

EXHIBIT Q



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Bennington et al.

Serial No.: 08/119,367 Art Unit: 2602

Filed: September 9, 1993 Examiner: Lee, M.

For: Electronic Television Program
Schedule System and Method

DECLARATION UNDER 37 C.F.R. § 1.131

Hon. Commissioner of Patent and Trademarks
Washington, D.C. 20231

Sir:

1. We are applicants in the above-identified patent application and co-inventors of the subject matter described and claimed therein relating to searching and displaying program schedule information for programs other than a currently appearing television program.

2. Prior to September 28, 1992, we completed and reduced to practice operative prototypes that allowed a user to interactively navigate through program schedule information, for programs other than a currently appearing program, displayed simultaneously with the currently appearing television program on the same screen. These prototypes, completed by us prior to September 28, 1992,

*Plomer
12/1/95*

NYPS03...318177118V0005122234JCL0105N.110

embodied the "browse" feature of our invention, such as claimed in pending claims 42-55, 63-65, 70-128 and new claims 130-133. The prototypes used a personal computer as the data processor to run the application software and to support the database files containing the program schedule listings. The operation of these prototypes demonstrated to our satisfaction that our invention worked for its intended purpose.

3. Attached as Exhibit A is a letter dated prior to September 28, 1992, from Bill Cooper at Xpress Information Services, Ltd. to Brian Margolis of News America's TV Guide, which contains instructions on installing and running one such operative prototype application program, as well as a copy of the cover of the diskette, dated prior to September 28, 1992, containing the application program. (The dates on the Exhibit A letter and the diskette cover have been redacted.) Attached as Exhibit B is a copy of a screen display from the application program contained on the Exhibit A diskette, which further evidences the "browse" feature of our invention, as set forth in the above-identified claims. Exhibits A and B evidence that we reduced to practice the invention of the above-identified claims prior to September 28, 1992, and that the invention we reduced to practice at that time worked for its intended purpose.

4. Attached as Exhibit C (with dates redacted) is a copy of a TV Guide inter-office memorandum dated prior to September 28, 1992, from Robinowitz to Brian Robbins, Roger Youman and Mike Morris, all of TV Guide, enclosing

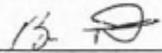
copies of screen displays from an operative prototype application program developed subsequent to the operative application program discussed in paragraph 3 above. (Omitted from Exhibit C are copies of screen displays not relevant to the "browse" feature of our invention.) The Exhibit C display screens further evidence the operability of the invention we reduced to practice, such as that claimed in the above-identified claims. Exhibit C also evidences the aspect of our invention of simultaneously displaying program schedule information for programs other than the currently appearing program. Exhibit C also evidences that we reduced to practice the invention of the above-identified claims prior to September 28, 1992, and that at that time it worked for its intended purpose.

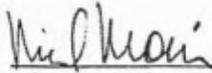
5. Attached as Exhibit D (with dates redacted) is a copy of a memorandum dated prior to September 28, 1992, from Animatrix, Inc. to Roger Youman at TV Guide, enclosing instructions on navigating through the operative prototype application program that we previously developed and reduced to practice. The Exhibit D instructions discuss the operability of the invention we reduced to practice, and, inter alia, specifically describe how the "browse" feature of our invention allowed a user to interactively select portions of program schedule information by issuing consecutive control commands for successively navigating through listing information for sequential time periods or channels in the operative prototype application program. Exhibit D also evidences that we reduced to practice

invention, such as that claimed in the above-identified claims, and that at that time it worked for its intended purpose.

