of an “overlay activation criterion,” further narrowing the overlay activation criterion is a “matching event” as supported at col. 4, ll. 41-45. The elements of a matching event are further described in the paragraph beginning at col. 4, l. 19 with reference to Fig. 3, for example the step of “check timetable and programmed events”, followed by logic branch of “do conditions match”, followed by action of “overlay the data”. Given the teachings of the Specification, a PHOSITA would understand an overlay activation criterion to be a criterion that activates an overlay, with one possible criterion being a matching event. Applicant respectfully submits such amendments cure the defects noted by the Office, and respectfully requests the claims be allowed.

///

Request for Allowance

Claims 1-21 are pending in this application. Applicant requests allowance of all pending claims.

Respectfully submitted,
Fish IP Law, LLP

Date: January 30, 2023

By: /Robert D. Fish/
Robert D. Fish
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
17/714,917	04/06/2022	Yakkov MERLIN	103692.0001USre1	6111
24392	7590	03/06/2023		
FISH IP LAW, LLP 19900 MacArthur Blvd, Suite 810 Irvine, CA 92612			EXAMINER BASEHOAR, ADAM L	
			ART UNIT	PAPER NUMBER
			3992	
			NOTIFICATION DATE	DELIVERY MODE
			03/06/2023	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Patents@fishiplaw.com
rfish@fishiplaw.com

Notice of Pre-AIA or AIA Status

1. The present application is being examined under the pre-AIA first to invent provisions.
2. For reissue applications filed on or after September 16, 2012, all references to 35 U.S.C. 251 and 37 CFR 1.172, 1.175, and 3.73 are to the current provisions.

DETAILED ACTION

3. This is a Final Action responsive to communications: Applicant's Response filed on 01/30/2023. Applicant's Response includes an Amendment to the Specification, an Amendment to the Claims, a new Reissue Declaration, and Remarks. Applicant's Response has been entered and made of record.
4. In light of the Amendment to the Claims, claims 1, 9, 13, and 20 have been further amended and claims 10 and 17 have been amended to revert to their original form in the Merlin '220 patent. Therefore, claims 1-21 are currently pending in the application. Claims 1 and 13 are independent claims.
5. The objection to the disclosure (see: Non-Final Action, p. 3) has been withdrawn as necessitated by the Amendment to the Specification.
6. The rejection of claims 1-21 under 35 U.S.C. 251 as being an improper recapture (see: Non-Final Action, pp. 5-8) has been withdrawn as necessitated by the Amendment to the Claims.

7. The Examiner notes that the first and second defects (see: Non-Final Action, pp. 9-10) identified in the Reissue Declaration have been overcome by the filing of the new Reissue Declaration. Specifically, at least the third and fourth errors (i.e., “A third error...also improperly recites...a broader right than he was entitled to”) identified in the new Reissue Declaration constitute at least one proper error upon which the instant reissue application is based. As noted in MPEP 1414(II), “Where applicant specifies one such error, this requirement of a reissue oath/declaration is satisfied...Where more than one error is specified in the oath/declaration and some of the designated ‘errors’ are found to not be ‘errors’ under 35 U.S.C. 251, any remaining error which is an error under 35 U.S.C. 251 will still support the reissue.”

8. The rejection of claims 1-21 under 35 U.S.C. 112 (pre-AIA), second paragraph (see: Non-Final Action, pp. 11-12), has been withdrawn as necessitated by the Amendment to the Claims. However, as noted below, a different rejection of claims 1-21 under 35 U.S.C. 112 (pre-AIA), second paragraph, has been made in light of the Amendment to the Claims.

Reissue

9. Applicant is reminded of the continuing obligation under 37 CFR 1.178(b), to timely apprise the Office of any prior or concurrent proceeding in which Patent No. 8,132,220 B2 is or was involved. These proceedings would include interferences, reissues, reexaminations, and litigation.

Applicant is further reminded of the continuing obligation under 37 CFR 1.56, to timely apprise the Office of any information which is material to patentability of the claims under consideration in this reissue application.

These obligations rest with each individual associated with the filing and prosecution of this application for reissue. See also MPEP §§ 1404, 1442.01 and 1442.04.

10. The patent sought to be reissued by this application has been involved in litigation. Any documents and/or materials which would be material to the patentability of this reissue application are required to be made of record in reply to this action.

11. Applicant is notified that any subsequent amendment to the specification and/or claims must comply with 37 CFR 1.173(b).

Claim Rejections - 35 USC § 251

12. **Claims 1-21 are rejected** under 35 U.S.C. 251 as being broadened in a reissue application filed outside the two year statutory period.

As noted in MPEP 1412.03(I), “A claim of a reissue application enlarges the scope of the claims of the patent if it is broader in at least one respect, even though it may be narrower in other respects...if any amended or newly added claim in the reissue contains within its scope any conceivable product or process which would not have infringed the patent, then that reissue claim would be broader than the patent claims...A claim which covers something that the original claims do not is a broadened claim. A claim would be considered a broadening claim if the patent owner would be able to sue any party for infringement who previously could not have been sued for infringement.”

In light of the above, it is difficult to see how independent claims 1 and 13 of the Merlin ‘220 patent could be compared to a product or process said to infringe the claims. For example,

one cannot read the drawing figures (i.e., Figs. 1-8) of the Merlin '220 patent onto independent claims 1 and 13 of the Merlin '220 patent. This is because independent claims 1 and 13 of the Merlin '220 patent present irreconcilable inconsistencies (i.e., the “overlay activation criterion” indicating that it comes from the Internet and simultaneously not from the Internet (i.e., from a user’s premises) – e.g., see: *TVnGO Ltd. v. LG Elecs.* U.S., No. 2020-1837 (Fed. Cir. Jun. 28, 2021)), that render their precise meanings not reasonably certain. Presumably, the amendments to independent claims 1 and 13 are supported by the specification of the Merlin '220 patent, as argued by Applicant in the Remarks, and therefore the drawing figures (i.e., Figs. 1-8) of the Merlin '220 patent can be read onto amended independent claims 1 and 13. Thus, the drawing figures (i.e., Figs. 1-8) of the Merlin '220 patent—if prior art—would anticipate or if used without Applicant’s permission would infringe amended independent claims 1 and 13, but would not anticipate or infringe independent claims 1 and 13 of the Merlin '220 patent. It necessarily follows that amended independent claims 1 and 13 enlarge the scope of independent claims 1 and 13 of the Merlin '220 patent, all contrary to 35 U.S.C. 251(d) (e.g., see: *Ex parte Adams*, Appeal 2007-0441 (March 14, 2007), pp. 10-11).

The Examiner notes that the term “overlay activation criterion” is not “arguably quite broad” as stated by Applicant (see: Remarks, p. 10), but rather the term “overlay activation criterion” is indefinite (e.g., see: *TVnGO Ltd. v. LG Elecs.* U.S., No. 2020-1837 (Fed. Cir. Jun. 28, 2021), pp. 10-11: “the intra-patent grounds discussed above are sufficient to establish indefiniteness... The district court correctly concluded that the asserted claims are invalid for indefiniteness.”). The Examiner further notes that a final holding of claim invalidity or unenforceability (after all appeals) is binding/controlling on the Office.

In general, it appears to the Examiner that Applicant is trying amend claims found indefinite by a District Court, and subsequently affirmed as indefinite by the CAFC, so that said claims are now definite in light of the disclosure of the Merlin '220 patent. As noted above, if Applicant's amendments are presumed to be successful in achieving their goal, said amendments would then be considered as enlarging the scope of the claims of the Merlin '220 patent. Unfortunately for Applicant, the instant reissue application was filed more than two years after the Merlin '220 patent issued. Thus, said amendments are considered improper.

13. **Claims 1-21 are rejected under 35 U.S.C. 251** as being improperly broadened in a reissue application made and sworn to by the assignee. The application for reissue may be made and sworn to by the assignee of the entire interest only if the application does not seek to enlarge the scope of the claims of the original patent or, for reissue applications filed on or after September 16, 2012, the application for the original patent was filed by the assignee of the entire interest under 37 CFR 1.46.

As noted above, independent claims 1 and 13 of the Merlin '220 patent have clearly been broadened by the Amendment to the Claims.

14. The new Reissue Declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following:

The new Reissue Declaration fails to identify an original patent claim that the application seeks to broaden (see: MPEP 1414(II)(B) and 37 CFR 1.175(b)). For an application filed on or after September 16, 2012 that seeks to enlarge the scope of the claims of the patent, the reissue oath or declaration must also identify a claim that the application seeks to broaden. The

Examiner notes that it does not appear to be Applicant's intent to broaden the claims (see: Remarks, p. 10: "the current amendments further narrow the scope of the claims...without otherwise broadening the meaning of overlay activation criterion"). As noted above, Applicant is currently outside the two year statutory period and thus cannot broaden the claims. However, because the claims have indeed been broadened by the Amendment to the Claims, the new Reissue Declaration is required to conform with 37 CFR 1.175(b).

Appropriate correction is required.

15. **Claims 1-21 are rejected** as being based upon a defective Reissue Declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the Declaration is set forth in the discussion above in this Office action.

Claim Rejections - 35 USC § 112

16. The following is a quotation of 35 U.S.C. 112 (pre-AIA), second paragraph:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

17. **Claims 1-21 are rejected** under 35 U.S.C. 112(b) or 35 U.S.C. 112 (pre-AIA), second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the inventor or a joint inventor, or for pre-AIA the applicant regards as the invention.

Independent claims 1 and 13 each newly recite the substantially similar limitations, "wherein said overly-enabling digital data includes...an overlay activation criterion, wherein the overlay activation criterion is a matching event" (emphasis added). With regards to the use of

the term “overlay activation criterion”, the Examiner notes that the District Court (see: Civil No. 18-10238 (RMB/KMW), Opinion (April 16, 2020)) determined that “the intrinsic evidence presents a POSA with irreconcilably inconsistent information...that ‘overlay activation criterion’ comes from the Internet and simultaneously not from the Internet...Because the Court cannot construe the claims, they are indefinite.” Similarly, the CAFC (see: *TVnGO Ltd. v. LG Elecs.* U.S., No. 2020-1837 (Fed. Cir. Jun. 28, 2021)) also determined that “one of ordinary skill would lack reasonably certainty as to the source of an ‘overlay activation criterion’... the intra-patent grounds discussed above are sufficient to establish indefiniteness...The district court correctly concluded that the asserted claims are invalid for indefiniteness.” Thus, independent claims 1 and 13 are indefinite for at least the same reasons (i.e., fail to inform a person of ordinary skill in the art of the claimed invention’s scope with reasonable certainty) related to the “overlay activation criterion” limitation as discussed and determined by the District Court and affirmed by the CAFC.

The above rejection is not overcome by the addition of the “wherein the overlay activation criterion is a matching event” limitation to independent claims 1 and 13 and the deletion of the “a user command information” limitation from dependent claims 9 and 20. This issue appears to have been squarely addressed in the Decision by the CAFC (see: *TVnGO Ltd. v. LG Elecs.* U.S., No. 2020-1837 (Fed. Cir. Jun. 28, 2021), p. 11: “merely dismissing the dependent claims as invalid, as TVnGO proposes, ignores that they are one of the few sources of intrinsic evidence on the meaning of ‘overlay activation criterion’ in this record. When faced with this unknown and undefined phrase, a skilled artisan would look for clarification not only in the specification but also in ‘[o]ther claims of the patent in question,’ which ‘can also be valuable sources of enlightenment as to the meaning of a claim term.’ *Phillips*, 415 F.3d at 1314.

Here, however, he or she would discover an inconsistency, throwing the meaning of ‘overlay activation criterion’ into doubt. These dependent claims are intrinsic evidence”) and found unpersuasive.

Dependent claims 2-12 and 14-21 are similarly rejected at least via dependency.

Response to Arguments

18. Applicant’s general arguments with respect to newly amended independent claims 1 and 13 have been considered but are moot in view of the new ground(s) of rejection. Additional details related to Applicant’s general arguments are further discussed in the rejections above.

Conclusion

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam L Basehoar whose telephone number is (571)272-4121. The examiner can normally be reached on 8:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kosowski can be reached on 571-272-3744. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ADAM L BASEHOAR/
Primary Examiner, Art Unit 3992

Conferees:

/JOSHUA D CAMPBELL/
Primary Examiner, Art Unit 3992

/ALEXANDER J KOSOWSKI/
Supervisory Patent Examiner, Art Unit 3992

<i>Index of Claims</i> 	Application/Control No. 17/714,917	Applicant(s)/Patent Under Reexamination MERLIN, Yakkov
	Examiner Adam L Basehoar	Art Unit 3992

✓	Rejected	-	Cancelled	N	Non-Elected	A	Appeal
=	Allowed	÷	Restricted	I	Interference	O	Objected

CLAIMS										
☐ Claims renumbered in the same order as presented by applicant ☐ CPA ☐ T.D. ☐ R.1.47										
CLAIM		DATE								
Final	Original	08/15/2022	02/06/2023							
	1	✓	✓							
	2	✓	✓							
	3	✓	✓							
	4	✓	✓							
	5	✓	✓							
	6	✓	✓							
	7	✓	✓							
	8	✓	✓							
	9	✓	✓							
	10	✓	✓							
	11	✓	✓							
	12	✓	✓							
	13	✓	✓							
	14	✓	✓							
	15	✓	✓							
	16	✓	✓							
	17	✓	✓							
	18	✓	✓							
	19	✓	✓							
	20	✓	✓							
	21	✓	✓							

<i>Search Notes</i> 	Application/Control No. 17/714,917	Applicant(s)/Patent Under Reexamination MERLIN, Yakkov
	Examiner Adam L Basehoar	Art Unit 3992

CPC - Searched*		
Symbol	Date	Examiner
H04N 21/(44016, 4782, 4316, 4622, 431)	08/15/2022	ALB

CPC Combination Sets - Searched*		
Symbol	Date	Examiner

US Classification - Searched*			
Class	Subclass	Date	Examiner
725	109	08/15/2022	ALB
715	717, 718	08/15/2022	ALB
345	629	08/15/2022	ALB

* See search history printout included with this form or the SEARCH NOTES box below to determine the scope of the search.

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<i>Search Notes</i> 	Application/Control No. 17/714,917	Applicant(s)/Patent Under Reexamination MERLIN, Yakkov
	Examiner Adam L Basehoar	Art Unit 3992

Search Notes		
Search Notes	Date	Examiner
Reviewed Prior Application(s) History/Cited Prior Art	08/15/2022	ALB
Inventor Name Search (PE2E)	08/15/2022	ALB
Recapture Review Conducted	08/15/2022	ALB
Litigation Search (04/11/2022)	08/15/2022	ALB
PE2E Text and Classification Search (see attached search history)	08/15/2022	ALB
Reviewed Applicant's Response (01/30/2023)	02/06/2023	ALB
Searched Patent Data Portal (Patent No. 8,132,220) - No Prior/Pending Reexams/Reissues Found	02/06/2023	ALB
Searched P-TACTS (Patent No. 8,132,220) - No Prior/Pending AIA Proceedings Found	02/06/2023	ALB
Reviewed: TVnGO Ltd. v. LG Elecs. U.S., No. 2020-1837 (Fed. Cir. Jun. 28, 2021) and Civil No. 18-10238 (RMB/KMW)	02/06/2023	ALB

Interference Search			
US Class/CPC Symbol	US Subclass/CPC Group	Date	Examiner

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
17/714,917	04/06/2022	Yakkov MERLIN	103692.0001USre1	6111
24392	7590	05/31/2023		
FISH IP LAW, LLP 19900 MacArthur Blvd, Suite 810 Irvine, CA 92612			EXAMINER BASEHOAR, ADAM L	
			ART UNIT	PAPER NUMBER
			3992	
			NOTIFICATION DATE	DELIVERY MODE
			05/31/2023	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Patents@fishiplaw.com
rfish@fishiplaw.com

<i>Applicant-Initiated Interview Summary</i>	Application No. 17/714,917	Applicant(s) MERLIN, Yakkov		
	Examiner Adam L Basehoar	Art Unit 3992	AIA (First Inventor to File) Status No	Page 1 of 2

All Participants (applicant, applicants representative, PTO personnel)	Title	Type
Adam L Basehoar	Primary Examiner	Telephonic
Alex Kosowski	SPE	
Dennis Bonshock	Primary Examiner	
Tomas Prieto (Reg. No. 60,675)	Agent of Record	

Date of Interview: 23 May 2023

Issues Discussed:

35 U.S.C. 112

Generally discussed the 35 U.S.C. 112, second paragraph, rejection in light of Applicant's amendment to the independent and dependent claims, the disclosure of the Merlin '220 patent, and binding/controlling determinations made by a District Court and the CAFC regarding the claims and claim language (e.g., "overlay activation criterion") of the Merlin '220 patent. No specific agreement was reached.

Other

The Examiner further explained the rationale behind the broadening rejection under 35 U.S.C. 251 in light of the general intent of Applicant's amendment to the independent and dependent claims, MPEP 1412.03(I), an informative decision by the PTAB, and binding/controlling determinations made by a District Court and the CAFC regarding the claims and claim language (e.g., "overlay activation criterion") of the Merlin '220 patent. No specific agreement was reached. The Examiner noted that because the instant reissue application was filed more than two years after the Merlin '220 patent issued, there did not appear to be a proper mechanism to overcome both the 35 U.S.C. 251 and the 35 U.S.C. 112, second paragraph, rejections.

/ADAM L BASEHOAR/ Primary Examiner, Art Unit 3992	/A.J.K/ Supervisory Patent Examiner, Art Unit 3992
Applicant is reminded that a complete written statement as to the substance of the interview must be made of record in the application file. It is the applicants responsibility to provide the written statement, unless the interview was initiated by the Examiner and the Examiner has indicated that a written summary will be provided. See MPEP 713.04 Please further see: MPEP 713.04 Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews, paragraph (b) 37 CFR § 1.2 Business to be transacted in writing	

Applicant recordation instructions: The formal written reply to the last Office action must include the substance of the interview. (See MPEP section 713.04). If a reply to the last Office action has already been filed, applicant is given a non-extendable period of the longer of one month or thirty days from this interview date, or the mailing date of this interview summary form, whichever is later, to file a statement of the substance of the interview.

<i>Applicant-Initiated Interview Summary</i>	Application No. 17/714,917	Applicant(s) MERLIN, Yakkov		
	Examiner Adam L Basehoar	Art Unit 3992	AIA (First Inventor to File) Status No	Page 2 of 2

Examiner recordation instructions: Examiners must summarize the substance of any interview of record. A complete and proper recordation of the substance of an interview should include the items listed in MPEP 713.04 for complete and proper recordation including the identification of the general thrust of each argument or issue discussed, a general indication of any other pertinent matters discussed regarding patentability and the general results or outcome of the interview, to include an indication as to whether or not agreement was reached on the issues raised.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450**

Appl No.: 17/714,917
Inventor: Yakkov Merlin
Filing Date: April 6, 2022
Art Unit: 3992
Examiner: Basehoar, Adam L.
Attorney Docket No.: 103692.0001US1re

Title Method and Apparatus for Facilitating Toggling
Between Internet and TV Broadcasts

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

AFTER-FINAL RESPONSE

Sir:

This paper responds to the Final Office Action dated March 6, 2023. Please enter the amendments shown herein.

- Claim Amendments begin on page 2.
- Specification Amendments begin on page 7.
- Remarks begin on page 8.

AMENDMENTS TO THE CLAIMS

This listing of claims represents the current version of claims before the Office with amendments to be entered:

1. (thrice amended) A method for generating at a user's premises an overlay using video signals constituting a first data and overlay-enabling digital data constituting a second data, the method comprising:

(a) providing a combiner unit at the user's premises, wherein:

the combiner unit is coupled to a TV set and connected to a separate TV tuner box or TV tuner in the TV set, at the user's premises, and

the combiner unit is also connected through distinct networks to each of a video signal source providing video signals through the TV tuner box or TV tuner in the TV set, and an Internet data source providing overlay-enabling digital data over the Internet,

wherein said video signals and said overlay-enabling digital data originate from unrelated sources and are transmitted to the user's premises by different resources as mutually distinct and independent inputs,

and wherein said overlay-enabling digital data includes at least:

a Web link indicating a website where content that is associated with said overlay-enabling digital data is stored,

an image indicative of the content associated with said overlay-enabling digital data, and

an overlay activation criterion; and

(b) processing at the user's premises said overlay-enabling digital data and generating at the user's premises a corresponding overlay only if said overlay activation criterion is met, wherein generating [an] the overlay includes:

generating at the user's premises a first display screen including at least a first portion corresponding to said video signals and a second portion overlaid over said first portion and corresponding at least to said image, and

associating the Web link with said second portion of the first display screen thereby allowing a user to cause the combiner unit to retrieve said content, generate a

second video display screen including at least a portion which corresponds to said content, and input the second display screen to said TV set.

2. (original) The method according to claim 1, wherein said overlay-enabling digital data is received at the user premises according to a pre-stored user profile.
3. (twice amended) The method according to claim 1, further including: receiving a command from [a] the user at said user premises; and responsive to said command, resizing said first portion and/or said second portion of said first display screen.
4. (original) The method according to claim 1, wherein the content stored at said website enables streaming of digital data over the Internet; and
said method further including: pre-fetching and buffering said digital data stream from said website, thereby allowing said digital data stream to be displayed substantially without delay upon redirection by the user.
5. (twice amended) The method according to claim 1, wherein the overlay-enabling digital data comprises data representative of one or more second images, and for each of said one or more second images said overlay-enabling data comprises respective web site addresses where IP content associated with the respective second image is stored, and wherein said generating [an] the overlay further includes within said first display said one or more second images.
6. (original) The method according to claim 1, wherein the overlay-enabling digital data is supplementary or complementary to the video signals.
7. (original) The method according to claim 1, wherein the image includes an icon that indicates to the user that digital data from Internet content is currently being displayed and which provides an indication of a nature of said Internet content.
8. (original) The method according to claim 1, wherein the image contains textual information advising the user to press a particular button on the remote control unit.
9. (Cancelled) The method according to claim 1, wherein said overlay activation criterion includes at least one of the following: a timing information, data specifying one or more TV subscriber channels.

10. (original) The method according to claim 5, further including:

periodically accessing a web server for downloading said overlay-enabling digital data;
extracting from the overlay-enabling digital data said one or more second images and the
respective web sites corresponding to each of said second images;
retrieving and storing digital content from said web sites; and
if the overlay activation criterion is met and a user command that is associated with an
image from amongst said one or more second images is identified, displaying the
respective image from amongst the second images, accessing the respective web
site associated with the displayed image and extracting and buffering content
from the website.

11. (original) The method according to claim 5, further comprising displaying a respective IP
content when a corresponding one of said one or more second images is selected.

12. (original) The method according to claim 7, including selecting specific Internet content by
pressing a color-coded button on a remote control in accordance with a color of said icon.

13. (thrice amended) A TV-Internet Integration Box for generating at a user's premises an
overlay using video signals constituting a first data and overlay-enabling digital data constituting
a second data, the TV-Internet Integration Box comprising:

a combiner unit at [a] the user's premises coupled to a separate TV tuner box or TV
tuner,

wherein the combiner unit is also connected through distinct networks to each of a video
signal source providing video signals through the TV tuner box or TV tuner, and
an Internet data source providing overlay-enabling digital data over the Internet,
wherein

said video signals and said overlay-enabling digital data originate from unrelated sources
and are transmitted to the user's premises by different resources as mutually
distinct and independent inputs, and

wherein said overlay-enabling digital data includes at least:

a Web link indicating a website where content that is associated with said overlay-
enabling digital data is stored;

an image indicative of the content associated with said overlay-enabling digital data;
and
an overlay activation criterion, wherein
the combiner unit is responsive to an overlay activation criterion being met for
generating a corresponding overlay, including:
generating at the user's premises a first display screen including at least a first portion
corresponding to said video signals and a second portion overlaid over said
first portion and corresponding at least to said image, and
associating the Web link with said second portion of the first display screen thereby
allowing a user to cause the combiner unit to retrieve said content, and
generate a second video display screen including at least a portion which
corresponds to said content; and
a video output interface, coupled to or integrated within the combiner unit and
configured to be coupled to a video input of said TV set and to display said
first display screen or said second video display screen.

14. (original) The TV-Internet Integration Box according to claim 13, wherein said overlay-enabling digital data is received at the user premises according to a pre-stored user-profile.

15. (twice amended) The TV-Internet Integration Box according to claim 13, further including:
a command input for receiving a command from [a] the user at said user premises;
and a frame adjuster for resizing said first portion and/or said second portion of said first
display screen in response to said command.

16. (original) The TV-Internet Integration Box according to claim 13, further including:
a receiver for receiving a digital data stream, wherein the stream of the digital data is
enabled by the content stored at said website; and
a processing unit for pre-fetching and buffering said digital data stream from said
website, thereby allowing said digital data stream to be displayed substantially
without delay upon redirection by the user.

17. (original) The TV-Internet Integration Box according to claim 13, wherein the overlay-enabling digital data comprises data representative of one or more second images, and for each

of said one or more second images said overlay-enabling data comprises respective web site addresses where IP content associated with the respective second image is stored,

and wherein the combiner unit is configured to:

periodically access a web server for downloading said overlay-enabling digital data;

extract from the overlay-enabling digital data said one or more second images and the

respective web sites corresponding to each of said second images;

retrieve and store digital content from said web sites; and

if the overlay activation criterion is met, and a user command that is associated with an

image from amongst said one or more second images is identified, display the

respective image from amongst the second images, access the respective web site

associated with the displayed image and extract and buffer content from the

website.

18. (original) The TV-Internet Integration Box according to claim 13, wherein the image includes an icon that indicates to the user that digital data from Internet content is currently being displayed and which provides an indication of a nature of said Internet content.

19. (original) The TV-Internet Integration Box according to claim 13, wherein the image contains textual information advising the user to press a particular button on the remote control unit.

20. (Cancelled) The TV-Internet Integration Box according to claim 13, wherein said overlay activation criterion includes at least one of the following: a timing information, data specifying one or more TV subscriber channels.

21. (original) The TV-Internet Integration Box according to claim 18, wherein the icon is colored so as to allow user selection of a specific Internet content by pressing a color-coded button on a remote control in accordance with a color of said icon.

AMENDMENTS TO THE SPECIFICATION

Please replace the paragraph beginning at column 4, line 19 with the following:

FIG. 3 is a flow diagram showing the principal actions carried out by the TV-Internet Integration Box 16. In accordance with one embodiment of the invention, the subscriber selects what kind of IP content he wishes to receive and in respect of which program details, such as icons and/or textual data, are to be displayed together with the TV broadcast data. For example, a subscriber may wish to block certain types of program material or may wish to receives details thereof only during limited hours, for example when the children are asleep. To this end, the subscriber is able to program the TV-Internet Integration Box 16 in much the same way that a video cassette recorder is programmed so as to store in the memory [25] 26 a timetable indicating what type of IP data is to be displayed and when. The timetable is updated as and when required by the subscriber. The TV-Internet Integration Box 16 is adapted to check the timetable periodically and to filter out incoming IP content that is either of a type that is not required or that is broadcast during an unauthorized time window. By such means, an additional layer of authorization may be provided to that stored in the database 19 for access by the web server 14, thus allowing pre-fetching of IP content and storage in the memory [25] 26 of the TV-Internet Integration Box 16. Upon detecting a matching event, corresponding to received IP content that is of interest to the subscriber, the TV-Internet Integration Box 16 overlays the matched IP content with the current broadcast and displays the new integrated video on the subscriber's TV set 17. For example, the matched information may be an icon that indicates to the subscriber that an Internet movie is currently being broadcast; or it may be an advertisement or information related to the TV program being broadcast.

REMARKS/ARGUMENTS

The Final Office Action mailed on or about March 6, 2023 (“2023 March Final”) has been carefully considered. In response claims 2, 4, 6-8, 10-12, 14, 16-19, and 21 are original relative to the subject patent to be reissued. Claims 10 and 17 are amended to return to their original state relative to the subject patent to be reissued. Claims 3, 5, 15 are amended as submitted in the preliminary amendment relative to the subject patent to be reissued. Claims 1, 9, 13, and 20 are twice amended. No new matter is added.

Notice of Related Litigation and Request for Expedited “Special” Handling

Patent US 8,132,220 (“the ‘220 Patent”) was the subject of litigation in the District of New Jersey as well as an appeal to the Federal Circuit. Orders from both courts rendered claims 1, 9, 10, 13, 17, and 20 of the ‘220 Patent invalid as indefinite. The District of New Jersey matter is Civil No. 18-10238 (RMB/KMW). The Federal Circuit matter is Case 20-1837. Pursuant to MPEP 1442, Applicant respectfully requests this matter be taken up for action in advance of other reissue applications.

Examiner’s Interview

The Applicant’s representative, Tomás A. Prieto, and Examiner Adam L Basehoar, held a telephonic interview on May 23, 2023 (2023 May Interview) to discuss this application as well as pending reissue application 17/867,612 (“the ‘612 Application”). During the interview the parties discussed the rejections under 35 USC 251 and 35 USC 112, 2nd paragraph. The parties also briefly discussed the *ex parte Adams* PTAB decision cited in the 2023 March Final. Examiner Basehoar provided additional insight into his rationale in issuing the rejection in view of the prior litigation of the applications and the cited PTAB decision. No agreements were reached.

Applicant wishes to thank Examiner Basehoar for granting the interview and for his consideration in providing additional information and insights.

Claim Amendments

Claims 2, 4, 6-8, 10-12, 14, 16-19, and 21 are original relative to the subject patent to be reissued. Claims 3, 5, 15 are twice amended as previously submitted in the preliminary amendment and Applicant's prior response relative to the subject patent to be reissued. Claims 1 and 13 are thrice amended. No new matter is added.

Cancelled Claims (Claims 9 and 20)

Pursuant to MPEP 1453(II), a claim to be cancelled should be cancelled by a direction to cancel the claims. As such:

Please cancel claims 9 and 20.

Amendments to the Specification

The Office previously objected to col. 4, ll. 31 and 40 for reciting an incorrect reference to the memory element of Fig. 3. The objection was then withdrawn following Applicant's response. Enclosed above are previously-presented amendments to the Specification that overcame the prior objections.

Claim Rejection – 35 USC § 251

The Office rejected claims 1-21 under 35 USC § 251 as being broadened in a reissue application filed outside the two-year statutory period. Applicant respectfully disagrees. In support, Applicant notes the following:

The Office Action indicates that because the original claims 1 and 13 “present irreconcilable inconsistencies that render their precise meaning not reasonably certain”, it would be difficult to see how the claims could “be compared to a product or process said to infringe the claims.” (2023 March Final, pages 4-5). Using the figures of the ‘220 patent as an example, the Examiner asserted that the drawings could be read into the amended claims. However, because of the inconsistencies in the original claims 1 and 13, the same figures of the ‘220 patent could not be read into the original claims 1 and 13. Therefore, the Examiner explains that:

[Figs. 1-8] of the Merlin '220 patent-if prior art-would anticipate or if used without Applicant's permission would infringe amended independent claims 1 and 13, but would not anticipate or infringe independent claims 1 and 13 of the Merlin '220 patent. It necessarily follows that amended independent claims 1 and 13 enlarge the scope of claims 1 and 13 of the Merlin '220 patent, all contrary to 35 U.S.C. 251(d). (2023 March Final, page 5)

This quoted section is a near-verbatim recitation of a section on page 11 of *Ex parte Adams*, cited by the Examiner in support of his conclusion. Based on the assertion of *Ex parte Adams* (in particular, pages 10-11) in the rejection and the subsequent conversation with Examiner Basehoar during the 2023 May Interview, it is Applicant's understanding that the crux of this rejection is as follows:

An indefinite claim contains no scope, and therefore cannot be infringed by any product or process. Amending a previously indefinite claim to make it definite, no matter the amendment, broadens the claim according to the test described by the Examiner because no product or process can infringe the indefinite claim but there could be a product or process that infringes a definite claim.

Applicant respectfully disagrees, especially in view of the currently-presented claims.

Applicant first notes that the *Ex parte Adams* is an informative decision, not precedential. Based on the 2023 May Interview, Applicant understands why the Examiner cited to it in the rejection. However, Applicant notes that because *Ex parte Adams* is merely informative, the Examiner has the latitude to disagree with the decision itself as well as the applicability of the decision to the particular issues of this application.

In *Ex parte Adams*, the PTAB set forth the reasoning discussed above: that an indefinite claim has **no scope** and thus, no product or process could possibly infringe. Thus, amendments to an indefinite claim that made the claim definite would result in claims that then could be infringed. As such, no matter the amendments, amending a previously-indefinite claim to make it indefinite would automatically broaden the scope claim. (see *Adams*, page 11) If strictly adhered to, the implication of *Ex parte Adams* is that any ambiguity or confusion that gave rise to indefiniteness would be fatal for the purposes of reissue.

However, the courts have allowed for amendments to indefinite claims during reissue, especially when the substantive scope of the claim is not meaningfully changed.

