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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ROBERT P. LILLENES, HAN-SHENG YUH,
WEIDONG WILLIAM WANG, and WAYNE SCOTT

Appeal 2015-005536
Application 11/643,883
Technology Center 2100

Before JOHN A. JEFFERY, ST. JOHN COURTENAY III, and
SCOTT B. HOWARD, *Administrative Patent Judges*.

JEFFERY, *Administrative Patent Judge*.

DECISION ON APPEAL

This application returns to us after another panel of this Board¹ affirmed the Examiner’s rejection of then-pending claims 1–8, 10–21, and 23–26. *Ex parte Lilleness*, No. 2011-007127 (PTAB Oct. 28, 2013) (“Bd. Dec.”). Prosecution reopened after that decision, and Appellants now appeal under 35 U.S.C. § 134(a) from the Examiner’s subsequent rejection of claims 1–8, 10–21, and 23–26. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

¹ The panel for this appeal is the same as the earlier appeal except that Judge Howard replaces then-Judge Dillon.

STATEMENT OF THE CASE

Appellants' invention includes a "platform," such as a Web tablet, PDA, personal computer, or remote control, that initiates (1) playing media content, and (2) retrieving related information from an information source responsive to activating a platform command key. *See generally* Abstract; Spec. 1–3, 10; Figs. 13–14.

CLAIMED SUBJECT MATTER

Claim 1 is illustrative:

1. In a platform configured to initiate operation of an appliance, a readable media having processor executable instructions for retrieving information, the instructions performing steps comprising:

in response to a sensed activation of a single command key of the platform causing the platform to transmit a command to cause the appliance to initiate a rendering of a media content having nm associated address for a platform external information source that has information related to the media content, transmit a request to retrieve information related to the media content from the platform external information source via use of the address for the platform external information source that is associated to the media content, and display the retrieved information in a display of the platform,

wherein the address for the platform external information source which is to be used to retrieve information related to the media content from the platform external information source is determined as a function of the single command key that was activated.

THE REJECTIONS

The Examiner rejected claims 1, 2, 4, 5, 10–15, 17, 18, and 23–26 under 35 U.S.C. § 102(e) as anticipated by Dubil (US 2003/0034957 A1;

Feb. 20, 2003) or, alternatively, under 35 U.S.C. § 103(a) as unpatentable over Dubil and Mitchell (US 2002/0162120 A1; Oct. 31, 2002). Final Act. 2–6.²

The Examiner rejected claims 3,³ 7, 8, 16, 20, and 21 under 35 U.S.C. § 103(a) as unpatentable over Dubil “and/or” Mitchell in view of Houghton (US 6,757,707 B1; June 29, 2004). Final Act. 6–8.

The Examiner rejected claims 6 and 19 under 35 U.S.C. § 103(a) as unpatentable over Dubil “and/or” Mitchell in view of Darbee (US 6,130,726; Oct. 10, 2000). Final Act. 8.

THE OBVIOUSNESS REJECTION OVER DUBIL AND MITCHELL

Regarding claim 1, the Examiner finds that Dubil’s “platform” (remote control device 100) (1) transmits a command to cause an “appliance”⁴ to initiate rendering media content having an associated address for a platform-external⁵ information source with information related

² Throughout this opinion, we refer to (1) the Final Rejection mailed September 30, 2014 (“Final Act.”); (2) the Appeal Brief filed November 21, 2014 (“App. Br.”); (3) the Examiner’s Answer mailed March 5, 2015 (“Ans.”); and (4) the Reply Brief filed May 5, 2015 (“Reply Br.”).

³ Although the Examiner includes claim 2 in the statement of this rejection, the Examiner nonetheless refers to claim 3 in the rejection’s discussion. *Compare* Final Act. 6 *with* Final Act. 7. *Accord* App. Br. 12–13 (noting that claim 3 was rejected over Dubil (alone or in view of Mitchell) and Houghton). Accordingly, we present the correct claim listing here for clarity, and deem the Examiner’s error in this regard as harmless.

⁴ We presume, as the panel did in the earlier Decision, that the Examiner intends to map the recited “appliance” to Dubil’s television 250. *Accord* Bd. Dec. 3 n.3.

⁵ Although the claims omit the hyphen between “platform” and “external,” we nonetheless include it here for proper grammatical form.

to the content; (2) transmits a request to receive the information via use of the address for the platform-external information source, and (3) displays the retrieved information, where steps (1) to (3) are responsive to a sensed activation of a single platform command key.

Although the Examiner finds that Dubil determines a platform-external information source address as a function of the activated single command key in the anticipation rejection, the Examiner nonetheless cites Mitchell for teaching this feature in concluding that the claim would have also been obvious over Dubil's and Mitchell's collective teachings. Final Act. 2–4.