6. All of the foregoing acts took place within the United States of America.

7. We hereby declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

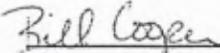

Bruce Davis


Michael Morris


Gerald E. Bennington


George Backer


Shawn Green


Bill Cooper

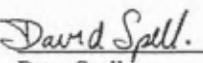

Dave Spell

Exhibit A

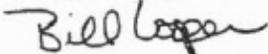
Bill Cooper
X*PRESS Information Services, Ltd.
4700 South Syracuse Parkway Suite 1050
Denver, CO 80237
(303) 267-4112

Mr. Brian Margolis
News America 900
1211 Avenue of the Americas
New York, NY 10036

Dear Brian,

The diskette that has been sent to you contains the Tvguide application and supporting files. To start the application simply copy the files onto your PC and read the readme file. This version contains the Primetime listings in as grid format as requested. To access the listings simply start the application and go to the TV Guide Main Menu, at the menu press 5 or arrow to that location and press enter. If you have any questions give me a call at 303-267-4112.

Sincerely,



Bill Cooper
Programmer/Analyst



TV guide Demo

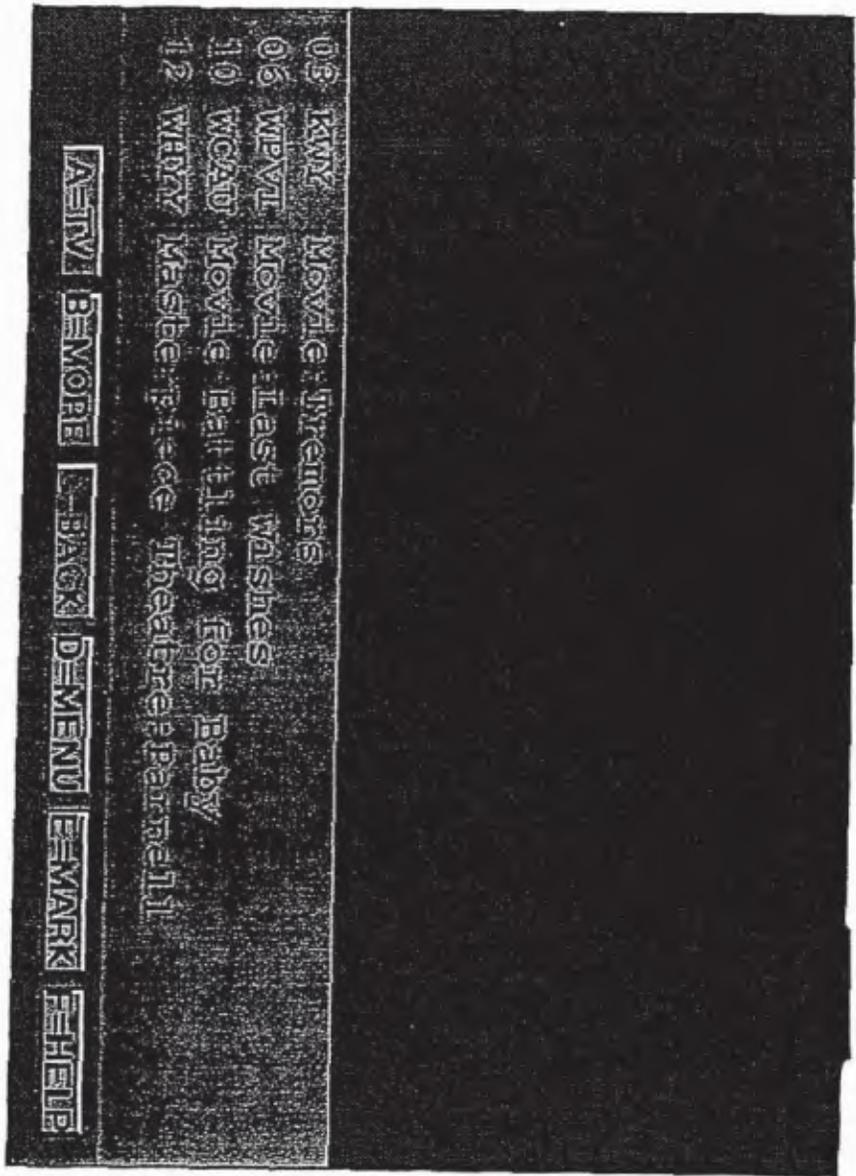




ART



Exhibit B



- 03 KMY Movie: Tremors
- 06 WPTI Movie: Last Wishes
- 10 WCAU Movie: Built to Kill: For Baby
- 12 WATY Movie: Face Theater: Parrnell

AEIV BEVORE BACX DEMENU EEWARK EHELE

Exhibit C



Inter-Office Memorandum

TO: Brian Robbins
Roger Youman
Mike Morris
FROM: Robinowitz
SUBJECT: EPG storyboards

gmr

Here's Marnie's first pass at an Electronic Program Guide. I'll see you guys at noon in my office for the conference call with her.



