



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
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/416,554	05/03/2006	Young-Gu Lee	678-2450	7248
66547	7590	02/19/2013	EXAMINER	
THE FARRELL LAW FIRM, P.C. 290 Broadhollow Road Suite 210E Melville, NY 11747			CHAUHAN, ULKA J	
			ART UNIT	PAPER NUMBER
			2679	
			MAIL DATE	DELIVERY MODE
			02/19/2013	PAPER

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.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte YOUNG-GU LEE and HOON YOO

Appeal 2010-004570
Application 11/416,554
Technology Center 2600

Before MAHSHID D. SAADAT, ALLEN R. MacDONALD, and
JASON V. MORGAN, *Administrative Patent Judges*.

MACDONALD, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

STATEMENT OF THE CASE

Introduction

This is a decision on Appellants' Request for Rehearing.

Exemplary Claim

Exemplary claim 1 under appeal reads as follows (emphasis added):

1. A method for forming a broadcast program time table in an electric program guide (EPG) database, the method comprising the steps of:

storing present program information of event information table present/follow (EIT P/F) information in a first program information area of a corresponding segment area in the electric program guide (EPG) database by determining a segment, in which *program discontinuity* occurs, in an event information table (EIT) schedule if the EIT P/F information is received; and

storing program information of an Nth segment in a second program information area when the Nth segment of the EIT schedule is received, and program discontinuity occurs in the Nth segment, the Nth segment being a segment included in the received EIT schedule.

Appellants' Contentions

1. Appellants quote the Board's decision and contend that the Board erred because "the Board has merely deferred to the Examiner's assertions." (Rehearing Request 2).

2. Appellants contend that the Board erred because its "form of analysis directly contradicts requirements set forth by both the Board of Patent Appeals and Interferences itself and the Court of Appeals for the Federal Circuit." (Rehearing Request 4).

2.A. In particular, Appellants note that the Board's *Frye* decision "sets forth the form of review to be performed by the Board." *Ex parte Frye*,

Appeal 2010-004570
Application 11/416,554

Appeal No. 2009-006013 (BPAI 2010)(Precedential). Appellants go on to quote from *Frye*:

The Board's role in any subsequent appeal is to, “*on written appeal of an applicant*, review adverse decisions of examiners upon applications for patents.” 35 U.S.C. § 6(b) (2006) (emphasis added) ... The panel then reviews the obviousness rejection for error based upon the issues identified by the appellant, and in light of the arguments and evidence produced thereon (sic) *Seer* (sic) *Oetiker*, 977 F.2d at 1445 (“In reviewing the Examiner’s decision on appeal, the Board must necessarily weigh all of the evidence and argument.”) (emphasis added) ... Specifically, the Board reviews the particular finding(s) contested by the appellant anew in light of all the evidence and argument on that issue. See *Ex parte Frye*, Appeal No. 2009-006013 (Bd. App. 2010).

(Rehearing Request 2-3).

2.B. Further in particular, Appellants note the Federal Circuit’s *Gechter* decision and argues that the Board is required to set forth findings of fact. *Gechter v. Davidson*, 116 F.3d 1454 (Fed.Cir.1997). Appellants go on to quote from *Gechter*:

The Board is required to set forth in its opinions specific findings of fact and conclusions of law adequate for form a basis of our review. In particular, we expect that the Board's anticipation analysis be conducted on a limitation by limitation bases, with specific fact findings for each contested limitation and satisfactory explanations for such findings. Claim construction must also be explicit, at least to any construction disputed by the parties to the interference (or an applicant or patentee in an ex parte proceeding). See *Gechter v. Davidson*, 116 F.3d 1454, 1457-58 (Fed.Cir.1997).

(Rehearing Request 3).

3. Appellants contend that the Board erred because:

[T]he Board has referred to the Examiner's reasoning without reviewing the particular findings contested *anew*, and has failed to directly consider and address all of Appellants' arguments.

(Rehearing Request 3; emphasis in original).

4. Appellants contend that the Board erred because:

[T]he Examiner has not responded to Appellants' arguments in the Reply Brief, and therefore, by merely referring to the Examiner's previous findings, the Board has failed to address Appellants' arguments in the Reply Brief.

(Rehearing Request 3-4).

ANALYSIS

First Contention

We disagree with Appellants' first contention that "the Board has merely deferred to the Examiner's assertions." (Rehearing Request 2). Appellants' contention misstates the facts of record.

Contrary to Appellants allegation, this Board did not merely indicate agreement with the Examiner. Rather, as the panel stated (emphasis added):

We adopt as our own (1) the findings and reasons set forth by the Examiner in the action from which this appeal is taken, and (2) the reasons set forth by the Examiner in the Examiner's Answer in response to Appellants' Appeal Brief. We concur with the Examiner's anticipation finding.

(Decision 3). Adoption of the Examiner's findings and reasons can form an adequate record to permit judicial review. In *Hyatt*, the Federal Circuit explicitly pointed out that "[t]he Board adopted the examiner's findings" and "[t]he Board adopted the examiner's analysis." *In re Hyatt*, 211 F.3d 1367, 1370-71 (Fed. Cir. 2000). The court in *Hyatt* then concluded that "the Board addressed the limitations of each claim in a manner adequate to permit

judicial review” and the court “decline[d] the invitation to vacate the Board’s decision on the ground that [the Board] failed to explain its reasoning sufficiently to enable us to review its rulings.” *Hyatt*, 211 F.3d at 1371. Further, Appellants attention is directed to our reviewing court’s Rule 36 decision in *Carnahan* where the Federal Circuit affirmed the Board decision in *Ex Parte Carnahan*, Appeal 2010-011437 (BPAI 2011), which “incorporated by reference the Examiner’s Answer.” *In re Carnahan*, 440 Fed.Appx 927 (Fed. Cir. 2011) (nonprecedential).