In *Slimfold Mfg. Co v Kinkead Props.* 626 F.Supp 493 (1956), correcting an antecedent basis issue during reissue does not meaningfully change the scope of the claim. (*Slimfold* at 497-498). *Slimfold* cites to *In re Altempohl*, 500 F.2d 1151 (Fed. Cir. 1974), which states that “[l]ack of antecedent basis in a claim could render it invalid under 35 USC 112, second paragraph, and correction of such a defect by reissue should not have to depend on difference in scope of the claim.” (*Altempohl* at 1156). These holdings show that courts have ruled on the possibility of using reissue to correct issues that could give rise to indefiniteness. Moreover, the indication that correcting these issues does not meaningfully change the scope of the claim logically dictates that the flawed claims being amended must have a scope such that the amended claims have a substantially similar scope.

As stated by the court in *Altempohl*, “[i]n as much as 35 USC 251 is a remedial provision, which should be liberally construed, a patentee should be allowed to correct an error or ambiguity in a claim without having to rely on implication or litigation.” (*Altempohl* at 1156-1157). To effectively render any indefiniteness issue unrecoverable as in *Ex parte Adams* would run counter to the court-recognized remedial nature of the reissue process.

When a claim in reissue is identical to a claim in the original patent, then a product or process infringing the reissue claim necessarily infringes the claim of the original patent. *General Plastic Corp. v Finkelstein*, 145 F.Supp 862, 863-864 (1956). Claims 1 and 13 presented via this response have been amended to correct potential antecedent basis issues and for consistency in terminology. None of these amendments broaden the scope of the claim.

As it pertains to the limitations that recite “overlay activation criterion”, the claims remain identical to those of the original ‘220 patent. Therefore, for the purposes of the claim language giving rise to the district court’s determination of an inconsistency between claims 1 and 9 (and 13 and 20) of the ‘220 patent and ultimately a conclusion of indefiniteness of claim 1 of the ‘220 patent, claims 1 and 13 are identical to those of the ‘220 patent.

Because the scope of claims 1 and 13 presented in this response is at least identical, if not slightly narrower than, the scope of the corresponding claims of the ‘220 patent, the current claims cannot logically be considered to broaden the scope of the claims and as such 35 USC 251(d) does not apply.

Claims 9 and 20, which combined with claims 1 and 13, respectively gave rise to the conclusions of indefiniteness by the district court, have been cancelled. Cancelling a claim cannot constitute broadening a claim because there is no way for a cancelled claim to be infringed.

In summary, it is Applicant's position that claims 1 and 13 cannot be considered to be broadened because the limitations giving rise to the conclusion of indefiniteness by the district court have not been amended and the scope of the claims as a whole has not been changed by the minor amendments to correct potential antecedent basis. It is further Applicant's position that the scope of claims 9 and 20 has not changed because cancelled claims have no scope, which would be the same as the indefinite claims 9 and 20.

As to the rejections under 35 USC 251 asserting that the Reissue Declaration is defective and that it is improperly sworn by the assignee because the claims are broadened in scope, Applicant respectfully disagrees. As noted above, it is Applicant's position that the claims have not been broadened.

For the reasons discussed above, Applicant respectfully requests withdrawal of the rejections under 35 USC 251.

Claim Rejection – 35 USC § 112(b)

Claims 1 and 13 have been rejected under 35 USC 112, 2nd paragraph because the recitation of "overlay activation criterion" could be interpreted as both coming "from the Internet and simultaneously not from the Internet" (2023 March Final, page 8). This rejection appears to mirror the holding of invalidity of the claims at the District Court level (Civil No. 18-10238 (RMB/KMW), Opinion (April 16, 2020)) ("the District Court Decision") and affirmed by the CAFC (*TVnGo Ltd v LG Elecs.* U.S., No. 2020-1837 (Fed. Cir. Jun. 28, 2021)) ("the CAFC Decision").

The District Court Decision identified an inconsistency between the recitation of "overlay activation criterion" in independent claims 1 and 13 and their respective dependent claims 9 and 20. Thus, the inconsistency is not in claims 1 and 13 alone, but rather in claim 1 when interpreted in combination with claim 9 and in claim 13 when interpreted in combination with

claim 20. The inconsistency arises in that in claims 1 and 13, the “overlay activation criterion” is provided “over the Internet” whereas claims 9 and 20 state that the “user command information” may be a component of the “overlay activation criterion” and when the limitation of “user command information” is read in the context of the specification, the “user command information” is “provided at the user’s premises and not over the Internet.”

In response, Applicants have now cancelled claims 9 and 20, such that there is no link between the “user command information” and the “overlay activation criterion”, thus resolving the ambiguity because the “overlay activation criterion” is no longer claimed to be originated “not from the Internet.” Thus, one of ordinary skill in the art would be appraised of the metes and bounds of the claim.

As to the dependent claims 9 and 20 specifically, the CAFC Decision states at page 11:

Further, merely dismissing the dependent claims as invalid, as TVnGo proposes, ignores that they are one of the few sources of intrinsic evidence on the meaning of “overlay activation criterion” in this record. When faced with this unknown and undefined phrase, a skilled artisan would look for clarification not only in the specification but also in “[o]ther claims of the patent in question,” which “can also be valuable sources of enlightenment as to the meaning of a claim term.” Phillips, 415 F.3d at 1314. Here, however, he or she would discover an inconsistency, throwing the meaning of “overlay activation criterion” into doubt. These dependent claims are intrinsic evidence. Arguing that they are invalid does not change that.

In this section, the CAFC is not indicating that the dependent claims must stay as they are and can never be amended or cancelled to remove the recitation of “overlay activation criterion.” Rather, in this section the CAFC is responding to the possibility that the dependent claims be held invalid does not remedy the inconsistency issue. This is because as long as the recitation of “overlay activation criterion” remains in claims 9 and 20, the inconsistency with respective claims 1 and 13 continues to exist and as such the independent claims 1 and 13 will also be indefinite. In other words, even if the dependent claims are invalid with valid independent claims, the invalid dependent claims still remain as a part of the patent document and as such would be a source of inconsistency to the skilled artisan.

However, by cancelling claims 9 and 20, the link between the “overlay activation criterion” and the “user command information” is broken. A reissue patent without those claims would no longer have a source of confusion/inconsistency for the skilled artisan. Instead, the skilled artisan would only discover the meaning of “overlay activation criterion” as coming “from the Internet” of independent claims 1 and 13. The sections of the specification cited in the District Court Decision as related to the “user command information” would not raise the inconsistency either as there is nothing in these sections of the specification that would lead to the skilled artisan to interpret it as being related to the “overlay activation criterion.” The remaining dependent claims that recite “overlay activation criterion” are consistent with this interpretation.

For the reasons discussed above, it is Applicant’s position that the claims are definite. As such, Applicant respectfully requests withdrawal of the rejections under 35 USC 112, 2nd paragraph.

Request for Allowance

Claims 1-8, 10-19 and 21 are pending in this application. Applicant requests allowance of all pending claims.

Respectfully submitted,
Fish IP Law, LLP

Date: June 2, 2023

By: /Tomas A. Prieto/
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Electronic Acknowledgement Receipt

EFS ID:	48097035
Application Number:	17714917
International Application Number:	
Confirmation Number:	6111
Title of Invention:	Method And Apparatus For Facilitating Toggling Between Internet And TV Broadcasts
First Named Inventor/Applicant Name:	Yakkov MERLIN
Customer Number:	24392
Filer:	Tomas Prieto/Tammy Lightman
Filer Authorized By:	Tomas Prieto
Attorney Docket Number:	103692.0001USre1
Receipt Date:	02-JUN-2023
Filing Date:	06-APR-2022
Time Stamp:	18:50:29
Application Type:	Utility under 35 USC 111(a)

Payment information:

Submitted with Payment		no			
File Listing:					
Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1		Response-02b-TVnGo1US1re-FILED.pdf	78009	yes	14
			fc94c4fae903d27dc304ee43b6172b059852936d		

	Multipart Description/PDF files in .zip description		
	Document Description	Start	End
	Response After Final Action	1	1
	Claims	2	6
	Specification	7	7
	Applicant Arguments/Remarks Made in an Amendment	8	14

Warnings:

Information:

Total Files Size (in bytes):	78009
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New Applications Under 35 U.S.C. 111

If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

National Stage of an International Application under 35 U.S.C. 371

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

New International Application Filed with the USPTO as a Receiving Office

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

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PATENT APPLICATION FEE DETERMINATION RECORD Substitute for Form PTO-875				Application or Docket Number 17/714,917		Filing Date 04/06/2022		☐ To be Mailed	
ENTITY: ☐ LARGE ☒ SMALL ☐ MICRO									
APPLICATION AS FILED - PART I									
		(Column 1)			(Column 2)				
FOR		NUMBER FILED	NUMBER EXTRA			RATE (\$)	FEE (\$)		
☐ BASIC FEE (37 CFR 1.16(a), (b), or (c))		N/A	N/A			N/A			
☐ SEARCH FEE (37 CFR 1.16(k), (i), or (m))		N/A	N/A			N/A			
☐ EXAMINATION FEE (37 CFR 1.16(o), (p), or (q))		N/A	N/A			N/A			
TOTAL CLAIMS (37 CFR 1.16(i))		minus 20 = *				x \$50 =			
INDEPENDENT CLAIMS (37 CFR 1.16(h))		minus 3 = *				x \$240 =			
☐ APPLICATION SIZE FEE (37 CFR 1.16(s))		If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$310 (\$155 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).							
☐ MULTIPLE DEPENDENT CLAIM PRESENT (37 CFR 1.16(j))									
* If the difference in column 1 is less than zero, enter "0" in column 2.						TOTAL			
APPLICATION AS AMENDED - PART II									
		(Column 1)			(Column 2)	(Column 3)			
AMENDMENT	06/02/2023	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA		RATE (\$)	ADDITIONAL FEE (\$)	
	Total (37 CFR 1.16(i))	* 21	Minus	** 21	= 0		x \$40 =	0	
	Independent (37 CFR 1.16(h))	* 2	Minus	*** 3	= 0		x \$192 =	0	
	☐ Application Size Fee (37 CFR 1.16(s))								
	☐ FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(j))								
							TOTAL ADD'L FEE	0	
AMENDMENT		CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA		RATE (\$)	ADDITIONAL FEE (\$)	
	Total (37 CFR 1.16(i))	*	Minus	**	=		x \$0 =		
	Independent (37 CFR 1.16(h))	*	Minus	***	=		x \$0 =		
	☐ Application Size Fee (37 CFR 1.16(s))								
	☐ FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(j))								
							TOTAL ADD'L FEE		
* If the entry in column 1 is less than the entry in column 2, write "0" in column 3.							LIE		
** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 20, enter "20".							/VIKKI GRAY/		
*** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 3, enter "3".									
The "Highest Number Previously Paid For" (Total or Independent) is the highest number found in the appropriate box in column 1.									

This collection of information is required by 37 CFR 1.16. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
17/714,917	04/06/2022	Yakkov MERLIN	103692.0001USre1	6111
24392	7590	07/26/2023		
FISH IP LAW, LLP 19900 MacArthur Blvd, Suite 810 Irvine, CA 92612			EXAMINER BASEHOAR, ADAM L	
			ART UNIT	PAPER NUMBER
			3992	
			NOTIFICATION DATE	DELIVERY MODE
			07/26/2023	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Patents@fishiplaw.com
rfish@fishiplaw.com

Advisory Action Before the Filing of an Appeal Brief	Application No. 17/714,917	Applicant(s) MERLIN, Yakkov	
	Examiner Adam L Basehoar	Art Unit 3992	AIA (FITF) Status No

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 02 June 2023 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

NO NOTICE OF APPEAL FILED

1. ☒ The reply was filed after a final rejection. No Notice of Appeal has been filed. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114 if this is a utility or plant application. Note that RCEs are not permitted in design applications. The reply must be filed within one of the following time periods:

a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action; or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

c) ☐ A prior Advisory Action was mailed more than 3 months after the mailing date of the final rejection in response to a first after-final reply filed within 2 months of the mailing date of the final rejection. The current period for reply expires _____ months from the mailing date of the prior Advisory Action or SIX MONTHS from the mailing date of the final rejection, whichever is earlier.

Examiner Note: If box 1 is checked, check either box (a), (b) or (c). ONLY CHECK BOX (b) WHEN THIS ADVISORY ACTION IS THE FIRST RESPONSE TO APPLICANTS FIRST AFTER-FINAL REPLY WHICH WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. ONLY CHECK BOX (c) IN THE LIMITED SITUATION SET FORTH UNDER BOX (c). See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) or (c) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendments filed after a final rejection, but prior to the date of filing a brief, will not be entered because

a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);

b) ☐ They raise the issue of new matter (see NOTE below);

c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____ (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): (a) ☐ will not be entered, or (b) ☒ will be entered, and an explanation of how the new or amended claims would be rejected is provided below or appended.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on _____

9. ☐ The affidavit or other evidence filed after final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

10. ☐ The affidavit or other evidence filed after the date of filing the Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

11. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

12. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.

13. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____

14. ☒ Other: See Continuation Sheet.

STATUS OF CLAIMS

15. The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: 9 and 20.

Claim(s) rejected: 1-8, 10-19 and 21.

Claim(s) withdrawn from consideration: _____.

/ADAM L BASEHOAR/ Primary Examiner, Art Unit 3992	/A.J.K/ Supervisory Patent Examiner, Art Unit 3992
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Continuation of AMENDMENTS 5. Applicant's reply has overcome the following rejection(s):

The Examiner notes that the amendments to independent claims 1 and 13 overcome (1) the rejection of claims 1-21 under 35 U.S.C. 251 as being broadened in a reissue application filed outside the two year statutory period (see: Final Action, pp. 4-6), (2) the rejection of claims 1-21 under 35 U.S.C. 251 as being improperly broadened in a reissue application made and sworn to by the assignee (see: Final Action, p. 6), and (3) the rejection of claims 1-21 under 35 U.S.C. 251 as being based upon a defective Reissue Declaration (see: Final Action, pp. 6-7).

The Examiner generally agrees with Applicant (see: Remarks, p. 11) that the scope of amended independent claims 1 and 13 is at least identical to the scope of their corresponding claims in the Merlin '220 patent. Therefore, it would be improper to maintain any rejection under 35 U.S.C. 251 (e.g., broadening in a reissue application filed outside the two year statutory period, an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based, etc.) related to claim scope broadening.

Continuation of REQUEST FOR RECONSIDERATION/OTHER 14. Other:

First, the Examiner notes that newly canceled dependent claims 9 and 20 are objected to for failing to comply with 37 CFR 1.173(b)(2). 37 CFR 1.173(b)(2) at least requires, "except that a patent claim or added claim should be canceled by a statement canceling the claim without presentation of the text of the claim." Newly canceled dependent claims 9 and 20 each improperly present the text of the canceled claim (e.g., see: MPEP 1453(II)(C) and 1453(V)(B)).

Second, claims 1-8, 10-19, and 21 remain rejected under 35 U.S.C. 112(b) or 35 U.S.C. 112 (pre-AIA), second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the inventor or a joint inventor, or for pre-AIA the applicant regards as the invention. As acknowledged by Applicant, amended independent claims 1 and 13 at least maintain the identical scope as their corresponding claims in the Merlin '220 patent. Therefore, amended independent claims 1 and 13 each still recite, "wherein said overly-enabling digital data includes...an overlay activation criterion" (emphasis added).

With regards to the use of the term "overlay activation criterion", the Examiner notes that the District Court (see: Civil No. 18-10238 (RMB/KMW), Opinion (April 16, 2020)) determined that the term "'overlay activation criterion'...neither of which are terms of art, nor defined by the specifications" is used in a manner "that is inconsistent with the use of that same term in dependent claims 9 and 20, and the specifications of both patents." Additionally, the District Court determined that "the intrinsic evidence presents a POSA with irreconcilably inconsistent information...that 'overlay activation criterion' comes from the Internet and simultaneously not from the Internet...Because the Court cannot construe the claims, they are indefinite." Similarly, the CAFC (see: TVnGO Ltd. v. LG Elecs. U.S., No. 2020-1837 (Fed. Cir. Jun. 28, 2021)) highlighted the fact that there was a lack of intrinsic evidence as to the meaning of the term "overlay activation criterion" and pointed out that the term was not "mentioned, let alone defined, in the shared specification...And the 'limited information' provided by the prosecution history isn't enough to provide certainty." Additionally, the CAFC also determined "one of ordinary skill would lack reasonably certainty as to the source of an 'overlay activation criterion'... the intra-patent grounds discussed above are sufficient to establish indefiniteness...The district court correctly concluded that the asserted claims are invalid for indefiniteness."

Thus, amended independent claims 1 and 13 are indefinite for at least the same reasons (i.e., fail to inform a person of ordinary skill in the art of the claimed invention's scope with reasonable certainty) related to the "overlay activation criterion" limitation as discussed and determined by the District Court and affirmed by the CAFC. The Examiner further notes that a final holding of claim invalidity or unenforceability (after all appeals) is binding/controlling on the Office. Here, amended independent claims 1 and 13 at least maintain the identical scope as found indefinite by the District Court and affirmed by the CAFC.

The above rejection is not overcome by the cancellation of dependent claims 9 and 20. This issue appears

to have been squarely addressed in the Decision by the CAFC (see: TVnGO Ltd. v. LG Elecs. U.S., No. 2020-1837 (Fed. Cir. Jun. 28, 2021), p. 11: “merely dismissing the dependent claims as invalid, as TVnGO proposes, ignores that they are one of the few sources of intrinsic evidence on the meaning of ‘overlay activation criterion’ in this record. When faced with this unknown and undefined phrase, a skilled artisan would look for clarification not only in the specification but also in ‘[o]ther claims of the patent in question,’ which ‘can also be valuable sources of enlightenment as to the meaning of a claim term.’ Phillips, 415 F.3d at 1314. Here, however, he or she would discover an inconsistency, throwing the meaning of ‘overlay activation criterion’ into doubt. These dependent claims are intrinsic evidence”) and found unpersuasive. As noted by the CAFC, dependent claims 9 and 20 are one of the few sources of intrinsic evidence on the meaning of “overlay activation criterion” in the record. Merely canceling dependent claims 9 and 20 does not eliminate this vital intrinsic evidence from the prosecution history, and thus a skilled artisan would still discover the inconsistency which throws the meaning of “overlay activation criterion” into doubt. Canceling dependent claims 9 and 20 does not change that.

If the Examiner agreed with Applicant that, “A reissue patent without those claims would no longer have a source of confusion/inconsistency...the skilled artisan would only discover the meaning of ‘overlay activation criterion’ as coming ‘from the Internet’,” then the Examiner would be inclined to reintroduce the recently withdrawn rejections under 35 U.S.C. 251 related to claim scope broadening. That is to say, newly discovering that the meaning of “overlay activation criterion” only comes “from the Internet” is not simply correcting an antecedent basis issue that does not meaningfully change the scope of the claims. Dependent claims 2-8, 10-12, 14-19, and 21 are similarly rejected at least via dependency.

Conferee:

/Joshua D. Campbell/

<i>Search Notes</i> 	Application/Control No. 17/714,917	Applicant(s)/Patent Under Reexamination MERLIN, Yakkov
	Examiner Adam L Basehoar	Art Unit 3992

CPC - Searched*		
Symbol	Date	Examiner
H04N 21/(44016, 4782, 4316, 4622, 431)	08/15/2022	ALB

CPC Combination Sets - Searched*		
Symbol	Date	Examiner

US Classification - Searched*			
Class	Subclass	Date	Examiner
725	109	08/15/2022	ALB
715	717, 718	08/15/2022	ALB
345	629	08/15/2022	ALB

* See search history printout included with this form or the SEARCH NOTES box below to determine the scope of the search.

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<i>Search Notes</i> 	Application/Control No. 17/714,917	Applicant(s)/Patent Under Reexamination MERLIN, Yakkov
	Examiner Adam L Basehoar	Art Unit 3992

Search Notes		
Search Notes	Date	Examiner
Reviewed Prior Application(s) History/Cited Prior Art	08/15/2022	ALB
Inventor Name Search (PE2E)	08/15/2022	ALB
Recapture Review Conducted	08/15/2022	ALB
Litigation Search (04/11/2022)	08/15/2022	ALB
PE2E Text and Classification Search (see attached search history)	08/15/2022	ALB
Reviewed Applicant's Response (01/30/2023)	02/06/2023	ALB
Searched Patent Data Portal (Patent No. 8,132,220) - No Prior/Pending Reexams/Reissues Found	02/06/2023	ALB
Searched P-TACTS (Patent No. 8,132,220) - No Prior/Pending AIA Proceedings Found	02/06/2023	ALB
Reviewed: TVnGO Ltd. v. LG Elecs. U.S., No. 2020-1837 (Fed. Cir. Jun. 28, 2021) and Civil No. 18-10238 (RMB/KMW)	02/06/2023	ALB
Reviewed Applicant's After Final Response (06/02/2023)	07/13/2023	ALB
Consulted Steve Stein (Managing Quality Assurance Specialist)	07/13/2023	ALB

Interference Search			
US Class/CPC Symbol	US Subclass/CPC Group	Date	Examiner

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<i>Index of Claims</i> 	Application/Control No. 17/714,917	Applicant(s)/Patent Under Reexamination MERLIN, Yakkov
	Examiner Adam L Basehoar	Art Unit 3992

✓	Rejected	-	Cancelled	N	Non-Elected	A	Appeal
=	Allowed	÷	Restricted	I	Interference	O	Objected

CLAIMS										
☐ Claims renumbered in the same order as presented by applicant ☐ CPA ☐ T.D. ☐ R.1.47										
CLAIM		DATE								
Final	Original	08/15/2022	02/06/2023	07/13/2023						
	1	✓	✓	✓						
	2	✓	✓	✓						
	3	✓	✓	✓						
	4	✓	✓	✓						
	5	✓	✓	✓						
	6	✓	✓	✓						
	7	✓	✓	✓						
	8	✓	✓	✓						
	9	✓	✓	○						
	10	✓	✓	✓						
	11	✓	✓	✓						
	12	✓	✓	✓						
	13	✓	✓	✓						
	14	✓	✓	✓						
	15	✓	✓	✓						
	16	✓	✓	✓						
	17	✓	✓	✓						
	18	✓	✓	✓						
	19	✓	✓	✓						
	20	✓	✓	○						
	21	✓	✓	✓						

OK TO ENTER: /A.L.B/

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450**

Appl No.: 17/714,917
Inventor: Yakkov Merlin
Filing Date: April 6, 2022
Art Unit: 3992
Examiner: Basehoar, Adam L.
Attorney Docket No.: 103692.0001US1re

Title Method and Apparatus for Facilitating Toggling
Between Internet and TV Broadcasts

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

AFTER-FINAL RESPONSE

Sir:

This paper responds to the Final Office Action dated March 6, 2023. Please enter the amendments shown herein.

- Claim Amendments begin on page 2.
- Specification Amendments begin on page 7.
- Remarks begin on page 8.

OK TO ENTER: /A.L.B/

Electronic Patent Application Fee Transmittal				
Application Number:		17714917		
Filing Date:		06-Apr-2022		
Title of Invention:		Method And Apparatus For Facilitating Toggling Between Internet And TV Broadcasts		
First Named Inventor/Applicant Name:		Yakkov MERLIN		
Filer:		Tomas Prieto/Tammy Lightman		
Attorney Docket Number:		103692.0001USre1		
Filed as Small Entity				
Filing Fees for Utility under 35 USC 111(a)				
Description	Fee Code	Quantity	Amount	Sub-Total in USD(\$)
Basic Filing:				
Pages:				
Claims:				
Miscellaneous-Filing:				
Petition:				
Patent-Appeals-and-Interference:				
Post-Allowance-and-Post-Issuance:				
Extension-of-Time:				

Description	Fee Code	Quantity	Amount	Sub-Total in USD(\$)
Extension - 3 months with \$0 paid	2253	1	592	592
Miscellaneous:				
Total in USD (\$)				592

Electronic Acknowledgement Receipt

EFS ID:	48525427
Application Number:	17714917
International Application Number:	
Confirmation Number:	6111
Title of Invention:	Method And Apparatus For Facilitating Toggling Between Internet And TV Broadcasts
First Named Inventor/Applicant Name:	Yakkov MERLIN
Customer Number:	24392
Filer:	Tomas Prieto/Tammy Lightman
Filer Authorized By:	Tomas Prieto
Attorney Docket Number:	103692.0001USre1
Receipt Date:	31-AUG-2023
Filing Date:	06-APR-2022
Time Stamp:	18:51:12
Application Type:	Utility under 35 USC 111(a)

Payment information:

Submitted with Payment	yes
Payment Type	DA
Payment was successfully received in RAM	\$ 592
RAM confirmation Number	E20238UI51489597
Deposit Account	500341
Authorized User	Tammy Lightman

The Director of the USPTO is hereby authorized to charge indicated fees and credit any overpayment as follows:

37 CFR 1.16 (National application filing, search, and examination fees)

37 CFR 1.17 (Patent application and reexamination processing fees)

37 CFR 1.19 (Document supply fees)
 37 CFR 1.20 (Post Issuance fees)
 37 CFR 1.21 (Miscellaneous fees and charges)

File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1	Notice of Appeal Filed	Notice-of-Appeal-TVnGO1US1re.pdf	246255	no	2
			e6e23736600a6c8df3a32dde08ceb916d0031694		

Warnings:

Information:

2	Fee Worksheet (SB06)	fee-info.pdf	38220	no	2
			ba721cae22b8473483b1f15ccda644ff31a798b		

Warnings:

Information:

Total Files Size (in bytes): 284475

This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.

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If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

National Stage of an International Application under 35 U.S.C. 371

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

New International Application Filed with the USPTO as a Receiving Office

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

Electronic Patent Application Fee Transmittal

Application Number:	17714917			
Filing Date:	06-Apr-2022			
Title of Invention:	Method And Apparatus For Facilitating Toggling Between Internet And TV Broadcasts			
First Named Inventor/Applicant Name:	Yakkov MERLIN			
Filer:	Tomas Prieto/Tammy Lightman			
Attorney Docket Number:	103692.0001USre1			
Filed as Small Entity				
Filing Fees for Utility under 35 USC 111(a)				
Description	Fee Code	Quantity	Amount	Sub-Total in USD(\$)
Basic Filing:				
Pages:				
Claims:				
Miscellaneous-Filing:				
Petition:				
Patent-Appeals-and-Interference:				
NOTICE OF APPEAL	2401	1	336	336
Post-Allowance-and-Post-Issuance:				

Description	Fee Code	Quantity	Amount	Sub-Total in USD(\$)
Extension-of-Time:				
Miscellaneous:				
Total in USD (\$)				336

Electronic Acknowledgement Receipt

EFS ID:	48525169
Application Number:	17714917
International Application Number:	
Confirmation Number:	6111
Title of Invention:	Method And Apparatus For Facilitating Toggling Between Internet And TV Broadcasts
First Named Inventor/Applicant Name:	Yakkov MERLIN
Customer Number:	24392
Filer:	Tomas Prieto/Tammy Lightman
Filer Authorized By:	Tomas Prieto
Attorney Docket Number:	103692.0001USre1
Receipt Date:	31-AUG-2023
Filing Date:	06-APR-2022
Time Stamp:	18:23:48
Application Type:	Utility under 35 USC 111(a)

Payment information:

Submitted with Payment	yes
Payment Type	DA
Payment was successfully received in RAM	\$ 336
RAM confirmation Number	E20238UI24467882
Deposit Account	500341
Authorized User	Tammy Lightman

The Director of the USPTO is hereby authorized to charge indicated fees and credit any overpayment as follows:

37 CFR 1.16 (National application filing, search, and examination fees)

37 CFR 1.17 (Patent application and reexamination processing fees)

37 CFR 1.19 (Document supply fees)
 37 CFR 1.20 (Post Issuance fees)
 37 CFR 1.21 (Miscellaneous fees and charges)

File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1	Notice of Appeal Filed	Notice-of-Appeal-TVnGO1US1re.pdf	241557	no	2
			949e87231475bc4de9ccff0ef51c93ca1f4f4e27		

Warnings:

Information:

2	Fee Worksheet (SB06)	fee-info.pdf	37943	no	2
			5192a2672df37a107de9c31e3a08d9e048f2c67a		

Warnings:

Information:

Total Files Size (in bytes):	279500
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This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.

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New International Application Filed with the USPTO as a Receiving Office

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

NOTICE OF APPEAL FROM THE EXAMINER TO THE PATENT TRIAL AND APPEAL BOARD		Docket Number (Optional) 103692.0001US1re
I hereby certify that this correspondence is being facsimile transmitted to the USPTO, EFS-Web transmitted to the USPTO, or deposited with the United States Postal Service with sufficient postage in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, on Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>August 31, 2023</u> .	In re Application of TVnGo Ltd. (BVI)	
Signature <u>/Tammy Lightman/</u> Typed or printed name <u>Tammy Lightman</u>	Application Number 17/714917	Filed April 6, 2022
For Method And Apparatus For Facilitating Toggling Between Internet And TV Broadcasts		
Art Unit 3992		Examiner BASEHOAR, ADAM L
Applicant hereby appeals to the Patent Trial and Appeal Board from the last decision of the examiner.		
The fee for this Notice of Appeal is (37 CFR 41.20(b)(1))		\$ <u>840.00</u>
☒ Applicant asserts small entity status. See 37 CFR 1.27. Therefore, the fee shown above is reduced by 50%, and the resulting fee is:		\$ <u>336.00</u>
☐ Applicant certifies micro entity status. See 37 CFR 1.29. Therefore, the fee shown above is reduced by 75%, and the resulting fee is: Form PTO/SB/15A or B or equivalent must either be enclosed or have been submitted previously.		\$ _____
☐ A check in the amount of the fee is enclosed.		
☐ Payment by credit card. Form PTO-2038 is attached.		
☒ The Director is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. <u>500341</u> .		
☒ Payment made via EFS-Web.		
☒ A petition for an extension of time under 37 CFR 1.136(a) (PTO/AIA/22 or equivalent) is enclosed. For extensions of time in reexamination proceedings, see 37 CFR 1.550.		
WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.		
I am the		
☐ applicant	☒ attorney or agent of record Registration number <u>60675</u>	☐ attorney or agent acting under 37 CFR 1.34 Registration number _____
Signature <u>/Tomas A. Prieto/</u>		
Typed or printed name <u>Tomas A. Prieto</u>		
Telephone Number <u>949-943-8300</u>		
Date <u>August 31, 2023</u>		
NOTE: This form must be signed in accordance with 37 CFR 1.33. See 37 CFR 1.4 for signature requirements and certifications. Submit multiple forms if more than one signature is required, see below*.		
☐ * Total of _____ forms are submitted.		

This collection of information is required by 37 CFR 41.20(b)(1) and 41.31. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Privacy Act Statement

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8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl No.: **17/714,917**
Appellant: **TVnGO Ltd. (BVI)**
Filing Date: **April 6, 2022**
Art Unit: **3992**
Examiner: **Basehoar, Adam L.**
Attorney Docket No.: **103692.0001US1re**

Title **METHOD AND APPARATUS FOR FACILITATING
TOGGLING BETWEEN INTERNET AND TV
BROADCASTS**

MS Appeal Brief - Patents
Commissioner of Patents and Trademarks
Washington, D.C. 20231
Attention: Patent Trial And Appeals Board

APPELLANT'S BRIEF UNDER 37 CFR § 41.37

This brief follows the appellant's Notice of Appeal filed in this matter on August 31, 2023. The fees required under § 41.20, and any required petition for extension of time for filing this brief and fees therefor, are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

This brief contains the following items under the headings in the order here indicated:

- I. Real Party In Interest
- II. Related Appeals, Interferences, And Trials
- III. Summary Of Claimed Subject Matter
- IV. Argument
- V. Claims Appendix

I. Real Party In Interest

The real party in interest is TVnGO Ltd. (BVI)

II. Related Appeals, Interferences, and Trials

Patent US 8,132,220 (“the ‘220 Patent”) was the subject of litigation in the District of New Jersey as well as an appeal to the Federal Circuit. Orders from both courts rendered claims 1, 9, 10, 13, 17, and 20 of the ‘220 Patent invalid as indefinite. The District of New Jersey matter is Civil No. 18-10238 (RMB/KMW). The Federal Circuit matter is Case 20-1837.

III. Summary Of Claimed Subject Matter

Supporting passages are provided in brackets pointing to sections of US patent number 8,132,220 (“the ‘220 patent”) that was filed as US App 17/714,917 for the current reissue proceedings.

A) **Independent Claim 1** is directed to a method for generating an overly using video signals, at a user’s premises that includes a combiner unit at the user’s premises connected to a TV tuner box or a TV tuner in a user’s TV set (col 3, ln 31-56), where the combiner unit is connected through distinct networks to a video signal source that provides video signals and an Internet data source that provides overlay-enabling data over the internet (col 6, ln 40-59). The video signals and overlay-enabling data come from different, unrelated sources (col 3, ln 31-56; Fig. 1). The overlay-enabling digital data includes a Web link, an image indicative of content associated with the overlay-enabling digital data and an overlay activation criterion (col. 5, ln 21-36; col 7, ln 51-col 8, ln 4) The method further includes the steps of processing the overlay-enabling digital data to generate an overlay if a criterion is met, where the generation of the overlay includes generating a first display screen having video signals and an overlay portion and an association of the Web link with the overlay portion such that the content can be retrieved and displayed on a second display screen on the TV set (col. 5, ln 21-36; col 7, ln 51-col 8, ln 39; Fig. 7A-8).

