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BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ROBERT ALAN KNEE, ANTHONY R. FAVIA, BRUCE DAVIS, and LARRY MILLER

Appeal 2010-007982
Application 10/357,154
Technology Center 2400

Before JOHN A. JEFFERY, JEREMY J. CURCURI, and DAVID C. McKONE, *Administrative Patent Judges*.

McKONE, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from a Final Rejection of claims 1-12, 14-25, 27-38, and 40-51, which constitute all the claims pending in this application. *See* App. Br. 3.[1] Claims 13, 26, 39, and 52 are cancelled. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

[1] Throughout this opinion, we refer to the Appeal Brief filed June 16, 2009 ("App. Br."), the Examiner's Answer mailed December 17, 2009 ("Ans."), and the Reply Brief filed February 17, 2010 ("Reply Br.").

STATEMENT OF THE CASE

Appellants' invention relates to electronic program schedule systems that provide users of television receivers with schedule information for programs delivered, e.g., by broadcast, cablecast, or satellite. *See* Spec. ¶ 1:4-10. Claim 1, which is illustrative of the invention, reads as follows:

> 1. A method for using an interactive television program guide to display promotional information for a user on a display, comprising:
>
> allowing the user to use the interactive television program guide to access information that is not promotional information;
>
> in response to a request by the user to access the information that is not promotional information, displaying the information that is not promotional information in a first region on the display, wherein the information that is not promotional information is accessed by tuning to a virtual channel; and
>
> simultaneously displaying promotional information in a second region on the display, wherein the promotional information in the second region on the display extends substantially across the display and wherein the promotional information is selectable by the user.

THE REJECTION

Claims 1-12, 14-25, 27-38, and 40-51 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bennington (US 6,418,556 B1, July 9, 2002) and Alten[2] (US 5,781,246, July 14, 1998). *See* Ans. 3-6.

[2] Bennington, Alten, and Appellants' Specification all contain some overlapping disclosure. If prosecution continues, Appellants and the Examiner should consider whether, at the time Appellants' invention was

ISSUE

Appellants argue claims 1-12, 14-25, 27-38, and 40-51 as a group. *See* App. Br. 8-14. The Examiner finds that Bennington teaches each element of claim 1 except for "wherein the information that is not promotional information is accessed by tuning to a virtual channel." *See* Ans. 3-4. The Examiner further finds that Alten teaches the missing limitation and concludes that a person of ordinary skill in the art would have modified Bennington according to the teaching of Alten. *See* Ans. 4 (citing Alten, col. 28, ll. 33-36). The issue is whether the Examiner has articulated a reason, with rational underpinning, to combine Bennington and Alten. *See* App. Br. 8-11.

ANALYSIS

Bennington describes an electronic program scheduling system with a receiver for receiving broadcast, satellite, or cablecast television programs. *See* Bennington, Abstract. In Bennington's system, a user navigates through menus using a remote controller. *See* Bennington, col. 8, ll. 49-60. Regarding claim 1, the Examiner finds that Bennington's description of a user accessing the menu of Figure 6 teaches displaying information that is not promotional in a first region on the display in response to a request by the user to access that information. *See* Ans. 3 (citing Bennington, col. 13, ll. 15-22, 36-38, and identifying item 61 of Fig. 6 as the first region). The Examiner also finds that Figure 6 shows simultaneously displaying

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made, one or more of Alten and Bennington were owned by, or subject to assignment to, the same person who owned Appellants' invention, and, thus, should be disqualified as prior art. *See* 35 U.S.C. § 103(c).

promotional information in a second region on the display, wherein the promotional information in the second region on the display extends substantially across the display, *see* Ans. 4 (identifying items 62 and/or 64 of Fig. 6 as the second region), and wherein the promotional information is selectable by the user, *see id.* (citing Bennington, Figs. 15, 17; col. 13, ll. 38-45).

