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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte YAKOV KAMEN and DAN KIKINIS

Appeal 2011-007329
Application 10/008,229
Technology Center 2400

Before JOSEPH L. DIXON, THU A. DANG, and
JAMES R. HUGHES, *Administrative Patent Judges*.

DIXON, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from a rejection of claims 1-17 and 19-21. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

The claims are directed to adding categories of broadcasted programs to a set of categories based on tuning of a broadcasted program viewing device. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A method comprising:

providing a first set of categories of broadcasted programs;

providing a second set of categories of broadcasted programs; and

adding a first category from the first set to the second set of categories of broadcasted programs in response to tuning a broadcasted program viewing device to a broadcasted program fitting into the first category of the first set of categories a predetermined number of times, wherein the predetermined number of times is greater than 1.

REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Rothmuller	US 5,635,989	June 3, 1997
Bedard	US 5,801,747	Sept. 1, 1998
Blonstein	US 5,978,043	Nov. 2, 1999

Schein	US 6,323,911 B1	Nov. 27, 2001 (filed Apr. 28, 1997)
Candelore ¹	US 2002/0104081 A1	Aug. 1, 2002 (filed Dec. 4, 2000)
Ellis	US 2005/0204382 A1	Sept. 15, 2005 (cont. of 09/717,729, filed Nov. 21, 2000)

REJECTIONS

Claims 7-12 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Claim 21 stands rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Claims 1, 7, 19, and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Candelore and Bedard.

Claims 2 and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Candelore, Bedard, and Blonstein.

Claims 3-5 and 9-11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Candelore, Bedard, and Rothmuller.

Claims 6 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Candelore, Bedard, Ellis, and Schein.

Claims 13 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Candelore, Ellis, and Schein.

¹ Although the filing date of Candelore is after the filing date of provisional application 60/250,977 to which the present application claims priority, Appellants have not raised the issue of whether Candelore is prior art to the appealed claims. Accordingly, we assume that the Examiner correctly applies Candelore as prior art in rejecting the appealed claims.

Claim 14 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Candelore, Ellis, Schein, and Blonstein.

Claims 15-17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Candelore, Ellis, Schein, and Rothmuller.

ANALYSIS

The Non-Statutory Subject Matter Rejection

We agree with the Examiner and find that independent claim 7 recites non-statutory subject matter (Ans. 3-4). Claim 7 is drawn to “tangible computer-readable media,” which when read in light of the Specification encompasses “electrical, optical, acoustical and other forms of propagated signals (e.g., carrier waves, infrared signals, digital signals, etc.)” (Spec. ¶ [0029]). Such physical, and thus tangible, but transitory signals are not patentable. *See In re Nuijten*, 500 F.3d 1346, 1353 (Fed. Cir. 2007); *see also* “Subject Matter Eligibility of Computer Readable Media,” 1351 Off. Gaz. Pat. Office 212 (Feb. 23, 2010) (“A claim drawn to such a computer readable medium that covers both transitory and non-transitory embodiments may be amended to narrow the claim to cover only statutory embodiments to avoid a rejection under 35 U.S.C. § 101 by adding the limitation ‘non-transitory’ to the claim.”).

We are therefore not persuaded that the Examiner erred in rejecting claim 7 and claims 8-12, which depend from claim 7 and also encompass unpatentable transitory signals.

The Written Description Rejection

Appellants argue that the Specification describes “adding the [sic] a first category from the first set to the second set of categories of broadcasted programs in response to tuning a broadcasted program viewing device to a broadcasted program fitting into the first category of the first set of categories a predetermined number of times” and that “[i]t then follows that the predetermined number of times would be determined prior to providing the first set of categories [as recited in claim 21] in order to identify the first category of the first set of categories to be added and determine whether the threshold is met” (App. Br. 5) (citing Spec. ¶¶ [0014]-[0015]). However, it does not necessarily follow from Appellants’ cited description that the predetermined number of times would be predetermined prior to the step of “providing the first set of categories of broadcasted programs,” as recited in claim 21. For example, the predetermining of that threshold number could occur after the “providing” step but before the “adding” step. Although the number must be predetermined at some time prior to using the number for the “adding” step, Appellants have not shown which possible time for predetermining this number they were in possession of when the application was originally filed. The test for satisfying the written description requirement is not whether there exists a logical possibility for a claimed feature, but whether Appellants had actual possession. *See Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991). Appellants have not shown that the Specification provides evidence of such actual possession.