Handwritten note:
KWTU-TV
Westwood
11:35 AM

①



(2)

Exhibit D

Date

Design

To

ROGER YOU MAN



Company & Fax #

TV GUIDE 215-293-4041

From

Steve

of pages (including cover page)

3

Comments

Follow the instructions at the bottom of the screen in the demo.
Here are some additional points:

Carson Screen:

Click anywhere to display the remote.
Only the Title and Browse buttons work.
Title - Toggles on and off the bottom display bar.
Browse - Toggles on and off the Browse Bar
With the Browse bar on, click the L/R arrows to browse by
time, and the up/down arrows to browse through channels,
when you come to Lucy, click Enter.

Lucy Screen:

Click the Menu button

Menu Screen

Click Enter

Listings Screen:

Click down arrow to COM 30.
Click right arrow to 7:30
Click left arrow back to 6:00
Click down arrow to next page.
Click Menu

Menu Screen:

Click down arrow to Listings by Channel

Listings by Channel Screen:

Click right arrow to Channel 44
Click left arrow back to Channel 43
Click Menu

Menu Screen:

Click down arrow to Listings by Program Type

Listings by Program Type:

Click Left/Right arrows to view other categories
Click Menu

Menu Screen:

Click down arrow to Find by Program Name

Find by Program Name Screen:

Click down arrow to change 1st letter
Click right arrow when you reach "M" to go to 2nd letter
Click right arrow to go to 3rd letter
Click down arrow to change 3rd letter
Click right arrow when you reach "R"
Click Menu

Menu:

Click down arrow to Pay-Per-View
Pay-Per-View Screen
Click right arrow to go to next type
Click Details
Click Details again
Click right arrow to go to next type

That's the demo. To return to the Main Menu of the demo click the MENU button in the bottom left-hand corner, or to quit the demo press Command Period (.)



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Bennington et al.

Serial No.: 08/119,367 Art Unit: 2602 ✓

Filed: September 9, 1993 Examiner: Lee, M.

For: Electronic Television Program
Schedule System and Method

RESPONSE TO OFFICE ACTION AND PETITION FOR EXTENSION OF TIME

Hon. Commissioner of Patent and Trademarks
Washington, D.C. 20231

Sir:

5/17/1997 GDUCKETT 00000047 08119367
FC:117 930.0000

In response to the Office Action dated November 20, 1996, please consider the following remarks. Also submitted herewith is the Declaration of Bruce Davis under 37 C.F.R. § 1.132. Applicants hereby petition for a three-month extension of time to respond to the Office Action pursuant to 37 C.F.R. § 1.136(a)(1). A check in the amount of \$930.00 to cover the fee for such petition is enclosed herewith. The Commissioner is hereby authorized to charge our Deposit Account No.

I hereby certify that the enclosed copies of this application and the accompanying Declaration of Inventor are true and correct copies of the original application and Declaration of Inventor as filed with the United States Patent and Trademark Office.
Signed: Helen Fineman
Name: Helen Fineman
Date: 5/30/97

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23-0800 for any deficiencies in fees, or for any additional fees, in connection with this response.

R E M A R K S

This amendment is filed in response to the Office Action dated November 20, 1996.

There are 43 claims now pending in this application, as follows: 38-46, 48, 50, 51, 55, 63-65, 70-73, 75, 77, 85, 86, 90-93, 96, 99-102, 104, 105, 112, 113, 125-128, 130 and 132. The Office Action of November 20 did not indicate that claims 39-41 are also currently pending.