B) **Independent Claim 13** is directed to a TV-Internet integration box used to generate an overlay at a user’s premises that includes a combiner unit (col 6, ln 40-col 7, ln7, Fig. 6). The combiner unit executes the program steps mirroring those of method claim 1 (Citations corresponding to independent claim 1 above also apply here).

IV. Argument

A. Overview

This appeal is in response to a Final Office Action dated March 6, 2023 (“2023 March Final”) and an Advisory Action dated July 26, 2023 (“2023 July AA”). Appellant filed an after-final response on June 2, 2023 (“2023 June Response”), responding to the 2023 March Final. The 2023 July AA was then issued in response to the 2023 June Response.

The 2023 March Final included rejections under 35 USC 251 and 35 USC 112, 2nd paragraph (pre-AIA). In response to the 2023 June Response, the rejections under 35 USC 251 were withdrawn as noted in the 2023 July AA.

The rejection under 35 USC 112, 2nd paragraph was maintained in the 2023 July AA and is the subject of the present appeal.

B. Rejection of claims 1-8, 10-19 and 21 under 35 USC 112, 2nd Paragraph

Claims 1-8, 10-19 and 21 have been rejected under 35 USC §112, 2nd paragraph for being indefinite for “the same reasons (.e., fail to inform a person of ordinary skill in the art of the claimed invention’s scope with reasonable certainty) related to the “overlay activation criterion” limitation as discussed and determined by the District Court and affirmed by the CAFC.” (2023 March Final, page 8). Appellant respectfully disagrees, especially in view of the cancellation of claims 9 and 20. In support Appellant notes the following:

1. Cancelling Claims 9 and 20 Resolves the Indefiniteness Issue of Claims 1 and 13 Because It Breaks the Link of Terminology Giving Rise to the Inconsistencies Leading to the Invalidity

As quoted by the Examiner, the rationale from the District Court (“DC”) and affirmed by the Court of Appeals for the Federal Circuit (“CAFC”) regarding the indefiniteness holding of claims 1 and 13 is as follows (page 8 of the 2023 March Final):

With regards to the use of the term "overlay activation criterion", the Examiner notes that the District Court (see: Civil No. 18-10238 (RMB/KMW), Opinion (April 16, 2020)) determined that the intrinsic evidence presents a POSA with irreconcilably inconsistent

information ... that 'overlay activation criterion' comes from the Internet and simultaneously not from the Internet ... Because the Court cannot construe the claims, they are indefinite." Similarly, the CAFC (see: TVnGO Ltd. v. LG Elecs. U.S., No. 2020-1837 (Fed. Cir. Jun. 28, 2021)) also determined "one of ordinary skill would lack reasonably certainty as to the source of an 'overlay activation criterion' ... the intra-patent grounds discussed above are sufficient to establish indefiniteness ... The district court correctly concluded that the asserted claims are invalid for indefiniteness."

In the 2023 July AA, the Examiner responded to Appellant's arguments with a similar argument that added additional detail and explanation:

With regards to the use of the term "overlay activation criterion", the Examiner notes that the District Court (see: Civil No. 18-10238 (RMB/KMW), Opinion (April 16, 2020)) determined that the term "'overlay activation criterion' ... neither of which are terms of art, nor defined by the specifications" is used in a manner "that is inconsistent with the use of that same term in dependent claims 9 and 20, and the specifications of both patents." Additionally, the District Court determined that "the intrinsic evidence presents a POSA with irreconcilably inconsistent information ... that 'overlay activation criterion' comes from the Internet and simultaneously not from the Internet ... Because the Court cannot construe the claims, they are indefinite." Similarly, the CAFC (see: TVnGO Ltd. v. LG Elecs. U.S., No. 2020-1837 (Fed. Cir. Jun. 28, 2021)) highlighted the fact that there was a lack of intrinsic evidence as to the meaning of the term "overlay activation criterion" and pointed out that the term was not "mentioned, let alone defined, in the shared specification ... And the 'limited information' provided by the prosecution history isn't enough to provide certainty." Additionally, the CAFC also determined "one of ordinary skill would lack reasonably certainty as to the source of an 'overlay activation criterion' ... the intra-patent grounds discussed above are sufficient to establish indefiniteness ... The district court correctly concluded that the asserted claims are invalid for indefiniteness."

The DC's decision (affirmed by the CAFC) as discussed in the section quoted by the Examiner indicates that the indefiniteness of the claims is brought about an inconsistency created by the use of the term "overlay activation criterion" in independent claims 1 and 13 (as held by the DC and CAFC to require the overlay activation criterion to come from the Internet) and then again in dependent claims 9 and 20 (held by the DC and CAFC to open the possibility that the overlay activation criterion could come "not" from the Internet). As Appellant understands the Examiner's rationale as well as the DC and CAFC decisions, this inconsistency across the independent and dependent claims creates an uncertainty in the possible meaning of the claim, resulting in the indefiniteness of all of the claims.

Appellant notes that now-cancelled claims 9 and 20 of the ‘220 patent never recited “user command information.” Now-cancelled claim 9 read as follows:

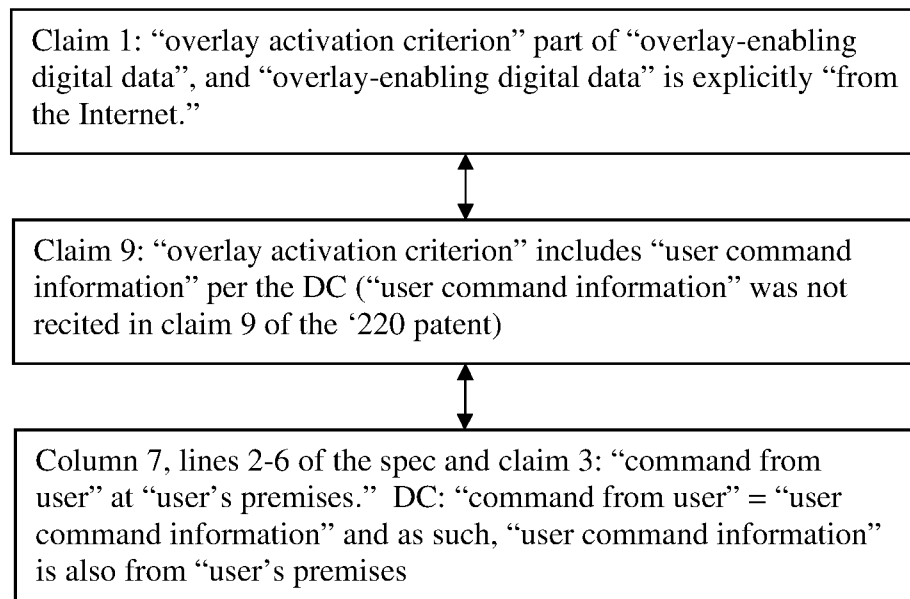
9. The method according to claim 1, wherein said overlay activation criterion includes at least one of the following: a timing information, data specifying one or more TV subscriber channels.

It appears that the DC simply used the claims language of US 9,407,969 (“the ‘969 patent”) and applied it to both the ‘969 patent and the ‘220 patent. Appellant’s understanding is that the rejections in the 2023 March Final have been in such a way that they are consistent with the DC and CAFC decisions. As such, and despite the actual original language of the claims, claims 9 and 20 have nevertheless been cancelled. Appellant’s arguments respond to the rejections in the 2023 March Final while also taking into account the controlling DC and CAFC decisions.

The DC determined that in “claims 1, and 13, ‘overlay activation criterion’ must necessarily come from the Internet because the claim states that ‘overlay activation criterion’ is a component of the ‘overlay-enabling digital data’ which data, the claim explicitly states, is provided ‘over the Internet’”. Thus, it is Appellant’s understanding that the DC does not find an internal inconsistency within claim 1 and that as such, there is no uncertainty of the meaning of the terms of claim 1 in isolation – within claim 1, “overlay activation criterion” explicitly comes from the internet. **Accordingly, it is Appellant’s understanding that claims 1 and 13 in isolation would be definite.**

The inconsistency (and thus indefiniteness) arises with dependent claims 9 and 20 because the DC found that the “user command information” may be a component of the “overlay activation criterion” and that the “user command information” comes from the user’s premises. The DC arrived at this conclusion by equating the “user command information” of claims 9 and 20 with the “command from a user” of claim 3 and also column 7, lines 2-6 of the specification, which indicate that the “command from a user” is from “the user’s premises.” See DC’s decision, pages 8-9.

Thus, visually, the link between the terminology that creates the discrepancy leading to the DC’s finding of indefiniteness can be represented accordingly:



There is no direct link between the “overlay activation criterion” of claim 1 and the “command from the user” of claims 3 and 15 and the associated language of col 7, ln 2-6 in the specification. The link was created via the limitation of claim 9 and then the DC’s linking of the “user command information” of claim 9 of the ‘969 patent to the “command from user” of claim 3 and corresponding language of the col 7, ln 2-6.

Because the DC was clear that in claim 1, the “overlay activation criterion” unequivocally comes from the Internet and because there is no direct link from the recitation of the “overlay activation criterion” claim 1 to the “command from the user” of claim 3 or the corresponding language of column 7, lines 2-6, cancelling claim 9 is sufficient to break the link between the “overlay activation criterion” and the “user command information” created via claim 9 and also the link found by the DC between the “user command information” of claim 9 and the language of column 7, lines 2-6 and the “command from the user” of claim 3. Therefore, the link between the recitation of “overlay activation criterion” coming from the Internet and the commands from a user coming from the user’s premises of claim 3 and col 7, ln 2-6 of the specification is broken.

With the cancellation of claim 9, there is no other way to link a possible interpretation of the “overlay activation criterion” of claim 1 as coming “not from the Internet”. Thus, with the

cancellation of claim 9, the meaning of the term “overlay activation criterion” is consistent and thus definite. The arguments above also apply to the link between claims 13 and 20. A reissue patent without cancelled claims 9 and 20 would no longer have a source of confusion/inconsistency for the skilled artisan. Instead, the skilled artisan would only discover the meaning of “overlay activation criterion” as coming “from the Internet” of independent claims 1 and 13.

2. Cancelling Claims 9 and 20 Overcomes the Rejection under 35 USC 112, 2nd Paragraph Because There Would No Longer Be An Inconsistency In The Claims and The Prosecution History Would Similarly Make The Intended Interpretation of the Claims Clear

In the 2023 July AA, the Examiner indicated that the rejections under 35 USC 112, 2nd paragraph would not be overcome by cancelling claims 9 and 20. The Examiner reasons that:

Merely canceling dependent claims 9 and 20 does not eliminate this vital intrinsic evidence from the prosecution history, and thus a skilled artisan would still discover the inconsistency which throws the meaning of "overlay activation criterion" into doubt. Canceling dependent claims 9 and 20 does not change that.

Appellant respectfully disagrees. Cancelling claims effectively removes them from a reissued patent such that the link discussed that gives rise to the inconsistency and subsequently the indefiniteness no longer exists for the skilled artisan would find.

Page 11 of the CAFC decision states:

Further, merely dismissing the dependent claims as **invalid**, as TVnGO proposes, ignores that they are one of the few sources of intrinsic evidence on the meaning of 'overlay activation criterion' in this record. When faced with this unknown and undefined phrase, a skilled artisan would look for clarification not only in the specification but also in '[o]ther claims of the patent in question,' which 'can also be valuable sources of enlightenment as to the meaning of a claim term.' Phillips, 415 F.3d at 1314. Here, however, he or she would discover an inconsistency, throwing the meaning of “overlay activation criterion” into doubt. These dependent claims are intrinsic evidence. Arguing that they are **invalid** does not change that. (emphasis added)

Here, the CAFC only discusses the invalidity of the claims at issue and does not address cancellation. A court finding the claims invalid is not the same thing as cancelling claims during

a USPTO proceeding. A court can declare patent claims invalid during a proceeding. A court does not have the power to cancel or amend patent claims.

In the reasoning offered by the CAFC on page 11, the CAFC explains that the independent claims cannot be found to be valid and definite while the dependent claims are indefinite (and thus invalid) because the inconsistency raised by the dependent claims carries back to the terminology of the independent claims. This is because, per the DC and CAFC, the dependent claims exist as a source of claim interpretation of terminology found in the independent claim.

Thus, as long as the dependent claims are a part of the text of the patent, they remain a source of information for the interpretation of the independent claims. Unfortunately, this also means that, as long as the dependent claims remain a part of the text of the patent, the inconsistency also remains a part of the patent and the independent claims remain indefinite.

Cancelling claims, on the other hand, removes the text of the cancelled claim from the patent. After a claim is cancelled during prosecution, the issued patent (or reissued patent) is read as if the cancelled claim never existed. When a potential infringer reads an issued patent to determine whether their product or process infringes, they look at the issued claims and not the cancelled claims because the cancelled claims are not part of the patent.

As to the Examiner's assertion that even with the cancellation of claims, the skilled artisan would still find the inconsistency from the prosecution history, Appellant respectfully disagrees.

In *Standard Oil Co. v. American Cyanamid Co.*, 774 F.2d 448, the CAFC stated as follows in a case involving a reissued patent (emphasis added):

Finally, the prosecution history (sometimes called "file wrapper and contents") of the patent consists of the entire record of proceedings in the Patent and Trademark Office. This includes all express representations made by or on behalf of the applicant to the examiner to induce a patent grant, or, as here, to reissue a patent. Such representations include amendments to the claims and arguments made to convince the examiner that the claimed invention meets the statutory requirements of novelty, utility, and nonobviousness. **Thus, the prosecution history (or file wrapper) limits the interpretation of claims so as to exclude**

any interpretation that may have been disclaimed or disavowed during prosecution in order to obtain claim allowance. *Standard Oil Co. v. American Cyanamid Co.*, 774 F.2d 448, 452 (Fed. Cir. 1985)

Were this application proceed to a reissued patent, a person reading the prosecution history would have access to the entire prosecution history, including this very document. Upon reading the reissued patent and prosecution history, the reader would not see cancelled claims 9 and 20 within the patent document itself. There would be no confusion created by the text of the reissued patent document.

Further, when digging into the prosecution history, the reader would see that via the cancellation of claims 9 and 20, the Appellant intended to exclude the possibility that the claims could be interpreted to mean that the “overlay activation criterion” could come from the user’s premises. To that point, Appellant states the following, to remove any doubt:

Dear Reader of the Prosecution History: Claims 9 and 20 are cancelled herein because it is Appellant’s intent to remove any possible interpretation of the “overlay activation criterion” as coming from the user’s premises (i.e., not from the internet).

Because the cancelled claims (in this case, claims 9 and 20) would not be part of the reissued patent and would not be available for a reader to read as a source of clarification or meaning within the patent text, and because the prosecution history would include a clear intent to remove the interpretation of “overlay activation criterion” that caused the inconsistency at the DC and CAFC levels, a reader of the patent and the prosecution history (including the reissue prosecution history) would not find the inconsistency within the claims to exist and would clearly understand the metes and bounds of the claims.

3. Cancelling Claims 9 and 20 to Overcome the 35 USC 112, 2nd Paragraph Rejection Is Consistent With the DC and CAFC Rulings

Appellant recognizes that the Office (in this case, the Examiner assigned to the reissue application and the Patent Trial and Appeal Board (“PTAB”) that is considering this appeal) is bound to follow the DC and CAFC decisions with regard to the rejection under 35 USC 112, 2nd paragraph and that the Examiner and/or the PTAB cannot directly reverse the decision of the DC or the CAFC. Put another way, Appellant sees that overturning the rejection under 35 USC 112,

2nd paragraph requires an approach that resolves the indefiniteness issues noted by the DC and affirmed by the CAFC while simultaneously remaining consistent with the holding. It is Appellant's position that cancelling claims 9 and 20 without amending the independent claims 1 and 13 (such that their scope remains unchanged) resolves the indefiniteness issue as explained above, and also is consistent with the DC and CAFC decision such that withdrawing the current rejection under 35 USC 112, 2nd paragraph does not result in the Examiner or the PTAB attempting to reverse the courts' decisions or usurp their authority.

In reading the Examiner's rejection, Appellant's understanding is that the Examiner is potentially interpreting the DC and CAFC decisions as deeming claims 9 and 20 necessary for the interpretation of the "overlay activation criterion" of claims 1 and 13 and that because of that, the DC and CAFC are in essence declaring that they cannot be cancelled or otherwise removed from the text of the patent. This understanding comes from the 2023 July AA, where the Examiner states:

The above rejection is not overcome by the cancellation of dependent claims 9 and 20. This issue appears to have been squarely addressed in the Decision by the CAFC (see: *TVnGO Ltd. v. LG Elecs. U.S.*, No. 2020-1837 (Fed. Cir. Jun. 28, 2021), p. 11: "merely dismissing the dependent claims as invalid, as TVnGO proposes, ignores that they are one of the few sources of intrinsic evidence on the meaning of 'overlay activation criterion' in this record. When faced with this unknown and undefined phrase, a skilled artisan would look for clarification not only in the specification but also in '[o]ther claims of the patent in question,' which 'can also be valuable sources of enlightenment as to the meaning of a claim term.' Phillips, 415 F.3d at 1314. Here, however, he or she would discover an inconsistency, throwing the meaning of 'overlay activation criterion' into doubt. These dependent claims are intrinsic evidence") and found unpersuasive. As noted by the CAFC, dependent claims 9 and 20 are one of the few sources of intrinsic evidence on the meaning of "overlay activation criterion" in the record. Merely canceling dependent claims 9 and 20 does not eliminate this vital intrinsic evidence from the prosecution history, and thus a skilled artisan would still discover the inconsistency which throws the meaning of "overlay activation criterion" into doubt. Canceling dependent claims 9 and 20 does not change that.

Appellant respectfully disagrees and notes the following:

Appellant notes that the CAFC is not declaring that dependent claims cannot be cancelled to address the indefiniteness. The relevant section quoted by the Examiner in the 2023 July AA is as follows:

merely dismissing the dependent claims as invalid, as TVnGO proposes, ignores that they are one of the few sources of intrinsic evidence on the meaning of 'overlay activation criterion' in this record. When faced with this unknown and undefined phrase, a skilled artisan would look for clarification not only in the specification but also in '[o]ther claims of the patent in question,' which 'can also be valuable sources of enlightenment as to the meaning of a claim term.' Phillips, 415 F.3d at 1314

The Examiner further paraphrases the CAFC, indicating:

As noted by the CAFC, dependent claims 9 and 20 are one of the few sources of intrinsic evidence on the meaning of "overlay activation criterion" in the record. Merely **canceled** dependent claims 9 and 20 does not eliminate this vital intrinsic evidence from the prosecution history, and thus a skilled artisan would still discover the inconsistency which throws the meaning of "overlay activation criterion" into doubt. **Canceled** dependent claims 9 and 20 does not change that. (emphasis added)

However, the CAFC decision does not actually say anything about *cancelling* the claims. The actual text of the CAFC decision reads on page 11:

Here, however, he or she would discover an inconsistency, throwing the meaning of "overlay activation criterion" into doubt. These dependent claims are intrinsic evidence. Arguing that they are **invalid** does not change that. (emphasis added)

Invalidating the claims at the trial level is not the same as cancelling claims during a USPTO proceeding or process (such as a reissue application prosecution or a disclaimer). When a claim is invalidated by a court, the document of the patent itself doesn't change. Actually changing the text of the patent can only be done via the avenues available through the USPTO.

Here, the CAFC is not stating that the claims cannot be cancelled. Instead, the CAFC is stating that, because the dependent claims remain in the text of the patent even if invalidated at the court level, it is not possible to leave the dependent claims as invalid for being indefinite while declaring the independent claims are valid. In other words, as long as the indefinite dependent claims remain in the text of the patent, then the independent claims must also be indefinite because the text of claims 9 and 20 of the '969 patent help inform the reader of the possible meanings of the terms in claims 1 and 13, respectively. In the section of page 11 referenced by the Examiner, the CAFC is responding to an argument made by TVnGO where TVnGO argued that a determination of invalidity of a dependent claim should not affect validity

of an otherwise clear independent claim. The CAFC disagreed with this, with the reasoning set forth on page 11 of the CAFC decision. Nothing in this section of the CAFC decision or any other part of the CAFC decision (or the District Court decision, for that matter) indicates that the claims can't be cancelled or that the dependent claims **MUST** remain in the text of the patent. As noted above, this section only indicates that the dependent claims, as a source of potential claim interpretation, affect the interpretation of the terms of the independent claims. In this case, this means that the inconsistency that makes the dependent claims indefinite also renders the independent claims indefinite.

Because the CAFC and/or the DC never said the claims could not be cancelled, cancelling dependent claims 9 and 20 to remove the inconsistency and thus the indefiniteness of respective independent claims 1 and 13 does not contradict the DC or the CAFC decisions.

4. Scope Of Claims Not Enlarged Because Claims Are Fundamentally Unchanged

The independent claims 1 and 13 presented for appeal are substantially identical to those of the issued '220 patent and the minor differences do not change the claim scope from the rejected claims or from the scope of the claims on the patent. The Examiner agrees, indicating in the 2023 July AA that the "the scope of amended independent claims 1 and 13 is at least identical to the scope of their corresponding claims in in the Merlin '220 patent."

In the 2023 July AA, the Examiner indicates that:

If the Examiner agreed with Applicant that, "A reissue patent without those claims would no longer have a source of confusion/inconsistency ... the skilled artisan would only discover the meaning of 'overlay activation criterion' as coming 'from the Internet'," then the Examiner would be inclined to reintroduce the recently withdrawn rejections under 35 U.S.C. 251 related to claim scope broadening.

Appellant is confused as to how this hypothetical rejection could be rationally supported given that the Examiner recognizes that the scope of the current independent claims is identical to those of the claims rejected by the DC and affirmed by the CAFC. It is unclear how a claim could go from "identical scope" to "different scope" without materially touching the language of the claim itself.

5. The Purpose of the Reissue Process is to Correct Deficient Patents, Including Indefiniteness Issues

Appellant asserts that the cancellation of claims 9 and 20 resolves the indefiniteness issue raised by the DC and the CAFC while remaining consistent with those decisions. As noted above and agreed upon by the Examiner, the scope of claims 1 and 13 has not changed.

If a claim whose scope has been unchanged can nevertheless be declared to have been improperly broadened, this seems to imply that an indefinite claim in a patent (or potentially indefinite in an unlitigated patent) that is over two years after issue can *never* be corrected via reissue because it will *always* be considered to be improperly broadened.

As stated by the court in *In re Altempohl*, 500 F.2d 1151 (CCPA 1974), “[i]n as much as 35 USC 251 is a remedial provision, which should be liberally construed, a patentee should be allowed to correct an error or ambiguity in a claim without having to rely on implication or litigation.” (*Altempohl* at 1156-1157). To effectively render any indefiniteness issue unrecoverable for patents after two years of issue would run counter to the court-recognized remedial nature of the reissue process.

However, courts have shown that this effective “death sentence” under 35 USC 112, 2nd paragraph is not the intent. Past cases have shown that it is possible to correct indefiniteness issues via reissue, even for patents outside of the two-year broadening post-issue period. In *Slimfold Mfg. Co v Kinkead Props.* 626 F.Supp 493 (1987), correcting an antecedent basis issue during reissue does not meaningfully change the scope of the claim. (*Slimfold* at 497-498). *Slimfold* cites to *In re Altempohl*, 500 F.2d 1151 (CCPA 1974), which states that “[l]ack of antecedent basis in a claim could render it invalid under 35 USC 112, second paragraph, and correction of such a defect by reissue should not have to depend on difference in scope of the claim.” (*Altempohl* at 1156). To effectively render any indefiniteness issue unrecoverable would run counter to the court-recognized remedial nature of the reissue process.

While the issue raised by the DC and CAFC in this situation is not an antecedent basis issue, these holdings show that courts have ruled on the possibility of using reissue to correct issues that could give rise to indefiniteness – especially where the scope of the claim on its face is fundamentally unchanged. Here, the scope of the independent claims is unchanged. As such, a

holding of indefiniteness should be correctable via reissue, which is in line with the whole purpose of the reissue process and consistent with court decisions that make such a correction permissible.

C. Request for Reversal

For the reasons discussed above, it is Appellant's position that claims 1 and 13 are definite under 35 USC 112, 2nd paragraph. Appellant respectfully requests reversal of the Examiner's rejections.

Respectfully submitted,

/Tomas A Prieto/

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V. Claims Appendix

1. A method for generating at a user's premises an overlay using video signals constituting a first data and overlay-enabling digital data constituting a second data, the method comprising:

(a) providing a combiner unit at the user's premises, wherein:

the combiner unit is coupled to a TV set and connected to a separate TV tuner box or

TV tuner in the TV set, at the user's premises, and

the combiner unit is also connected through distinct networks to each of a video

signal source providing video signals through the TV tuner box or TV tuner in

the TV set, and an Internet data source providing overlay-enabling digital data

over the Internet,

wherein said video signals and said overlay-enabling digital data originate from

unrelated sources and are transmitted to the user's premises by different

resources as mutually distinct and independent inputs,

and wherein said overlay-enabling digital data includes at least:

a Web link indicating a website where content that is associated with said

overlay-enabling digital data is stored,

an image indicative of the content associated with said overlay-enabling digital

data, and

an overlay activation criterion; and

(b) processing at the user's premises said overlay-enabling digital data and generating at

the user's premises a corresponding overlay only if said overlay activation

criterion is met, wherein generating [an] the overlay includes:

generating at the user's premises a first display screen including at least a first portion corresponding to said video signals and a second portion overlaid over said first portion and corresponding at least to said image, and associating the Web link with said second portion of the first display screen thereby allowing a user to cause the combiner unit to retrieve said content, generate a second video display screen including at least a portion which corresponds to said content, and input the second display screen to said TV set.

2. The method according to claim 1, wherein said overlay-enabling digital data is received at the user premises according to a pre-stored user profile.

3. The method according to claim 1, further including: receiving a command from [a] the user at said user premises; and responsive to said command, resizing said first portion and/or said second portion of said first display screen.

4. The method according to claim 1, wherein the content stored at said website enables streaming of digital data over the Internet; and

said method further including: pre-fetching and buffering said digital data stream from said website, thereby allowing said digital data stream to be displayed substantially without delay upon redirection by the user.

5. The method according to claim 1, wherein the overlay-enabling digital data comprises data representative of one or more second images, and for each of said one or more second images said overlay-enabling data comprises respective web site addresses where IP content associated with the respective second image is stored, and wherein said generating [an] the overlay further includes within said first display said one or more second images.

6. The method according to claim 1, wherein the overlay-enabling digital data is supplementary or complementary to the video signals.
7. The method according to claim 1, wherein the image includes an icon that indicates to the user that digital data from Internet content is currently being displayed and which provides an indication of a nature of said Internet content.
8. The method according to claim 1, wherein the image contains textual information advising the user to press a particular button on the remote control unit.
9. (Cancelled)
10. The method according to claim 5, further including:
- periodically accessing a web server for downloading said overlay-enabling digital data;
 - extracting from the overlay-enabling digital data said one or more second images and the respective web sites corresponding to each of said second images;
 - retrieving and storing digital content from said web sites; and
 - if the overlay activation criterion is met and a user command that is associated with an image from amongst said one or more second images is identified, displaying the respective image from amongst the second images, accessing the respective web site associated with the displayed image and extracting and buffering content from the website.
11. The method according to claim 5, further comprising displaying a respective IP content when a corresponding one of said one or more second images is selected.

12. The method according to claim 7, including selecting specific Internet content by pressing a color-coded button on a remote control in accordance with a color of said icon.

13. A TV-Internet Integration Box for generating at a user's premises an overlay using video signals constituting a first data and overlay-enabling digital data constituting a second data, the TV-Internet Integration Box comprising:

a combiner unit at [a] the user's premises coupled to a separate TV tuner box or TV tuner,

wherein the combiner unit is also connected through distinct networks to each of a video signal source providing video signals through the TV tuner box or TV tuner, and an Internet data source providing overlay-enabling digital data over the Internet, wherein

said video signals and said overlay-enabling digital data originate from unrelated sources and are transmitted to the user's premises by different resources as mutually distinct and independent inputs, and

wherein said overlay-enabling digital data includes at least:

a Web link indicating a website where content that is associated with said overlay-enabling digital data is stored;

an image indicative of the content associated with said overlay-enabling digital data; and

an overlay activation criterion, wherein

the combiner unit is responsive to an overlay activation criterion being met for generating a corresponding overlay, including:

generating at the user's premises a first display screen including at least a first portion corresponding to said video signals and a second portion overlaid over said first portion and corresponding at least to said image, and associating the Web link with said second portion of the first display screen thereby allowing a user to cause the combiner unit to retrieve said content, and generate a second video display screen including at least a portion which corresponds to said content; and a video output interface, coupled to or integrated within the combiner unit and configured to be coupled to a video input of said TV set and to display said first display screen or said second video display screen.

14. The TV-Internet Integration Box according to claim 13, wherein said overlay-enabling digital data is received at the user premises according to a pre-stored user-profile.

15. The TV-Internet Integration Box according to claim 13, further including:

a command input for receiving a command from [a] the user at said user premises; and a frame adjuster for resizing said first portion and/or said second portion of said first display screen in response to said command.

16. The TV-Internet Integration Box according to claim 13, further including:

a receiver for receiving a digital data stream, wherein the stream of the digital data is enabled by the content stored at said website; and a processing unit for pre-fetching and buffering said digital data stream from said website, thereby allowing said digital data stream to be displayed substantially without delay upon redirection by the user.

17. The TV-Internet Integration Box according to claim 13, wherein the overlay-enabling digital data comprises data representative of one or more second images, and for each of said one or more second images said overlay-enabling data comprises respective web site addresses where IP content associated with the respective second image is stored,

and wherein the combiner unit is configured to:

periodically access a web server for downloading said overlay-enabling digital data;

extract from the overlay-enabling digital data said one or more second images and the respective web sites corresponding to each of said second images;

retrieve and store digital content from said web sites; and

if the overlay activation criterion is met, and a user command that is associated with an image from amongst said one or more second images is identified, display the respective image from amongst the second images, access the respective web site associated with the displayed image and extract and buffer content from the website.

18. The TV-Internet Integration Box according to claim 13, wherein the image includes an icon that indicates to the user that digital data from Internet content is currently being displayed and which provides an indication of a nature of said Internet content.

19. The TV-Internet Integration Box according to claim 13, wherein the image contains textual information advising the user to press a particular button on the remote control unit.

20. (Cancelled)

21. The TV-Internet Integration Box according to claim 18, wherein the icon is colored so as to allow user selection of a specific Internet content by pressing a color-coded button on a remote control in accordance with a color of said icon.

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First Named Inventor/Applicant Name:	Yakkov MERLIN
Customer Number:	24392
Filer:	Tomas Prieto/Tammy Lightman
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1	Appeal Brief Filed	Appeal-Brief-01d-TVnGO1US1re-FILED.pdf	104710 30c47bc423630133b1285e83381f6f4769882dd8	no	23

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Please find below and/or attached an Office communication concerning this application or proceeding.

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

Application Number: 17/714,917
Filing Date: 6 Apr 2022
Appellant(s): TVNGO LTD. (BVI)

Tomas A. Prieto (Reg. No. 60,675)
For Appellant

EXAMINER'S ANSWER

This is in response to the Appeal Brief filed 10/27/2023 appealing from the Final Office Action mailed 03/06/2023 and the Advisory Action mailed 07/26/2023.

(1) Grounds of Rejection to be Reviewed on Appeal

Every ground of rejection set forth in the Advisory Action dated 07/26/2023 from which the Appeal is taken is being maintained by the Examiner except for the grounds of rejection (if any) listed under the subheading “WITHDRAWN REJECTIONS.” New grounds of rejection (if any) are provided under the subheading “NEW GROUNDS OF REJECTION.”

The following ground(s) of rejection are applicable to the appealed claims:

- I. Claims 1-8, 10-19, and 21 are rejected under 35 U.S.C. 112(b) or 35 U.S.C. 112 (pre-AIA), second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the inventor or a joint inventor, or for pre-AIA the applicant regards as the invention.

(2) Response to Argument

Appellant’s arguments filed 10/27/2023 have been fully considered but they are not persuasive.

1. Cancelling Claims 9 And 20 Resolves the Indefiniteness Issue Of Claims 1 And 13

The Appellant argues (Appeal Brief: pp. 5-9) that now-cancelled claims 9 and 20 of the Merlin ‘220 patent never recited “user command information”, and supposes that the District Court (DC) simply used the claims language of the Merlin ‘969 patent (U.S. Patent No. 9,407,969) and applied it to both the Merlin ‘969 patent and the Merlin ‘220 patent.

