

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS INC.,
Petitioner,

v.

JOHN L. BERMAN,
Patent Owner.

Case IPR2016-01571
Patent 5,523,791

Before KEN B. BARRETT, PATRICK M. BOUCHER, and
MELISSA A. HAAPALA, *Administrative Patent Judges*.

HAAPALA, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

United Patents Inc. (“Petitioner”) filed a Petition pursuant to 35 U.S.C. §§ 311–319 to institute an *inter partes* review of claims 2–16 of U.S. Patent No. 5,523,791 (“the ’791 patent”). Paper 1 (“Pet.”). John L. Berman (“Patent Owner”) filed a Preliminary Response. Paper 8 (“Prelim. Resp.”). Applying the standard set forth in 35 U.S.C. § 314(a), which requires demonstration of a reasonable likelihood that Petitioner would prevail with respect to at least one challenged claim, we deny Petitioner’s request and do not institute an *inter partes* review.

I. BACKGROUND

A. The ’791 Patent (Ex. 1001)

The ’791 patent describes techniques for superimposing images over television scenes. Ex. 1001, 1:5–6. A viewer can use an input device, such as a joystick, to select an overlay image and position the overlaid image with respect to the background video to set up humorous or otherwise expressive effects. *See id.* at 1:34–52. The ’791 patent further describes warping (distorting) the background video in a manner similar to a fun-house mirror by varying the phase of the horizontal or vertical synchronization pulses to produce a variable phase shift of the horizontal lines. *See id.* at 3:5–12; 5:43–61.

Figure 1 of the ’571 patent is reproduced below:

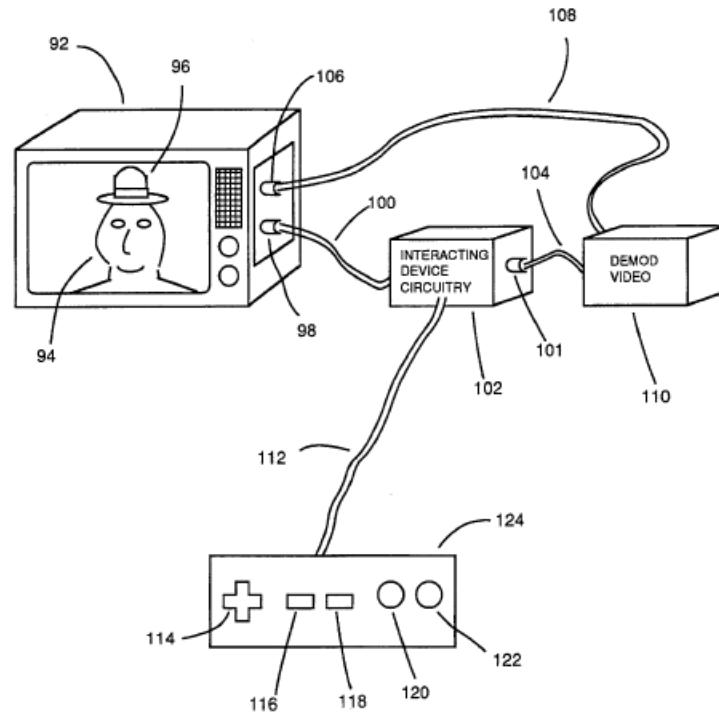


Figure 1

Figure 1 illustrates a preferred embodiment used to overlay an image on background video and to interact with the overlaid image. *See id.* at 3:27–39, 3:39–4:14. A source of demodulated video (e.g., video cassette recorder, cable converter) is connected to interacting apparatus 102, which combines demodulated video 94 (background video) with overlaid image 96, such as the hat illustrated in Figure 1. *Id.* at 3:39–42. The combination of background video 94 with overlaid image 96 is supplied to television receiver 92. *Id.* at 48–50. Interacting apparatus is controlled by joystick 124 to signal to the interacting apparatus to perform various functions, such as selecting a particular overlay image, positioning an overlay image relative to background video, and producing a distortion of the picture. *See id.* at 3:51–4:14.

B. Illustrative Claims

Claims 2 and 16 are illustrative of the subject matter of the claims at issue:

2. An apparatus for inserting an overlay image onto a background video image, said apparatus comprising:

video input means, for receiving a video signal corresponding to said background video image;

synchronization means, coupled to said video input means, for generating synchronization signals from said background video signal;

viewer input means, comprising selection means for receiving an input command from a viewer to select an overlay image and position input means for receiving a position input from a viewer and generating a position signal to position an image on a display;

processor means, coupled to said operator input means, for receiving said input command and generating overlay image data;

first memory means, coupled to said processor means, for storing said overlay image data;

address generator means, coupled to said memory means, said processor means and said synchronization means for selectively generating memory addresses for said memory means in response to said processor means and in synchronization with said synchronization means; and

video output means, coupled to said memory means, for selectively reading the overlay image data from said memory means in synchronization with said synchronization means and merging said overlay image with said background video image.

16. A method of distorting a video image comprising the steps of:

receiving a video signal corresponding to said video image;

separating vertical and horizontal synchronization signals from said video signal and generating horizontal and vertical synchronizing pulses;

receiving an input command from an operator for selecting a normal or distorted image;

selectively applying, in response to said input command and a predetermined pattern, said horizontal synchronizing signals and said horizontal synchronizing pulses to each horizontal line of said video signal and outputting a distorted video signal for generating a distorted video image.

C. References

Petitioner relies on the following references:

1. U.S. Patent No. 4,855,813, issued Aug. 8, 1989 (“Russell”) (Ex. 1003).
2. U.S. Patent No. 5,594,467, issued Jan. 14, 1997 (“Marlton”) (Ex. 1005).
3. Intel 82786 Graphics Coprocessor User’s Manual (1988) (“Intel User’s Manual”) (Ex. 1004).

D. Grounds Asserted

Petitioner challenges the patentability of the claims of the ’791 patent under 35 U.S.C. § 103(a) over the following combinations of references:

Reference(s)	Claim(s)
Russell alone or in view of Intel User’s Manual	2
Russell alone or in view of Intel User’s Manual	3–8, 10–15
Russel and Marlton	9, 16

E. Related Proceedings

Petitioner and Patent Owner identify the following litigation involving the ’791 Patent: (1) *Berman v. Comcast Corp.*, Case No. 2-16-cv-00412

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