Appellants argue that neither Dubil nor Mitchell causes a platform to perform the three above-noted recited steps responsive to a sensed activation of a single platform command key, let alone determine the recited address as a function of that key as claimed. App. Br. 5–12; Reply Br. 2–6. According to Appellants, Dubil does not transmit a request to retrieve information from a source external to the remote control using the recited address responsive to activating a single command key as claimed, but rather provides and stores such information *before* command key activation. App. Br. 7–10; Reply Br. 2–3. Appellants add that Mitchell is likewise deficient in this regard, for URL-based information is said to be retrieved when the remote control is placed in a “receive mode,” regardless of whether a channel selection key is activated. App. Br. 11–12; Reply Br. 4–6.

ISSUE

Under § 103, has the Examiner erred in rejecting claim 1 by finding that Dubil's platform (1) transmits a command to cause an appliance to

initiate rendering media content having an associated address for an information source with information related to the content, and (2) transmits a request to retrieve the information using the address, and (3) displays the retrieved information, where steps (1) to (3) are responsive to a sensed activation of a single platform command key, and the address is determined as a function of that key?

ANALYSIS

Claims 1, 4, 5, 10–14, 17, 18, and 23–26

We begin by noting key differences in claim 1 that is before us in this appeal as compared to the version of that claim that was before the panel in the earlier appeal. After the earlier panel’s decision, Appellants narrowed claim 1 to require, among other things, (1) performing the three above-noted steps responsive to a sensed activation of a *single* command key; (2) a *platform-external* information source; and (3) determining that source’s address as a function of the single activated command key. *See* Amendments filed Nov. 21, 2013, Mar. 18, 2014, and July 9, 2014.

Despite these amendments, the Examiner continues to rely principally on *Dubil* in the rejections in this appeal—a reference that was also at issue in the earlier appeal. Accordingly, the Board’s findings and conclusions regarding *Dubil* in the earlier appeal are likewise applicable here and are, therefore, incorporated by reference.

Turning to the rejection, we note, as did the panel in the earlier decision, that it is undisputed that *Dubil*’s remote control device 100 (“platform”) includes a number of command keys, including keys that change channels. *Bd. Dec. 4. See also Dubil* ¶ 14 (noting that the user can

control “channel up/down” functions with the remote control device). Nor is it disputed that one of those keys is a “channel up” button. *See* Ans. 8 (equating a key press of a *channel up button* to a command). And, as in the earlier appeal, there is no dispute that Dubil’s remote control device displays information related to the currently-viewed channel. Bd. Dec. 4.

Rather, this dispute hinges on whether the three recited steps noted above are responsive to a sensed activation of a *single* platform command key, and the address is determined as a function of that key as claimed.

We see no error in the Examiner’s findings in this regard. As shown in Dubil’s Figure 2, remote control 100 receives information to be displayed from two different sources: (1) remote central station 200, or (2) Internet-connected host 202, the latter of which can be a set-top box (STB) or personal computer. *See* Dubil ¶¶ 16, 27. As the Examiner explains, Dubil’s system displays information related to the *currently-viewed* program—a program that results from pressing the “channel up” button. Ans. 8–9. That is, the program that is viewed changes each time that button is pressed to change the channel. *See id.* Notably, the Examiner finds that with each such key press, a command is transmitted that not only causes an appliance to render media content (i.e., a program) with an address for an associated information source, but also retrieve that information from the Internet and deliver the information to the remote control where it is accessed from the remote control’s memory and displayed. Final Act. 3; *see also* Ans. 8–9; Bd. Dec. 5.

According to Appellants, because the retrieved information is stored in Dubil’s remote control *before* command key activation, the information retrieval request is not sent to a platform-external information source

responsive to activating a single command key as claimed. App. Br. 7–9; Reply Br. 2–3. Although Appellants are correct to the extent that information 104 related to a currently-viewed television program *can be* stored in the remote control’s memory 224 for later viewing or interaction, Dubil’s permissive “can be” language suggests that it need not be stored there, but nevertheless can be stored there *as an option*, for example, *if* the viewer wants to read the program-related information *later*. See Dubil ¶¶ 22, 24.

In any event, the Examiner’s obviousness rejection is not based on Dubil alone, but rather over the collective teachings of Dubil and Mitchell. See Final Act. 2–4; Ans. 9–10. In Mitchell, after STB 102 receives URL addresses embedded in a television signal, namely in its vertical blanking interval (VBI), the STB then sends those URLs to a remote device 204 where they are processed to enable accessing supplemental content via the Internet and displaying it on remote display 220. Mitchell, Abstract; ¶¶ 23, 58, 77; Fig. 2. As shown in step 502 of Mitchell’s Figure 5, this process is triggered by the user activating the remote device by, for example, *pressing a designated button* 232, 234 to place the remote device in a receive mode to receive the URL addresses from the STB. Mitchell ¶ 75. Notably, control buttons 234 can also include *channel selection*, thus at least suggesting that a channel selection control button can also be used to activate the remote device. See Mitchell ¶ 39 (“One of the control buttons 234 may *also* be used to set the remote device 204 to the receive mode.”) (emphasis added).