All claims stand rejected under 35 U.S.C. § 103 as being obvious over publications of Insight Telecast in view of a Jerrold Communications publication, "Cable Television Equipment." The reliance on a publication by Insight is particularly inapposite because Insight itself, which later became StarSight Telecast, Inc., incorporated applicants' novel invention only after the invention was publicly shown to the trade. Moreover, Insight also made laudatory comments about applicants' invention after adopting it for use in the StarSight EPG, as discussed infra.

The present rejection is based on the contention that the Insight Telecast publication "discloses an electronic program guide ("EPG") system which inherently includes a memory means, a user control means, a data processing means, and a video display generator," but it does not disclose "the partial overlaying display format as claimed," which is said in the Office Action to be disclosed by the Jerrold publication. The rejection also relies on the contention that conventional television receivers and computers use display schemes, such as a displayed channel number, that would have made it obvious to one of ordinary skill in the art to switch off the program guide after a period of time.

However, the presently claimed invention is not directed simply to an EPG that displays program schedule information in a partial overlaying display format, which, as the Examiner correctly points out, is all the combination of the cited references discloses. Nor are the present claims directed merely to turning the EPG display off after a certain period of time.

The principal invention of the claims remaining in the present application -- i.e., the so-called "Browse" mode of operation -- permits a user to interactively scan through program listings in a time and/or channel domain while continuing to view the current program, thereby providing the user with substantially the same experience as channel surfing through actual television programs, with the exception that the user is

instead surfing through schedule listings. The user can thus interactively navigate through the listing information at his leisure by issuing appropriate sequential time and/or channel control commands, while not missing any content of the program being simultaneously viewed. The cited references, taken alone or in combination, do not in any way disclose or suggest the desirability of such an interactive navigation scheme. The idea of giving a user the ability to surf through program listings in response to consecutive user control commands, while watching the currently appearing program or display signal, is not obvious in view of merely providing schedule information in an overlay, which is what the cited references disclose.

The on-demand navigation of the present invention constitutes a significant and novel improvement over prior electronic program guides, such as those described in the cited references, which, at most, merely allow the user to view schedule information in a certain display format on a screen. In contrast, applicants' presently claimed invention provides a fully interactive capability for allowing the user to sequentially navigate through the program schedule information in a time and/or channel domain.

The prior art of record contains no disclosure suggesting the desirability of allowing a user to surf in a channel and/or time domain through program listings by issuing appropriate sequential control commands, while continuing to watch a currently

tuned program, nor does it contain any disclosure suggesting how such a navigation scheme could be implemented. Moreover, an important problem solved by the claimed invention -- i.e., providing a solution to the user's dilemma of either "surfing" through channels to see what's on, or watching a particular program on television -- is not contemplated by any reference relied on in the Office Action. Indeed, the prior art of record neither discloses nor suggests this significant aspect of applicants' invention. Accordingly, the presently claimed invention is allowable over the references of record.

Moreover, the references currently relied on teach or suggest no more -- i.e., the display of schedule information in an overlay -- than other references previously cited and overcome during prosecution of this application. The newly cited references do not add anything to the previously cited art and, therefore, can not support a rejection based on obviousness under Section 103.

In addition, the broadest claims currently pending in the application, as presently amended, including as requested by the Examiner, indicate that the system is responsive to television tuning commands to allow a user to select (e.g., for viewing, tuning or recording) a program for which schedule information is displayed. Other claims are directed to the Browse mode in combination with the capability of a user to select a reminder for a chosen program, as also requested by the Examiner. However, the cited art neither mentions nor suggests either of these aspects of the presently

claimed invention. Thus, the fact that all of the pending claims remaining in the application now include either the selecting or reminder aspect is an independent basis for allowance of the present application. And, taken in combination with the fact that the prior art fails to suggest the novel navigation scheme as claimed herein, the rejection under Section 103 should be withdrawn.