We are therefore not persuaded that the Examiner erred in rejecting claim 21.

The Obviousness Rejections

Claims 1, 7, 19, and 21

Appellants contend that neither Candelore nor Bedard, alone or in combination, disclose “adding ... a first category from the first set to the second set of categories of broadcasted programs in response to tuning a broadcasted program viewing device to a broadcasted program fitting into the first category of the first set of categories *a predetermined number of times*, wherein the predetermined number of times is greater than 1,” as recited in claim 1 (App. Br. 5-7). We disagree.

We first note that the Examiner interprets the claim 1 limitation “categories of broadcasted programs” to include channels in finding that Candelore’s electronic program guide (EPG) meets the limitation of a “first set of categories of broadcast programs” and that Candelore’s favorites list, which may include channels, meets the limitation of “a second set of categories of broadcasted programs.” (*See* Ans. 5). We agree with this interpretation and find that the broadest reasonable interpretation of “categories of broadcasted programs” encompasses channels. For example, the Specification provides that “some channels may be oriented towards one category of content.” (Spec. ¶ [0004]). We thus agree with the Examiner (Ans. 5; Candelore, ¶¶ [0045]-[0046]) and find that Candelore discloses “adding a first category [i.e., a channel] from the first set [i.e., the channels available on the EPG] to the second set of categories [i.e., the favorites list]” (claim 1).

Regarding the limitation “in response to tuning a broadcasted program viewing device to a broadcasted program fitting into the first category of the first set of categories *a predetermined number of times*, wherein the

predetermined number of times is greater than 1” (claim 1), we find that Bedard discloses this feature (Ans. 5). While Appellants correctly argue that Bedard discloses a predetermined amount of time that a program must be viewed before a channel is added to Bedard’s viewer profile (App. Br. 6-7), which Bedard calls a “viewing unit” (Bedard, col. 4, ll. 5-14), this is not the only criterion Bedard requires for adding a channel to the viewer profile. Bedard adds a channel to the viewer profile based on the number of times a program has been viewed for the predetermined amount of time, i.e., the number of “viewing units.” Specifically, Bedard discloses “a channel of channels 100 is eligible to become a viewer profile entry 202 (i.e., *more than one viewing unit* during the viewer profile collection period).” (Bedard, col. 5, ll. 7-9) (emphasis added). Appellants’ arguments do not specifically address this portion of Bedard relied upon by the Examiner (*see* Ans. 5). Accordingly, we are not persuaded of error in the Examiner’s finding that Bedard discloses “a predetermined number of times, wherein the predetermined number of times is greater than 1” (claim 1).

We are therefore not persuaded that the Examiner erred in rejecting claim 1 and claims 7, 19, and 21 not separately argued. Although claims 6 and 12, which depend from claims 1 and 7, are nominally argued separately, Appellants provide no new specific arguments for patentability for these claims (*see* App. Br. 8-9). We therefore sustain the rejection of claims 6 and 12 for the reasons discussed above.

Claims 2 and 8

Appellants contend that “Blonstein describes removing a *channel* from a favorites list. *See* col. 12, lines 23-30. However, there is no teaching

or suggestion of removing a *category* as recited in claims 2 and 8.” (App. Br. 8). We disagree.

As discussed above, we interpret the claimed “categories of broadcasted programs” (claim 1) to include channels. Blonstein discloses removing a channel from a favorites list (Blonstein, col. 12, ll. 23-30), as Appellants admit, which meets the claim 2 limitation “removing a second category from the second set.” We are therefore not persuaded that the Examiner erred in rejecting claim 2 and claim 8 not separately argued.