Second Contention

Appellants’ second contention that the Board has erred is based on several points. (Rehearing Request 2-3).

- 1) That the Board’s *Frye* holding, which sets forth the form of review to be performed by the Board, also sets a particular format for an opinion of this Board.
- 2) The Federal Circuit’s *Gechter* holding, that the Board is required to do fact finding in an interference (where the Board is the initial fact finder), is extendable to the unrelated review functions of the Board (where the Board is *not* the initial fact finder).

We disagree with Appellants’ analysis as it relates to both the *Frye* holding of this Board and the *Gechter* holding of the Federal Circuit.

As to *Frye*, we agree with Appellants that the Board must review the particular finding(s) contested by the appellant anew in light of all the evidence and argument on that issue. However, contrary to Appellants’ contention that under *Frye* they are entitled to a particular Board decision format and content, *Frye* is silent as to such a requirement. In *Frye* the

Board panel set forth an analysis which reiterated and agreed with some points made in the Appeal Brief argument of Appellant Frye. However, nothing precluded the *Frye* panel from referencing Appellant Frye's Appeal Brief arguments and adopting those points as its own.¹ *Frye* does not hold that this Board is required in their decisions to regurgitate in-whole the examiner findings and reasoning and/or appellant briefing points with which the panel agrees.

As to *Gechter*, we agree with Appellants that the Board must explain the basis for its rulings sufficiently to enable meaningful judicial review by the Federal Circuit. However, contrary to Appellants' contention that under *Gechter* they are entitled to a particular Board decision format and content, our review of *Gechter* finds no mention of this special requirement as argued by Appellants. Our review finds that *Gechter* states "the statute's mandate to 'review' implies inherent power in this court to require that the Board's decision be capable of review." 116 F.3d at 1454, 1457. We disagree with Appellants' request and find inappropriate their attempt to convert this inherent power of our reviewing court into an Appellants' entitlement that the Board's decision must be set forth in a specific format.

Further, *Gechter* involved an interference decision where the Board was the fact finder as opposed to the appeal before the Board for review of the adverse decision of the Examiner including the fact finding of the Examiner therein. Although the *Gechter* rule of "inherent power in this court to require that the Board's decision be capable of review" is applicable to all decisions of the Board, the Federal Circuit has never held as argued by

¹ The format of many reversals of this Board is one of reference to and adoption of particular points made in an Appellant's Appeal Brief.

Appellants that Appellants are entitled as a matter of law to more than the decision they received. To the contrary, Appellants attention is again directed to the court's decisions in *Hyatt* and *Carnahan*.

Third Contention

Appellants argue that the Board has erred because Appellants allege the Board did not review the particular findings contested anew, and has failed to directly consider all of Appellants' arguments. We disagree with Appellants' conclusion that this panel erred.

Since this panel *did not state* in its decision that it was not reviewing the particular findings contested anew and *did not state* that it was not considering Appellants' arguments, we assume that Appellants, in making general allegations, intended to argue that this Board in its decision did not provide an individualized critique of each argument that Appellants presented in their Appeal Brief and Reply Brief.

Oetiker requires that in reviewing the Examiner's decision on appeal, the Board must necessarily weigh all of the evidence and arguments. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). However, Appellants cite to no basis for interpreting *Oetiker* as holding that this Board is required to provide an individualized critique of each argument that Appellants present. This panel did consider all of Appellants' argument in its deliberations and reviewed the particular findings contested anew. This panel did not err in not discussing individually each of Appellants' arguments in its ultimate decision.

Fourth Contention

Appellants argue that the Board has erred because since Examiner has not responded to Appellants' arguments in the Reply Brief, then the Board

did not address Appellants' arguments in the Reply Brief. We disagree with Appellants' conclusion that this panel erred.

These Reply Brief arguments were weighted in our review of the Examiner's decision. However, except for the argument we discuss directly below, these Reply Brief arguments were merely variations on the "Sull et al. does not provide any teachings regarding program discontinuity" (App. Br. 6) arguments of the Appeal Brief, i.e., they were not substantively different from the arguments of Appellants Appeal Brief.

Appellants' Reply Brief argues that "the cited paragraph [0275] of Sull is unrelated to step 1030 of Sull" at page 3 thereof. However, our review of these cited portions of Sull, found that paragraph [0275] discusses the meaning of "segmentation information" and step 1030 is directed to how "segmentation information" is processed. Thus, the Examiner properly cited to paragraph [0275] in discussing step 1030. *See* Ans. 7. Although we did not memorialize the results of our review for the record, we deemed this argument to be frivolous and observed that this argument was confined to the Reply Brief. While we chose at that time not to place our concerns into the record and to overlook Appellants' filing of a frivolous argument, given Appellants' contention in the Request for Rehearing, we now make our concerns of record.

As we noted above, *In re Oetiker* requires that in reviewing the Examiner's decision on appeal, the Board must necessarily weigh all of the evidence and arguments. 977 F.2d at 1445. However, Appellants cite to no basis for interpreting *Oetiker* as holding that this Board is required to consider frivolous arguments. Although ultimately this panel did in fact

Appeal 2010-004570
Application 11/416,554

consider Appellants' frivolous argument in its deliberations, this panel made no error in not discussing that frivolous argument in its ultimate decision.

DECISION

In view of the foregoing discussion, we grant Appellants' Request for Rehearing to the extent of reconsidering our decision, but we deny Appellants' request with respect to making any change thereto.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(v).

REQUEST FOR REHEARING DENIED

ke