Appellant further argues that it is their understanding that the DC does not find an internal inconsistency within claim 1 and that as such, there is no uncertainty of the meaning of the terms of claim 1 in isolation. Appellant notes that it is also their understanding that claims 1 and 13 in isolation would be definite because the inconsistency (and thus indefiniteness) arises with dependent claims 9 and 20. Therefore, Appellant argues cancelling claim 9 is sufficient to break the link between the “overlay activation criterion” and the “user command information” created via claim 9. Finally, Appellant argues that with the cancellation of claim 9, there is no other way to link a possible interpretation of the “overlay activation criterion” of claim 1 as coming “not from the Internet” and thus the meaning of the term “overlay activation criterion” is consistent and definite. Consequently, Appellant notes that a skilled artisan would only discover the meaning of “overlay activation criterion” as coming “from the Internet” of independent claims 1 and 13.

The Examiner respectfully disagrees with the Appellant.

First, as acknowledged by Appellant, amended independent claims 1 and 13 at least maintain the virtually identical scope as their corresponding claims in the Merlin ‘220 patent which were determined to be invalid for indefiniteness by that District Court (see: Civil No. 18-10238 (RMB/KMW), Opinion (April 16, 2020)). That determination by the District Court was then affirmed by the CAFC (see: *TVnGO Ltd. v. LG Elecs. U.S.*, No. 2020-1837 (Fed. Cir. Jun. 28, 2021)). Therefore, amended independent claims 1 and 13 each still recite, “wherein said overly-enabling digital data includes...an overlay activation criterion” (emphasis added).

Second, the Examiner disagrees that now-cancelled claims 9 and 20 of the Merlin ‘220 patent never recited “user command information.” As shown below, representative dependent

claim 9 of the Merlin '220 patent (currently cancelled in the instant reissue proceeding) explicitly recited “user command information.”

9. The method according to claim 1, wherein said overlay activation criterion includes at least one of the following: a timing information, data specifying one or more TV subscriber channels, a user command information.

As noted in the Advisory Action, newly cancelled dependent claims 9 and 20 each now improperly present text of the cancelled claims (e.g., see: MPEP 1453(II)(C) and 1453(V)(B)). And as further shown below, the Examiner also notes that newly cancelled dependent claims 9 and 20 each now improperly exclude/remove the “a user command information” limitation.

9. (Cancelled) The method according to claim 1, wherein said overlay activation criterion includes at least one of the following: a timing information, data specifying one or more TV subscriber channels.

(Current Entered Claim Set – Filed 06/02/2023)

9. (twice amended) The method according to claim 1, wherein said overlay activation criterion includes at least one of the following: a timing information or, data specifying one or more TV subscriber channels[, a user command information].

(Prior Entered Claim Set – Filed 01/20/2023)

Third, the Examiner notes that cancelling dependent claims 9 and 20 does not resolve the indefiniteness issue of independent claims 1 and 13. The term “overlay activation criterion”, as noted above, is still recited in each of independent claims 1 and 13, and it is the use of this term, in view of the intrinsic evidence (e.g., the claims, written description, prosecution history, etc.) on the meaning of said term in the record, that fails to inform a person of ordinary skill in the art of the claimed invention’s scope with reasonable certainty. That is to say, independent claims 1 and 13 are not only viewed in isolation as suggested by Appellant.

The CAFC noted that, “neither ‘overlay activation criterion’...has an ordinary meaning in the art...The patent record is also unhelpful. Neither phrase is mentioned, let alone defined, in the shared specification...the ‘limited information’ provided by the prosecution history isn’t enough to provide reasonable certainty here... This dearth of evidence leaves the skilled artisan unable to resolve the inconsistencies” (see: CAFC Decision, pp. 7-8). As further noted by the CAFC, “overlay activation criterion” is an unknown and undefined phrase, and dependent claims 9 and 20 are one of the few sources of intrinsic evidence on the meaning of “overlay activation criterion” on the record. Therefore, cancelling dependent claims 9 and 20 does not eliminate this vital intrinsic evidence (see: CAFC Decision, p. 10: “the intrinsic evidence presents...irreconcilably inconsistent information: the ‘220 and ‘969 [p]atents indicate that ‘overlay activation criterion’ comes from the Internet and simultaneously *not* from the Internet”)(underline emphasis added) from the prosecution history, and thus a skilled artisan would still discover the inconsistency which throws the meaning of “overlay activation criterion” into doubt. That is to say, the intrinsic evidence of at least the prosecution history remains and it would still be a source of confusion/inconsistency for the skilled artisan.

Finally, the Examiner notes that cancelling dependent claims 9 and 20 is not sufficient to break the link between the “overlay activation criterion” and the “user command information.” More specifically, even if dependent claims 9 and 20 were cancelled, a cancelled claim is not removed from the prosecution history and is consequently available for use in construing the remaining claims of the patent. Cancelled dependent claims can be used to construe an independent claim because the dependent claims are included in the prosecution history, which becomes a part of the public record demonstrating Appellant/Patent Owner’s understanding of its

own claim terms. Thus, as noted above, a skilled artisan would still discover the inconsistency which throws the meaning of “overlay activation criterion” into doubt.

While not a necessary requirement, the above is especially true in reissue applications. If a reissue patent was issued from the instant reissue proceeding with dependent claims 9 and 20 cancelled, said claims would not vanish from the published reissue patent as intimated by Appellant. Rather, the entirety of cancelled dependent claims 9 and 20 would merely be printed in the newly published reissue patent surrounded by brackets (e.g., see: MPEP 1453(IV)) to indicate their deletion.

2. Cancelling Claims 9 And 20 In View Of The Rejection Under 35 U.S.C. 112 (pre-AIA), Second Paragraph

The Appellant generally argues (Appeal Brief: pp. 9-11) that cancelling dependent claims 9 and 20 effectively removes them from a reissued patent such that the link discussed that gives rise to the inconsistency and subsequently the indefiniteness no longer exists for the skilled artisan to find. Appellant argues that after a claim is canceled during prosecution, the issued patent (or reissued patent) is read as if the cancelled claim never existed.

The Appellant further argues that if this application were to proceed to a reissued patent, a person reading the prosecution history would have access to the entire prosecution history and the reader would not see cancelled claims 9 and 20 within the patent document itself. Thus, Appellant argues that there would be no confusion created by the text of the reissued patent document, and a reader of the patent and the prosecution history would not find the inconsistency within the claims to exist and would clearly understand the metes and bounds of the claims. To buttress this point, the Appellant appears to attempt to affirmatively disclaim/disavow claim

scope related to the “overlay activation criterion” limitation in the instant reissue prosecution history.

The Examiner respectfully disagrees with the Appellant.

The Examiner notes that the use of “overlay activation criterion” in dependent claims 9 and 20 in a way that contradicts the use of “overlay activation criterion” in the independent claims prevents reasonable certainty. As pointed out by the CAFC, “one of ordinary skill would lack reasonable certainty as to the source of an ‘overlay activation criterion’ – whether the internet or a user’s premises” (see: CAFC Decision, p. 10). And as noted above, dependent claims 9 and 20 are one of the few sources of intrinsic evidence on the meaning of “overlay activation criterion” in the record. That is to say, “neither ‘overlay activation criterion’...has an ordinary meaning in the art...The patent record is also unhelpful. Neither phrase is mentioned, let alone defined, in the shared specification...the ‘limited information’ provided by the prosecution history isn’t enough to provide reasonable certainty here...This dearth of evidence leaves the skilled artisan unable to resolve the inconsistencies” (see: CAFC Decision, pp. 7-8).

Even if dependent claims 9 and 20 were cancelled, a cancelled claim is not removed from the prosecution history and is consequently available for use in construing the remaining claims of the patent. Cancelled dependent claims can be used to construe an independent claim because the dependent claims are included in the prosecution history, which becomes a part of the public record demonstrating Appellant/Patent Owner’s understanding of its own claim terms. Thus, as noted above, a skilled artisan would still discover the inconsistency which throws the meaning of “overlay activation criterion” into doubt.

And the Appellant is incorrect regarding what a reader would see if this application were to proceed to a reissued patent. The reader would explicitly see cancelled claims 9 and 20 within the patent document itself. As noted above, if a reissue patent was issued from the instant reissue proceeding with dependent claims 9 and 20 cancelled, said claims would not vanish from the published reissue patent as intimated by Appellant. Rather, the entirety of cancelled dependent claims 9 and 20 would merely be printed in the newly published reissue patent surrounded by brackets (e.g., see: MPEP 1453(IV)) to indicate their deletion.

Appellant's arguments as to the proper metes and bounds of independent claims 1 and 13 do not supersede one of the few sources of intrinsic evidence on the meaning of "overlay activation criterion" already in the record. In fact, this issue appears to have been generally addressed in the Decision by the CAFC (see: CAFC Decision, p. 10: "For its part, TVnGO asserts that an overlay activation criterion 'comes from the Internet,' ... This distinction lacks intrinsic support").

Dear Reader of the Prosecution History: Claims 9 and 20 are cancelled herein because it is Appellant's intent to remove any possible interpretation of the "overlay activation criterion" as coming from the user's premises (i.e., not from the internet).

Additionally, Appellant's above statement disclaiming/disavowing claim scope related to the "overlay activation criterion" limitation cannot override the claim language itself, which controls the bounds of the claim, and the intrinsic evidence already in the record. Further, Appellant's above statement disclaiming/disavowing claim scope related to the "overlay activation criterion" limitation is not binding on the Office in the instant reissue proceeding.

3. Cancelling Claims 9 And 20 In View Of The DC And CAFC Rulings

The Appellant generally argues (Appeal Brief: pp. 11-14) that the CAFC is not declaring that dependent claims cannot be cancelled to address the indefiniteness. More specifically, the Appellant points out that the CAFC decision does not actually say anything about cancelling the claims and notes that invalidating the claims at the trial level is not the same as cancelling the claims during a USPTO proceeding or process (such as a reissue application prosecution or a disclaimer). Appellant further argues that the CAFC is stating that as long as the indefinite dependent claims remain in the text of the patent, then the independent claims must also be indefinite because the text of claims 9 and 20 help inform the reader of the possible meanings of the terms in claims 1 and 13, respectively. Thus, Appellant argues that cancelling dependent claims 9 and 20 does not contradict the DC or the CAFC decisions.

The Examiner both agrees and disagrees with the Appellant.

First, the Examiner notes that a final holding of claim invalidity or unenforceability (after all appeals) is binding/controlling on the Office. Here, amended independent claims 1 and 13 at least maintain the virtually identical scope as found indefinite by the District Court and affirmed by the CAFC. Aside from Appellant arguments, independent claims 1 and 13 have not been amended in a substantive way and there has not been a sufficient showing of facts not previously considered in the record.

Second, to be clear, the Examiner is not saying that dependent claims 9 and 20 cannot be cancelled or otherwise removed from the text of the Merlin '220 patent. And the Examiner agrees that the CAFC decision does not say anything about cancelling the claims. Likewise, it is also noted that the CAFC made no determination on whether or not independent claims 1 and 13 would be deemed definite if dependent claims 9 and 20 were cancelled from the Merlin '220

patent. The Examiner appreciates the distinction between invalidating claims at the trial level and cancelling claims during a USPTO proceeding. However, as discussed above, cancelling or otherwise removing dependent claims 9 and 20 from the text of the Merlin '220 patent would not overcome the indefiniteness rejection under 35 U.S.C. 112 (pre-AIA), second paragraph.

It is noted that the referenced arguments by TVnGO appeared to hinge on the idea that the “scope of the independent claim whose meaning is clear on its face” or “[W]here the scope of the independent claim is clear.” However, as determined by the CAFC, when all the intrinsic evidence is properly evaluated the scope of independent claims 1 and 13 is not clear and thus the claims are invalid for indefiniteness.

4. Scope Of The Claims

The Appellant generally argues (Appeal Brief: p. 14) that the scope of the claims is not enlarged because the claims are fundamentally unchanged. More specifically, Appellant notes that independent claims 1 and 13, as currently presented, are substantially identical to those issued in the Merlin '220 patent and do not change the scope from the claims in the Merlin '220 patent. Finally, Appellant expresses confusion as to how a hypothetical rejection related to claim scope broadening could be rationally supported given that the Examiner recognizes that the scope of the current independent claims is identical to those of the claims rejected by the DC and affirmed by the CAFC.

The Examiner both agrees and disagrees with the Appellant.

First, similar to the above discussion, the Examiner agrees that amended independent claims 1 and 13 at least maintain virtually identical scope as their corresponding claims in the

Merlin '220 patent that were found indefinite by the District Court and affirmed by the CAFC.

Therefore, the scope of amended independent claims 1 and 13 are not enlarged because said claims are fundamentally unchanged. That is to say, amended independent claims 1 and 13 still present irreconcilable inconsistencies (i.e., the “overlay activation criterion” indicating that it comes from the Internet and simultaneously not from the Internet (i.e., from a user’s premises)) that render their precise meanings not reasonably certain.

Second, in the hope of alleviating confusion and making the record clearer, the Examiner will further clarify the cited statement from the Advisory Action. The Examiner’s position is that if the Appellant were correct, based on Appellant’s general argument (i.e., “A reissue patent without cancelled claims 9 and 20 would no longer have a source of confusion/inconsistency...the skilled artisan would only discover the meaning of ‘overlay activation criterion’ as coming ‘from the Internet’...intended to exclude the possibility that the claims could be interpreted to mean that the ‘overlay activation criterion’ could come from the user’s premises”) and the cancelling of dependent claims 9 and 20, then the scope of amended independent claims 1 and 13 would indeed be changed. In that case, independent claims 1 and 13 found indefinite by the District Court, and subsequently affirmed as indefinite by the CAFC, would now be definite in light of the disclosure of the Merlin ‘220 patent.

However, as previously noted (e.g., see: Final Action, pp. 4-6 – citing *Ex parte Adams*, Appeal 2007-0441 (March 14, 2007)), this would be considered an enlarging of the scope of the claims (e.g., see: MPEP 1412.03(I) - “For example, if any amended or newly added claim in the reissue contains within its scope any conceivable product or process which would not have infringed the patent, then that reissue claim would be broader than the patent claims...A claim which covers something that the original claims do not is a broadened claim. A claim would be

considered a broadening claim if the patent owner would be able to sue any party for infringement who previously could not have been sued for infringement”) of the Merlin ‘220 patent which would be improper since the instant reissue application was filed more than two years after the Merlin ‘220 patent issued. At the simplest level, the scope of amended independent claims 1 and 13 would be considered enlarged because (1) the “overlay activation criterion” limitation would be limited to only coming “from the Internet” instead of coming “from the Internet” and simultaneously “not from the Internet” (i.e., the scope going from A + not A to merely A)(e.g., see: CAFC Decision, p. 10: “the intrinsic evidence presents...irreconcilably inconsistent information: the ‘220 and ‘969 [p]atents indicate that ‘overlay activation criterion’ comes from the Internet and simultaneously *not* from the Internet”) and (2) their claim scope would go from indefinite (see above) to definite and thus said claims would cover something that the original claims did not (e.g., the Patent Owner would now be able to sue parties for infringement who previously could not have been sued for infringement).

It is noted that in the Advisory Action the Examiner withdrew the rejection of all claims under 35 U.S.C. 251 for improper claim broadening because the Examiner generally agreed with Appellant that the scope of amended independent claims 1 and 13 is at least identical to the scope of their corresponding claims in the Merlin ‘220 patent. In light of that determination of claim scope, it would have been improper to maintain any rejection under 35 U.S.C. 251 related to claim scope broadening. Thus, while there is no current rejection under 35 U.S.C. 251 for improper claim broadening, the Examiner would appreciate the Board’s commentary on this hypothetical issue. That is to say, if the Board ultimately agrees with the Appellant that the rejection under 35 U.S.C. 112 (pre-AIA), second paragraph, is improper and should be withdrawn, would the now definite claims, in light of the claim scope fact pattern discussed

above, be considered improper claim broadening in view of the previously cited informative PTAB decision (see: *Ex parte Adams*, Appeal 2007-0441 (March 14, 2007))? It is the Examiner's belief that addressing this hypothetical issue would be beneficial to the both the Examiner and the Appellant, and would lead to improved compact prosecution upon the Board's forthcoming decision.

Third, the Examiner notes that disclaiming/disavowing claim scope (i.e., altering claim scope) related to the "overlay activation criterion" limitation without substantively amending the language of independent claims 1 and 13 appears to be precisely what Appellant is attempting to accomplish in the instant reissue application. That is to say, Appellant attempts to exclude the possibility that the claims could be interpreted to mean that the "overlay activation criterion" could come from a user's premises by providing the following statement disclaiming/disavowing claim scope related to the "overlay activation criterion" limitation:

Dear Reader of the Prosecution History: Claims 9 and 20 are cancelled herein because it is Appellant's intent to remove any possible interpretation of the "overlay activation criterion" as coming from the user's premises (i.e., not from the internet).

As noted above, said statement is not binding on the Office in the instant reissue proceeding.

5. The Purpose Of The Reissue Process

The Appellant generally argues (Appeal Brief: pp. 15-16) that while the issue raised by the DC and CAFC in this situation is not an antecedent basis issue, the courts have ruled on the possibility of using reissue to correct issues that could give rise to indefiniteness. Therefore, Appellant further argues that because the scope of the independent claims is unchanged, a holding of indefiniteness should be correctable via reissue, which is in line with the whole purpose of the reissue process.

The Examiner both agrees and disagrees with the Appellant.

The Examiner initially agrees, as discussed above, that amended independent claims 1 and 13 at least maintain virtually identical scope as their corresponding claims in the Merlin '220 patent that were found indefinite by the District Court and affirmed by the CAFC. Therefore, while it does not resolve the indefiniteness rejection under 35 U.S.C. 112 (pre-AIA), second paragraph, the cancellation of dependent 9 and 20 is not precluded in the instant reissue application.

However, as previously noted, changing the meaning of “overlay activation criterion” to only come “from the Internet” would not be simply correcting an antecedent basis issue that does not meaningfully change the scope of the claims. In fact, as recognized by Appellant, this situation is not a basic antecedent basis issue. And while the reissue process allows for a vast array of errors to be corrected in a patent (see: MPEP 1402), the Examiner notes that 35 U.S.C. 251 imposes strict limits (see: MPEP 1412.03) related to a “broadened reissue claim” when a reissue application is filed after two years from the grant of the original patent (e.g., see: Informative Decision - *Ex parte Adams*, Appeal 2007-0441 (March 14, 2007) which is related to attempting to change indefinite patent claims with substantially similar “irreconcilable inconsistencies” in a reissue application filed more than two years after the patent issued). Unfortunately for Appellant, the instant reissue application was filed more than two years after the Merlin '220 patent issued. Thus, Appellant’s options in the instant reissue proceeding are strictly limited.

Conclusion

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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Supervisory Patent Examiner, Art Unit 3992

Requirement to pay appeal forwarding fee. In order to avoid dismissal of the instant appeal in any application or ex parte reexamination proceeding, 37 CFR 41.45 requires payment of an appeal forwarding fee within the time permitted by 37 CFR 41.45(a), unless appellant had timely paid the fee for filing a brief required by 37 CFR 41.20(b) in effect on March 18, 2013.

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PATENT APPLICATION FEE DETERMINATION RECORD Substitute for Form PTO-875				Application or Docket Number 17/714,917		Filing Date 04/06/2022		☐ To be Mailed		
ENTITY: ☐ LARGE ☒ SMALL ☐ MICRO										
APPLICATION AS FILED - PART I										
		(Column 1)			(Column 2)					
FOR		NUMBER FILED			NUMBER EXTRA			RATE (\$)	FEE (\$)	
☐ BASIC FEE (37 CFR 1.16(a), (b), or (c))		N/A			N/A			N/A		
☐ SEARCH FEE (37 CFR 1.16(k), (i), or (m))		N/A			N/A			N/A		
☐ EXAMINATION FEE (37 CFR 1.16(o), (p), or (q))		N/A			N/A			N/A		
TOTAL CLAIMS (37 CFR 1.16(i))		minus 20 = *						x \$50 =		
INDEPENDENT CLAIMS (37 CFR 1.16(h))		minus 3 = *						x \$240 =		
☐ APPLICATION SIZE FEE (37 CFR 1.16(s))		If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$310 (\$155 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).								
☐ MULTIPLE DEPENDENT CLAIM PRESENT (37 CFR 1.16(j))										
* If the difference in column 1 is less than zero, enter "0" in column 2.						TOTAL				
APPLICATION AS AMENDED - PART II										
		(Column 1)			(Column 2)			(Column 3)		
AMENDMENT	04/15/2024	CLAIMS REMAINING AFTER AMENDMENT			HIGHEST NUMBER PREVIOUSLY PAID FOR			PRESENT EXTRA	RATE (\$)	ADDITIONAL FEE (\$)
	Total (37 CFR 1.16(i))	* 18	Minus	** 21	= 0			x \$40 =	0	
	Independent (37 CFR 1.16(h))	* 2	Minus	*** 3	= 0			x \$192 =	0	
	☐ Application Size Fee (37 CFR 1.16(s))									
	☐ FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(j))									
								TOTAL ADD'L FEE	0	
AMENDMENT		CLAIMS REMAINING AFTER AMENDMENT			HIGHEST NUMBER PREVIOUSLY PAID FOR			PRESENT EXTRA	RATE (\$)	ADDITIONAL FEE (\$)
	Total (37 CFR 1.16(i))	*	Minus	**	=			x \$0 =		
	Independent (37 CFR 1.16(h))	*	Minus	***	=			x \$0 =		
	☐ Application Size Fee (37 CFR 1.16(s))									
	☐ FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(j))									
								TOTAL ADD'L FEE		
* If the entry in column 1 is less than the entry in column 2, write "0" in column 3.								LIE		
** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 20, enter "20".								/RHONDA BELL/		
*** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 3, enter "3".										
The "Highest Number Previously Paid For" (Total or Independent) is the highest number found in the appropriate box in column 1.										

This collection of information is required by 37 CFR 1.16. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**
If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

AMENDMENTS TO THE CLAIMS

This listing of claims represents the current version of claims before the Office with amendments to be entered:

1. (thrice amended) A method for generating at a user's premises an overlay using video signals constituting a first data and overlay-enabling digital data constituting a second data, the method comprising:

(a) providing a combiner unit at the user's premises, wherein:

the combiner unit is coupled to a TV set and connected to a separate TV tuner box or TV tuner in the TV set, at the user's premises, and

the combiner unit is also connected through distinct networks to each of a video signal source providing video signals through the TV tuner box or TV tuner in the TV set, and an Internet data source providing overlay-enabling digital data over the Internet,

wherein said video signals and said overlay-enabling digital data originate from unrelated sources and are transmitted to the user's premises by different resources as mutually distinct and independent inputs,

and wherein said overlay-enabling digital data includes at least:

a Web link indicating a website where content that is associated with said overlay-enabling digital data is stored,

an image indicative of the content associated with said overlay-enabling digital data, and

an overlay activation criterion; and

(b) processing at the user's premises said overlay-enabling digital data and generating at the user's premises a corresponding overlay only if said overlay activation criterion is met, wherein generating [an] the overlay includes:

generating at the user's premises a first display screen including at least a first portion corresponding to said video signals and a second portion overlaid over said first portion and corresponding at least to said image, and

associating the Web link with said second portion of the first display screen thereby allowing a user to cause the combiner unit to retrieve said content, generate a second video display screen including at least a portion which corresponds to said content, and input the second display screen to said TV set.

2. (original) The method according to claim 1, wherein said overlay-enabling digital data is received at the user premises according to a pre-stored user profile.
3. (twice amended) The method according to claim 1, further including: receiving a command from [a] the user at said user premises; and responsive to said command, resizing said first portion and/or said second portion of said first display screen.
4. (original) The method according to claim 1, wherein the content stored at said website enables streaming of digital data over the Internet; and
said method further including: pre-fetching and buffering said digital data stream from said website, thereby allowing said digital data stream to be displayed substantially without delay upon redirection by the user.
5. (twice amended) The method according to claim 1, wherein the overlay-enabling digital data comprises data representative of one or more second images, and for each of said one or more second images said overlay-enabling data comprises respective web site addresses where IP content associated with the respective second image is stored, and wherein said generating [an] the overlay further includes within said first display said one or more second images.
6. (original) The method according to claim 1, wherein the overlay-enabling digital data is supplementary or complementary to the video signals.
7. (original) The method according to claim 1, wherein the image includes an icon that indicates to the user that digital data from Internet content is currently being displayed and which provides an indication of a nature of said Internet content.
8. (original) The method according to claim 1, wherein the image contains textual information advising the user to press a particular button on the remote control unit.

9. (Cancelled) The method according to claim 1, wherein said overlay activation criterion includes at least one of the following: a timing information, data specifying one or more TV subscriber channels.

10. (original) The method according to claim 5, further including:

periodically accessing a web server for downloading said overlay-enabling digital data; extracting from the overlay-enabling digital data said one or more second images and the respective web sites corresponding to each of said second images; retrieving and storing digital content from said web sites; and if the overlay activation criterion is met and a user command that is associated with an image from amongst said one or more second images is identified, displaying the respective image from amongst the second images, accessing the respective web site associated with the displayed image and extracting and buffering content from the website.

11. (original) The method according to claim 5, further comprising displaying a respective IP content when a corresponding one of said one or more second images is selected.

12. (original) The method according to claim 7, including selecting specific Internet content by pressing a color-coded button on a remote control in accordance with a color of said icon.

13. (thrice amended) A TV-Internet Integration Box for generating at a user's premises an overlay using video signals constituting a first data and overlay-enabling digital data constituting a second data, the TV-Internet Integration Box comprising:

a combiner unit at [a] the user's premises coupled to a separate TV tuner box or TV tuner,

wherein the combiner unit is also connected through distinct networks to each of a video signal source providing video signals through the TV tuner box or TV tuner, and an Internet data source providing overlay-enabling digital data over the Internet, wherein

said video signals and said overlay-enabling digital data originate from unrelated sources and are transmitted to the user's premises by different resources as mutually distinct and independent inputs, and

wherein said overlay-enabling digital data includes at least:

- a Web link indicating a website where content that is associated with said overlay-enabling digital data is stored;
 - an image indicative of the content associated with said overlay-enabling digital data;
 - and
 - an overlay activation criterion, wherein
- the combiner unit is responsive to an overlay activation criterion being met for generating a corresponding overlay, including:
- generating at the user's premises a first display screen including at least a first portion corresponding to said video signals and a second portion overlaid over said first portion and corresponding at least to said image, and
 - associating the Web link with said second portion of the first display screen thereby allowing a user to cause the combiner unit to retrieve said content, and
 - generate a second video display screen including at least a portion which corresponds to said content; and
- a video output interface, coupled to or integrated within the combiner unit and configured to be coupled to a video input of said TV set and to display said first display screen or said second video display screen.

14. (original) The TV-Internet Integration Box according to claim 13, wherein said overlay-enabling digital data is received at the user premises according to a pre-stored user-profile.

15. (twice amended) The TV-Internet Integration Box according to claim 13, further including:

- a command input for receiving a command from [a] the user at said user premises;
- and a frame adjuster for resizing said first portion and/or said second portion of said first display screen in response to said command.

16. (original) The TV-Internet Integration Box according to claim 13, further including:

- a receiver for receiving a digital data stream, wherein the stream of the digital data is enabled by the content stored at said website; and

a processing unit for pre-fetching and buffering said digital data stream from said website, thereby allowing said digital data stream to be displayed substantially without delay upon redirection by the user.

17. (original) The TV-Internet Integration Box according to claim 13, wherein the overlay-enabling digital data comprises data representative of one or more second images, and for each of said one or more second images said overlay-enabling data comprises respective web site addresses where IP content associated with the respective second image is stored,

and wherein the combiner unit is configured to:

periodically access a web server for downloading said overlay-enabling digital data;

extract from the overlay-enabling digital data said one or more second images and the respective web sites corresponding to each of said second images;

retrieve and store digital content from said web sites; and

if the overlay activation criterion is met, and a user command that is associated with an image from amongst said one or more second images is identified, display the respective image from amongst the second images, access the respective web site associated with the displayed image and extract and buffer content from the website.

18. (original) The TV-Internet Integration Box according to claim 13, wherein the image includes an icon that indicates to the user that digital data from Internet content is currently being displayed and which provides an indication of a nature of said Internet content.

19. (original) The TV-Internet Integration Box according to claim 13, wherein the image contains textual information advising the user to press a particular button on the remote control unit.

20. (Cancelled)

21. (original) The TV-Internet Integration Box according to claim 18, wherein the icon is colored so as to allow user selection of a specific Internet content by pressing a color-coded button on a remote control in accordance with a color of said icon.

AMENDMENTS TO THE SPECIFICATION

Please replace the paragraph beginning at column 4, line 19 with the following:

FIG. 3 is a flow diagram showing the principal actions carried out by the TV-Internet Integration Box 16. In accordance with one embodiment of the invention, the subscriber selects what kind of IP content he wishes to receive and in respect of which program details, such as icons and/or textual data, are to be displayed together with the TV broadcast data. For example, a subscriber may wish to block certain types of program material or may wish to receives details thereof only during limited hours, for example when the children are asleep. To this end, the subscriber is able to program the TV-Internet Integration Box 16 in much the same way that a video cassette recorder is programmed so as to store in the memory [25] 26 a timetable indicating what type of IP data is to be displayed and when. The timetable is updated as and when required by the subscriber. The TV-Internet Integration Box 16 is adapted to check the timetable periodically and to filter out incoming IP content that is either of a type that is not required or that is broadcast during an unauthorized time window. By such means, an additional layer of authorization may be provided to that stored in the database 19 for access by the web server 14, thus allowing pre-fetching of IP content and storage in the memory [25] 26 of the TV-Internet Integration Box 16. Upon detecting a matching event, corresponding to received IP content that is of interest to the subscriber, the TV-Internet Integration Box 16 overlays the matched IP content with the current broadcast and displays the new integrated video on the subscriber's TV set 17. For example, the matched information may be an icon that indicates to the subscriber that an Internet movie is currently being broadcast; or it may be an advertisement or information related to the TV program being broadcast.

REMARKS/ARGUMENTS

The Final Office Action mailed on or about March 6, 2023 (“2023 March Final”) has been carefully considered. The Advisory Action mailed on or about July 26, 2023 (“2023 July AA”) has also been carefully considered.

In response claims 2, 4, 6-8, 10-12, 14, 16-19, and 21 are original relative to the subject patent to be reissued. Claims 10 and 17 are amended to return to their original state relative to the subject patent to be reissued. Claims 3, 5, 15 are amended as submitted in the preliminary amendment relative to the subject patent to be reissued. Claims 1, 9, 13, and 20 are twice amended. No new matter is added.

This application was appealed, and an Appellant’s Brief and Examiner’s Answer entered. This RCE has been filed prior to the filing of a reply brief or forwarding to the PTAB.

Notice of Related Litigation and Request for Expedited “Special” Handling

Patent US 8,132,220 (“the ‘220 Patent”) was the subject of litigation in the District of New Jersey as well as an appeal to the Federal Circuit. Orders from both courts rendered claims 1, 9, 10, 13, 17, and 20 of the ‘220 Patent invalid as indefinite. The District of New Jersey matter is Civil No. 18-10238 (RMB/KMW). The Federal Circuit matter is Case 20-1837. Pursuant to MPEP 1442, Applicant respectfully requests this matter be taken up for action in advance of other reissue applications.

Examiner’s Interview

The Applicant’s representative, Tomás A. Prieto, and Examiner Adam L Basehoar, held a telephonic interview on May 23, 2023 (2023 May Interview) to discuss this application as well as pending reissue application 17/867,612 (“the ‘612 Application”). During the interview the parties discussed the rejections under 35 USC 251 and 35 USC 112, 2nd paragraph. The parties also briefly discussed the *ex parte Adams* PTAB decision cited in the 2023 March Final. Examiner Basehoar provided additional insight into his rationale in issuing the rejection in view of the prior litigation of the applications and the cited PTAB decision. No agreements were reached.

Applicant wishes to thank Examiner Basehoar for granting the interview and for his consideration in providing additional information and insights.

Claim Amendments

Claims 2, 4, 6-8, 10-12, 14, 16-19, and 21 are original relative to the subject patent to be reissued. Claims 3, 5, 15 are twice amended as previously submitted in the preliminary amendment and Applicant's prior response relative to the subject patent to be reissued. Claims 1 and 13 are thrice amended. No new matter is added.

Cancelled Claims (Claims 9 and 20)

Pursuant to MPEP 1453(II), a claim to be cancelled should be cancelled by a direction to cancel the claims. As such:

Please cancel claims 9 and 20.

Amendments to the Specification

The Office previously objected to col. 4, ll. 31 and 40 for reciting an incorrect reference to the memory element of Fig. 3. The objection was then withdrawn following Applicant's response. Enclosed above are previously-presented amendments to the Specification that overcame the prior objections.

Claim Rejection – 35 USC § 251

The Office rejected claims 1-21 under 35 USC § 251 as being broadened in a reissue application filed outside the two-year statutory period. Applicant respectfully disagrees. Based on Applicant's arguments in the after-final response filed June 2, 2023, the Examiner withdrew the rejection in the 2023 July AA.

