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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JEYHAN KARAOGUZ and JAMES BENNETT

Appeal 2011-001699
Application 10/675,904
Technology Center 2400

Before: JOSEPH L. DIXON, ST. JOHN COURTENAY III, and
CARLA M. KRIVAK, *Administrative Patent Judges*.

COURTENAY III, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from a final rejection of claims 1-31. We have jurisdiction under 35 U.S.C. § 6(b).

We Affirm.

STATEMENT OF THE CASE

Appellants' claimed invention relates to media interfaces. Independent claim 1, reproduced below, is representative of the subject matter on appeal:

1. A method for customizing a channel interface, the method comprising:

determining one or both of personal media and/or broadcast media that is to be presented in a media channel;

determining a schedule for presenting said one or both of personal media and/or broadcast media in said media channel; and

presenting for displaying, at a first geographic location, said schedule comprising said one or both of personal media and/or broadcast media in a media guide, wherein said media channel may be pushed from said first geographic location to a second geographic location, *wherein said media guide comprises a plurality of channels, and wherein one or more of said plurality of channels may be selected and viewed at said first geographic location prior to pushing said media channel to said second geographic location.*

(disputed limitations emphasized).

REJECTION

The Examiner rejected claims 1-31 under 35 U.S.C. § 103(a) based upon the combined teachings and suggestions of Novak (U.S. Pat. Pub. No. US 2002/0104099 A1) and Cooper (U.S. Patent No. US 6,754,904 B1). (Ans. 4-9).

GROUPING OF CLAIMS

Based on Appellants' arguments, we decide the appeal of the rejection of claims 1-31 on the basis of representative claim 1. *See* 37 C.F.R. § 41.37(c)(1)(iv).

CONTENTIONS

Appellants contend, *inter alia*, that:

Even though Novak's upload source 122 may utilize an STB [Set Top Box], the fact remains that the synthetic channel media objects (uploaded at the source 122 and seen in Fig. 7) are only accessed and displayed at the location of the STB 152, and not from the location of the upload source 122 (*see* Novak at paragraph 0063).

Even though Cooper discloses two separate locations with two separate EPGs [Electronic Program Guides] (602a and 602b in Fig. 6), **none of Cooper's STBs (at either location 602a or 602b) can select and view a media channel (or media), prior to pushing the same media channel (or media) to the other location.** The Appellants agree (as stated by the Examiner in the above underlined citation) that Cooper discloses the communication of information from the first geographic location to the second geographic location. However, such "communicated information" is in the form of a message 600, which only includes links (e.g., 616 and 618) that control the tuner of a set-top box (see Cooper at col. 4, lines 28-49). **The message 600 does not include media, which is displayed at the first STB location (e.g., 602a), prior to the same media being communicated for display at the second STB location (e.g., 602b).**

(App. Br. 7-8).

Appellants further contend that:

[E]ven though Cooper discloses that a user can receive and view a TV signal 800, it is the outgoing message (and not the received signal 800) that is sent to another location. In

addition, as discussed above, the message 600 does not include media, which is displayed at the first STB location (e.g., 602a), prior to the same media being communicated for display at the second STB location. In other words, **Cooper receives a TV signal 800 (which is displayed at the user location but it is not pushed to another location). Cooper also generates a message 600, which is sent to another location but it is not "media" that is displayed at the user location. . . .**

To summarize, Novak does not disclose or suggest that the "media guide comprises a plurality of channels, where one or more of the plurality of channels may be selected and viewed at the first geographic location prior to pushing the selected media channel to the second geographic location," as is required by independent claims 1, 11 and 21. . . .

(App. Br. 9).

ISSUE

Under § 103, did the Examiner err in finding that the cited references, either alone or in combination, would have taught or suggested the disputed limitation of "wherein said media guide comprises *a plurality of channels*, and wherein one or more of said plurality of channels may be selected and viewed at said first geographic location *prior to* pushing said selected media channel to the second geographic location," within the meaning of representative claim 1 (emphasis added), and of independent claims 11 and 21.

ANALYSIS

This appeal turns upon claim construction. Our reviewing court guides that "[i]n the patentability context, claims are to be given their broadest reasonable interpretations . . . limitations are not to be read into the

claims from the specification.” *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (citations omitted).