The Examiner concedes that Bennington does not teach accessing the non-promotional information "by tuning to a virtual channel." Ans. 4. However, the Examiner finds that Alten teaches accessing non-promotional information by tuning to a virtual channel, *see id.* (citing Alten, Fig. 37[3]; col. 28, ll. 29-37), and that a person of ordinary skill in the art would have modified Bennington, per the teaching of Alten, "in order to have the virtual channel appear as a conventional channel to the user, but not require any additional bandwidth as a carrier." Ans. 4. Alten teaches that a "Locator screen 201" may be accessed in several ways, for example by including it "as a virtual channel that is conveniently positioned in the channel-tuning sequence, such as between the highest and lowest available channel numbers" such that it "appears to be a conventional channel" but "requires no additional bandwidth as a carrier." Alten, col. 28, ll. 29-36. The Locator

[3] The rejection refers to Alten's Figure 20. *See* Ans. 4. However, the Examiner states that Figure 20 was mistakenly referred to and that Figure 37 was intended to be cited. *See* Ans. 12. Indeed, Alten, at column 28, lines 29-37, which refers to "a virtual channel," does so in the context of discussing "Locator screen 201," which is depicted in Figure 37, not Figure 20. *See* Alten, col. 27, ll. 37-39. Appellants argue that the Examiner's discussion of Figure 20 is "wrong and not relevant," App. Br. 12; however, Appellants themselves recognize that the passage in Alten cited by the Examiner refers to Figure 37, *see* App. Br. 11. Thus, the Examiner's citation to Figure 20 of Alten is harmless error.

screen 201 is a menu that "displays all available channel numbers grouped according to the source of the program information appearing on any particular channel at any particular time . . . ." Alten, col. 27, ll. 40-43.

Appellants argue that modifying Bennington to access the menu of Figure 6 using a virtual channel would not save bandwidth. *See* App. Br. 9. According to Appellants, Alten is comparing virtual channels to conventional channels and Bennington's Figure 6 menu is not a conventional channel, but rather "a locally generated graphical menu that already does not require the bandwidth of a conventional channel." *Id.* Instead, Appellants argue, even if Bennington were modified to carry Figure 6's information over a virtual channel, it would still require the same amount of bandwidth. *See* App. Br. 10. From that, Appellants argue that the Examiner's stated reason to combine Bennington and Alten lacks rational underpinning. *See* App. Br. 9-10.

We disagree. The rejection is not stating that the menu of Bennington's Figure 6 is transmitted using a conventional channel and that a person of ordinary skill in the art would have switched to using a virtual channel to save bandwidth per the teaching of Alten. Rather, the Examiner cites Alten to show that a virtual channel is a well-known technique used to transmit data, such as menu data, without requiring a carrier to expend the bandwidth necessary for a conventional channel. *See* Ans. 4. Appellants do not provide any persuasive reason why Alten's well-known technique would fail to provide the same benefit when employed in Bennington's system. *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007) ("[I]f a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the

same way, using the technique is obvious unless its actual application is beyond his or her skill."). We conclude that modifying Bennington in the way suggested by the Examiner is nothing more than "the predictable use of prior art elements according to their established functions." *Id.*

Appellants point out that Bennington already discloses embedding schedule data in the vertical blanking intervals ("VBI") of a program broadcast signal. *See* App. Br. 10 (citing Bennington, col. 6, ll. 54-56). Appellants argue that "[t]his transmission method is the same method Alten discusses using in connection with virtual channels"; therefore, modifying Bennington would not save bandwidth because "Bennington already teaches using the VBI transmission method for transmitting schedule data *without* any use of virtual channels." App. Br. 10 (emphasis in original).[4] We are not persuaded by this argument. As explained above, the Examiner does not conclude that a person of ordinary skill in the art would have replaced a conventional channel in Bennington with Alten's virtual channel; rather, he concludes that a virtual channel, as taught in Alten, is a well-known technique for transmitting data such as that shown in Bennington's Figure 6.

[4] In fact, Bennington is not limited to carrying scheduling information in the vertical blanking intervals, but also envisions transmitting such information over conventional channels. *See* Bennington, col. 6, ll. 50-56 ("The data stream may be modulated and then transmitted on the cable line in any number of ways, including as part of a dedicated channel transmission operating at a frequency of, for example, 75 MHz. Those of skill in the art will understand that numerous other transmission schemes can be used to transmit the data stream, such as embedding it in the vertical blanking interval of a program broadcast signal."). In the case where a "dedicated channel" is used to carry Bennington's menu information, switching to a virtual channel, per the teaching of Alten, would have saved the bandwidth that otherwise would have been allocated to the dedicated channel.

See Ans. 4. Moreover, even if Bennington is indeed describing transmitting information in the VBI using something different from virtual channels (as opposed to describing virtual channels without actually using the words "virtual channels"), this teaching would not have steered a skilled artisan away from virtual channels. Rather, Bennington's recognition of the utility of transmitting menu data in the VBI shows that the leap a skilled artisan would have had to have made to get from Bennington to claim 1, in light of Alten, would have been that much smaller.