It is Applicant's understanding that the Examiner's position (as per the 2023 July AA) that, should the inconsistency giving rise to the rejections under 35 USC 112(b) be overcome via the cancellation of claims 9 and 20, then the Examiner would be forced to reintroduce the rejection under 35 USC 251 for broadening the claim scope outside of the permitted time frame.

If this understanding is correct, Applicant requests that the Examiner provide a rejection under 35 USC 251 in the alternative to the rejection under 35 USC 112(b). This way, Applicant can directly appeal this decision to the PTAB.

Claim Rejection – 35 USC § 112(b)

Claims 1 and 13 have been rejected under 35 USC 112, 2nd paragraph because the recitation of “overlay activation criterion” could be interpreted as both coming “from the Internet and simultaneously not from the Internet” (2023 March Final, page 8). This rejection appears to mirror the holding of invalidity of the claims at the District Court level (Civil No. 18-10238 (RMB/KMW), Opinion (April 16, 2020)) (“the District Court Decision”) and affirmed by the CAFC (*TVnGo Ltd v LG Elecs. U.S.*, No. 2020-1837 (Fed. Cir. Jun. 28, 2021)) (“the CAFC Decision”).

The District Court Decision identified an inconsistency between the recitation of “overlay activation criterion” in independent claims 1 and 13 and their respective dependent claims 9 and 20. Thus, the inconsistency is not in claims 1 and 13 alone, but rather in claim 1 when interpreted in combination with claim 9 and in claim 13 when interpreted in combination with claim 20. The inconsistency arises in that in claims 1 and 13, the “overlay activation criterion” is provided “over the Internet” whereas claims 9 and 20 state that the “user command information” may be a component of the “overlay activation criterion” and when the limitation of “user command information” is read in the context of the specification, the “user command information is “provided at the user’s premises and not over the Internet.”

In response, Applicants have now cancelled claims 9 and 20, such that there is no link between the “user command information” and the “overlay activation criterion”, thus resolving the ambiguity because the “overlay activation criterion” is no longer claimed to be originated “not from the Internet.” Thus, one of ordinary skill in the art would be appraised of the metes and bounds of the claim.

As to the dependent claims 9 and 20 specifically, the CAFC Decision states at page 11:

Further, merely dismissing the dependent claims as invalid, as TVnGo proposes, ignores that they are one of the few sources of intrinsic evidence on the meaning of “overlay

activation criterion” in this record. When faced with this unknown and undefined phrase, a skilled artisan would look for clarification not only in the specification but also in “[o]ther claims of the patent in question,” which “can also be valuable sources of enlightenment as to the meaning of a claim term.” Phillips, 415 F.3d at 1314. Here, however, he or she would discover an inconsistency, throwing the meaning of “overlay activation criterion” into doubt. These dependent claims are intrinsic evidence. Arguing that they are invalid does not change that.

In this section, the CAFC is not indicating that the dependent claims must stay as they are and can never be amended or cancelled to remove the recitation of “overlay activation criterion.” Rather, in this section the CAFC is responding to the possibility that the dependent claims be held invalid does not remedy the inconsistency issue. This is because as long as the recitation of “overlay activation criterion” remains in claims 9 and 20, the inconsistency with respective claims 1 and 13 continues to exist and as such the independent claims 1 and 13 will also be indefinite. In other words, even if the dependent claims are invalid with valid independent claims, the invalid dependent claims still remain as a part of the patent document and as such would be a source of inconsistency to the skilled artisan.

However, by cancelling claims 9 and 20, the link between the “overlay activation criterion” and the “user command information” is broken. A reissue patent without those claims would no longer have a source of confusion/inconsistency for the skilled artisan. Instead, the skilled artisan would only discover the meaning of “overlay activation criterion” as coming “from the Internet” of independent claims 1 and 13. The sections of the specification cited in the District Court Decision as related to the “user command information” would not raise the inconsistency either as there is nothing in these sections of the specification that would lead to the skilled artisan to interpret it as being related to the “overlay activation criterion.” The remaining dependent claims that recite “overlay activation criterion” are consistent with this interpretation.

For the reasons discussed above, it is Applicant’s position that the claims are definite. As such, Applicant respectfully requests withdrawal of the rejections under 35 USC 112, 2nd paragraph.

Request for Allowance

Claims 1-8, 10-19 and 21 are pending in this application. Applicant requests allowance of all pending claims.

Respectfully submitted,
Fish IP Law, LLP

Date: April 15, 2024

By: /Tomas A. Prieto/
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UNITED STATES
PATENT AND TRADEMARK OFFICE

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ELECTRONIC PAYMENT RECEIPT

APPLICATION #
17/714,917

RECEIPT DATE / TIME
04/15/2024 08:22:16 PM Z ET

ATTORNEY DOCKET #
103692.0001US1re

Title of Invention

Method And Apparatus For Facilitating Toggling Between Internet And TV Broadcasts

Application Information

APPLICATION TYPE Utility - Reissue

PATENT # -

CONFIRMATION # 6111

FILED BY Tomas Prieto

PATENT CENTER # 65103357

AUTHORIZED BY -

CUSTOMER # 24392

FILING DATE 04/06/2022

CORRESPONDENCE
ADDRESS -

FIRST NAMED
INVENTOR Yakkov MERLIN

Payment Information

PAYMENT METHOD
CARD / 9363

PAYMENT TRANSACTION ID
E20244EK23299926

PAYMENT AUTHORIZED BY
Tomas Prieto

FEE CODE	DESCRIPTION	ITEM PRICE(\$)	QUANTITY	ITEM TOTAL(\$)
2801	REQUEST FOR CONTINUED EXAMINATION (RCE) - 1ST REQUEST (SEE 37 CFR 1.114)	544.00	1	544.00
TOTAL AMOUNT:				\$544.00

This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.

New Applications Under 35 U.S.C. 111

If a new application is being filed and the application includes the necessary components for filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application

National Stage of an International Application under 35 U.S.C. 371

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

New International Application Filed with the USPTO as a Receiving Office

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450**

Appl No.: 17/714,917
Inventor: Yakkov Merlin
Filing Date: April 6, 2022
Art Unit: 3992
Examiner: Basehoar, Adam L.
Attorney Docket No.: 103692.0001USre1

Title Method and Apparatus for Facilitating Toggling
Between Internet and TV Broadcasts

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

REQUEST FOR CONTINUED EXAMINATION

Sir:

This paper responds to the Final Office Action dated March 6, 2023 and Advisory Action dated July 26, 2023, and is filed concurrent with a Request for Continued Examination. Please enter the amendments shown herein.

- Claim Amendments begin on page 2.
- Specification Amendments begin on page 7.
- Remarks begin on page 8.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Request for Continued Examination (RCE) Transmittal

Address to:
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Application Number	17/714,917
Filing Date	April 6, 2022
First Named Inventor	Yakkov MERLIN
Art Unit	3992
Examiner Name	Adam L. Basehoar
Attorney Docket Number	103692.0001US1re

This is a Request for Continued Examination (RCE) under 37 CFR 1.114 of the above-identified application.

Request for Continued Examination (RCE) practice under 37 CFR 1.114 does not apply to any utility or plant application filed prior to June 8, 1995, or to any design application. See Instruction Sheet for RCEs (not to be submitted to the USPTO) on page 2.

1. **Submission required under 37 CFR 1.114** Note: If the RCE is proper, any previously filed unentered amendments and amendments enclosed with the RCE will be entered in the order in which they were filed unless applicant instructs otherwise. If applicant does not wish to have any previously filed unentered amendment(s) entered, applicant must request non-entry of such amendment(s).

a. ☐ Previously submitted. If a final Office action is outstanding, any amendments filed after the final Office action may be considered as a submission even if this box is not checked.

i. ☒ Consider the arguments in the Appeal Brief or Reply Brief previously filed on October 27, 2023

ii. ☐ Other _____

b. ☒ Enclosed

i. ☒ Amendment/Reply

iii. ☐ Information Disclosure Statement (IDS)

ii. ☐ Affidavit(s)/ Declaration(s)

iv. ☐ Other _____

2. Miscellaneous

a. ☐ Suspension of action on the above-identified application is requested under 37 CFR 1.103(c) for a period of _____ months. (Period of suspension shall not exceed 3 months; Fee under 37 CFR 1.17(i) required)

b. ☐ Other _____

3. Fees

The RCE fee under 37 CFR 1.17(e) is required by 37 CFR 1.114 when the RCE is filed.

a. ☒ The Director is hereby authorized to charge the following fees, any underpayment of fees, or credit any overpayments, to Deposit Account No. 500341.

i. ☒ RCE fee required under 37 CFR 1.17(e)

ii. ☐ Extension of time fee (37 CFR 1.136 and 1.17)

iii. ☐ Other _____

b. ☐ Check in the amount of \$ _____ enclosed

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d. ☐ Payment by USPTO patent electronic filing system.

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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED

Signature	/Tomas A Prieto/	Date	April 15, 2024
Name (Print/Type)	Tomas A. Prieto	Registration No.	60,675

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Signature	/Tomas A. Prieto/	Date	April 15, 2024
Name (Print/Type)	Tomas A. Prieto	Date	April 15, 2024

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ELECTRONIC ACKNOWLEDGEMENT RECEIPT

APPLICATION #
17/714,917

RECEIPT DATE / TIME
04/15/2024 08:22:16 PM Z ET

ATTORNEY DOCKET #
103692.0001US1re

Title of Invention

Method And Apparatus For Facilitating Toggling Between Internet And TV Broadcasts

Application Information

APPLICATION TYPE Utility - Reissue

PATENT # -

CONFIRMATION # 6111

FILED BY Tomas Prieto

PATENT CENTER # 65103357

FILING DATE 04/06/2022

CUSTOMER # 24392

FIRST NAMED INVENTOR
Yakkov MERLIN

CORRESPONDENCE ADDRESS -

AUTHORIZED BY -

Documents

TOTAL DOCUMENTS: 3

DOCUMENT	PAGES	DESCRIPTION	SIZE (KB)
2024-04-15 - Transmittal Form - sb0030.pdf	1	Request for Continued Examination (RCE)	391 KB
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Response 2024-04-15 vers-02c_RCE - to_2023-03-06__cover page.pdf	1	Transmittal Letter	18 KB
Response 2024-04-15 vers-02c_RCE - to_2023-03-06_Final_TVnGo_1US1re wo cover-APP.TEXT.docx	11	Application body structured text document	34 KB

Warning: Bookmarks were found and have been removed. The claims appear to contain duplicate claim numbering. Please review and revise if necessary. At least one claim number appears to be missing or out of order. Please review and revise if necessary. The claim status identifier is not valid. Please review and revise if necessary. Dynamic dates have been converted to static dates.

Digest

DOCUMENT	MESSAGE DIGEST(SHA-512)
2024-04-15 - Transmittal Form - sb0030.pdf	D627BD71A63654106D04A38B00B9DF838480EB65BBD9CF8CFD685E3BA8A7F58AFBB237509F4BC0AA60D23525CB43D4412D92162C24267BE922CF22011A5836D8
Response 2024-04-15 vers-02c_RCE - to_2023-03-06_cover page.pdf	32BCD1668FE119B67F373B0B996183160D8DBF0D99BF56BCE60AA5A4E5E10C7D754D02FD6B61A829F9CFF005B63EA78553F50A21382205CC846AFD582D4D10D7
Response 2024-04-15 vers-02c_RCE - to_2023-03-06_Final_TVnGo_1US1re wo cover-APP.TEXT.docx	2C503C1E5DEE0AF6C4B9A527D287B6470268B06BB9894D43A1341821CA7F88C80C784354B2E5DD19D8B19DE9DA60EFB59EE53EC5E0C2F0FD0245300710D3EEF2

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If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

New International Application Filed with the USPTO as a Receiving Office

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

AMENDMENTS TO THE CLAIMS

This listing of claims represents the current version of claims before the Office with amendments to be entered:

1. (thrice amended) A method for generating at a user's premises an overlay using video signals constituting a first data and overlay-enabling digital data constituting a second data, the method comprising:

(a) providing a combiner unit at the user's premises, wherein:

the combiner unit is coupled to a TV set and connected to a separate TV tuner box or TV tuner in the TV set, at the user's premises, and

the combiner unit is also connected through distinct networks to each of a video signal source providing video signals through the TV tuner box or TV tuner in the TV set, and an Internet data source providing overlay-enabling digital data over the Internet,

wherein said video signals and said overlay-enabling digital data originate from unrelated sources and are transmitted to the user's premises by different resources as mutually distinct and independent inputs,

and wherein said overlay-enabling digital data includes at least:

a Web link indicating a website where content that is associated with said overlay-enabling digital data is stored,

an image indicative of the content associated with said overlay-enabling digital data, and

an overlay activation criterion; and

(b) processing at the user's premises said overlay-enabling digital data and generating at the user's premises a corresponding overlay only if said overlay activation criterion is met, wherein generating [an] the overlay includes:

generating at the user's premises a first display screen including at least a first portion corresponding to said video signals and a second portion overlaid over said first portion and corresponding at least to said image, and

associating the Web link with said second portion of the first display screen thereby allowing a user to cause the combiner unit to retrieve said content, generate a second video display screen including at least a portion which corresponds to said content, and input the second display screen to said TV set.

2. (original) The method according to claim 1, wherein said overlay-enabling digital data is received at the user premises according to a pre-stored user profile.

3. (twice amended) The method according to claim 1, further including: receiving a command from [a] the user at said user premises; and responsive to said command, resizing said first portion and/or said second portion of said first display screen.

4. (original) The method according to claim 1, wherein the content stored at said website enables streaming of digital data over the Internet; and

said method further including: pre-fetching and buffering said digital data stream from said website, thereby allowing said digital data stream to be displayed substantially without delay upon redirection by the user.

5. (twice amended) The method according to claim 1, wherein the overlay-enabling digital data comprises data representative of one or more second images, and for each of said one or more second images said overlay-enabling data comprises respective web site addresses where IP content associated with the respective second image is stored, and wherein said generating [an] the overlay further includes within said first display said one or more second images.

6. (original) The method according to claim 1, wherein the overlay-enabling digital data is supplementary or complementary to the video signals.

7. (original) The method according to claim 1, wherein the image includes an icon that indicates to the user that digital data from Internet content is currently being displayed and which provides an indication of a nature of said Internet content.

8. (original) The method according to claim 1, wherein the image contains textual information advising the user to press a particular button on the remote control unit.

9. (Cancelled) The method according to claim 1, wherein said overlay activation criterion includes at least one of the following: a timing information, data specifying one or more TV subscriber channels.

10. (original) The method according to claim 5, further including:

periodically accessing a web server for downloading said overlay-enabling digital data; extracting from the overlay-enabling digital data said one or more second images and the respective web sites corresponding to each of said second images; retrieving and storing digital content from said web sites; and if the overlay activation criterion is met and a user command that is associated with an image from amongst said one or more second images is identified, displaying the respective image from amongst the second images, accessing the respective web site associated with the displayed image and extracting and buffering content from the website.

11. (original) The method according to claim 5, further comprising displaying a respective IP content when a corresponding one of said one or more second images is selected.

12. (original) The method according to claim 7, including selecting specific Internet content by pressing a color-coded button on a remote control in accordance with a color of said icon.

13. (thrice amended) A TV-Internet Integration Box for generating at a user's premises an overlay using video signals constituting a first data and overlay-enabling digital data constituting a second data, the TV-Internet Integration Box comprising:

a combiner unit at [a] the user's premises coupled to a separate TV tuner box or TV tuner,

wherein the combiner unit is also connected through distinct networks to each of a video signal source providing video signals through the TV tuner box or TV tuner, and an Internet data source providing overlay-enabling digital data over the Internet, wherein

said video signals and said overlay-enabling digital data originate from unrelated sources and are transmitted to the user's premises by different resources as mutually distinct and independent inputs, and

wherein said overlay-enabling digital data includes at least:

- a Web link indicating a website where content that is associated with said overlay-enabling digital data is stored;
 - an image indicative of the content associated with said overlay-enabling digital data;
 - and
 - an overlay activation criterion, wherein
- the combiner unit is responsive to an overlay activation criterion being met for generating a corresponding overlay, including:
- generating at the user's premises a first display screen including at least a first portion corresponding to said video signals and a second portion overlaid over said first portion and corresponding at least to said image, and
 - associating the Web link with said second portion of the first display screen thereby allowing a user to cause the combiner unit to retrieve said content, and
 - generate a second video display screen including at least a portion which corresponds to said content; and
- a video output interface, coupled to or integrated within the combiner unit and configured to be coupled to a video input of said TV set and to display said first display screen or said second video display screen.

14. (original) The TV-Internet Integration Box according to claim 13, wherein said overlay-enabling digital data is received at the user premises according to a pre-stored user-profile.

15. (twice amended) The TV-Internet Integration Box according to claim 13, further including:

- a command input for receiving a command from [a] the user at said user premises;
- and a frame adjuster for resizing said first portion and/or said second portion of said first display screen in response to said command.

16. (original) The TV-Internet Integration Box according to claim 13, further including:

- a receiver for receiving a digital data stream, wherein the stream of the digital data is enabled by the content stored at said website; and

a processing unit for pre-fetching and buffering said digital data stream from said website, thereby allowing said digital data stream to be displayed substantially without delay upon redirection by the user.

17. (original) The TV-Internet Integration Box according to claim 13, wherein the overlay-enabling digital data comprises data representative of one or more second images, and for each of said one or more second images said overlay-enabling data comprises respective web site addresses where IP content associated with the respective second image is stored,

and wherein the combiner unit is configured to:

periodically access a web server for downloading said overlay-enabling digital data;

extract from the overlay-enabling digital data said one or more second images and the respective web sites corresponding to each of said second images;

retrieve and store digital content from said web sites; and

if the overlay activation criterion is met, and a user command that is associated with an image from amongst said one or more second images is identified, display the respective image from amongst the second images, access the respective web site associated with the displayed image and extract and buffer content from the website.

18. (original) The TV-Internet Integration Box according to claim 13, wherein the image includes an icon that indicates to the user that digital data from Internet content is currently being displayed and which provides an indication of a nature of said Internet content.

19. (original) The TV-Internet Integration Box according to claim 13, wherein the image contains textual information advising the user to press a particular button on the remote control unit.

20. (Cancelled)

21. (original) The TV-Internet Integration Box according to claim 18, wherein the icon is colored so as to allow user selection of a specific Internet content by pressing a color-coded button on a remote control in accordance with a color of said icon.

AMENDMENTS TO THE SPECIFICATION

Please replace the paragraph beginning at column 4, line 19 with the following:

FIG. 3 is a flow diagram showing the principal actions carried out by the TV-Internet Integration Box 16. In accordance with one embodiment of the invention, the subscriber selects what kind of IP content he wishes to receive and in respect of which program details, such as icons and/or textual data, are to be displayed together with the TV broadcast data. For example, a subscriber may wish to block certain types of program material or may wish to receives details thereof only during limited hours, for example when the children are asleep. To this end, the subscriber is able to program the TV-Internet Integration Box 16 in much the same way that a video cassette recorder is programmed so as to store in the memory [25] 26 a timetable indicating what type of IP data is to be displayed and when. The timetable is updated as and when required by the subscriber. The TV-Internet Integration Box 16 is adapted to check the timetable periodically and to filter out incoming IP content that is either of a type that is not required or that is broadcast during an unauthorized time window. By such means, an additional layer of authorization may be provided to that stored in the database 19 for access by the web server 14, thus allowing pre-fetching of IP content and storage in the memory [25] 26 of the TV-Internet Integration Box 16. Upon detecting a matching event, corresponding to received IP content that is of interest to the subscriber, the TV-Internet Integration Box 16 overlays the matched IP content with the current broadcast and displays the new integrated video on the subscriber's TV set 17. For example, the matched information may be an icon that indicates to the subscriber that an Internet movie is currently being broadcast; or it may be an advertisement or information related to the TV program being broadcast.

REMARKS/ARGUMENTS

The Final Office Action mailed on or about March 6, 2023 (“2023 March Final”) has been carefully considered. The Advisory Action mailed on or about July 26, 2023 (“2023 July AA”) has also been carefully considered.

In response claims 2, 4, 6-8, 10-12, 14, 16-19, and 21 are original relative to the subject patent to be reissued. Claims 10 and 17 are amended to return to their original state relative to the subject patent to be reissued. Claims 3, 5, 15 are amended as submitted in the preliminary amendment relative to the subject patent to be reissued. Claims 1, 9, 13, and 20 are twice amended. No new matter is added.

This application was appealed, and an Appellant’s Brief and Examiner’s Answer entered. This RCE has been filed prior to the filing of a reply brief or forwarding to the PTAB.

Notice of Related Litigation and Request for Expedited “Special” Handling

Patent US 8,132,220 (“the ‘220 Patent”) was the subject of litigation in the District of New Jersey as well as an appeal to the Federal Circuit. Orders from both courts rendered claims 1, 9, 10, 13, 17, and 20 of the ‘220 Patent invalid as indefinite. The District of New Jersey matter is Civil No. 18-10238 (RMB/KMW). The Federal Circuit matter is Case 20-1837. Pursuant to MPEP 1442, Applicant respectfully requests this matter be taken up for action in advance of other reissue applications.

Examiner’s Interview

The Applicant’s representative, Tomás A. Prieto, and Examiner Adam L Basehoar, held a telephonic interview on May 23, 2023 (2023 May Interview) to discuss this application as well as pending reissue application 17/867,612 (“the ‘612 Application”). During the interview the parties discussed the rejections under 35 USC 251 and 35 USC 112, 2nd paragraph. The parties also briefly discussed the *ex parte Adams* PTAB decision cited in the 2023 March Final. Examiner Basehoar provided additional insight into his rationale in issuing the rejection in view of the prior litigation of the applications and the cited PTAB decision. No agreements were reached.

Applicant wishes to thank Examiner Basehoar for granting the interview and for his consideration in providing additional information and insights.

Claim Amendments

Claims 2, 4, 6-8, 10-12, 14, 16-19, and 21 are original relative to the subject patent to be reissued. Claims 3, 5, 15 are twice amended as previously submitted in the preliminary amendment and Applicant's prior response relative to the subject patent to be reissued. Claims 1 and 13 are thrice amended. No new matter is added.

Cancelled Claims (Claims 9 and 20)

Pursuant to MPEP 1453(II), a claim to be cancelled should be cancelled by a direction to cancel the claims. As such:

Please cancel claims 9 and 20.

Amendments to the Specification

The Office previously objected to col. 4, ll. 31 and 40 for reciting an incorrect reference to the memory element of Fig. 3. The objection was then withdrawn following Applicant's response. Enclosed above are previously-presented amendments to the Specification that overcame the prior objections.

Claim Rejection – 35 USC § 251

The Office rejected claims 1-21 under 35 USC § 251 as being broadened in a reissue application filed outside the two-year statutory period. Applicant respectfully disagrees. Based on Applicant's arguments in the after-final response filed June 2, 2023, the Examiner withdrew the rejection in the 2023 July AA.

It is Applicant's understanding that the Examiner's position (as per the 2023 July AA) that, should the inconsistency giving rise to the rejections under 35 USC 112(b) be overcome via the cancellation of claims 9 and 20, then the Examiner would be forced to reintroduce the rejection under 35 USC 251 for broadening the claim scope outside of the permitted time frame.

If this understanding is correct, Applicant requests that the Examiner provide a rejection under 35 USC 251 in the alternative to the rejection under 35 USC 112(b). This way, Applicant can directly appeal this decision to the PTAB.

Claim Rejection – 35 USC § 112(b)

Claims 1 and 13 have been rejected under 35 USC 112, 2nd paragraph because the recitation of “overlay activation criterion” could be interpreted as both coming “from the Internet and simultaneously not from the Internet” (2023 March Final, page 8). This rejection appears to mirror the holding of invalidity of the claims at the District Court level (Civil No. 18-10238 (RMB/KMW), Opinion (April 16, 2020)) (“the District Court Decision”) and affirmed by the CAFC (*TVnGo Ltd v LG Elecs.* U.S., No. 2020-1837 (Fed. Cir. Jun. 28, 2021)) (“the CAFC Decision”).

The District Court Decision identified an inconsistency between the recitation of “overlay activation criterion” in independent claims 1 and 13 and their respective dependent claims 9 and 20. Thus, the inconsistency is not in claims 1 and 13 alone, but rather in claim 1 when interpreted in combination with claim 9 and in claim 13 when interpreted in combination with claim 20. The inconsistency arises in that in claims 1 and 13, the “overlay activation criterion” is provided “over the Internet” whereas claims 9 and 20 state that the “user command information” may be a component of the “overlay activation criterion” and when the limitation of “user command information” is read in the context of the specification, the “user command information is “provided at the user’s premises and not over the Internet.”

In response, Applicants have now cancelled claims 9 and 20, such that there is no link between the “user command information” and the “overlay activation criterion”, thus resolving the ambiguity because the “overlay activation criterion” is no longer claimed to be originated “not from the Internet.” Thus, one of ordinary skill in the art would be appraised of the metes and bounds of the claim.

As to the dependent claims 9 and 20 specifically, the CAFC Decision states at page 11:

Further, merely dismissing the dependent claims as invalid, as TVnGo proposes, ignores that they are one of the few sources of intrinsic evidence on the meaning of “overlay

activation criterion” in this record. When faced with this unknown and undefined phrase, a skilled artisan would look for clarification not only in the specification but also in “[o]ther claims of the patent in question,” which “can also be valuable sources of enlightenment as to the meaning of a claim term.” Phillips, 415 F.3d at 1314. Here, however, he or she would discover an inconsistency, throwing the meaning of “overlay activation criterion” into doubt. These dependent claims are intrinsic evidence. Arguing that they are invalid does not change that.

In this section, the CAFC is not indicating that the dependent claims must stay as they are and can never be amended or cancelled to remove the recitation of “overlay activation criterion.” Rather, in this section the CAFC is responding to the possibility that the dependent claims be held invalid does not remedy the inconsistency issue. This is because as long as the recitation of “overlay activation criterion” remains in claims 9 and 20, the inconsistency with respective claims 1 and 13 continues to exist and as such the independent claims 1 and 13 will also be indefinite. In other words, even if the dependent claims are invalid with valid independent claims, the invalid dependent claims still remain as a part of the patent document and as such would be a source of inconsistency to the skilled artisan.

However, by cancelling claims 9 and 20, the link between the “overlay activation criterion” and the “user command information” is broken. A reissue patent without those claims would no longer have a source of confusion/inconsistency for the skilled artisan. Instead, the skilled artisan would only discover the meaning of “overlay activation criterion” as coming “from the Internet” of independent claims 1 and 13. The sections of the specification cited in the District Court Decision as related to the “user command information” would not raise the inconsistency either as there is nothing in these sections of the specification that would lead to the skilled artisan to interpret it as being related to the “overlay activation criterion.” The remaining dependent claims that recite “overlay activation criterion” are consistent with this interpretation.

For the reasons discussed above, it is Applicant’s position that the claims are definite. As such, Applicant respectfully requests withdrawal of the rejections under 35 USC 112, 2nd paragraph.

Request for Allowance

Claims 1-8, 10-19 and 21 are pending in this application. Applicant requests allowance of all pending claims.

Respectfully submitted,
Fish IP Law, LLP

Date: April 15, 2024

By: /Tomas A. Prieto/
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EXAMINER	
BASEHOAR, ADAM L	
ART UNIT	PAPER NUMBER
3992	

DATE MAILED: 02/24/2025

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
17/714,917	04/06/2022	Yakov MERLIN	103692.0001US1re	6111

TITLE OF INVENTION: Method And Apparatus For Facilitating Toggling Between Internet And TV Broadcasts

APPLN. TYPE	ENTITY STATUS	ISSUE FEE DUE	PUBLICATION FEE DUE	PREV. PAID ISSUE FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	SMALL	\$516	\$0.00	\$0.00	\$516	05/27/2025

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. PROSECUTION ON THE MERITS IS CLOSED. THIS NOTICE OF ALLOWANCE IS NOT A GRANT OF PATENT RIGHTS. THIS APPLICATION IS SUBJECT TO WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE OFFICE OR UPON PETITION BY THE APPLICANT. SEE 37 CFR 1.313 AND MPEP 1308.

THE ISSUE FEE AND PUBLICATION FEE (IF REQUIRED) MUST BE PAID WITHIN THREE MONTHS FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. THIS STATUTORY PERIOD CANNOT BE EXTENDED. SEE 35 U.S.C. 151. THE ISSUE FEE DUE INDICATED ABOVE DOES NOT REFLECT A CREDIT FOR ANY PREVIOUSLY PAID ISSUE FEE IN THIS APPLICATION. IF AN ISSUE FEE HAS PREVIOUSLY BEEN PAID IN THIS APPLICATION (AS SHOWN ABOVE), THE RETURN OF PART B OF THIS FORM WILL BE CONSIDERED A REQUEST TO REAPPLY THE PREVIOUSLY PAID ISSUE FEE TOWARD THE ISSUE FEE NOW DUE.

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(Typed or printed name)
(Signature)
(Date)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
17/714,917	04/06/2022	Yakov MERLIN	103692.0001US1re	6111

TITLE OF INVENTION: Method And Apparatus For Facilitating Toggling Between Internet And TV Broadcasts

APPLN. TYPE	ENTITY STATUS	ISSUE FEE DUE	PUBLICATION FEE DUE	PREV. PAID ISSUE FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	SMALL	\$516	\$0.00	\$0.00	\$516	05/27/2025

EXAMINER	ART UNIT	CLASS-SUBCLASS
BASEHOAR, ADAM L	3992	725-087000

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Please check the appropriate assignee category or categories (will not be printed on the patent) : ☐ Individual ☐ Corporation or other private group entity ☐ Government

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☐ Applicant asserting small entity status. See 37 CFR 1.27

☐ Applicant changing to regular undiscounted fee status.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
17/714,917	04/06/2022	Yakkov MERLIN	103692.0001US1re	6111
24392	7590	02/24/2025	EXAMINER	
FISH IP LAW, LLP			BASEHOAR, ADAM L	
19900 MacArthur Blvd, Suite 810			ART UNIT	
Irvine, CA 92612			PAPER NUMBER	
			3992	
DATE MAILED: 02/24/2025				

Determination of Patent Term Extension or Adjustment under 35 U.S.C. 154 (b)

A reissue patent is for "the unexpired part of the term of the original patent." See 35 U.S.C. 251. Accordingly, the above-identified reissue application is not eligible for Patent Term Extension or Adjustment under 35 U.S.C. 154(b).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571)-272-7702. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at 1-(888)-786-0101 or (571)-272-4200.

OMB Clearance and PRA Burden Statement for PTOL-85 Part B

The Paperwork Reduction Act (PRA) of 1995 requires Federal agencies to obtain Office of Management and Budget approval before requesting most types of information from the public. When OMB approves an agency request to collect information from the public, OMB (i) provides a valid OMB Control Number and expiration date for the agency to display on the instrument that will be used to collect the information and (ii) requires the agency to inform the public about the OMB Control Number's legal significance in accordance with 5 CFR 1320.5(b).

The information collected by PTOL-85 Part B is required by 37 CFR 1.311. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, Virginia 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450. Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. The United States Patent and Trademark Office (USPTO) collects the information in this record under authority of 35 U.S.C. 2. The USPTO's system of records is used to manage all applicant and owner information including name, citizenship, residence, post office address, and other information with respect to inventors and their legal representatives pertaining to the applicant's/owner's activities in connection with the invention for which a patent is sought or has been granted. The applicable Privacy Act System of Records Notice for the information collected in this form is COMMERCE/PAT-TM-7 Patent Application Files, available in the Federal Register at 78 FR 19243 (March 29, 2013).

<https://www.govinfo.gov/content/pkg/FR-2013-03-29/pdf/2013-07341.pdf>

Routine uses of the information in this record may include disclosure to:

- 1) law enforcement, in the event that the system of records indicates a violation or potential violation of law;
- 2) a federal, state, local, or international agency, in response to its request;
- 3) a contractor of the USPTO having need for the information in order to perform a contract;
- 4) the Department of Justice for determination of whether the Freedom of Information Act (FOIA) requires disclosure of the record;
- 5) a Member of Congress submitting a request involving an individual to whom the record pertains, when the individual has requested the Member's assistance with respect to the subject matter of the record;
- 6) a court, magistrate, or administrative tribunal, in the course of presenting evidence, including disclosures to opposing counsel in the course of settlement negotiations;
- 7) the Administrator, General Services Administration (GSA), or their designee, during an inspection of records conducted by GSA under authority of 44 U.S.C. 2904 and 2906, in accordance with the GSA regulations and any other relevant (i.e., GSA or Commerce) directive, where such disclosure shall not be used to make determinations about individuals;
- 8) another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c));
- 9) the Office of Personnel Management (OPM) for personnel research purposes; and
- 10) the Office of Management and Budget (OMB) for legislative coordination and clearance.

If you do not furnish the information requested on this form, the USPTO may not be able to process and/or examine your submission, which may result in termination of proceedings, abandonment of the application, and/or expiration of the patent.