At the outset, we observe that the first-recited “wherein” clause and the contested third-recited “wherein” clause each include “may be” language that is expressly *equivocal* in scope (claim 1). We conclude that such language makes optional the recited acts of *pushing* the media channel and *selecting* and *viewing* “one or more of said plurality of channels,” as recited in claim 1. Thus, we conclude the claim scope is not limited by such language that suggests or makes optional but does not *require* the steps to be performed.¹

Moreover, because the act of *selection* is not positively recited as actually being performed (because of the “wherein . . . *may be* selected” language in claim 1), we accord no patentable weight to the informational content of the recited displayed “schedule comprising said one or both of personal media and/or broadcast media in a media guide” (claim 1). As presently claimed, the *displayed* media guide and schedule are non-functional descriptive material because the informational content of these

¹ See MPEP § 2111.04 regarding “wherein” clauses:

Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure. However, examples of claim language, although not exhaustive, that may raise a question as to the limiting effect of the language in a claim are:

- (A) “adapted to” or “adapted for” clauses;
- (B) “wherein” clauses; and
- (C) “whereby” clauses.

(MPEP § 2111.04 Eighth Edition, Rev. 9, Aug. 2012).

elements is not positively recited as actually being employed to affect or change any machine or computer function.² Therefore, the informational content of the displayed media guide and schedule is not entitled to weight in the patentability analysis.³ Thus, to the extent Appellants' arguments are premised on a narrow interpretation that claim 1 *requires* the acts following the "may be" qualifiers to be performed, we find such arguments unavailing for the (two) aforementioned reasons.⁴

Even assuming *arguendo* that the aforementioned limitations may be accorded patentable weight, Appellants' arguments are not persuasive because we find the weight of the evidence supports the Examiner's underlying factual findings and ultimate legal conclusion of obviousness. *See* Response to Argument (Ans. 11-15).

² The informational content of non-functional descriptive material is not entitled to weight in the patentability analysis. *See Ex parte Nehls*, 88 USPQ2d 1883, 1887-90 (BPAI 2008) (precedential); *Ex parte Curry*, 84 USPQ2d 1272 (BPAI 2005) (informative) (Federal Circuit Appeal No. 2006-1003), *aff'd*, Rule 36 (June 12, 2006); *Ex parte Mathias*, 84 USPQ2d 1276 (BPAI 2005) (informative), *aff'd*, 191 Fed. Appx. 959 (Fed. Cir. 2006).

³ *Cf.* Functional descriptive material consists of data structures and computer programs which impart functionality when employed as a computer component. *See* Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility ("Guidelines"), 1300 Off. Gaz. Pat. Office 142 (November 22, 2005), especially pages 151-152. The Manual of Patent Examining Procedure (MPEP) includes substantively the same guidance. *See* MPEP, 8th edition (Rev. 9, Aug. 2012), § 2111.05.

⁴ In the event of further prosecution, the Examiner should consider a rejection under 35 U.S.C. § 112 (b) (Sept. 16, 2012). *See Ex parte Miyazaki*, 89 USPQ2d 1207, 1211 (BPAI 2008) ("Precedential") ("[I]f a claim is amenable to two or more plausible claim constructions, the USPTO is justified in requiring the applicant to more precisely define the metes and bounds of the claimed invention by holding the claim unpatentable under 35 U.S.C. § 112, second paragraph, as indefinite.").

In particular, we agree with the Examiner's claim construction because it comports with the express language of claim 1: "it is the Examiner's position that a 'plurality of channels' and a 'media channel' have separate meaning as claimed, where one or more of the 'plurality of channels' is 'selected and viewed', and the 'media channel' is pushed from a first location to a second location." (Ans. 11).

Regarding Appellants' contention that Cooper's communicated information is in the form of a message 600, which only includes links (e.g., 616 and 618) that control the tuner of a set-top box (*see* Cooper at col. 4, lines 28-49), we particularly observe that Appellants' arguments in both the principal Brief, page 9 and the Reply Brief equate the claimed "media channel" as being *equivalent* to *media* (*see* e.g., Reply Brief, p. 4, last line: "the received information [in Cooper] is not media content."). However, we conclude that Appellants' construction is inconsistent with the broader description in the Specification, which states: "personal media and/or broadcast media that is to be presented in a *communication channel*" (Spec. 32, Abstract) (emphasis added). Thus, we conclude that a reasonable interpretation of the claimed "media channel" more broadly covers links to a communication *channel* for viewing media, such as taught or suggested by Cooper's transmitted media links 616 and 618 (*see* col. 4, ll. 32-33, "Each link **616** and **618** can include a reference to a television channel feature").

