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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte THOMAS H. JAMES and DIPAK M. SHAH

Appeal 2010-007708¹
Application 11/097,481
Technology Center 2400

Before JEAN R. HOMERE, KALYAN DESHPANDE, and TREVOR M. JEFFERSON, *Administrative Patent Judges*.

HOMERE, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The real party in interest is DIRECTV Group, Inc. (App. Br. 1.)

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-20. (App. Br. 2.) We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Appellants' Invention

Appellants invented a system for delivering satellite signals to a plurality of receivers. In particular, upon receiving a satellite signal (120) at a low noise block (LNB) amplifier (128) of a satellite antenna (108), the LNB forwards the received signal to a module (300) coupled thereto. A multi-switch (400) included in the module (300) forwards the signal to an interface (410), which subsequently delivers the signal to a receiver (308) via a power inserter (302) that controls the signal flow and the command flow between the multi-switch and the receiver.

(Figures 1, 3, 4, Specification 6, ll. 1-12.)

Illustrative Claim

Independent claim 1 further illustrates the invention as follows:

1. A system for delivering satellite video signals for display on a monitor, comprising:
 - a module comprising a multiswitch, the multiswitch selectively directing the satellite video signals to a plurality of outputs of the multiswitch;
 - an interface for delivering the satellite video signals to at least one receiver; and
 - a power inserter, coupled between the interface and the at least one receiver, for controlling the flow of signals between the multiswitch and the at least one receiver, wherein the satellite video signals continuously flow through the power

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inserter to the at least one receiver while commands selectively flow between the module and the at least one receiver through the power inserter.

Prior Art Relied Upon

The Examiner relies on the following prior art as evidence of unpatentability:

Green	US 5,805,975	Sep. 8, 1998
Coffin	US 7,010,265 B2	Mar. 7, 2006 (filed May 22, 2002)
Gurantz	US 7,130,576 B1	Oct. 31, 2006 (filed Nov. 6, 2002)
Lindstrom	US 2005/0193419 A1	Sep. 1, 2005 (filed Dec. 31, 2004)

Rejections on Appeal

The Examiner rejects the claims on appeal as follows:

1. Claims 1-8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Gurantz and Green.
2. Claims 9-14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Gurantz, Green, and Lindstrom.
3. Claims 15-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Coffin, Gurantz, and Green.

ANALYSIS

We consider Appellants' arguments *seriatim* as they are presented in the principal Brief, pages 6-12.

Dispositive Issue: Have Appellants shown by a preponderance of the evidence that the Examiner erred in finding that Gurantz and Green are properly combined to teach or suggest *a power inserter coupled between a multi-switch interface and a receiver for controlling the flow of signals and the flow of command therebetween*, as recited claim 1?

Appellants argue that the combination of Gurantz and Green does not teach or suggest the disputed limitations emphasized above. In particular, Appellants argue that Green discloses a processor that converts different signal polarities into a single polarity as opposed to a multi-switch system that selects between different polarizations for a given satellite. Further, Appellants argue that Green discloses a power inserter that merely serves as an entry point from a power source, as opposed to a mechanism for controlling the signal flow and the flow of commands between the multi-switch and a receiver. (App. Br. 7-9.) Therefore, Appellants submit that Green's elimination of the multi-switch teaches away from the invention. (*Id.*) Additionally, Appellants argue that there is insufficient motivation to incorporate Green's power inserter in Gurantz to thereby control the signal flow and the command flow between the multi-switch and the receiver as required by the disputed limitations. (*Id.* at 10.)

In response, the Examiner finds that because Green's disclosure of a communicating satellite signals to a receiver via a power inserter complements Gurantz's disclosure of communicating satellite signals between a multi-switch and a receiver, the cited references are properly combined to teach the disputed limitations. (Ans. 11-14.)

On the record before us, we agree with the Examiner's findings and ultimate conclusion of obviousness. We note at the outset that Appellants have not disputed the Examiner's findings regarding Gurantz' disclosure of a multi-switch for selectively directing satellite signals to a receiver. Appellants mainly argue that Green's power inserter cannot be properly incorporated between Gurantz' multi-switch and the receiver because the Green's processor is not compatible with Gurantz' multi-switch. This argument is not persuasive. We find that while Green's processor converts the polarity of incoming satellite signals (col. 5, ll. 1-11), as opposed to selecting between the different signal polarizations as would a multi-switch, Green's use of the processor does not teach away from the multi-switch.² We find no

² It has been held that "[w]hat the prior art teaches and whether it teaches toward or away from the claimed invention ... is a determination of fact." *Para-Ordnance Mfg., Inc. v. SGS Importers Int'l, Inc.*, 73 F.3d 1085, 1088 (Fed. Cir. 1995.) "A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994.) Teaching an alternative or equivalent method, however, does not teach away from

disclosure in Green that tends to criticize, discredit or discourage the use of the multi-switch. Rather, the cited portion of Green merely provides an alternative mechanism for processing satellite signals to a receiver.