Notice of Allowability	Application No. 17/714,917	Applicant(s) MERLIN, Yakkov	
	Examiner Adam L Basehoar	Art Unit 3992	AIA (FITF) Status No

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to Applicant's RCE Response filed on 04/15/2024.
☐ A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on _____.

2. ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on _____; the restriction requirement and election have been incorporated into this action.

3. ☒ The allowed claim(s) is/are 1-8,10-19 and 21 . As a result of the allowed claim(s), you may be eligible to benefit from the **Patent Prosecution Highway** program at a participating intellectual property office for the corresponding application. For more information, please see http://www.uspto.gov/patents/init_events/pph/index.jsp or send an inquiry to PPHfeedback@uspto.gov.

4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

Certified copies:

a) ☐ All b) ☐ Some* c) ☐ None of the:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).

6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)	5. ☒ Examiner's Amendment/Comment
2. ☐ Information Disclosure Statements (PTO/SB/08), Paper No./Mail Date _____.	6. ☒ Examiner's Statement of Reasons for Allowance
3. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material _____.	7. ☐ Other _____.
4. ☐ Interview Summary (PTO-413), Paper No./Mail Date. _____.	

/ADAM L BASEHOAR/ Primary Examiner, Art Unit 3992	
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Notice of Pre-AIA or AIA Status

1. The present application is being examined under the pre-AIA first to invent provisions.
2. For reissue applications filed on or after September 16, 2012, all references to 35 U.S.C. 251 and 37 CFR 1.172, 1.175, and 3.73 are to the current provisions.

DETAILED ACTION

3. A Request for Continued Examination (RCE) under 37 CFR 1.114 was filed in this application after appeal to the Patent Trial and Appeal Board, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's RCE Response filed on 04/15/2024 has been entered and made of record.
4. The RCE Response includes an Amendment to the Specification, an Amendment to the Claims, and Remarks.

As noted by Applicant (see: Remarks, p. 2), the Amendment to the Specification is duplicative to previously-presented amendments to the specification, filed on 01/30/2023, that overcame prior objections.

Similarly, the Examiner notes that the Amendment to the Claims appears to be duplicative to the Amendment to the Claims previously filed on 06/02/2023 except that the instant Amendment to the Claims now properly cancels dependent claim 20 (e.g., see: MPEP 1453(II)(C) and 1454(V)(B)).

Finally, it is noted that the Applicant has newly requested, based on their understanding of the Examiner's position, that the Examiner provide a rejection under 35 U.S.C. 251 in the alternative to the rejection under 35 U.S.C. 112 (pre-AIA), second paragraph (see: Remarks, pp. 2-3). However, as noted below, (1) the rejection of claims 1-8, 10-19, and 21 under 35 U.S.C. 112 (pre-AIA), second paragraph, has been withdrawn, and (2) the Examiner no longer believes a rejection under 35 U.S.C. 251 for improper claim broadening is warranted.

5. This is a Notice of Allowability responsive to communications: Applicant's RCE Response and the Decision (see: *Ex parte Merlin*, Appeal 2024-003078 (December 02, 2024)) by the Patent Trial and Appeal Board (PTAB) in related reissue application 17/867,612. The PTAB Decision in related reissue application 17/867,612 addresses substantially identical issues as found in the instant reissue application. The PTAB Decision at least concluding:

Therefore, on the totality of the record now before us, we are persuaded that the Examiner erred in rejecting claims 1-8, 10-19, and 21 as indefinite.

CONCLUSION

In summary:

Claim(s) Rejected	35 U.S.C. §	References/Basis	Affirmed	Reversed
1-8, 10-19, 21	112	Indefiniteness		1-8, 10-19, 21

REVERSED

(PTAB Decision – p. 10)

6. Importantly, the PTAB Decision determined that the term “overlay activation criterion” in independent claims 1 and 13 does not render the claims indefinite. In doing so, the PTAB Decision distinguishes itself from the holdings by the CAFC (see: *TVnGO Ltd. v. LG Elecs. U.S.*, No. 2020-1837 (Fed. Cir. Jun. 28, 2021)) based on the fact that “the record differs from that which was before the Federal Circuit because the record of this reissue application is also part of the prosecution history... Appellant’s disavowal of the ‘overlay activation criterion’ coming from the user’s premises, as recited in dependent claims 9 and 20, is clear and unmistakable.” Thus, the prosecution history of this reissue application also constitutes additional intrinsic evidence that “removed the problematic interpretation clearly and unmistakably.”

The Examiner notes that on page 9 of the PTAB Decision, footnote 6 implies that support for “overlay activation criteria” is provided by Fig. 3 and column 4, lines 27-57 of the Merlin ‘969 patent (i.e., the patent associated with related reissue application 17/867,612). It is noted that the data stored (e.g., “a timetable indicating what type of IP data is to be displayed and when”) in the memory of the TV-Internet Integration Box is stored locally by a subscriber (i.e., a user), and is thus not “overlay activation criteria” that comes from the Internet. At best, clearer support for the overlay activation criterion is provided in column 7, line 51 – column 8, line 4 of the Merlin ‘220 patent. Specifically, the second data (i.e., the claimed overlay-enabling digital data) at least includes data “on which channel or channels the associated IP content is to be streamed and at what times.” That is to say, Table I of the Merlin ‘220 patent appears to provide clearer support for all three elements (i.e., “Web link”, “image”, and “overlay activation criterion”) of the claimed “overlay-enabling digital data” that comes from the Internet.

TABLE I

Second data - definition				60
Icon image	Channel	Time	Website of IP content	
ICON.GIF	2: 23	19:30; 21:30	www.AB.com/adverts/123.htm	

7. The Examiner further notes that a “complete reversal of the examiner’s rejection brings the case up for immediate action by the examiner... Though the examiner is expected to bring the prior art search up-to-date prior to passing an application to issue, the examiner should never regard such a reversal as a challenge to make a new search to uncover other and better references” (see: MPEP 1214.04).

8. Finally, the Examiner notes that the PTAB Decision did not specifically address (e.g., see: footnote 3 on page 4 of the PTAB Decision), as requested by Applicant and Examiner, the potential issue of improper claim broadening in view of a previously cited informative PTAB decision (see: *Ex parte Adams*, Appeal 2007-0441 (March 14, 2007)). Further, the PTAB did not exercise its discretionary authority under 37 CFR 41.50(b) to make any new grounds of rejection.

In light of the determination by the PTAB that the term “overlay activation criterion” in independent claims 1 and 13 clearly does not render the claims indefinite, the Examiner does not believe a rejection under 35 U.S.C. 251 for improper claim broadening is presently warranted. The fact pattern in *Ex parte Adams*, Appeal 2007-0441 (March 14, 2007) now appears to be sufficiently different (i.e., the fatal contradiction resided within the same independent claim) from the situation in the instant reissue application.

9. Thus, the rejection of claims 1-8, 10-19, and 21 (see: Final Action, pp. 7-9; and Advisory Action, pp. 2-3) under 35 U.S.C. 112 (pre-AIA), second paragraph, as being indefinite has been withdrawn as necessitated by the PTAB Decision.

10. Therefore, claims 1-8, 10-19, and 21 are allowed.

EXAMINER'S AMENDMENT

11. An Examiner's Amendment to the record appears below. Should the changes and/or additions be unacceptable to Applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this Examiner's Amendment was given by Tomas A. Prieto (Attorney of Record - Reg. No. 60,675) on 02/10/2025.

The Examiner's Amendment further amends independent claims 1 and 13 for consistency in terminology; newly amends dependent claims 8 and 19 to resolve potential antecedent basis issues; and properly cancels dependent claim 9 in view of 37 CFR 1.173(b)(2).

Claims 1, 8, 9, 13, and 19 have been amended as follows:

1. (Amended) A method for generating at a user's premises an overlay using video signals constituting a first data and overlay-enabling digital data constituting a second data, the method comprising:

(a) providing a combiner unit at the user's premises, wherein:

the combiner unit is coupled to a TV set and connected to a separate TV tuner box or TV tuner in the TV set, at the user's premises, and

the combiner unit is also connected through distinct networks to each of a video signal source providing video signals through the separate TV tuner box or the TV tuner in the TV set, and an Internet data source providing overlay-enabling digital data over the Internet,

wherein said video signals and said overlay-enabling digital data originate from unrelated sources and are transmitted to the user's premises by different resources as mutually distinct and independent inputs,

and wherein said overlay-enabling digital data includes at least:

a Web link indicating a website where content that is associated with said overlay-enabling digital data is stored,

an image indicative of the content associated with said overlay-enabling digital data, and

an overlay activation criterion; and

(b) processing at the user's premises said overlay-enabling digital data and generating at the user's premises a corresponding overlay only if said overlay activation criterion is met, wherein generating [an] the overlay includes:

generating at the user's premises a first display screen including at least a first portion corresponding to said video signals and a second portion overlaid over said first portion and corresponding at least to said image, and

associating the Web link with said second portion of the first display screen thereby allowing a user to cause the combiner unit to retrieve said content, generate a second video

display screen including at least a portion which corresponds to said content, and input the second display screen to said TV set.

8. (Amended) The method according to claim 1, wherein the image contains textual information advising the user to press a particular button on [the] a remote control unit.

9. (Cancelled)

13. (Amended) A TV-Internet Integration Box for generating at a user's premises an overlay using video signals constituting a first data and overlay-enabling digital data constituting a second data, the TV-Internet Integration Box comprising:

a combiner unit at [a] the user's premises coupled to a separate TV tuner box or TV tuner,

wherein the combiner unit is also connected through distinct networks to each of a video signal source providing video signals through the separate TV tuner box or the TV tuner, and an Internet data source providing overlay-enabling digital data over the Internet,

wherein said video signals and said overlay-enabling digital data originate from unrelated sources and are transmitted to the user's premises by different resources as mutually distinct and independent inputs, and

wherein said overlay-enabling digital data includes at least:

a Web link indicating a website where content that is associated with said overlay-enabling digital data is stored;

an image indicative of the content associated with said overlay-enabling digital data; and

an overlay activation criterion, wherein

the combiner unit is responsive to [an] the overlay activation criterion being met for generating a corresponding overlay, including:

generating at the user's premises a first display screen including at least a first portion corresponding to said video signals and a second portion overlaid over said first portion and corresponding at least to said image, and

associating the Web link with said second portion of the first display screen thereby allowing a user to cause the combiner unit to retrieve said content, and generate a second video display screen including at least a portion which corresponds to said content; and

a video output interface, coupled to or integrated within the combiner unit and configured to be coupled to a video input of said TV set and to display said first display screen or said second video display screen.

19. (Amended) The TV-Internet Integration Box according to claim 13, wherein the image contains textual information advising the user to press a particular button on [the] a remote control unit.

REASONS FOR ALLOWANCE

12. The following is an Examiner's statement of reasons for allowance:

Regarding independent claims 1 and 13, the Examiner notes that each claim recites substantially identical subject matter found allowable by the previous examiner during prosecution of the 11/794,825 application. The current Examiner has performed an updated search of the claimed subject matter, but has not discovered any prior art better than the art previously made of record. Therefore, the current Examiner agrees with the previous examiner's indication of allowability, and thus independent claims 1 and 13 are allowable at least for the same reasons as determined during the original prosecution history of the 11/794,825 application. For example, see the following examiner's statement of reasons for allowance from the 11/794,825 application (Notice of Allowability mailed on 09/23/2011):

Allowable Subject Matter

Claims 19-39 are allowed.

The following is an examiner's statement of reasons for allowance:

With regard to independent claims 19 and 29, the prior art fails to disclose or reasonably suggest the invention taken as a whole with respect to a combiner unit at the user's premises separate from a TV tuner box or TV tuner in the TV set that receives video and overlay enabling digital data from mutually distinct, unrelated sources and inputs, wherein the unrelated sources are a video source and the Internet, wherein the overlay enabling digital data comprise a web link indicating a website where content that is associated with the overlay-enabling digital data is stored, an image indicative of the content associated with the overlaying digital data, and overlay activation criterion.

The closest prior art (Akiyama (WO 02/19689) and Butler (US 20020007493)) discloses receiving both video and overlay activation criteria from the same source (Butler, paragraph [0055], [0058]) and receiving the supplemental content from a different source such as the Internet (Akiyama, page 16-18), however fails to disclose that the source of the video content and the overlay activation criteria are unrelated and received via mutually distinct and independent inputs.

Dependent claims 2-8, 10-12, 14-19, and 21 are allowable at least because they depend from an allowable base claim.

Any comments considered necessary by Applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled “Comments on Statement of Reasons for Allowance.”

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam L Basehoar whose telephone number is (571)272-4121.

The examiner can normally be reached 8:00AM - 4:30PM.

Examiner interviews are available via telephone, in-person, and video conferencing using a USPTO supplied web-based collaboration tool. To schedule an interview, applicant is encouraged to use the USPTO Automated Interview Request (AIR) at <http://www.uspto.gov/interviewpractice>.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kosowski can be reached on 571-272-3744. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of published or unpublished applications may be obtained from Patent Center. Unpublished application information in Patent Center is available to registered users. To file and manage patent submissions in Patent Center, visit: <https://patentcenter.uspto.gov>. Visit <https://www.uspto.gov/patents/apply/patent-center> for more information about Patent Center and <https://www.uspto.gov/patents/docx> for information about filing in DOCX format. For additional questions, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ADAM L BASEHOAR/
Primary Examiner, Art Unit 3992

Conferees:

Application/Control Number: 17/714,917
Art Unit: 3992

Page 13

/ROBERT L NASSER/
Primary Examiner, Art Unit 3992

/ALEXANDER J KOSOWSKI/
Supervisory Patent Examiner, Art Unit 3992

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	Examiner Adam L Basehoar	Art Unit 3992	Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date YYYY-MM-DD	Name	CPC Classification	US Classification
	A					
	B					
	C					
	D					
	E					
	F					
	G					
	H					
	I					
	J					
	K					
	L					
	M					

FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date YYYY-MM-DD	Country	Name	CPC Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	Patent Trial and Appeal Board (PTAB) Decision, Ex parte Merlin, Appeal 2024-003078 (December 02, 2024), pp. 1-10 (Year: 2024)
	V	
	W	
	X	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in YYYY-MM-DD format are publication dates. Classifications may be US or foreign.

Issue Classification 	Application/Control No. 17/714,917	Applicant(s)/Patent Under Reexamination MERLIN, Yakkov
	Examiner Adam L Basehoar	Art Unit 3992

CPC						
Symbol					Type	Version
H04N	/	21	/	44016	F	2013-01-01
H04N	/	21	/	4316	I	2013-01-01
H04N	/	21	/	4331	I	2013-01-01
H04N	/	21	/	4381	I	2013-01-01
H04N	/	21	/	4438	I	2013-01-01
H04N	/	21	/	4622	I	2013-01-01
H04N	/	21	/	4782	I	2013-01-01
H04N	/	21	/	6118	I	2013-01-01
H04N	/	21	/	6125	I	2013-01-01
H04N	/	21	/	6143	I	2013-01-01
H04N	/	21	/	64322	I	2013-01-01
H04N	/	21	/	812	I	2013-01-01
H04N	/	21	/	854	I	2013-01-01
H04N	/	21	/	431	A	2013-01-01

CPC Combination Sets					
Symbol				Type	Set
	/		/		

NONE (Assistant Examiner) _____ (Date) _____		Total Claims Allowed: 19	
/ADAM L BASEHOAR/ Primary Examiner, Art Unit 3992 (Primary Examiner) _____ (Date) _____		06 February 2025 (Date)	O.G. Print Claim(s) 1 O.G. Print Figure 1

Issue Classification 	Application/Control No. 17/714,917	Applicant(s)/Patent Under Reexamination MERLIN, Yakkov
	Examiner Adam L Basehoar	Art Unit 3992

INTERNATIONAL CLASSIFICATION			
CLAIMED			
H04N	/	7	/ 173
G06F	/	3	/ 00
G09G	/	5	/ 00
NON-CLAIMED			
	/		/

US ORIGINAL CLASSIFICATION	
CLASS	SUBCLASS
725	109

CROSS REFERENCES(S)						
CLASS	SUBCLASS (ONE SUBCLASS PER BLOCK)					
345	629					
715	717					

NONE		Total Claims Allowed:	
(Assistant Examiner)	(Date)	19	
/ADAM L BASEHOAR/ Primary Examiner, Art Unit 3992	06 February 2025	O.G. Print Claim(s)	O.G. Print Figure
(Primary Examiner)	(Date)	1	1

Issue Classification 	Application/Control No. 17/714,917	Applicant(s)/Patent Under Reexamination MERLIN, Yakkov
	Examiner Adam L Basehoar	Art Unit 3992

☐ Claims renumbered in the same order as presented by applicant ☐ CPA ☐ T.D. ☐ R.1.47															
CLAIMS															
Final	Original	Final	Original	Final	Original	Final	Original	Final	Original	Final	Original	Final	Original	Final	Original
1	1	10	10	19	19										
2	2	11	11	20	20										
3	3	12	12	21	21										
4	4	13	13												
5	5	14	14												
6	6	15	15												
7	7	16	16												
8	8	17	17												
9	9	18	18												

NONE	Total Claims Allowed:	
(Assistant Examiner)	(Date)	19
/ADAM L BASEHOAR/ Primary Examiner, Art Unit 3992	06 February 2025	O.G. Print Claim(s)
(Primary Examiner)	(Date)	1
		O.G. Print Figure
		1

<i>Index of Claims</i> 	Application/Control No. 17/714,917	Applicant(s)/Patent Under Reexamination MERLIN, Yakkov
	Examiner Adam L Basehoar	Art Unit 3992

✓	Rejected	-	Cancelled	N	Non-Elected	A	Appeal
=	Allowed	÷	Restricted	I	Interference	O	Objected

CLAIMS										
☐ Claims renumbered in the same order as presented by applicant ☐ CPA ☐ T.D. ☐ R.1.47										
CLAIM		DATE								
Final	Original	08/15/2022	02/06/2023	07/13/2023	02/06/2025					
1	1	✓	✓	✓	=					
2	2	✓	✓	✓	=					
3	3	✓	✓	✓	=					
4	4	✓	✓	✓	=					
5	5	✓	✓	✓	=					
6	6	✓	✓	✓	=					
7	7	✓	✓	✓	=					
8	8	✓	✓	✓	=					
9	9	✓	✓	○	-					
10	10	✓	✓	✓	=					
11	11	✓	✓	✓	=					
12	12	✓	✓	✓	=					
13	13	✓	✓	✓	=					
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16	16	✓	✓	✓	=					
17	17	✓	✓	✓	=					
18	18	✓	✓	✓	=					
19	19	✓	✓	✓	=					
20	20	✓	✓	○	-					
21	21	✓	✓	✓	=					

<i>Search Notes</i> 	Application/Control No. 17/714,917	Applicant(s)/Patent Under Reexamination MERLIN, Yakkov
	Examiner Adam L Basehoar	Art Unit 3992

CPC - Searched*		
Symbol	Date	Examiner
H04N 21/(44016, 4782, 4316, 4622, 431)	08/15/2022	ALB

CPC Combination Sets - Searched*		
Symbol	Date	Examiner

US Classification - Searched*			
Class	Subclass	Date	Examiner
725	109	08/15/2022	ALB
715	717, 718	08/15/2022	ALB
345	629	08/15/2022	ALB

* See search history printout included with this form or the SEARCH NOTES box below to determine the scope of the search.

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<i>Search Notes</i> 	Application/Control No. 17/714,917	Applicant(s)/Patent Under Reexamination MERLIN, Yakkov
	Examiner Adam L Basehoar	Art Unit 3992

Search Notes		
Search Notes	Date	Examiner
Reviewed Prior Application(s) History/Cited Prior Art	08/15/2022	ALB
Inventor Name Search (PE2E)	08/15/2022	ALB
Recapture Review Conducted	08/15/2022	ALB
Litigation Search (04/11/2022)	08/15/2022	ALB
PE2E Text and Classification Search (see attached search history)	08/15/2022	ALB
Reviewed Applicant's Response (01/30/2023)	02/06/2023	ALB
Searched Patent Data Portal (Patent No. 8,132,220) - No Prior/Pending Reexams/Reissues Found	02/06/2023	ALB
Searched P-TACTS (Patent No. 8,132,220) - No Prior/Pending AIA Proceedings Found	02/06/2023	ALB
Reviewed: TVnGO Ltd. v. LG Elecs. U.S., No. 2020-1837 (Fed. Cir. Jun. 28, 2021) and Civil No. 18-10238 (RMB/KMW)	02/06/2023	ALB
Reviewed Applicant's After Final Response (06/02/2023)	07/13/2023	ALB
Consulted Steve Stein (Managing Quality Assurance Specialist)	07/13/2023	ALB
Reviewed Applicant's Request for Continued Examination (RCE) Response (04/15/2024)	02/06/2025	ALB
Reviewed Related Reissue Application 17/867,612 File History	02/06/2025	ALB
Interference Search	02/06/2025	ALB

Interference Search			
US Class/CPC Symbol	US Subclass/CPC Group	Date	Examiner
H04N 21/(44016, 4782, 4316, 4622, 431)		02/06/2025	ALB
725	109	02/06/2025	ALB
715	717, 718	02/06/2025	ALB
345	629	02/06/2025	ALB

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United States Patent And Trademark Office <u>Reissue Terminal Disclaimer Review Form</u>	Application No. 17/714,917	Art Unit 3992
	Examiner ADAM L BASEHOAR	AIA Status No

Original Patent Number of Patent to be Reissued is: <u>8,132,220</u>	The Maintenance fee status is: ☒ up to date ☐ not up to date (Consult with SPRS)
---	---

Is there a terminal disclaimer filed and accepted during the prosecution of (i) the current reissue application, (ii) the underlying patent, and/or (iii) reexamination proceeding(s) of the underlying patent?

☒ NO
☐ YES (Complete the rest of the form)

The reissue patent is subject to Terminal Disclaimer(s) that was/were:

☐ filed and accepted (DISQ or DISQ.E.FILE) during the prosecution of the current reissue application.
(Enter terminal disclaimer(s) filing date(s) below).

1. _____ 2. _____ 3. _____

The underlying patent of the current reissue application is subject to Terminal Disclaimer(s) that was/were:

☐ accepted (DISQ or DISQ.E.FILE) and of record in the prosecution of the underlying patent and/or reexamination proceeding(s) of the underlying patent. (Enter application/control no(s) and terminal disclaimer(s) filing date(s) below).

1. _____ 2. _____ 3. _____



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
 Address: COMMISSIONER FOR PATENTS
 P.O. Box 1450
 Alexandria, Virginia 22313-1450
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BIB DATA SHEET

CONFIRMATION NO. 6111

SERIAL NUMBER 17/714,917	FILING or 371(c) DATE 04/06/2022 RULE	CLASS 725	GROUP ART UNIT 3992	ATTORNEY DOCKET NO. 103692.0001US1re		
APPLICANTS /ALB/ TVNGO LTD. (BVI), Amsterdam, NETHERLANDS; INVENTORS /ALB/ Yakkov MERLIN, Raanana, ISRAEL;						
** CONTINUING DATA ***** /ALB/ This application is a REI of 11/794,825 07/06/2007 PAT 8132220 which is a 371 of PCT/IL2005/000035 01/11/2005 ** FOREIGN APPLICATIONS ***** /ALB/ ** IF REQUIRED, FOREIGN FILING LICENSE GRANTED ** ** SMALL ENTITY ** 04/07/2022						
Foreign Priority claimed ☐ Yes ☒ No 35 USC 119(a-d) conditions met ☐ Yes ☒ No Verified and Acknowledged <u>/ADAM L BASEHOAR/</u> Examiner's Signature		☐ Met after Allowance Initials	STATE OR COUNTRY ISRAEL	SHEETS DRAWINGS 7	TOTAL CLAIMS 	INDEPENDENT CLAIMS 2
ADDRESS /ALB/ FISH IP LAW, LLP 19900 MacArthur Blvd, Suite 810 Irvine, CA 92612 UNITED STATES						
TITLE /ALB/ Method And Apparatus For Facilitating Toggling Between Internet And TV Broadcasts						
FILING FEE RECEIVED 0.00	FEES: Authority has been given in Paper No. _____ to charge/credit DEPOSIT ACCOUNT No. _____ for following:			☐ All Fees		
				☐ 1.16 Fees (Filing)		
				☐ 1.17 Fees (Processing Ext. of time)		
				☐ 1.18 Fees (Issue)		
				☐ Other _____		
☐ Credit						

PE2E SEARCH - Search History (Prior Art)

There are no Prior Art searches to show.

PE2E SEARCH - Search History (Interference)

Ref #	Hits	Search Query	DBs	Default Operator	Plurals	British Equivalents	Time Stamp
N60	1	"8132220".pn.	(US-PGPUB; USPAT)	OR	ON	ON	2025/02/06 02:29 PM
N61	37195	H04N21/44016,4782,4316,4622,431.cpc. OR 725/109;715/717,718;345/629.ccls.	(US-PGPUB; USPAT)	OR	ON	ON	2025/02/06 02:30 PM
N62	3	(H04N21/44016,4782,4316,4622,431.cpc. OR 725/109;715/717,718;345/629.ccls.) AND (overlay ADJ activation ADJ criterion).clm.	(US-PGPUB; USPAT)	OR	ON	ON	2025/02/06 02:30 PM
N63	239	(H04N21/44016,4782,4316,4622,431.cpc. OR 725/109;715/717,718;345/629.ccls.) AND (overlay near3 data).clm.	(US-PGPUB; USPAT)	OR	ON	ON	2025/02/06 02:31 PM
N64	1	(H04N21/44016,4782,4316,4622,431.cpc. OR 725/109;715/717,718;345/629.ccls.) AND (overlay near3 data SAME combiner ADJ unit).clm.	(US-PGPUB; USPAT)	OR	ON	ON	2025/02/06 02:31 PM
N65	2	(H04N21/44016,4782,4316,4622,431.cpc. OR 725/109;715/717,718;345/629.ccls.) AND (overlay near3 data SAME web ADJ link).clm.	(US-PGPUB; USPAT)	OR	ON	ON	2025/02/06 02:31 PM
N66	91	(H04N21/44016,4782,4316,4622,431.cpc. OR 725/109;715/717,718;345/629.ccls.) AND (overlay near3 data SAME (image OR icon)).clm.	(US-PGPUB; USPAT)	OR	ON	ON	2025/02/06 02:32 PM
N67	86	(H04N21/44016,4782,4316,4622,431.cpc. OR 725/109;715/717,718;345/629.ccls.) AND (overlay SAME video ADJ signal\$1).clm.	(US-PGPUB; USPAT)	OR	ON	ON	2025/02/06 02:32 PM

N68	14	(H04N21/44016,4782,4316,4622,431.cpc. OR 725/109;715/717,718;345/629.ccls.) AND (overlay SAME video ADJ signal\$1 SAME (TV OR television)).clm.	(US-PGPUB; USPAT)	OR	ON	ON	2025/02/06 02:33 PM
N69	9	(H04N21/44016,4782,4316,4622,431.cpc. OR 725/109;715/717,718;345/629.ccls.) AND (overlay SAME criterion).clm.	(US-PGPUB; USPAT)	OR	ON	ON	2025/02/06 02:33 PM
N70	40	(H04N21/44016,4782,4316,4622,431.cpc. OR 725/109;715/717,718;345/629.ccls.) AND (video ADJ signal SAME digital ADJ data).clm.	(US-PGPUB; USPAT)	OR	ON	ON	2025/02/06 02:33 PM
N71	4	(H04N21/44016,4782,4316,4622,431.cpc. OR 725/109;715/717,718;345/629.ccls.) AND (video ADJ signal SAME digital ADJ data SAME (distinct OR different)).clm.	(US-PGPUB; USPAT)	OR	ON	ON	2025/02/06 02:34 PM
N72	3	(overlay ADJ activation ADJ criterion).clm.	(US-PGPUB; USPAT)	OR	ON	ON	2025/02/06 02:34 PM
N73	0	(overlay ADJ activation ADJ criteria).clm.	(US-PGPUB; USPAT)	OR	ON	ON	2025/02/06 02:34 PM
N74	4435	(overlay near3 data).clm.	(US-PGPUB; USPAT)	OR	ON	ON	2025/02/06 02:35 PM
N75	1	(overlay near3 data SAME combiner ADJ unit).clm.	(US-PGPUB; USPAT)	OR	ON	ON	2025/02/06 02:35 PM
N76	2	(overlay near3 data SAME web ADJ link).clm.	(US-PGPUB; USPAT)	OR	ON	ON	2025/02/06 02:35 PM
N77	1551	(overlay near3 data SAME (image OR icon)).clm.	(US-PGPUB; USPAT)	OR	ON	ON	2025/02/06 02:35 PM
N78	381	(overlay SAME video ADJ signal\$1).clm.	(US-PGPUB; USPAT)	OR	ON	ON	2025/02/06 02:36 PM
N79	39	(overlay SAME video ADJ signal\$1 SAME (TV OR television)).clm.	(US-PGPUB; USPAT)	OR	ON	ON	2025/02/06 02:36 PM
N80	125	(overlay SAME criterion).clm.	(US-PGPUB; USPAT)	OR	ON	ON	2025/02/06 02:36 PM
N81	804	(video ADJ signal SAME digital ADJ data).clm.	(US-PGPUB; USPAT)	OR	ON	ON	2025/02/06 02:37 PM

N82	74	(video ADJ signal SAME digital ADJ data SAME (distinct OR different)).clm.	(US-PGPUB; USPAT)	OR	ON	ON	2025/02/06 02:37 PM
N83	80	(internet SAME video ADJ signal\$1 SAME combin\$5).clm.	(US-PGPUB; USPAT)	OR	ON	ON	2025/02/06 02:37 PM
N84	19	(internet SAME video ADJ signal\$1 SAME combin\$5 SAME (tv OR television)).clm.	(US-PGPUB; USPAT)	OR	ON	ON	2025/02/06 02:38 PM
N86	3	(internet SAME video ADJ signal\$1 SAME combin\$5 SAME (tv OR television) SAME overla\$5).clm.	(US-PGPUB; USPAT)	OR	ON	ON	2025/02/06 02:38 PM

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450**

Appl No.: 17/714,917
Inventor: Yakkov Merlin
Filing Date: April 6, 2022
Art Unit: 3992
Examiner: Basehoar, Adam L.
Attorney Docket No.: 103692.0001USre1

Title Method and Apparatus for Facilitating Toggling
Between Internet and TV Broadcasts

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

REQUEST FOR CONTINUED EXAMINATION

Sir:

This paper responds to the Final Office Action dated March 6, 2023 and Advisory Action dated July 26, 2023, and is filed concurrent with a Request for Continued Examination. Please enter the amendments shown herein.

- Claim Amendments begin on page 2.
- Specification Amendments begin on page 7.
- Remarks begin on page 8.

PART B - FEE(S) TRANSMITTAL

Complete and send this form, together with applicable fee(s), by mail or fax, or via the USPTO patent electronic filing system.

By mail, send to: Mail Stop ISSUE FEE
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

By fax, send to: (571)-273-2885

INSTRUCTIONS: This form should be used for transmitting the ISSUE FEE and PUBLICATION FEE (if required). Blocks 1 through 5 should be completed where appropriate. All further correspondence will be mailed to the current correspondence address as indicated unless corrected below or directed otherwise in Block 1, by (a) specifying a new correspondence address; and/or (b) indicating a separate "FEE ADDRESS" for maintenance fee notifications. **Because electronic patent issuance may occur shortly after issue fee payment, any desired continuing application should preferably be filed prior to payment of this issue fee in order not to jeopardize copendency.**

CURRENT CORRESPONDENCE ADDRESS (Note: Use Block 1 for any change of address)

Note: A certificate of mailing can only be used for domestic mailings of the Fee(s) Transmittal. This certificate cannot be used for any other accompanying papers. Each additional paper, such as an assignment or formal drawing, must have its own certificate of mailing or transmission.

Certificate of Mailing or Transmission

I hereby certify that this Fee(s) Transmittal is being deposited with the United States Postal Service with sufficient postage for first class mail in an envelope addressed to the Mail Stop ISSUE FEE address above, or being transmitted to the USPTO via the USPTO patent electronic filing system or by facsimile to (571) 273-2885, on the date below.

Tomas A. Prieto	(Typed or printed name)
/Tomas A. Prieto/	(Signature)
February 26, 2025	(Date)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
17/714,917	04/06/2022	Yakov MERLIN	103692.0001US1re	6111

TITLE OF INVENTION: Method And Apparatus For Facilitating Toggling Between Internet And TV Broadcasts

APPLN. TYPE	ENTITY STATUS	ISSUE FEE DUE	PUBLICATION FEE DUE	PREV. PAID ISSUE FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	SMALL	\$516	\$0.00	\$0.00	\$516	05/27/2025

EXAMINER	ART UNIT	CLASS-SUBCLASS
BASEHOAR, ADAM L	3992	725-087000

1. Change of correspondence address or indication of "Fee Address" (37 CFR 1.363).

☐ Change of correspondence address (or Change of Correspondence Address form PTO/AIA/122 or PTO/SB/122) attached.