Although Appellants urge that "**Novak does not disclose that the interface 702 or the [single] synthetic channel schedule comprise a plurality of channels**" (Reply Br. 4, ll. 1-2), we conclude that Appellants' claim 1 only requires a single "media channel" to be "pushed from said first geographic location to a second geographic location" as per the plain

language of the claim (“wherein said media channel may be pushed”), and in accordance with the Examiner’s claim construction discussed above.

We observe that Novak’s Figure 8 depicts an electronic program guide (EPG 802) that includes a personal channel (Joe’s TV channel) as shown in Novak’s Figure 7, along with other broadcast media channels (i.e., teaching a media guide comprising a plurality of channels). We acknowledge that Novak’s Figure 8 appears to be located at a second geographical location on the subscribing end user side (para. [0074]), which the Examiner correlates with Novak’s STB 152 (Ans. 12 *citing* Novak, Fig. 1).

However, we find Novak’s Figure 8 teaches that the acts of selecting and viewing a *plurality* of program guide channels were *well known* and thus would have been obvious to an artisan when performed at *any* location, including at the location of the author of Novak’s personal synthetic channel corresponding to the claimed first geographical location. (*See* Novak, para. [0063]; *see also* Ans. 12: “the Examiner has addressed the claimed ‘first location’ with Novak’s Upload Source 122 [Fig. 1].”). We further observe that Novak’s Figure 8 bears a *striking similarity* to Appellants’ exemplary media channel guide 100, as shown in Figure 1B of Appellants’ drawings.

The Examiner admits that in Novak “it is unclear if one or more of the plurality of channels may be selected and viewed at the first location prior to pushing the media channel to the second geographic location.” (Ans. 12). However, the Examiner relied upon the Cooper reference to teach or suggest this limitation. We agree with the Examiner’s findings (Ans. 13) regarding Cooper’s teaching of a first EPG located at a first geographic location (600a-

DC), and a second EPG located at a second geographic location (600b–Boston), as depicted in Cooper’s Figure 6.

We further agree with the Examiner that “Cooper’s teaching of Message 600, which is communicated between the STBs, [] demonstrate[s] that, in a similar fashion to Novak, Cooper teaches an act of communication from a first location to a second location. In particular, Cooper establishes that this communication is performed after the user has selected and viewed a channel in the EPG (as described in Col. 6 Lines 19-57; with further reference to Steps 1000 and 1006 of Fig. 10).” (Ans. 13). We note that the Examiner’s rejection is based on the *combined* teachings and suggestions of Novak and Cooper.

Regarding the disputed temporal “prior to” limitation (claim 1), absent a showing of secondary considerations (e.g., unexpected results), we are not persuaded that the Examiner’s ultimate legal conclusion of obviousness is in error. We find at least Novak’s Figures 7, 8, and Cooper’s Figure 6 establish that *selecting* and *viewing* electronic program guide channels are *well known* regardless of when and where the acts are performed. Moreover, we find that merely changing locations and sequence order would yield predictable results.

Notwithstanding Appellants’ arguments (*see also* Reply Br. 2-7), the Supreme Court guides that “when a patent ‘simply arranges old elements with each performing the same function it had been known to perform’ and yields no more than one would expect from such an arrangement, the combination is obvious.” *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 417 (2007) (quoting *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273, 282 (1976)).

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This reasoning is applicable here. Therefore, on this record, we are not persuaded of error regarding the Examiner's underlying factual findings and ultimate legal conclusion of obviousness. Accordingly, we sustain the rejection of claim 1. Claims 2-31 (not argued separately) fall therewith. *See* 37 C.F.R. § 41.37(c)(1)(iv).

DECISION

We affirm the Examiner's rejection under §103 of claims 1-31.

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).

ORDER
AFFIRMED

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