To further support the patentability of the presently claimed invention, submitted herewith is the declaration of Bruce Davis pursuant to 37 C.F.R. 1.132 (hereinafter, "Davis Dec."), one of the inventors of the present invention, which includes facts establishing several so-called "secondary considerations" of non-obviousness. Such secondary considerations must be considered in assessing the obviousness of the claimed invention. In re Sernaker, 702 F.2d 989, 217 U.S.P.Q. 1 (Fed. Cir. 1983). These include copying of the claimed invention, long-felt need, and commercial success.

The inventors first disclosed the Browse feature at the Western Cable Show in Anaheim, California, in December 1992. Davis Dec. ¶ 2. In addition to demonstrating a prototype EPG with the Browse feature at the show, a brochure was distributed that illustrated the feature and referred to it as "Browse." Davis Dec. ¶ 3. Since the Browse feature was first disclosed by the inventors, several commercial EPG

providers have adopted the feature, including StarSight Telecast, Inc., EchoStar Communications Corp., and General Instrument. Davis Dec. ¶ 4.

For example, StarSight Telecast, which is the assignee of at least 8 issued EPG-related patents, has incorporated the Browse feature into its products and highlighted it as one of the important features of its EPG in filings with the Securities and Exchange Commission. Davis Dec. ¶ 5. The adoption of the Browse feature by StarSight after applicants publicly displayed it at a trade show attended by StarSight (Davis Dec. ¶ 5) is strong evidence that the feature was copied. Moreover, that StarSight, which was formerly Insight, apparently copied applicants' invention weighs heavily against relying on one of its publications as a basis for an obviousness rejection.

In addition, at least one industry publication has commented that the claimed Browse feature is an "excellent way to find out what's on" television. Davis Dec. ¶ 5. The laudatory statements of StarSight concerning the Browse feature, as well as the professional approval evidenced by the industry publication, are further support for the non-obviousness of the invention. See, e.g., Corning Glass Works v. Sumitomo Electric USA Inc., 671 F. Supp. 1369, 1398, 5 U.S.P.Q.2d 1545, 1569 (S.D.N.Y. 1987), aff'd., 868 F.2d 1251, 9 U.S.P.Q.2d 1962 (Fed. Cir. 1989) ("Praise for the invention, including awards accorded to the inventors for their invention, are further evidence of the novelty and worth of the inventions."); Nuclear Chicago Corp.

v. Nuclear Data Inc., 173 U.S.P.Q. 326, 336-37 (N.D. Ill.), rev'd on other grounds, 465 F.2d 428, 174 U.S.P.Q. 381 (7th Cir. 1972) (patentability is supported by favorable comments in trade publications); Tile Council of America v. Ceramic Tilers Supply, 159 U.S.P.Q. 204, 216 (C.D. Cal. 1968) ("The favorable mention of the developments of the [invention] in trade publications and by competitors is indicative of non-obviousness.").

With regard to both EchoStar and General Instrument, they have also adopted the claimed Browse feature, as plainly evidenced by their product literature. Davis Dec. ¶¶ 7-8. Again, adoption of the invention after public display at a trade show strongly suggests copying, and such copying has long been held to weigh against the obviousness of the invention. E.g., Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 679, 7 U.S.P.Q.2d 1315, 1319 (Fed. Cir. 1988) ("Copying is an indicium of non-obviousness, and is to be given proper weight."). With regard to General Instrument, which manufactures cable television converters/decoders, it is also important to note that although it included an EPG in its products at about the time the Browse feature was first publicly disclosed, the Browse feature was apparently not added until later, which further evidences copying.

Not only have these EPG providers apparently copied applicants' Browse feature into their products, but each of them also uses the term "Browse" to describe it.