☐ "Fee Address" indication (or "Fee Address" Indication form PTO/AIA/47 or PTO/SB/47; Rev 03-02 or more recent) attached. **Use of a Customer Number is required.**

2. For printing on the patent front page, list

(1) The names of up to 3 registered patent attorneys or agents OR, alternatively,

(2) The name of a single firm (having as a member a registered attorney or agent) and the names of up to 2 registered patent attorneys or agents. If no name is listed, no name will be printed.

1 Fish IP Law, LLP
2 Tomas A. Prieto
3

3. ASSIGNEE NAME AND RESIDENCE DATA TO BE PRINTED ON THE PATENT (print or type)

PLEASE NOTE: Unless an assignee is identified below, no assignee data will appear on the patent. If an assignee is identified below, the document must have been previously recorded, or filed for recordation, as set forth in 37 CFR 3.11 and 37 CFR 3.81(a). Completion of this form is NOT a substitute for filing an assignment.

(A) NAME OF ASSIGNEE

TVNGO LTD. (BVI)

(B) RESIDENCE: (CITY AND STATE OR COUNTRY)

Amsterdam, NL

Please check the appropriate assignee category or categories (will not be printed on the patent): ☐ Individual ☒ Corporation or other private group entity ☐ Government

4a. Fees submitted: ☒ Issue Fee ☐ Publication Fee (if required)

4b. Method of Payment: (Please first reapply any previously paid fee shown above)

☒ Electronic Payment via the USPTO patent electronic filing system ☐ Enclosed check ☐ Non-electronic payment by credit card (Attach form PTO-2038)

☐ The Director is hereby authorized to charge the required fee(s), any deficiency, or credit any overpayment to Deposit Account No. _____

5. Change in Entity Status (from status indicated above)

☐ Applicant certifying micro entity status. See 37 CFR 1.29

☐ Applicant asserting small entity status. See 37 CFR 1.27

☐ Applicant changing to regular undiscounted fee status.

NOTE: Absent a valid certification of Micro Entity Status (see forms PTO/SB/15A and 15B), issue fee payment in the micro entity amount will not be accepted at the risk of application abandonment.

NOTE: If the application was previously under micro entity status, checking this box will be taken to be a notification of loss of entitlement to micro entity status.

NOTE: Checking this box will be taken to be a notification of loss of entitlement to small or micro entity status, as applicable.

NOTE: This form must be signed in accordance with 37 CFR 1.31 and 1.33. See 37 CFR 1.4 for signature requirements and certifications.

Authorized Signature /Tomas A. Prieto/

Date February 26, 2025

Typed or printed name Tomas A. Prieto

Registration No. 60,675



UNITED STATES
PATENT AND TRADEMARK OFFICE

P.O. Box 1450
Alexandria, VA 22313 - 1450
www.uspto.gov

ELECTRONIC ACKNOWLEDGEMENT RECEIPT

APPLICATION #
17/714,917

RECEIPT DATE / TIME
02/26/2025 10:25:42 AM Z ET

ATTORNEY DOCKET #
103692.0001US1re

Title of Invention

Method And Apparatus For Facilitating Toggling Between Internet And TV Broadcasts

Application Information

APPLICATION TYPE Utility - Reissue

PATENT # -

CONFIRMATION # 6111

FILED BY Tomas Prieto

PATENT CENTER # 69341097

FILING DATE 04/06/2022

CUSTOMER # 24392

FIRST NAMED INVENTOR Yakkov MERLIN

CORRESPONDENCE ADDRESS -

AUTHORIZED BY -

Documents

TOTAL DOCUMENTS: 1

DOCUMENT	PAGES	DESCRIPTION	SIZE (KB)
2025-02-26 Issue Fee Transmittal.pdf	1	Issue Fee Payment (PTO-85B)	99 KB

Warning: The attached file contains comments or annotations. Comments are not recommended and may cause processing problems with the document.

Digest

DOCUMENT	MESSAGE DIGEST(SHA-512)
2025-02-26 Issue Fee Transmittal.pdf	9051FCF39214AEC36E8C3293450A2D895273F476F967BBFA3 FD9CB66A10F90BB1677E75FD01F8057001C50D32D93BF8E11 A7BB463226F121010AED9E6D7BA6F1

This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as

described in MPEP 503.

New Applications Under 35 U.S.C. 111

If a new application is being filed and the application includes the necessary components for filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application

National Stage of an International Application under 35 U.S.C. 371

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

New International Application Filed with the USPTO as a Receiving Office

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.



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PATENT AND TRADEMARK OFFICE

P.O. Box 1450
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ELECTRONIC PAYMENT RECEIPT

APPLICATION #
17/714,917

RECEIPT DATE / TIME
02/26/2025 10:25:42 AM Z ET

ATTORNEY DOCKET #
103692.0001US1re

Title of Invention

Method And Apparatus For Facilitating Toggling Between Internet And TV Broadcasts

Application Information

APPLICATION TYPE Utility - Reissue

PATENT # -

CONFIRMATION # 6111

FILED BY Tomas Prieto

PATENT CENTER # 69341097

AUTHORIZED BY -

CUSTOMER # 24392

FILING DATE 04/06/2022

CORRESPONDENCE ADDRESS -

FIRST NAMED INVENTOR Yakkov MERLIN

Payment Information

PAYMENT METHOD
CARD / 2000

PAYMENT TRANSACTION ID
E20252PA27385701

PAYMENT AUTHORIZED BY
Tomas Prieto

PRE-AUTHORIZED ACCOUNT
500341

PRE-AUTHORIZED CATEGORY

37 CFR 1.16 (National application filing, search, and examination fees); 37 CFR 1.17 (Patent application and reexamination processing fees); 37 CFR 1.19 (Document supply fees); 37 CFR 1.20 (Post Issuance fees); 37 CFR 1.21 (Miscellaneous fees and charges)

FEE CODE	DESCRIPTION	ITEM PRICE(\$)	QUANTITY	ITEM TOTAL(\$)
2511	REISSUE ISSUE FEE	516.00	1	516.00
TOTAL AMOUNT:				\$516.00

This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.

New Applications Under 35 U.S.C. 111

If a new application is being filed and the application includes the necessary components for filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application

National Stage of an International Application under 35 U.S.C. 371

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New International Application Filed with the USPTO as a Receiving Office

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	ISSUE DATE	PATENT NO.	ATTORNEY DOCKET NO.	CONFIRMATION NO.
17/714,917	04/22/2025	RE50399	103692.0001US1re	6111

24392 7590 04/02/2025

FISH IP LAW, LLP
19900 MacArthur Blvd, Suite 810
Irvine, CA 92612

ISSUE NOTIFICATION

The projected patent number and issue date are specified above. The patent will issue electronically. The electronically issued patent is the official patent grant pursuant to 35 U.S.C. § 153. The patent may be accessed on or after the issue date through Patent Center at <https://patentcenter.uspto.gov/>. The patent will be available in both the public and the private sides of Patent Center. Further assistance in electronically accessing the patent, or about Patent Center, is available by calling the Patent Electronic Business Center at 1-888-217-9197.

The USPTO is implementing electronic patent issuance with a transition period, during which period the USPTO will mail a ceremonial paper copy of the electronic patent grant to the correspondence address of record. Additional copies of the patent (i.e., certified and presentation copies) may be ordered for a fee from the USPTO's Certified Copy Center at <https://certifiedcopycenter.uspto.gov/index.html>. The Certified Copy Center may be reached at (800)972-6382.

Determination of Patent Term Extension or Adjustment under 35 U.S.C. 154 (b)

A reissue patent is for "the unexpired part of the term of the original patent." See 35 U.S.C. 251. Accordingly, the above-identified reissue application is not eligible for Patent Term Extension or Adjustment under 35 U.S.C. 154(b).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571)-272-7702. Questions relating to issue and publication fee payments should be directed to the Application Assistance Unit (AAU) of the Office of Patents Stakeholder Experience (OPSE), Stakeholder Support Division (SSD) at (571)-272-4200.

INVENTOR(s) (Please see PATENT CENTER site <https://patentcenter.uspto.gov> for additional inventors):

Yakkov MERLIN, Raanana, ISRAEL;

APPLICANT(s) (Please see PATENT CENTER site <https://patentcenter.uspto.gov> for additional applicants):

TVNGO LTD. (BVI), Amsterdam, NETHERLANDS, Assignee (with 37 CFR 1.172 Interest);

The United States represents the largest, most dynamic marketplace in the world and is an unparalleled location for business investment, innovation, and commercialization of new technologies. The USA offers tremendous resources and advantages for those who invest and manufacture goods here. Through SelectUSA, our nation works to encourage and facilitate business investment. To learn more about why the USA is the best country in the world to develop technology, manufacture products, and grow your business, visit SelectUSA.gov.

United
States
of
America

To Promote the Progress

of Science and Useful Arts

The Director

*of the United States Patent and Trademark Office has received
an application for the reissue of a patent. The title and description
of the invention are enclosed. The requirements of law have been
complied with, and it has been determined that a reissue patent
on the invention shall be granted under the law.*

Therefore, this United States

Patent

grants to the person(s) having title to this patent the right to exclude others from making, using, offering for sale, or selling the invention throughout the United States of America or importing the invention into the United States of America, and if the invention is a process, of the right to exclude others from using, offering for sale or selling throughout the United States of America, or importing into the United States of America, products made by that process, for the unexpired part of the term of the original grant, subject to the payment of maintenance fees as provided by 35 U.S.C. 41(b). See the Maintenance Fee Notice on the inside of the cover.

Coke Moya Sneyd
ACTING DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

Maintenance Fee Notice

If the application for the original patent being reissued is a utility application filed on or after December 12, 1980, maintenance fees are due three years and six months, seven years and six months, and eleven years and six months after the date of the grant of the original patent, or within a grace period of six months thereafter upon payment of a surcharge as provided by law. The amount, number and timing of the maintenance fees required may be changed by law or regulation. Unless payment of the applicable maintenance fee is received in the United States Patent and Trademark Office on or before the date the fee is due or within a grace period of six months thereafter, the patent will expire as of the end of such grace period.

No maintenance fees are required in plant or design patents.



US00RE50399E

(19) **United States**
(12) **Reissued Patent**
Merlin

(10) **Patent Number:** **US RE50,399 E**
(45) **Date of Reissued Patent:** **Apr. 22, 2025**

(54) **METHOD AND APPARATUS FOR
FACILITATING TOGGLING BETWEEN
INTERNET AND TV BROADCASTS**

FOREIGN PATENT DOCUMENTS

RU 2239293 10/2004
WO 00/07372 2/2000
(Continued)

(71) Applicant: **TVNGO LTD. (BVI)**, Amsterdam (NL)
(72) Inventor: **Yakkov Merlin**, Raanana (IL)
(73) Assignee: **TVNGO LTD. (BVI)**, Amsterdam (NL)
(21) Appl. No.: **17/714,917**
(22) Filed: **Apr. 6, 2022**

OTHER PUBLICATIONS

Patent Trial and Appeal Board (PTAB) Decision, Ex parte Merlin,
Appeal 2024-003078 (Dec. 2, 2024), pp. 1-10 (Year: 2024).*

Related U.S. Patent Documents

Reissue of:

(64) Patent No.: **8,132,220**
Issued: **Mar. 6, 2012**
Appl. No.: **11/794,825**
PCT Filed: **Jan. 11, 2005**
PCT No.: **PCT/IL2005/000035**
§ 371 (c)(1),
(2) Date: **Jul. 6, 2007**
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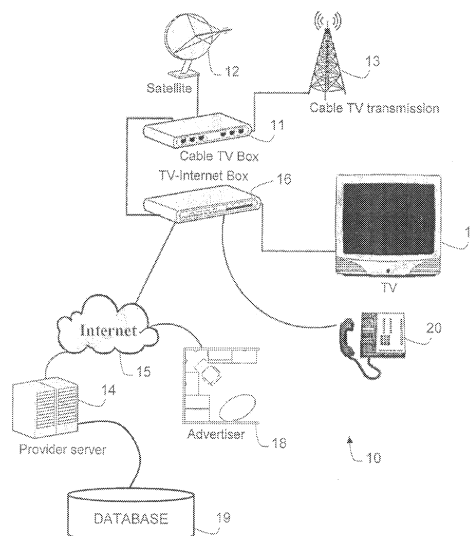
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(57) **ABSTRACT**

A TV-Internet Integration Box allows display of first data broadcast over a TV subscriber channel simultaneously together with second data broadcast over a digital data communications network has respective first and second inputs for receiving at a user premises the first data and the second data according to a user-profile associated with the second data. A combiner unit combines the first data and second data to form a combined video signal; and a video output coupled to the combiner unit conveys the combined video signal to a TV set in a user premises for displaying a first image corresponding to the first data and having superimposed thereon a second image corresponding to the second data. A user at the user premises may interact with the second image for redirecting to the digital data communications network and displaying a program broadcast thereby in at least a portion of the TV set.

19 Claims, 7 Drawing Sheets



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H04N 21/643 (2011.01)
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- (58) **Field of Classification Search**
USPC 725/109; 715/717, 718; 345/629
See application file for complete search history.

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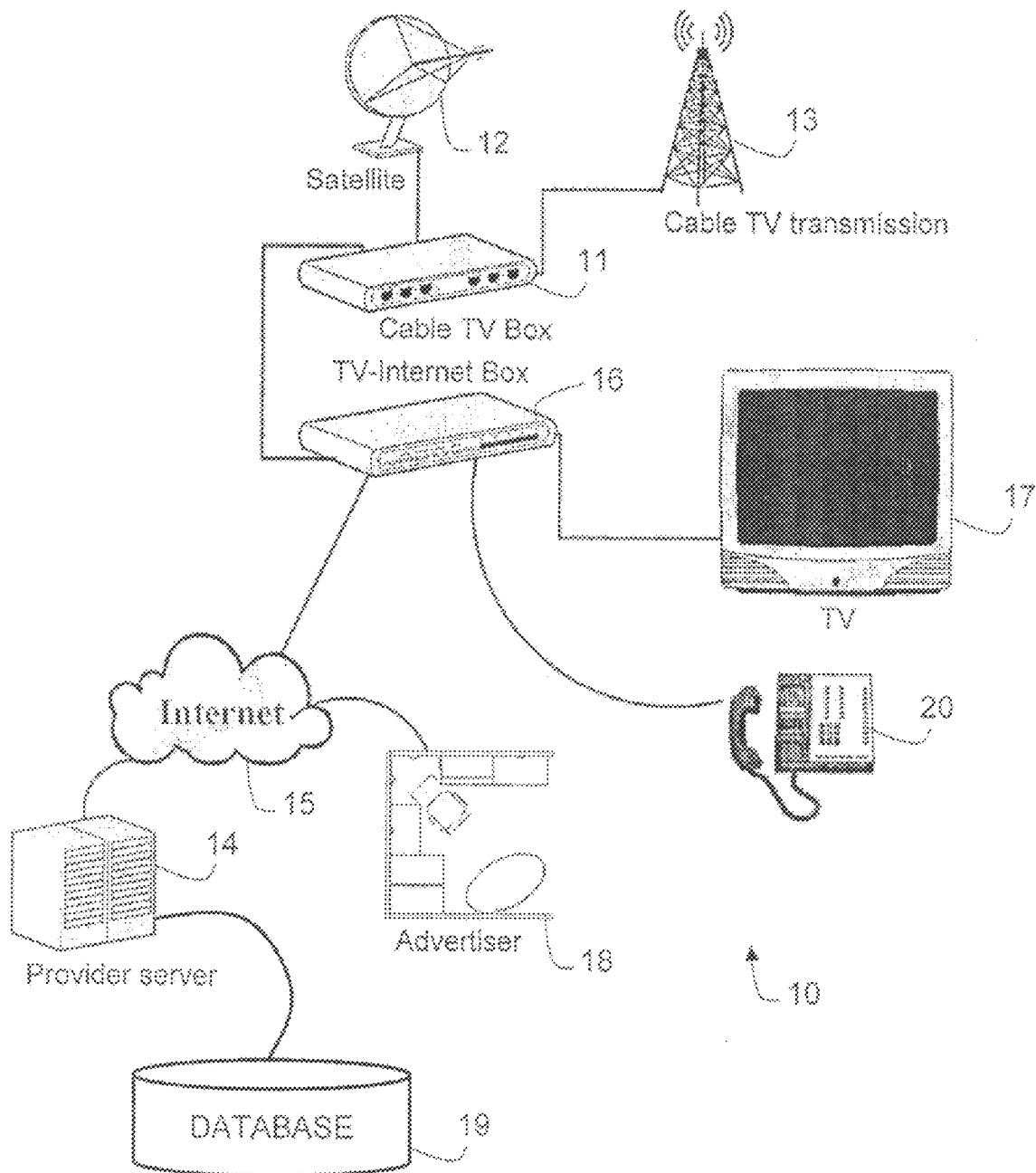


FIG. 1

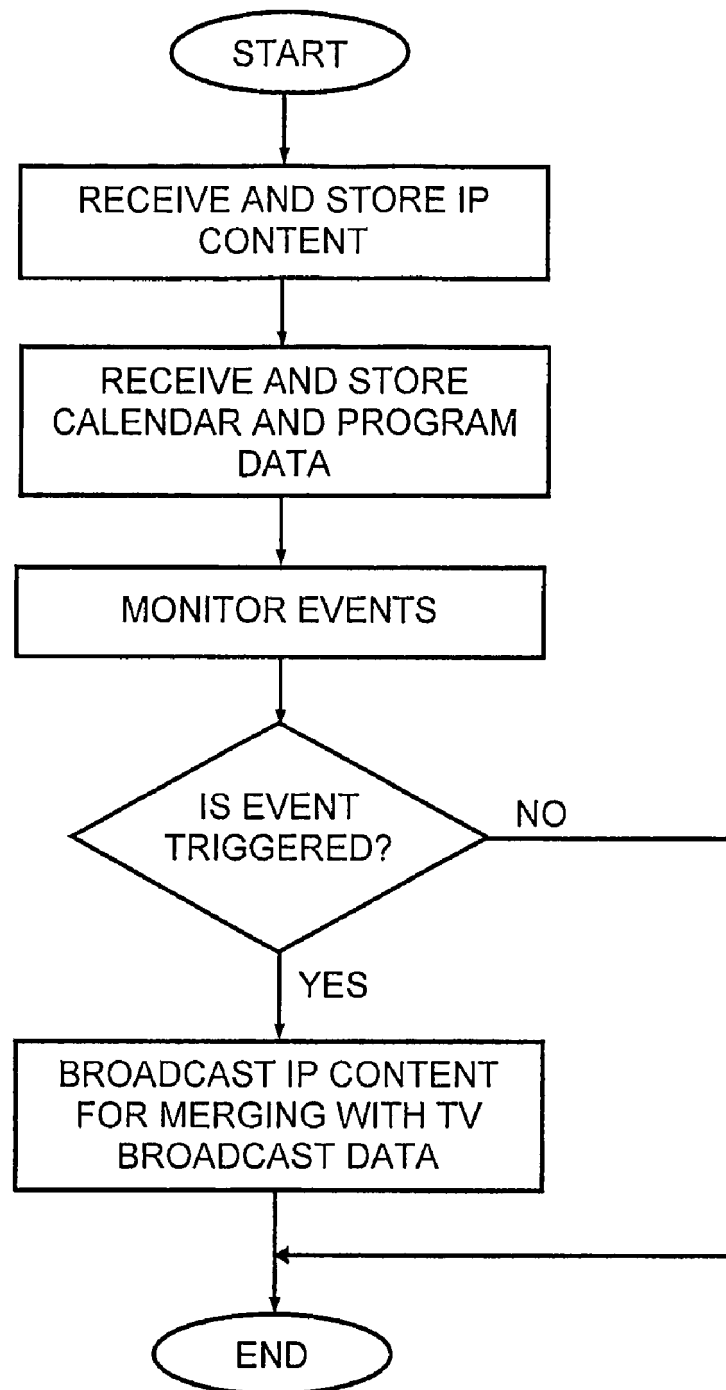


FIG. 2

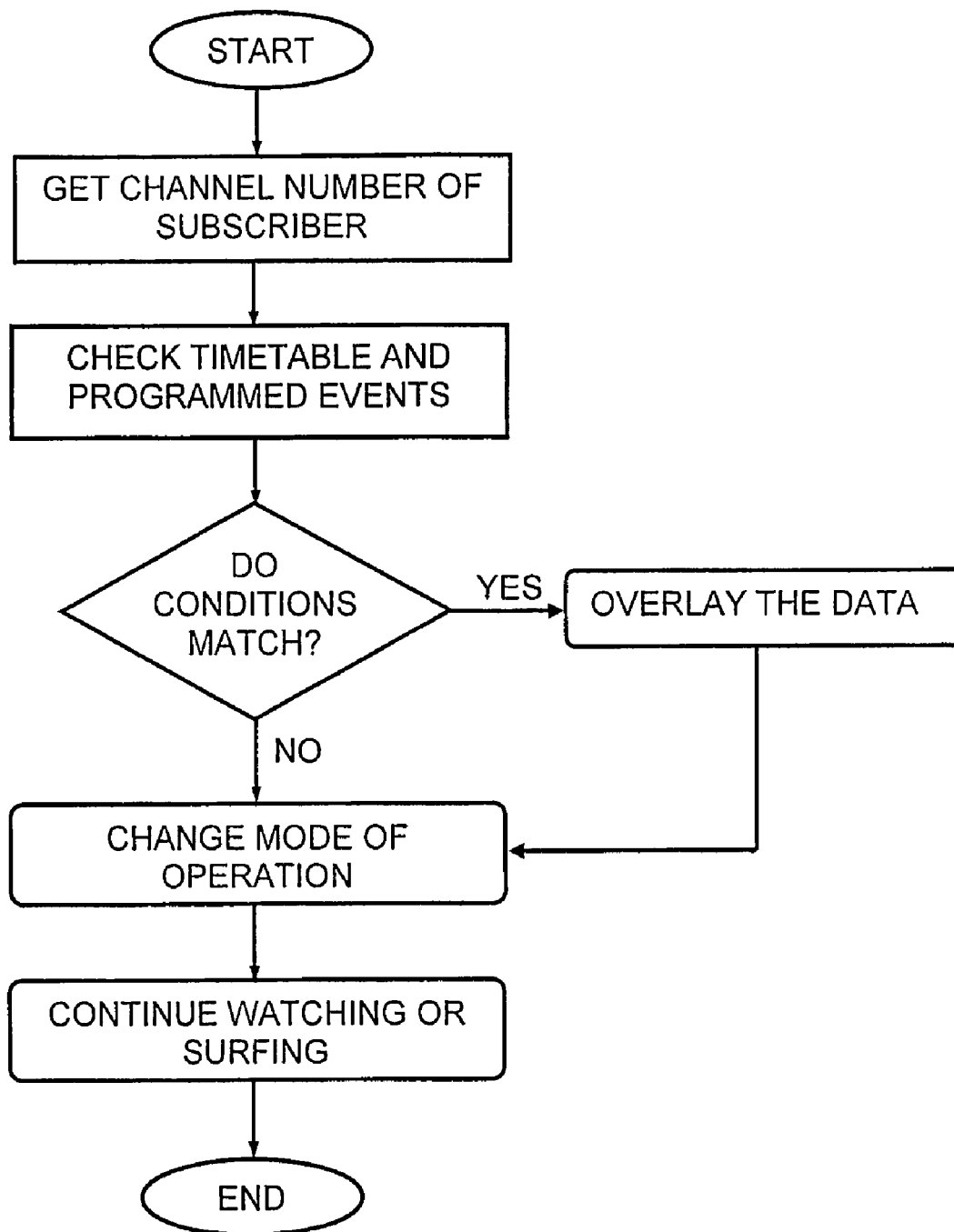
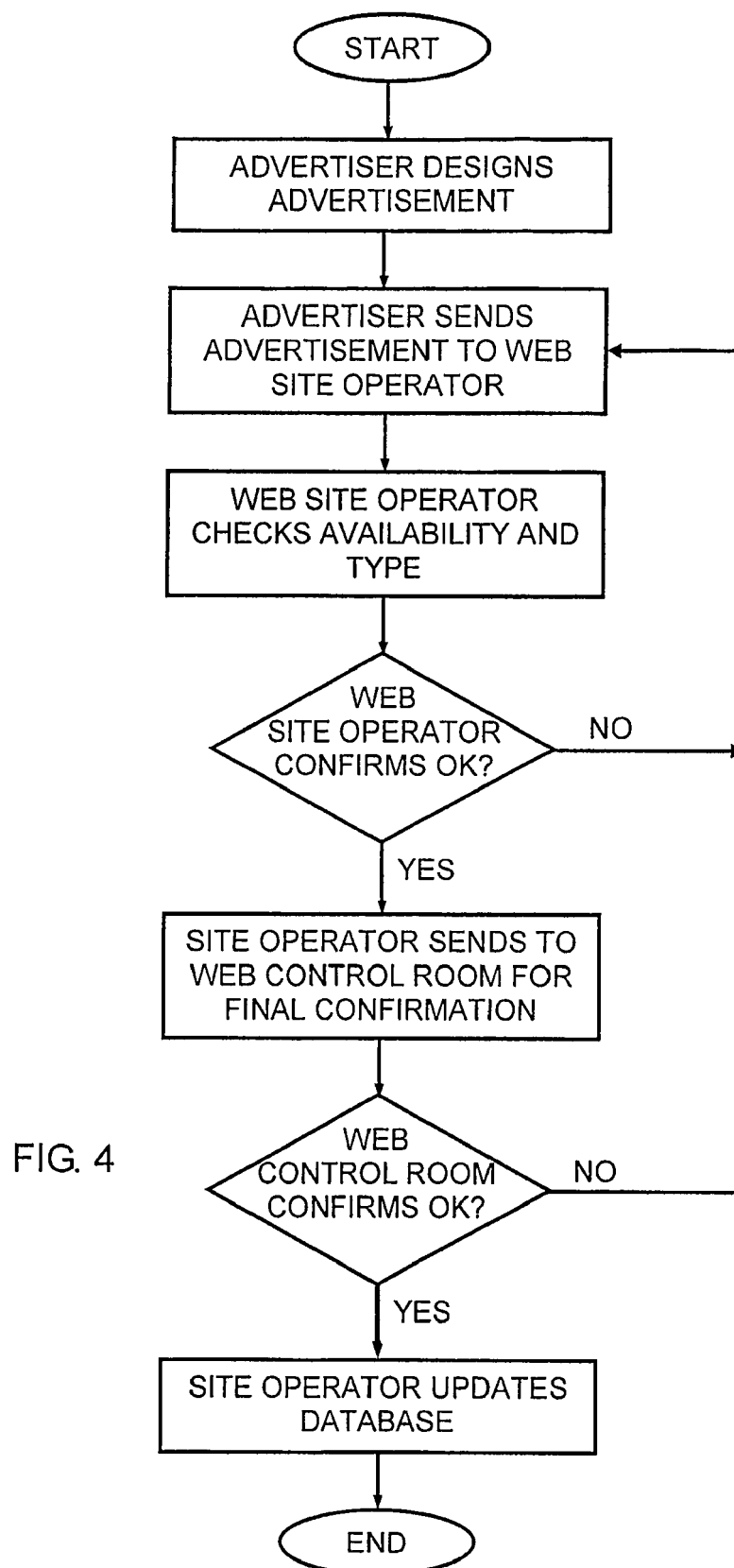