Appellants also argue that selecting the icon 65C of Bennington's Figure 6 to access the information of Figure 20 is not the equivalent of tuning to a virtual channel, asserting instead that tuning to a virtual channel requires entering a channel number or using a change channel command to select information positioned in a channel-tuning sequence. *See* App. Br. 12 (citing Spec. 43:14-24). It is not necessary for us to find that selecting the icon 65C, modified by the teaching of Alten, constitutes tuning to a virtual channel. To be sure, the Examiner's Response to Argument explains that the icons in Figure 6's menu, including icon 65C, link to other information, including channel data, that may require additional transmission bandwidth or channels to carry. *See* Ans. 7. However, the rejection itself cites to Bennington's description of a user tuning to the menu of Figure 6 as teaching "allowing the user to use the interactive television program guide to access information that is not promotional information," *see* Ans. 3 (citing Bennington, col. 13, ll. 15-22, 36-38), a finding we agree with. Thus, the rejection, as stated, articulates sufficient grounds for concluding that claim 1 is obvious.

Moreover, while Appellants' Specification describes, as an example of tuning to a virtual channel, entering a channel number using numeric keys on a remote controller, *see* Spec. 43:4-7, and positioning virtual channels "at any other desired location in the channel-tuning sequence," Spec. 43:14-16, Appellants do not explain why these examples should be imported as limitations into claim 1. Indeed, the Specification, at page 43, lines 20-22, further explains that virtual channels "also can be accessed as a menu in the menu mode" and that "[w]hen accessed as a channel, these virtual channels have the functionality of a channel, and when accessed as a menu, they function as a Menu feature . . . ." Thus, if the information of Bennington's Figure 20 is accessed from Figure 6 using a virtual channel (as taught by Alten), this would constitute tuning to a virtual channel.

Appellants contend that even if the Examiner is relying on tuning from Bennington's Figure 6 to Figure 20 to show accessing a virtual channel, Figure 20 would not disclose displaying selectable promotional information in a region of the display that extends substantially across the display. *See* Reply Br. 6. This argument is also unpersuasive. Characterizing information as promotional or not promotional in claim 1 does not functionally change the method of claim 1 or the circuitry recited as carrying out the steps of this method, and, thus, such data is nonfunctional descriptive material. *See Ex parte Nehls*, 88 USPQ2d 1883, 1888-89 (BPAI 2008) (precedential); *see also Ex parte Curry*, 84 USPQ2d 1272, 1274 (BPAI 2005) (informative). As a general proposition, we need not give patentable weight to nonfunctional descriptive material absent a new and nonobvious functional relationship between the descriptive material and the substrate. *See In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004); *see also*

King Pharm., Inc. v. Eon Labs, Inc., 616 F.3d 1267, 1279 (Fed. Cir. 2010); MPEP § 2111.05(I)(A) (citing *In re Lowry*, 32 F.3d 1579, 1584 (Fed. Cir. 1994)). Thus, the characterization of information as promotional or not promotional in claim 1 does not carry patentable weight.

Like Bennington's Figure 6, Figure 20 teaches displaying information in a first region of the display (e.g., textual node identifier 201) and simultaneously displaying other (selectable) information in a second region of the display that extends substantially across the display (e.g., the list of consecutive channels 202A-202C and the corresponding schedule information, *see* Bennington, col. 15, ll. 21-40). Thus, regardless of whether the Examiner refers to tuning to the menu of Figure 6 or to tuning from the menu of Figure 6 to the menu of Figure 20, Bennington teaches each element of claim 1 save the use of virtual channels. Since it was well-known to use virtual channels to access such menu information, *see* Alten, col. 28, ll. 33-36, we are not persuaded that the Examiner's conclusion of obviousness lacked rational underpinning.

Appellants do not separately argue claims 2-12, 14-25, 27-38, and 40-51. *See* App. Br. 8-13.

Accordingly, we sustain the rejection of (1) independent claim 1; (2) independent claims 14, 27, and 40, which contain limitations substantially the same as claim 1; (3) claims 2-12, which depend on claim 1; (4) claims 15-25, which depend on claim 14; (5) claims 28-38, which depend on claim 27; and (6) claims 41-51, which depend on claim 40.

ORDER

The decision of the Examiner to reject claims 1-12, 14-25, 27-38, and 40-51 is affirmed.

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). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2010).

AFFIRMED

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