For example, StarSight refers to the feature as "Program Selection by Browsing." Davis Dec. ¶ 5. Similarly, EchoStar's product literature refers to the use of a "BROWSE BANNER." Davis Dec. ¶ 7. Finally, General Instrument uses the term "browse mode." Davis Dec. ¶ 8. This is the precise term applicants use to describe the claimed feature throughout the application. Moreover, the term "Browse" was used in the materials distributed by TV Guide at the Western Cable Show in December 1992. Davis Dec. ¶ 3. Such use of the very same name that applicants' have used to describe their invention is also evidence weighing in favor of non-obviousness. Nuclear Chicago, 173 U.S.P.Q. at 336 (widespread use of the patentee's name to describe the invention developed supports a finding of non-obviousness); Welin Davit & Boat Corp. v. C.M. Lane Life Boat Co., 38 F.2d 685, 687, 4 U.S.P.Q. 374, 376 (E.D. N.Y. 1930) ("no better proof is necessary to show general acquiescence than the fact that" the patentee's name for his invention was used).

Although there are numerous patents relating to EPGs, and many different ways to implement an EPG, the widespread acceptance of the claimed Browse feature by the EPG community evidences a long-felt need in this area that has been met by applicant's claimed invention. This is because the claimed Browse feature allows a user to "channel surf" or "channel graze" to scan programs on other channels and/or other times without changing the channel to another program or to a dedicated program

guide channel, thereby giving the user the benefit of not missing any portion of a program that is currently being viewed.

The long-felt need that has been filled by applicants' invention is further evidenced by consumer research information, which consistently shows that the Browse feature is the most used and most valuable feature of an EPG from the user standpoint.

In one recent survey, 72% of the users of an EPG stated that they "couldn't do without" the Browse feature. Davis Dec. ¶ 9. Similarly, in another recent survey, 78% of the respondents indicated that they used the Browse feature on a regular basis. Davis Dec. ¶ 10.

In yet another research study conducted over a period of 6 months, viewers' use of the EPG was electronically monitored, and it was determined that an average of 65% of the households used the Browse feature on a regular basis. In addition, those that used the Browse feature used it an average of 25 times per week, more than any other feature of the EPG. The results also indicated that an average of 40% of the households used the Browse feature as a primary method of tuning to other channels while watching a program. Davis Dec. ¶ 11.

Therefore, based on the use of -- and strong preference for -- the Browse feature as evidenced by these consumer studies, it is clear that applicants' claimed invention has filled a long-felt need from the user standpoint, as well as the supplier

standpoint. Long-felt need is another factor that weighs against a conclusion of obviousness. E.g., Standard Havens Products, Inc. v. Gencor Industries, Inc., 953 F.2d 1360, 1370, 21 U.S.P.Q.2d 1321, 1329 (Fed. Cir. 1991).

This same evidence that the claimed Browse feature has been incorporated into many commercial EPGs, and is considered by users to be an essential feature of an EPG also supports another objective indicium of non-obviousness – commercial success. The Federal Circuit has consistently held that commercial success, whether of the patentee or infringers, also evidences the non-obviousness of the invention. E.g., Symbol Technologies, Inc., v. Opticon, Inc., 935 F.2d 1569, 1579, 19 U.S.P.Q.2d 1241, 1248 (Fed. Cir. 1991); Akzo N.V. v. U.S. Int'l Trade Comm'm, 808 F.2d 1471, 1481, 1 U.S.P.Q.2d 1241, 1246 (Fed. Cir. 1986) (“Commercial success is . . . a strong factor favoring nonobviousness.”).

The commercial success of the claimed invention is also evidenced by StarSight's success in licensing its EPG to consumer electronics companies. Davis Dec. ¶ 6. Given the popularity of the Browse feature, as discussed above, StarSight's licensing success is no doubt attributable, at least in part, to its incorporation of the Browse feature in its product.

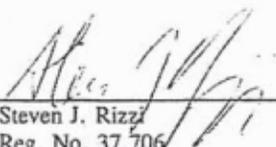
In sum, there are numerous secondary considerations of non-obviousness of the presently claimed invention, all of which collectively provide strong evidence of

patentability, and which must be considered in assessing whether the claims are allowable.

For all the reasons set forth above, it is believed that all pending claims of the present application are clearly in condition for allowance. Issuance of all pending claims at an early date is respectfully requested.

Respectfully submitted,

Dated: May 12, 1997

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