Further, we find unavailing Appellants' argument that the power inserter disclosed in Green does not teach or suggest the claimed power inserter because Green's power inserter is not used *for controlling* the signal flow and the command flow between the multi-switch and the receiver. Because the recited power inserter is not actually controlling the signal flow and the command flow, but it is merely capable of controlling such data, it is a statement of intended use, which is not entitled to patentable weight.³ Additionally, we note that the limitation at issue is directed to a functional limitation recited as part of an apparatus. It has been held that functional limitations are distinguishable over the prior art of record only after Appellants have made a showing that the prior art of record does not teach such capability.⁴ The record

the use of a claimed method. *See In re Dunn*, 349 F.2d 433, 438 (CCPA 1965.)

³ *See, e.g. Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp.*, 320 F.3d 1339, 1345 (Fed. Cir. 2003) (a statement of intended use "usually will not limit the scope of the claim because such statements usually do no more than define a context in which the invention operates").

⁴ Claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function, *see, e.g., In re Schreiber*, 128 F.3d 1473, 1477-78 (Fed. Cir. 1997), in order to satisfy the functional limitations in an apparatus claim, however, the prior art apparatus must be capable of performing the claimed function. *Id.* at

before us is devoid of such showing.⁵ Even if we were to give patentable weight to the functional limitation or intended use limitation, as claimed, we find that Green's disclosure teaches or at least suggests the claimed limitation. Green discloses a satellite broadcast system to accommodate two different polarity commands from two or more sources at the same time. In particular, signals received from a satellite are converted to standard frequencies and transmitted to a satellite receiver via a single coaxial cable and a power inserter. (Col. 2, l. 46-col. 3, l. 4, Fig. 2.) Green further discloses that the power inserter is used to insert power into a power source to thereby amplify signals with additional amplifiers. (Col. 5, ll. 39-49.) We thus find that by amplifying the signal, the power inserter is able to control the signal flow and the command flow from the processor to the satellite receiver.

1478. The prior art structure must be capable of performing the function without further programming. *Typhoon Touch Techs., Inc. v. Dell, Inc.*, 659 F.3d 1376, 1380 (Fed. Cir. 2011) (discussing *Microprocessor Enhancement Corp. v. Texas Instruments, Inc.*, 520 F.3d 1367 (Fed.Cir.2008)). When the functional language is associated with programming or some other structure required to perform the function, that programming or structure must be present in order to meet the claim limitation. *Id.*

⁵ Appellant has the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of prima facie obviousness or by rebutting the prima facie case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

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In considering the general form of Appellants' arguments in the principal Brief, they appear to have attacked the teachings of Gurantz and Green separately, as opposed to the combined disclosures proffered by the Examiner. We note that one cannot show nonobviousness by attacking the references individually where the rejections are based on combinations of references. *In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Here, the respective references relied on by the Examiner must be read, not in isolation, but for what the combination teaches or suggests when considered as a whole. We find nonetheless that the cumulative weight and the totality of the evidence on this record favor the Examiner's position that the combined disclosures of Gurantz, and Green would have taught or suggested the disputed limitations.

Next, regarding the lack of logical reason to combine arguments, we note that U.S. Supreme Court has held that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 416 (2007). The Court further instructs that:

[o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; . . . and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason for combining the known elements in a the fashion claimed by the patent at issue.

Id. at 418.

Additionally, the Court instructs that:

‘rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’... however, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.

Id. (citation omitted).

First, we find that the ordinarily skilled artisan, being a creative individual would have been able to fit the teachings of the cited references together like pieces of a puzzle to predictably result in the disputed limitations. That is, as discussed above, the proffered combination of the cited references would predictably result in a satellite system that couples a multi-switch to a power inserter to predictably regulate the flow of satellite signals to a receiver.

Further, as prescribed by the controlling case law, while it is often necessary for an Examiner to identify a reason for combining the familiar elements obtained from the prior art in establishing a prima facie case of obviousness, the identification of such a reason is not a *sine qua non* requirement. So long as the Examiner provides an articulated reasoning with some rational underpinning to substantiate the obviousness rejection, such a conclusion is proper. In this case, the Examiner provides more than just a mere conclusory statement. The Examiner notes that at the time of the claimed invention, an ordinarily skilled artisan would have been motivated to combine the cited

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disclosures because users of Gurantz's system would be motivated to utilize Green's power inserter to regulate the signal flow to the receiver. (Ans. 4.) In our view, such a statement suffices as an articulated reason with a rational underpinning to support the cited combination. As noted above, the case law allows the Examiner to look to the state of the prior art, including the knowledge of the ordinarily skilled artisan to arrive at such a reason for combining the known elements of the prior art. Consequently, the Examiner's reliance upon the cited references in order to arrive at an articulated reason with a rational underpinning to support the proffered combination is proper. For these same reasons, Appellants' argument that the combination is improper is not persuasive.

It follows that Appellants have not shown error in the Examiner's conclusion that the proffered combination renders claim 1 unpatentable.

Regarding claims 2-20, Appellants reiterate substantially the same arguments submitted for patentability of claim 1 above. (Ans. 11-12.) As discussed above, these arguments are not persuasive. Consequently, claims 2-20 fall for the reasons set forth in our discussion of claim 1 above. *See* 37 C.F.R. § 1.37(c)(1)(vii).

DECISION

We affirm the Examiner's rejections of claims 1-20 as set forth above.

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)(iv).

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AFFIRMED

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