FIG. 3



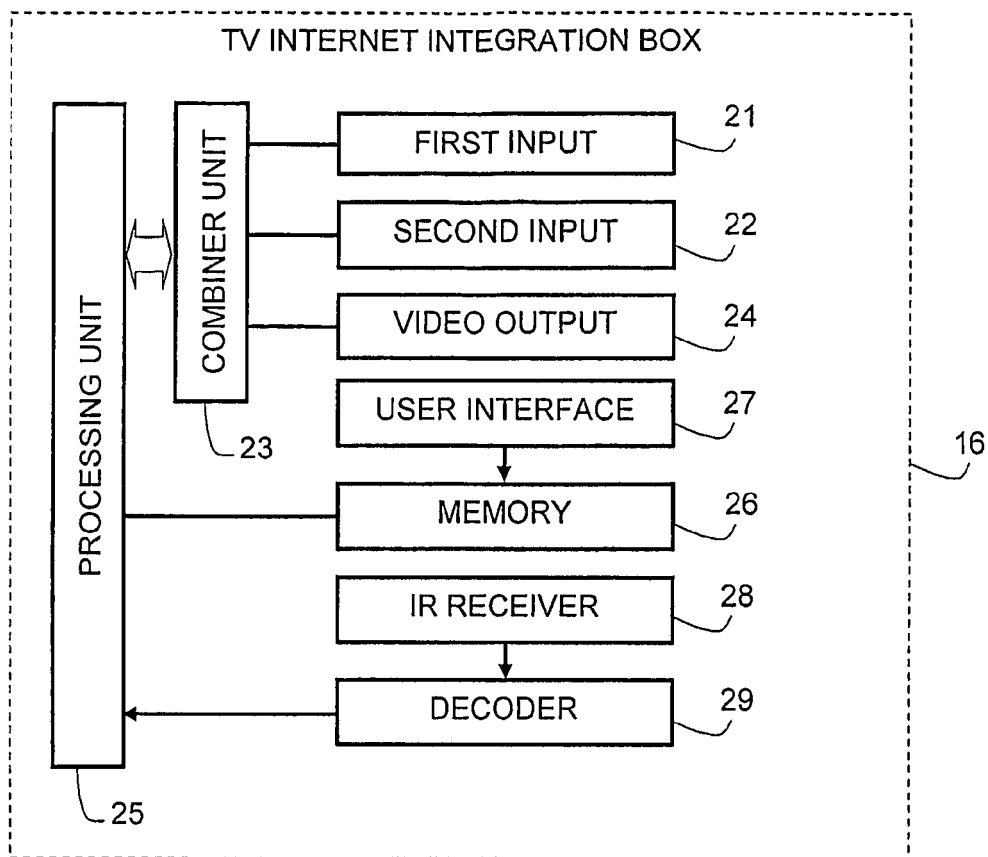


FIG. 5

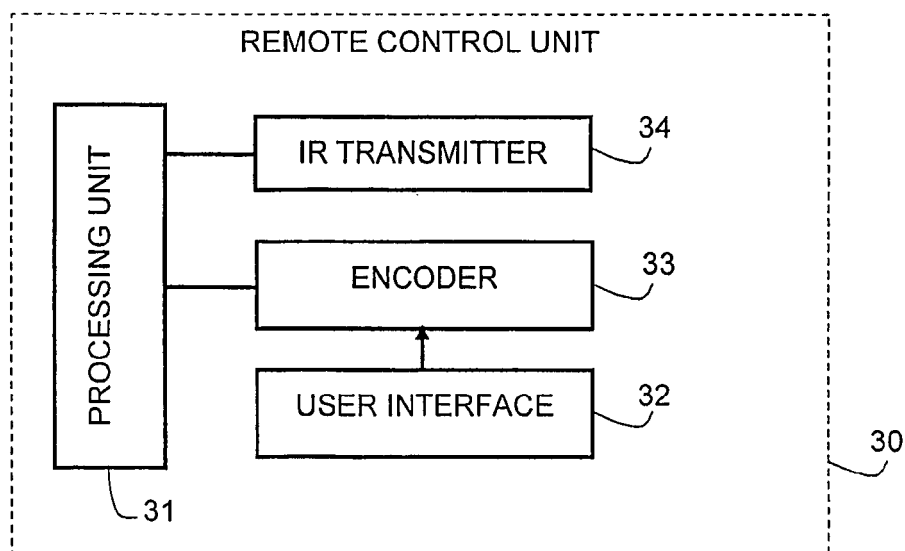


FIG. 6

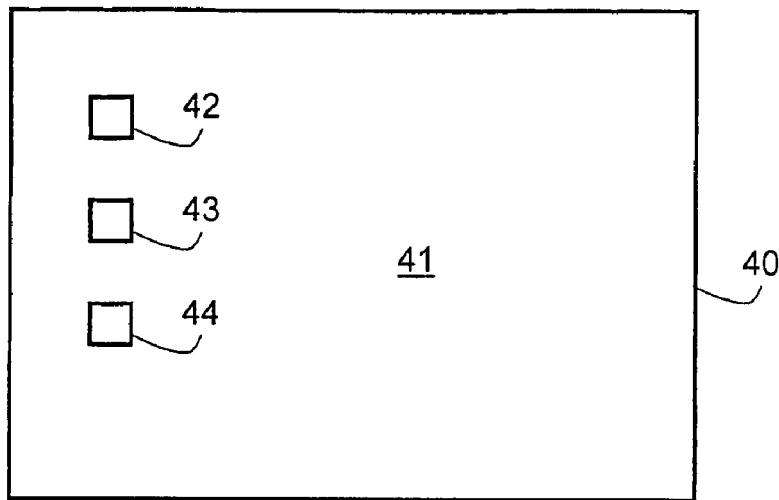


FIG. 7a

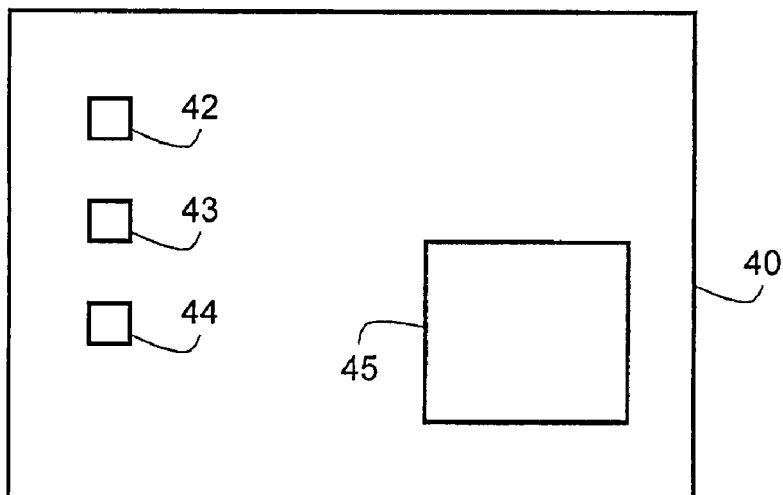


FIG. 7b

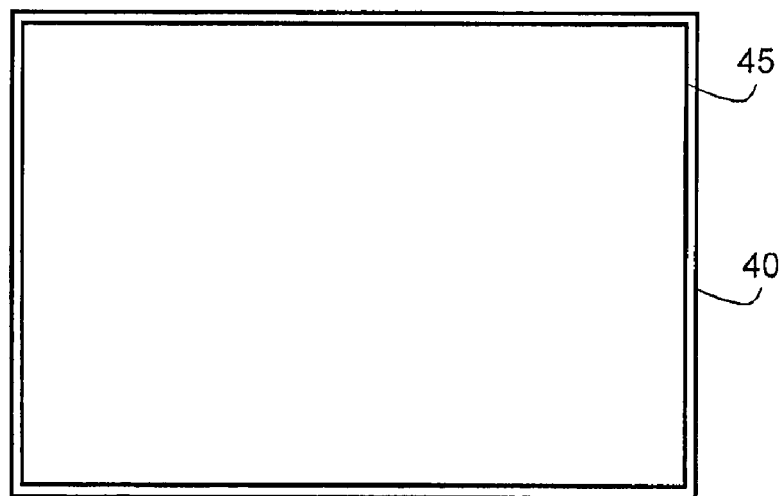


FIG. 7c

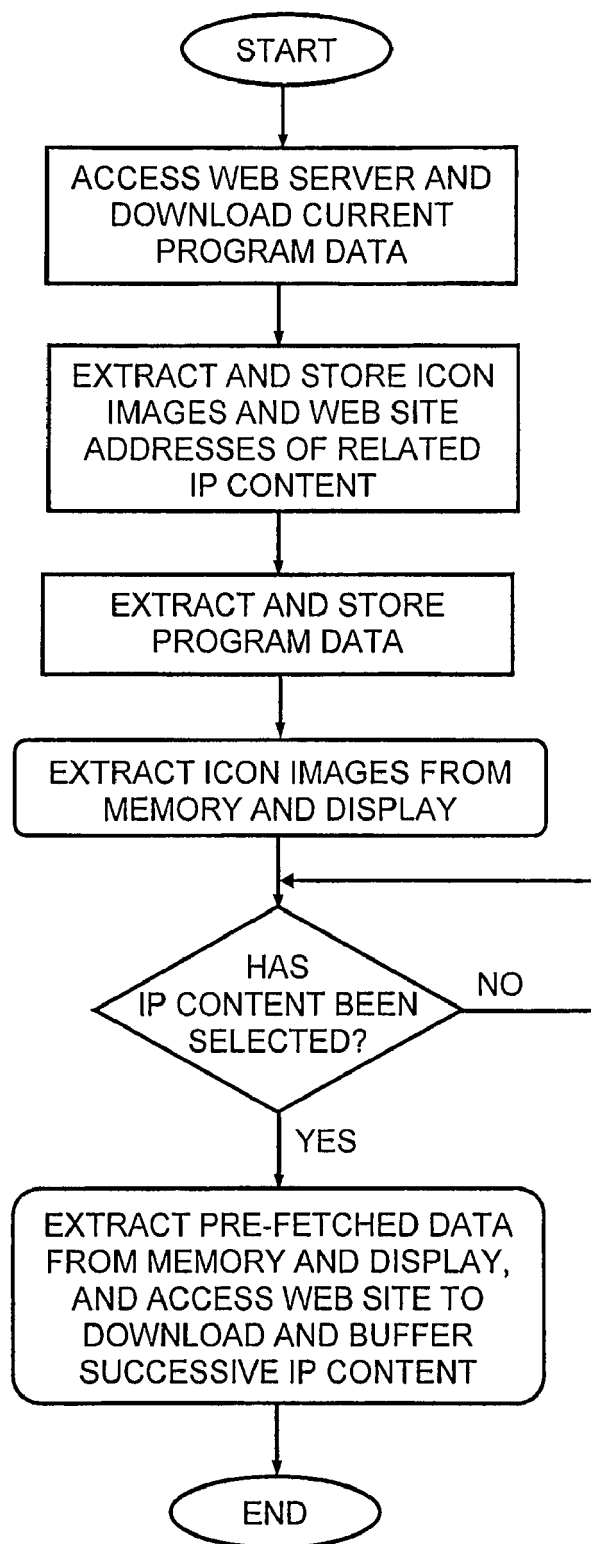


FIG. 8

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METHOD AND APPARATUS FOR FACILITATING TOGGLING BETWEEN INTERNET AND TV BROADCASTS

Matter enclosed in heavy brackets [] appears in the original patent but forms no part of this reissue specification; matter printed in italics indicates the additions made by reissue; a claim printed with strikethrough indicates that the claim was canceled, disclaimed, or held invalid by a prior post-patent action or proceeding.

FIELD OF THE INVENTION

This invention relates to the broadcast of audio/video content over the TV infrastructure and Internet.

BACKGROUND OF THE INVENTION

With the proliferation of cable TV and the high bandwidth currently available for the Internet, which promises to increase even more in the near future, Internet TV is fast becoming a viable alternative to regular and cable TV broadcast channels. Moreover, Internet TV is not subject to the government licensing laws required by cable and broadcast TV channels and thus offers programs that may not be obtainable using regular and cable TV broadcast channels.

It is not uncommon for Internet broadcasters to offer near DVD-quality movies that can be viewed either using video streaming or downloaded to the hard disk of a subscriber's computer for viewing "off-line". The video quality of such movies is vastly superior to that obtainable on a regular TV set, owing to the high resolution associated with computer displays that cannot presently be matched by TV screens. However, this is not particularly troublesome where only pictures are displayed; but it becomes a problem when textual information is displayed that is formatted for high resolution computer monitors since the text is then barely legible when displayed on lower resolution TV screens. Thus, if a regular TV set is used to display Internet content that is rich in text, the resulting display quality is poor.

It would therefore be a significant benefit to users of low resolution displays such as TV screens, to be able to watch regular and cable TV broadcasts and to integrate with Internet content on demand. In particular, it would be desirable to provide such a user with a visual and legible indication when viewing a regular or TV broadcast of available Internet movies or other programs and allow him to use the displayed indication to integrate with a desired Internet broadcast.

These requirements have been only partially addressed in the art. WO 00/08855 to United Video Properties, Inc. and entitled "A system and method for synchronizing television-related product content and internet-delivered information" describes a screen generator that merges program guide data with a TV image and superimposes an Interactive TV Guide on the regular TV image.

US 2002/0093594 (Kikinis) entitled "Method and system for identifying addressing data within a television presentation" illustrates in FIG. 5 the common connection of TV and Internet to a set-top box.

U.S. Pat. No. 6,606,746 to OpenTV, Inc. entitled "Interactive television system and method for displaying a graphical user interface using insert pictures" discloses interactive television having a compressed background picture and one or more compressed insert pictures commonly connected to a TV-Internet Integration box. The compressed insert pic-

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tures represent items of a GUI. The local system i.e. computer "pastes" the insert pictures into the background image.

U.S. Pat. No. 6,130,898 to Bell Atlantic Network Services, Inc., entitled "Simulcasting digital video programs for broadcast and interactive services" teaches an interactive TV system where TV broadcast data is merged with Internet data. To this end, public wireless packet data network is combined with a broadband digital broadcast network at a plurality of transmitter sites. Customer premises receiving systems include a receiving antenna and one or more digital entertainment terminals. The terminal includes a channel selector and digital receiver for capturing a digital transport stream from a selected channel. A processor converts selected program information from the transport stream for presentation, e.g. via a television set. The terminal also includes a CPU controlling the operation of the channel selector and the processor in response to user inputs.

None of these references appears to disclose the ability to merge broadcast TV signals with IP packet data at a customer site, specifically in such a manner that a conventional TV set is able to display Internet program selection data while viewing a TV broadcast program and to use the selected data to select an Internet channel, such as a movie, for display on the TV set instead of the TV broadcast program.

SUMMARY OF THE INVENTION

It is therefore an object of the present invention to provide a TV-Internet Integration Box having the ability to merge broadcast TV signals with IP packet data at a customer site.

It is a further object that such a TV-Internet Integration Box permits a TV set connected thereto to display Internet program selection data while viewing a TV broadcast program and to use the selected data to select an Internet movie for display instead of the TV broadcast program.

These objectives are realized in accordance with a first aspect of the invention by a method for facilitating first data broadcast over a TV subscriber channel to be displayed simultaneously together with second data broadcast over a digital data communications network, the method comprising:

- receiving said first data and said second data;
- combining said first data and said second data to form a combined video signal; and

- conveying said combined video signal to a TV set in a user premises for displaying a first image corresponding to the first data and having superimposed thereon a second image corresponding to the second data, said second image being configured to allow a user at said user premises to interact therewith for redirecting to the digital data communications network and displaying a program broadcast thereby in at least a portion of the TV set.

In accordance with a second aspect of the invention there is provided a method for facilitating first data broadcast over a TV subscriber channel to be displayed simultaneously together with second data broadcast over a digital data communications network, the method comprising:

- receiving said first data at a user premises;
- receiving said second data at the user premises according to a user-profile associated with the second data;
- combining said first data and said second data to form a combined video signal; and

- conveying said combined video signal to a TV set in a user premises for displaying a first image corresponding to the first data and having superimposed thereon a second image corresponding to the second data, said second image

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being configured to allow a user at said user premises to interact therewith for redirecting to the digital data communications network and displaying a program broadcast thereby in at least a portion of the TV set.

BRIEF DESCRIPTION OF THE DRAWINGS

In order to understand the invention and to see how it may be carried out in practice, a preferred embodiment will now be described, by way of non-limiting example only, with reference to the accompanying drawings, in which:

FIG. 1 is pictorial representation showing a TV-Internet Integration Box according to the invention connected to a mixed broadcast network for combining Internet and broadcast TV signals;

FIG. 2 is a flow diagram showing the principal actions carried out by the web server shown in FIG. 1;

FIG. 3 is a flow diagram showing the principal actions carried out by the TV-Internet Integration Box shown in FIG. 1;

FIG. 4 is a flow diagram showing the principal actions carried out by an IP content provider such as an advertiser for creating IP content for overlaying by the TV-Internet Integration Box with a broadcast TV signal;

FIG. 5 is a block diagram showing the functionality of the TV-Internet Integration Box shown in FIG. 1;

FIG. 6 is a block diagram showing the functionality of a remote control unit for interfacing with the TV-Internet Integration Box shown in FIG. 5;

FIGS. 7a, 7b and 7c are pictorial representations showing a TV set during different stages of receiving and displaying combined Internet and broadcast TV signals; and

FIG. 8 is a flow diagram showing the principal actions carried out by the TV-Internet Integration Box when pre-fetching a digital broadcast signal.

DETAILED DESCRIPTION OF EXEMPLARY EMBODIMENTS

FIG. 1 is pictorial representation showing a mixed broadcast network 10 having a Cable TV Box 11 coupled to a satellite 12 and a Cable TV transmitter 13 for receiving a cable TV broadcast signal (constituting first data). An Internet broadcast signal comprising IP packet data (constituting second data) is streamed from a web server 14 via the Internet 15 (constituting a digital data communications network) to a TV-Internet Integration Box 16 for display on a TV set 17 coupled thereto. The TV set 17 may be constituted by a computer having a video card and a high resolution display monitor. However, the principal benefit of the invention is obtained when a regular TV set having low resolution is used, since such a configuration has not so far been used to integrate Internet programs with conventional TV broadcasts in the manner proposed by the invention. The TV-Internet Integration Box 16 is connected to the Cable TV Box 11 for combining the broadcast TV signals received by the Cable TV Box 11 with the IP packet data broadcast via the Internet 15. Also shown is an advertiser 18 having a computer coupled to the Internet 15 for downloading advertising content to the web server 14 for storage in a database 19 and a telephone 20 coupled to the TV-Internet Integration Box 16 for feeding telephony signals to the TV-Internet Integration Box 16, which combines the received telephony signals with video data received from the Cable TV Box 11 and/or the Internet 15.

The advertiser 18 typically pays for specific time slots and for one or more specific channels during which his adver-

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tisement will be broadcast. Thus, in addition to the advertising content which is prepared and then stored on the web server 14 in known manner, the advertiser 18 also specifies when the advertisement is to be broadcast and on which TV channel or channels. By such means, a sports advertiser can request time during the interval of a football match to broadcast a commercial, while a toy advertiser would obviously prefer to broadcast a commercial during a children's TV program. Different time slots may be charged out at different rates depending on the ratings associated with the associated TV program. After selecting one or more time slots, the advertisement content as well as the selected time slots and program data are stored in the database 19 accessed by the web server 14.

FIG. 2 is a flow diagram showing the principal actions carried out by the web server 14, which is responsive to an event timetable stored and updated in the database 19. To this end, an IP content provider interfaces with the web server for creating IP content and associating therewith calendar and program data indicating dates, times and channels in respect of which the IP content is to be streamed to the customer premises. Once this is done, the web server 14 monitors events, which are triggered in known manner causing the web server 14 to extract from the database 19 pre-stored IP content for streaming over the Internet 15 to the TV-Internet Integration Box 16, where it is processed as described below with reference to FIG. 3 of the drawings.

FIG. 3 is a flow diagram showing the principal actions carried out by the TV-Internet Integration Box 16. In accordance with one embodiment of the invention, the subscriber selects what kind of IP content he wishes to receive and in respect of which program details, such as icons and/or textual data, are to be displayed together with the TV broadcast data. For example, a subscriber may wish to block certain types of program material or may wish to receive details thereof only during limited hours, for example when the children are asleep. To this end, the subscriber is able to program the TV-Internet Integration Box 16 in much the same way that a video cassette recorder is programmed so as to store in the memory 25 a timetable indicating what type of IP data is to be displayed and when. The timetable is updated as and when required by the subscriber. The TV-Internet Integration Box 16 is adapted to check the timetable periodically and to filter out incoming IP content that is either of a type that is not required or that is broadcast during an unauthorized time window. By such means, an additional layer of authorization may be provided to that stored in the database 19 for access by the web server 14, thus allowing pre-fetching of IP content and storage in the memory 25 of the TV-Internet Integration Box 16. Upon detecting a matching event, corresponding to received IP content that is of interest to the subscriber, the TV-Internet Integration Box 16 overlays the matched IP content with the current broadcast and displays the new integrated video on the subscriber's TV set 17. For example, the matched information may be an icon that indicates to the subscriber that an Internet movie is currently being broadcast; or it may be an advertisement or information related to the TV program being broadcast.

The subscriber can respond to the overlaid data using a remote control unit, described below with reference to FIG. 6 of the drawings, which is programmed to interact with the displayed icon or other data that is overlaid on the TV broadcast. To this end, the displayed IP content may optionally contain textual information advising the subscriber to press a particular button on the remote control unit. Alternatively, buttons on the remote control unit may be color-

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coded and the icon may be colored so as to indicate to the subscriber which color-coded button to press for selection of the corresponding IP content. If the subscriber responds to the overlaid data by pressing a button on the remote control unit, the TV-Internet Integration Box **16** receives the signal from the remote control unit and changes the priorities for use with the Picture-in-Picture (PIP) technique to display the TV broadcast in a reduced window and to show the other media, i.e. the IP content, in an enlarged window. The IP content can be a custom designed web page for TV, or a game or advertisement movie or any other information placed on the matched record. PIP techniques are known per se and allow a video or graphics image to be inserted on top of a movie clip and to be positioned and sized. An Effect In and Effect Out may be used to fade or move the inserted video to the screen. In accordance with one such technique, the bulk of the IP content e.g. corresponding to a movie may be rendered transparent so as to provide a transparent window through which an icon e.g. relating to the movie is visible. The video content of the TV broadcast is displayed in one window and the IP content in another window. Since the bulk of the IP content is transparent it will remain invisible to the subscriber, while the icon (or text) will be visible since it is opaque. On selecting the displayed icon, the attributes may simply be reversed so as to hide the icon while displaying the movie or other content. At the same time, the TV broadcast may be re-sized either to display it in a minimized window or the case that it is to be suppressed altogether, or to display it superimposed on the IP content so that both are visible at the same time in different, possibly overlapping, windows.

FIG. **4** is a flow diagram showing the principal actions carried out by an IP content provider such as an advertiser for creating IP content for overlaying by the TV-Internet Integration Box with a broadcast TV signal. Thus, the advertiser designs an advertisement and sends it together with a request to a web site link via the Internet or off-line as required. Since the IP content is intended for display on a low resolution TV screen, any textual information that forms part of the IP content is formatted so as to be legible when displayed on lower resolution TV screens. Generally, this requires reducing the quantity of textual information to a minimum and sizing any text so that it is legible. Often, a web advertiser will wish to create an on-line advertisement based on an existing web page. In such case, it may be necessary to reduce and resize any textual information so as to comply with these requirements.

The request specifies calendar and program data as explained above, which the web site operator checks for availability and type, defining to which group of users it belongs. If the required time slots are available for the requested channels, the site operator confirms the request and forwards the request to the web control room for final confirmation. On confirming the request, a status flag of the advertisement is changed so as to indicate that the advertisement is awaiting final confirmation from the web control room. At the web control room the advertisement is checked for content by human evaluators who either approve or reject the advertisement content and, in the case of rejection, may provide reasons therefore. If the advertisement (or other IP content) is approved by the web control center, its status is set to "approved" and the web control center bills the customer and the web site operator adds the advertisement and the scheduling information to the database **19**. The customer who is billed is typically the advertiser but may be any entity that is identified by a digital signature associated with the advertisement. If either of the requests for approval

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is rejected the status of the advertisement is set to "rejected" and the web control room informs the advertiser of the grounds for rejection, allowing the advertiser to change the request and re-send to the web site operator. Optionally, in such case the web server may be adapted to display to the advertiser the occupied timetable and suggest new timetable. Only those advertisements whose status flag indicates that they are approved by the web control room are actually available for transmission. The time slot and channel information associated with any advertisement that is not so approved remain available for other advertisements and will be shown as available to another advertiser who attempts to schedule an advertisement. Only when the advertisement is actually approved by the web site operator and its status is updated accordingly, are the transmission time and channel locked for use by other users.

The IP packet data may optionally be associated with predefined user-profiles that are also stored in the database **19** so that the advertisement or other IP data is sent only to specific TV-Internet Integration Boxes. Such user-profiles may be configured by the advertiser or by the user. Thus, for example, the invention allows supplementary or complementary program content to be associated with a TV broadcast, while providing the facility to view the supplementary program content only to specific subscribers, according to their user-profiles.

Thus, by way of non-limiting example, the invention allows sign language to be associated with a TV broadcast for the hard of hearing. It is known to display sign language in a corner of the screen, but since this is usually done indiscriminately it also apt to disturb the majority of viewers who do not need the sign language. The invention may be used to avoid this by conveying the sign language as IP content separate from main TV broadcast and allowing subscribers to register for a "sign language" service so that only registered subscribers receive the IP content. IP content files corresponding to sign language to be associated with different TV broadcasts are created as explained above, and stored in the database **19** together with user-profile data indicating which subscribers are registered to obtain the service. The user-profile data may contain data that further refines the target audience, such as categories of TV program alongside which the sign language is to be displayed. The user-profile data may further contain geographical data or language data that allows sign language corresponding to a target language to be conveyed to specific audiences. By such means, a TV program can be accompanied by a sign language overlay that is customized to a target language depending on the location of the IP target address or the language requested by the subscriber on registering for the service.

FIG. **5** is a block diagram showing the functionality of the TV-Internet Integration Box **16** shown in FIG. **1**. Thus, the TV-Internet Integration Box **16** comprises a first input **21** for receiving first data corresponding to a TV broadcast signal, typically being a cable TV signal and a second input **22** for receiving respective second data corresponding to IP packet data. The IP packet data may optionally be downloaded to specific TV-Internet Integration Boxes in accordance with predefined user-profiles associated with IP packet data and stored in the database **19**. A combiner unit **23** is coupled to the first and second inputs for combining the first data and the second data to form a combined video signal. A video output **24** is coupled to the combiner unit **23** for conveying the combined video signal to a TV set in a user premises. The TV set may be a conventional TV having a relatively low resolution screen for displaying a first image corre-

sponding to the first data and having superimposed thereon a second image corresponding to the second data. Alternatively, it can be a computer having a video card for displaying a combined video image on a high resolution display monitor.

The combiner unit **23** is shown coupled to a processing unit **25** although in practice it may be implemented in software by the processing unit **25**. A memory **26** is coupled to the processing unit **25** for storing program data, such as profiles and program timetables etc. so as to allow the processing unit **25** to filter incoming IP content according to pre-defined profiles and other selection data. The processing unit **25** is also coupled to a user interface **27** that allows the subscriber to program the TV-Internet Integration Box **16** and store the program data in the memory **26**. An IR receiver **28** is adapted to receive IR commands from a remote control unit described below with reference to FIG. **6** and is coupled to a decoder **29**, which decodes a received IR signal and feeds it to the processing unit **25** for further processing.

FIG. **6** is a block diagram showing the functionality of a remote control unit **30** for interfacing with the TV-Internet Integration Box **16** shown in FIG. **5**. The remote control unit **30** includes a processing unit **31** coupled to a user interface **32**, typically having a keypad or pushbuttons for program selection and setting as well as other functions. The user interface **32** is coupled to an encoder **33** which is responsive to a pressed key or key combination for producing a corresponding IR signal that is transmitted by an IR transmitter **34** to the TV-Internet Integration Box **16** for receipt by the IR receiver **28** thereof.

As noted above, the keys may be color coded in correspondence with pre-arranged colors of commonly displayed icons, so that pressing on a specific key activates the displayed icon of the same color. Alternatively, at least some of the keys may be covered with transfers depicting commonly displayed icons, whereupon the appropriate keys or button for activating each icon are easily recognized.

The keys may also be programmed so that depressing the same key more than once automatically re-sizes the windows containing the TV broadcast and the Internet broadcast. For example, FIG. **7a** shows the default situation where a TV screen **40** displays a conventional TV broadcast in a window **41** that is sized to occupy the whole area of the TV screen **40** and will be referred to as the primary window. Also shown are IP icons **42**, **43** and **44** each of which points to a different IP content that is streamed from a respective web site of known address. On pressing the key on the remote control unit **30** that corresponds to the icon **42**, the IP content corresponding thereto is displayed within a small window **45** (referred to as the secondary window) that is contained within the primary window **41** as shown in FIG. **7d**. The icons **42**, **43** and **44** remain visible so that, if desired, the selected program can be changed by pressing a different key on the remote control unit **30**. On pressing a key a second time in succession, the IP content is re-sized so that its window **45** occupies substantially the whole area of the screen as shown in FIG. **7c**. On pressing the key a third time in succession, the situation reverts to the default shown in FIG. **7a** where the primary window **41** containing the TV broadcast occupies the whole area of the TV screen **40**. Thus, each key operates as a three-way toggle that switches between three different display modes.

The second data containing display information for the icons also contains data that informs the TV-Internet Integration Box **16** on which channel or channels the associated IP content is to be streamed and at what times. The second

data also specifies the web site where the IP content is located. This is summarized in the following table:

TABLE I

Second data - definition			
Icon image	Channel	Time	Website of IP content
ICON.GIF	2; 23	19:30; 21:30	www.AB.com/adverts/123.htm

Thus, the second data depicted in Table I above shows that the icon image is contained in a file called ICON.GIF and that the IP content relating thereto is to be streamed on channels **2** and **23** at times 19:30 and 21:30, these being the start times. The end times are determined by the duration of the IP content to be streamed, which is downloaded from a web site whose name is shown in the table and is contained in the second data.

The second data is downloaded from the web server **14** whose web site address is known to the TV-Internet Integration Box **16**. In accordance with one embodiment, the processing unit **25** is programmed to access the web server **14** periodically and download current program data. For example, once every 2 to 3 hours the TV-Internet Integration Box **16** may automatically access the web server **14** to download the second data corresponding current program data for the next 3 hours as formatted according to Table I. The downloaded information is stored locally in the memory **26** of the TV-Internet Integration Box **16**. This allows the TV-Internet Integration Box **16** to pre-fetch IP content relating to all the currently displayed icons and to store the data relating thereto in the memory **26** thus obviating the need to access the web site of a selected icon for the purpose of downloading IP selected content. Since this carries the overhead of web access and downloading of data, which can be cumbersome particularly if there is insufficient bandwidth, pre-fetching in this manner ensures that initial IP content data will be immediately available on selection of one of the icons.

FIG. **8** is a flow diagram showing the principal actions carried out by the TV-Internet Integration Box when pre-fetching a digital broadcast signal. Thus, the TV-Internet Integration Box **16** periodically accesses the web server **14** and downloads current program data, constituting the second data. It then extracts from the current program data the image files of the current icons and stores them in the memory **26**. In like manner, it extracts the web sites of the IP content corresponding to the currently displayed icons and then accesses these sites to pre-fetch the respective IP content, which it likewise stores in the memory **26**. On selection of an icon, the TV-Internet Integration Box **16** opens a secondary window **45** within the primary window **41**, reads from the memory **26** the pre-fetched IP content and displays it in the secondary window **45**.

It will be understood that the TV-Internet Integration Box according to the invention may be at least partially implemented by a suitably programmed computer. Likewise, the invention contemplates a computer program being readable by a computer for executing the method of the invention. The invention further contemplates a machine-readable memory tangibly embodying a program of instructions executable by the machine for executing the method of the invention.

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The invention claimed is:

1. A method for generating at a user's premises an overlay using video signals constituting a first data and overlay-enabling digital data constituting a second data, the method comprising:

(a) providing a combiner unit at the user's premises, wherein:

the combiner unit is coupled to a TV set and connected to a separate TV tuner box or TV tuner in the TV set, at the user's premises, and

the combiner unit is also connected through distinct networks to each of a video signal source providing video signals through the *separate* TV tuner box or the TV tuner in the TV set, and an Internet data source providing overlay-enabling digital data over the Internet, wherein

said video signals and said overlay-enabling digital data originate from unrelated sources and are transmitted to the user's premises by different resources as mutually distinct and independent inputs, and wherein

said overlay-enabling digital data includes at least:

a Web link indicating a website where content that is associated with said overlay-enabling digital data is stored,

an image indicative of the content associated with said overlay-enabling digital data, and

an overlay activation criterion; and

(b) processing at the user's premises said overlay-enabling digital data and generating at the user's premises a corresponding overlay only if said *overlay* activation criterion is met, wherein generating [an] the overlay includes:

generating at the user's premises a first display screen including at least a first portion corresponding to said video signals and a second portion overlaid over said first portion and corresponding at least to said image, and

associating the Web link with said second portion of the first display screen thereby allowing a user to cause the combiner unit to retrieve said content, generate a second video display screen including at least a portion which corresponds to said content, and input the second display screen to said TV set.

2. The method according to claim 1, wherein said overlay-enabling digital data is received at the user premises according to a pre-stored user profile.

3. The method according to claim 1, further including: receiving a command from [a] the user at said user premises; and

responsive to said command, resizing said first portion and/or said second portion of said first display screen.

4. The method according to claim 1, wherein the content stored at said website enables streaming of digital data over the Internet; and

said method further including: pre-fetching and buffering said digital data stream from said website, thereby allowing said digital data stream to be displayed substantially without delay upon redirection by the user.

5. The method according to claim 1, wherein the overlay-enabling digital data comprises data representative of one or more second images, and for each of said one or more second images said overlay-enabling data comprises respective web site addresses where IP content associated with the respective second image is stored, and wherein said generating [an] the overlay further includes within said first display said one or more second images.

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6. The method according to claim 1, wherein the overlay-enabling digital data is supplementary or complementary to the video signals.

7. The method according to claim 1, wherein the image includes an icon that indicates to the user that digital data from Internet content is currently being displayed and which provides an indication of a nature of said Internet content.

8. The method according to claim 1, wherein the image contains textual information advising the user to press a particular button on [the] a remote control unit.

9. The method according to claim 1, wherein said overlay activation criterion includes at least one of the following: a timing information, data specifying one or more TV subscriber channels, a user command information.]

10. The method according to claim 5, further including: periodically accessing a web server for downloading said overlay-enabling digital data;

extracting from the overlay-enabling digital data said one or more second images and the respective web sites corresponding to each of said second images;

retrieving and storing digital content from said web sites; and

if the overlay activation criterion is met and a user command that is associated with an image from amongst said one or more second images is identified, displaying the respective image from amongst the second images, accessing the respective web site associated with the displayed image and extracting and buffering content from the website.

11. The method according to claim 5, further comprising displaying a respective IP content when a corresponding one of said one or more second images is selected.

12. The method according to claim 7, including selecting specific Internet content by pressing a color-coded button on a remote control in accordance with a color of said icon.

13. A TV-Internet Integration Box for generating at a user's premises an overlay using video signals constituting a first data and overlay-enabling digital data constituting a second data, the TV-Internet Integration Box comprising:

a combiner unit at [a] the user's premises coupled to a separate TV tuner box or TV tuner, wherein

the combiner unit is also connected through distinct networks to each of a video signal source providing video signals through the *separate* TV tuner box or the TV tuner, and an Internet data source providing overlay-enabling digital data over the Internet, wherein

said video signals and said overlay-enabling digital data originate from unrelated sources and are transmitted to the user's premises by different resources as mutually distinct and independent inputs, and

wherein said overlay-enabling digital data includes at least:

a Web link indicating a website where content that is associated with said overlay-enabling digital data is stored;

an image indicative of the content associated with said overlay-enabling digital data; and

an overlay activation criterion, wherein

the combiner unit is responsive to [an] the overlay activation criterion being met for generating a corresponding overlay, including:

generating at the user's premises a first display screen including at least a first portion corresponding to said video signals and a second portion overlaid over said first portion and corresponding at least to said image, and

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associating the Web link with said second portion of the first display screen thereby allowing a user to cause the combiner unit to retrieve said content, and generate a second video display screen including at least a portion which corresponds to said content; and
 a video output interface, coupled to or integrated within the combiner unit and configured to be coupled to a video input of said TV set and to display said first display screen or said second video display screen.

14. The TV-Internet Integration Box according to claim 13, wherein said overlay-enabling digital data is received at the user premises according to a pre-stored user-profile.

15. The TV-Internet Integration Box according to claim 13, further including:

- a command input for receiving a command from [a] the user at said user premises; and
- a frame adjuster for resizing said first portion and/or said second portion of said first display screen in response to said command.

16. The TV-Internet Integration Box according to claim 13, further including:

- a receiver for receiving a digital data stream, wherein the stream of the digital data is enabled by the content stored at said website; and
- a processing unit for pre-fetching and buffering said digital data stream from said website, thereby allowing said digital data stream to be displayed substantially without delay upon redirection by the user.

17. The TV-Internet Integration Box according to claim 13, wherein the overlay-enabling digital data comprises data representative of one or more second images, and for each of said one or more second images said overlay-enabling data comprises respective web site addresses where IP content associated with the respective second image is stored,

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and wherein the combiner unit is configured to:

- periodically access a web server for downloading said overlay-enabling digital data;
- extract from the overlay-enabling digital data said one or more second images and the respective web sites corresponding to each of said second images;
- retrieve and store digital content from said web sites; and
- if the overlay activation criterion is met, and a user command that is associated with an image from amongst said one or more second images is identified, display the respective image from amongst the second images, access the respective web site associated with the displayed image and extract and buffer content from the website.

18. The TV-Internet Integration Box according to claim 13, wherein the image includes an icon that indicates to the user that digital data from Internet content is currently being displayed and which provides an indication of a nature of said Internet content.

19. The TV-Internet Integration Box according to claim 13, wherein the image contains textual information advising the user to press a particular button on [the] a remote control unit.

[20. The TV-Internet Integration Box according to claim 13, wherein said overlay activation criterion includes at least one of the following: a timing information, data specifying one or more TV subscriber channels, a user command information.]

21. The TV-Internet Integration Box according to claim 18, wherein the icon is colored so as to allow user selection of a specific Internet content by pressing a color-coded button on a remote control in accordance with a color of said icon.

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