Claims 3-5 and 9-11

Appellants contend:

At most Rothmuller describes removing a program *title* from a favorite program list based upon expiration of a predefined time period. There is absolutely no teaching or suggestion of removing any category, let alone a *category* from a set of categories upon a broadcast viewing device *not being tuned* for a period of time at least equal to a first predetermined threshold, to at least one broadcasted *program* predetermined to be in the second category from the second set.

(App. Br. 8). However, Appellants’ argument does not take into consideration the collective teachings of the references.

Candelore discloses that the favorites list can be based on the rank of channels according to certain relative statistics and limited, for example, to the top fifteen channels (Candelore, ¶ [0038]). Bedard discloses that a viewer profile is limited to a certain number of channels, for example, 10% of all channels, or a numeric limit such as eight channels (Bedard, col. 4, l. 66-col. 5, l. 6). Thus, both Candelore and Bedard suggest removing channels from a set of channels because, in order to add a new channel to a limited favorites list of channels, some channel must be removed at some

point in time. As Appellants correctly assert, Rothmuller discloses removing a program, rather than a channel, or category, from a favorites list based upon a predetermined period of time (Rothmuller, col. 6, ll. 48-54). However, we agree with the Examiner (Ans. 7-8) and find that one of ordinary skill in the art would have applied Rothmuller's general technique of removing items from a favorites list based on a predetermined period of time to the channels in the favorites list of the combination of Candelore and Bedard. *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007).

We are therefore not persuaded that the Examiner erred in rejecting claim 3 and claims 4, 5, and 9-11 not separately argued.

Claims 13, 15-17, and 20

Appellants contend:

At most, Candelore describes adding a program to a favorites list based on *relative* viewing statistics. *See* paras. [0045], [0046]. There is absolutely no teaching or suggestion in Candelore of adding a category to a second set and tuning a broadcasted program viewing device for a period at least equal to a first predetermined threshold.

(App. Br. 9). We disagree.

As discussed above, we interpret the term “categories” to include channels. Thus, we agree with the Examiner (Ans. 10; Candelore, ¶¶ [0045]-[0046]) and find that Candelore discloses the limitation “to add a category from the first set to a second set of categories,” as recited in claim 13. Further, Candelore discloses that, in determining whether to add a channel to the favorites list, “the relative statistics can be based on the number of times a channel was tuned in to for over a certain period of time,

e.g., 10, 20, or 30 minutes.” (Candelore, ¶ [0045]). In other words, a channel must be viewed at least, for example, 10, 20, or 30 minutes before that viewing event can be counted toward the statistics for that channel. One of ordinary skill in the art would thus understand that adding a channel to Candelore’s favorites list is based at least in part on tuning to that channel for a predetermined period of time.

We are therefore not persuaded that the Examiner erred in rejecting claim 13 and claim 20 not separately argued. Although claims 15-17, which depend from claim 13, are nominally argued separately, Appellants provide no new specific arguments for these claims (*see* App. Br. 10). We therefore sustain the rejection of claims 15-17 for the reasons discussed above.

Claim 14

Appellants’ argument for claim 14 is the same as that provided for claim 2, namely, that “at most, Blonstein describes removing a *channel* from a favorites list.” (App. Br. 10). However, this argument is not persuasive for the reasons discussed above. We are therefore not persuaded that the Examiner erred in rejecting claim 14.

CONCLUSIONS OF LAW

The Examiner did not err in rejecting claims 7-12 under 35 U.S.C. § 101.

The Examiner did not err in rejecting claim 21 under 35 U.S.C. § 112, first paragraph.

The Examiner did not err in rejecting claims 1-17 and 19-21 under 35 U.S.C. § 103(a).

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DECISION

For the above reasons, we affirm the rejections of claims 1-17 and 19-21.

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). *See* 37 C.F.R. § 41.50(f).

AFFIRMED

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