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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte CHARLES W. BEESON, EARL J. BONOVIK, SHANNON A. KALLIN, and ERIN K. NELSON¹

Appeal 2014-005305
Application 13/280,171
Technology Center 2400

Before JASON V. MORGAN, JOSEPH P. LENTIVECH, and KARA L. SZPONDOWSKI, *Administrative Patent Judges*.

MORGAN, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

This is a decision on Appellants' Request for Rehearing. Appellants' Request for Rehearing is filed under 37 C.F.R. § 41.50(a)(1) requesting that we reconsider our Decision of August 15, 2016 ("Dec."), wherein we affirmed the Examiner's rejection of claims 13–18, 21, and 24. We have reconsidered our Decision in light of Appellants' contentions in the Request for Rehearing, and have found no errors. Therefore, we decline to change the Decision. Appellants' request is DENIED.

¹ Appellants identify The DIRECTV Group, Inc., as the real party in interest. App. Br. 2.

DISCUSSION

35 U.S.C. § 112, first paragraph—Claim 13

Appellants contend the Board erred in affirming the Examiner’s 35 U.S.C. § 112, first paragraph, rejection of claims 13–16 for failing to provide written description support for the claim 13 recitation of “forming a record command signal . . . in response to the swipe gesture.” To meet the written description requirement, the Specification must describe an invention understandable to an artisan of ordinary skill to show that Appellants actually invented the invention as claimed. *Ariad Pharm., Inc. v. Eli Lilly and Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010). Such description must reasonably convey to an artisan of ordinary skill that Appellants “had possession of the claimed subject matter as of the filing date.” *Id.*

Appellants argue the Specification “describes different types of gestures including swipe gestures.” Req. Reh’g 5 (citing Spec. ¶ 69). In particular, Appellants contend that swipe gestures are one of two selections, or gestures, described in the Specification and that the Specification clearly sets forth recording in response to a gesture. Reg. Reh’g 6 (citing Spec. ¶ 112–13).

Appellants’ contentions are unpersuasive because, as we found, the Specification “repeatedly describes using a swipe gesture to generate a *tune* command” (Dec. 4 (citing Spec. ¶¶ 69, 104, and 109)), but merely discloses “the use of a *button*—rather than a swipe gesture—to generate a record command” (Dec. 4 (citing Spec. ¶¶ 81, 98, Figs. 6, 18,)). We correctly found that the Specification’s disclosures fall short of disclosing the use of a swipe gesture for recording. *See* Dec. 4. The Specification’s disclosure that “*other* gestures may be used to perform *different* functions” (Spec. ¶ 112,

emphases added; *see* Req. Reh’g 6) does not disclose the use of a swipe gesture to effect a record command because the other gestures and different functions relate to gestures used to perform operations *other than* recording (*see* Spec. ¶ 112, Fig. 24).

Appellants acknowledge that claim 13 “was limited to recite only a ‘swipe gesture’” rather than a number of types of gestures. Req. Reh’g’ 6. However, this “swipe gesture” limitation was not originally claimed. *See* Spec. ¶ 33. Moreover, Appellants have not directed our attention to evidence that the Specification reasonably apprises an artisan of ordinary skill that Appellants had possession of the invention of claim 13, as limited by the “swipe gesture” recitation, at the time the application was filed. Therefore, we decline to change our Decision as it relates to the Examiner’s 35 U.S.C. § 112, first paragraph, rejection of claim 13.

We note that the Examiner found that the 35 U.S.C. § 112, first paragraph, rejection also is applicable to at least claims 17 and 24. Ans. 5. Although claim 17 now recites a screen device that “forms a record command . . . in response to the swipe gesture,” we did not address the Examiner’s attempt to extend the scope of the 35 U.S.C. § 112, first paragraph, rejection to encompass additional claims. We will not modify our Decision at this point to address this issue, but impel the Examiner to properly identify the claims affected by the lack of written description support for using swipe gesture to form a record command (claims 13–24) in the event of further prosecution.

35 U.S.C. § 112, fourth paragraph—Claim 24

Appellants contend the Board erred by failing consider the Examiner’s 35 U.S.C. § 112, fourth paragraph, rejection of claim 24.

However, the Examiner noted that Appellants “amended claim 24 after the Final Office Action to depend from claim 17 instead of claim 22” and withdrew the rejection. Ans. 5. As such, there was no 35 U.S.C. § 112, fourth paragraph, rejection of claim 24 for the Board to consider.

35 U.S.C. § 103(a)—Claims 13, 14, 16–18, 21, and 24

Appellants contend the Board erred in affirming the Examiner’s 35 U.S.C. § 103(a) rejection because “both the Board and the Examiner have formed a hindsight reconstruction using the claims as a guide.” Req. Reh’g 7; *see also id.* at 8. However, Appellants did not allege the Examiner erroneously relied on hindsight reasoning. *See* App. Br. 9–10; Reply Br. 5–8. We will not consider an untimely allegation of hindsight reasoning in the Examiner’s rejection. Furthermore, Appellants do not show the Board, in affirming the Examiner’s rejection, introduced new reasoning improperly grounded in hindsight.

In contending the Board erred, Appellants argue the swipe gesture in Poulidis “may be used to perform a single function to change the video signal.” Req. Reh’g 7 (citing Poulidis ¶¶ 41, 42). This argument is repetitive with Appellants’ prior contention that the Poulidis swipe gesture is merely “used as a single command to view a program.” App. Br. 9. The Examiner addressed this argument—in findings and conclusions we adopted (Dec. 3)—by noting that Poulidis “teaches a range of gestures that can be used for various purposes” and that its examples were “merely illustrative of the wide range of uses of” the Poulidis gesture commands (Ans. 8 (citing Poulidis ¶¶ 41, 42)). The Examiner concluded, and we agreed, that it would have been obvious to use the Poulidis swipe gesture as the basis for forming the record command taught or suggested by Lau. *See* Ans. 8; Dec. 6–7.

Appellants further argue the Board improperly relied on Ellis even though it was “not cited as a primary or secondary reference.” Req. Reh’g 7. Although the Examiner had cited to Ellis (*see* Ans. 7)—which is incorporated by reference by Lau (*see* ¶ 68)—Appellants did not previously contend that it was improper to rely on the teachings and suggestions of Ellis. Appellants merely argued that Ellis did not make up for the alleged deficiencies of Lau. Reply Br. 7. Appellants’ untimely argument that Ellis was improperly relied upon will not be considered.

Appellants further argue that there is no swipe gesture in a window in Ellis. Req. Reh’g 7. This argument was previously raised. *See* Reply Br. 7 (“Nowhere in Ellis is a gesture and/or performing a single swipe gesture . . . disclosed”). We found it unpersuasive and noted “the Examiner relies on the *combination* of the teachings and suggestions of Ellis (as incorporated by Lau), Lau, and Poulidis to teach or suggest the formation of a record command . . . in response to a swipe gesture.” *See* Dec. 6–7 (emphasis added).

For these reasons, Appellants do not show that the Board misapprehended or overlooked any issues raised by Appellants with respect to the Examiner’s 35 U.S.C. § 103(a) rejection. Therefore, we decline to change our Decision as it relates to the Examiner’s 35 U.S.C. § 103(a) rejection of claims 13, 14, 16–18, 21, and 24.

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DECISION

Based on the record before us now and in the original appeal, we have granted Appellants' request 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). *See* 37 C.F.R. § 41.50(f).

REQUEST FOR REHEARING DENIED