

NOTE: This disposition is nonprecedential.

**United States Court of Appeals  
for the Federal Circuit**

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**PRISUA ENGINEERING CORP.,**  
*Appellant*

v.

**SAMSUNG ELECTRONICS AMERICA, INC.,**  
*Appellee*

**KATHERINE K. VIDAL, UNDER SECRETARY OF  
COMMERCE FOR INTELLECTUAL PROPERTY  
AND DIRECTOR OF THE UNITED STATES  
PATENT AND TRADEMARK OFFICE,**  
*Intervenor*

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2021-1960

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Appeal from the United States Patent and Trademark  
Office, Patent Trial and Appeal Board in No. IPR2017-  
01188.

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Decided: June 30, 2023

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JOHN C. CAREY, Carey Rodriguez Milian Gonya, LLP,  
Miami, FL, argued for appellant. Also represented by  
NICHOLAS J. DOYLE.

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RICHARD L. RAINEY, Covington & Burling LLP, Washington, DC, argued for appellee. Also represented by BRADLEY KEITH ERVIN, ROBERT JASON FOWLER.

MARY L. KELLY, Office of the Solicitor, United States Patent and Trademark Office, Alexandria, VA, for intervenor. Also represented by PETER J. AYERS, SARAH E. CRAVEN, THOMAS W. KRAUSE, FARHEENA YASMEEN RASHEED.

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Before DYK, BRYSON, and STARK, *Circuit Judges*.

STARK, *Circuit Judge*.

Prisua Engineering Corp. (“Prisua”) appeals a decision of the Patent Trial and Appeal Board (“Board”) concluding that claims 1-4 and 8 of U.S. Patent No. 8,650,591 (“’591 patent”) are unpatentable as obvious. Because substantial evidence supports the Board’s findings, we affirm.

## I

The ’591 patent, titled “Video Enabled Digital Devices for Embedding User Data in Interactive Applications,” teaches apparatuses and methods that enable substituting a part of one video as a part of another video. For example, the technology could allow a user to substitute her own face for a character’s or actor’s face in a video game or movie.

Claims 1-4 and 8 of the ’591 patent are at issue on appeal. Claim 1, an apparatus claim from which claims 2-4 and 8 depend, is illustrative of the challenged claims and recites:

An interactive media apparatus for generating a displayable edited video data stream from an original video data stream, wherein at least one pixel in a frame of said original video data stream is digitally extracted to form a first image, said first image then replaced by a second image resulting from

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a digital extraction of at least one pixel in a frame of a user input video data stream, said apparatus comprising:

an image capture device capturing the user input video data stream;

*an image display device displaying the original video stream;*

*a data entry device, operably coupled with the image capture device and the image display device, operated by a user to select the at least one pixel in the frame of the user input video data stream to use as the second image, and further operated by the user to select the at least one pixel to use as the first image;*

wherein said data entry device is selected from a group of devices consisting of: a keyboard, a display, a wireless communication capability device, and an external memory device;

a digital processing unit operably coupled with the data entry device, said digital processing unit performing:

identifying the selected at least one pixel in the frame of the user input video data stream;

extracting the identified at least one pixel as the second image;

storing the second image in a memory device operably coupled with the interactive media apparatus;

receiving a selection of the first image from the original video data stream;

extracting the first image;

spatially matching an area of the second image to an area of the first image in the original video data stream, wherein spatially matching the areas results in equal spatial lengths and widths between said two spatially matched areas; and

performing a substitution of the spatially matched first image with the spatially matched second image to generate the displayable edited video data stream from the original video data stream.

'591 patent 7:14-54 (emphasis added). The two emphasized limitations are referred to as the “image display device limitation” and the “data entry device limitation” respectively. Both are at issue in this appeal.

After Prisua sued Samsung Electronics America, Inc. (“Samsung”) for infringing the '591 patent, Samsung petitioned the Board for *inter partes* review of claims 1-4, 8, and 11. See *Samsung Elecs. Am., Inc. v. Prisua Eng'g Corp.*, 948 F.3d 1342, 1349-50 (Fed. Cir. 2020) (explaining initial procedural history of this case). Samsung's grounds for unpatentability were based on, as relevant here, Patent Application Publication No. 2005/0151743 (“Sitrick”) and, alternatively, U.S. Patent No. 7,460,731 (“Senftner”).<sup>1</sup>

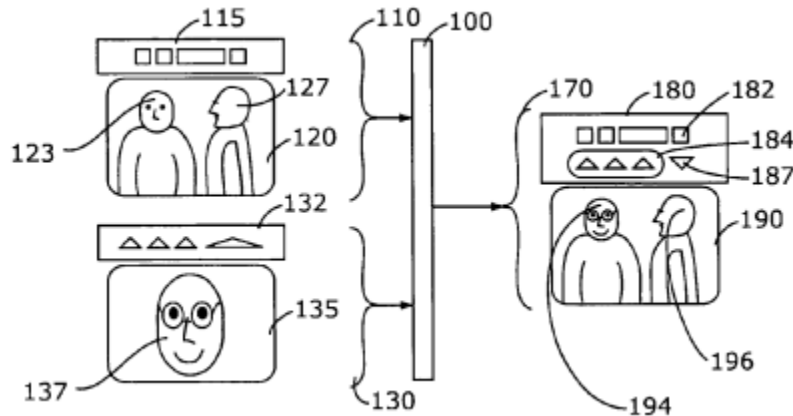
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<sup>1</sup> Samsung's grounds for obviousness for claims 3 and 4 relied on a combination of Sitrick, or alternatively, Senftner, with a third prior art reference. Because the issues presented in this appeal relate only to Sitrick and/or Senftner, for simplicity we refer just to these two references. Our discussion of the obviousness grounds based on those two references applies equally to the combination grounds with which Samsung challenges claims 3 and 4.

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Sitrick teaches “a system and method for processing a video input signal providing for tracking a selected portion in a predefined audiovisual presentation and integrating selected user images into the selected portion of the predefined audiovisual presentation.” J.A. 1970. Figure 1 of Sitrick is a “diagram of the [Sitrick] invention”:



J.A. 1971, 1980. As depicted in the figure, Sitrick teaches incorporating “a user specified image” (137) from image data (135) into an original video (120) to produce an output video (190) in which the user specified image replaces a portion of the original video (123).<sup>2</sup> J.A. 1980 (Sitrick ¶ 31). Senftner similarly teaches processes and devices for “creating personalized videos through partial image replacement.” J.A. 1953 (Senftner 1:36-37).

The Board instituted *inter partes* review and found claim 11 obvious in light of Sitrick. The Board further determined it could not assess the obviousness of claims 1-4 and 8 because they were indefinite under *IPXL Holdings*,

<sup>2</sup> We follow the terminology of Sitrick and, when discussing the reference, refer to the original source and the output as “videos” but refer to the replacement source as an “image.” The parties do not suggest this difference is material.

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