Based on this functionality, we see no error in the Examiner’s finding that, in light of Mitchell, *pressing the “channel up” button* in the Dubil/Mitchell system (e.g., from channel 7 to channel 8) would not only

cause the remote device to request channel 8's media, namely its television program, but also information related to that program. Ans. 10. In this scenario, the STB would (1) receive channel 8's television signal with the embedded URL; (2) transmit that television signal to the television; and (3) transmit the URL to the remote device. *Id.* As the Examiner indicates, once the remote device receives the URL, it will display supplemental content related to channel 8's television program. *Id.* See also Mitchell ¶ 77; Fig. 5 (steps 512, 514).

This functionality, then, at least suggests that the address for the platform-external information source (e.g., the URL associated with a particular channel's program) is determined as a function of a single activated command key, namely by pressing the "channel up" button to tune to that channel. As noted above, this activation triggers the extraction and transmission of that URL to the remote device so that associated supplemental content is displayed at that device. See Mitchell ¶ 77; Fig. 5 (steps 512, 514).

Appellants' contention that, in the receive mode, Mitchell's remote device receives URLs from the STB regardless of whether a channel selection key is activated (App. Br. 11–12; Reply Br. 4–6) is unavailing. Notably, Appellants' argument ignores the Examiner's reliance on the *remote device's* "channel up" key for not only changing channels, but *also* triggering activation that places the remote device in a receive mode to receive URLs responsive to pressing that key as noted previously. See Mitchell ¶¶ 39, 75. Appellants' arguments premised on using the *STB's* "channel up" key (Reply Br. 5) are, therefore, not germane to the Examiner's findings which are based on pressing the *remote device's*

“channel up” key. Appellants’ other hypothetical scenarios that are said to result in not retrieving and displaying information as recited when, for example, the cable head end system somehow fails to provide a URL in channel 8’s VBI, or the remote control is not placed in receive mode (*id.*), are not only speculative and unsubstantiated, they are not germane to the Examiner’s rejection.

Therefore, we are not persuaded that the Examiner erred in rejecting claim 1 as obvious over Dubil and Mitchell, and claims 4, 5, 10–14, 17, 18, and 23–26 not argued separately with particularity.

Claims 2 and 15

We also sustain the Examiner’s rejection of claim 2 reciting that the address for the platform-external information source is pre-stored within the platform. Despite Appellants’ arguments to the contrary (App. Br. 12; Reply Br. 6), we see no error in the Examiner’s reliance on Dubil in this regard. Final Act. 4. Notably, Dubil pre-stores retrieved information in the remote control device’s (platform’s) memory as Appellants acknowledge (*see* App. Br. 8–9) and as noted in the Board’s earlier decision. *See* Bd. Dec. 5.

Given this acknowledged pre-storage functionality, we see no reason why Dubil could not also pre-store addresses for that information as well within the remote control device to yield a predictable result, namely providing additional information by pre-storing both the addresses and the associated information. To the extent that such pre-storage would have rendered the Dubil/Mitchell system inoperative or otherwise unsuitable for its intended purpose to teach away from such an approach, there is no

persuasive evidence on this record to substantiate such a theory. Accordingly, the weight of the evidence on this record favors the Examiner's underlying factual findings and obviousness conclusion.

Therefore, we are not persuaded that the Examiner erred in rejecting claim 2 as obvious over Dubil and Mitchell, and claim 15 not argued separately with particularity.

THE OBVIOUSNESS REJECTION OVER DUBIL, MITCHELL, AND HOUGHTON

We also sustain the Examiner's obviousness rejection of claim 3 over Dubil, Mitchell, and Houghton. Final Act. 6–8. Claim 3 depends from claim 2, and adds that the address for the platform-external information source is provided to the platform by a user of the platform.

Appellants do not dispute the Examiner's reliance on Houghton's column 3, lines 30 to 51 (Final Act. 7) for teaching this feature, but rather contend that because the Dubil/Mitchell system requires an STB to (1) receive a TV signal with a URL, and (2) transmit the URL to the remote control so that it can display an associated web page, the Dubil/Mitchell system would allegedly not function if a *user* provides the recited address instead of the STB. App. Br. 13; Reply Br. 7.

This argument is unavailing. First, Appellants fail to substantiate this assertion with persuasive evidence, for such attorney argument—without supporting evidence—has little probative value. *See In re Geisler*, 116 F.3d 1465, 1470 (Fed. Cir. 1997). Second, nothing in the claim requires that the addresses are *only* provided by a user: they could *also* be provided by an STB *in addition to* those provided by a user, particularly in light of the open-

ended term “comprising” in the preamble of claim 1 from which claim 3 ultimately depends.

In any event, even if the claim was limited to only the user providing the addresses (which it is not), Appellants still have not demonstrated persuasively with supporting evidence why such user involvement would render the system inoperative. Even if the STB were required to provide the addresses to the platform as Appellants assert (*see* Reply Br. 13), we still see no reason why a user could not be involved in that process at least to some extent, for example, by verifying or confirming the addresses before they are provided to the platform.

Therefore, we are not persuaded that the Examiner erred in rejecting claim 3, and claims 7, 8, 16, 20, and 21 not argued separately with particularity.

THE REJECTION OVER DUBIL, MITCHELL, AND DARBEE

We also sustain the Examiner’s obviousness rejection of claims 6 and 19 over Dubil, Mitchell, and Darbee. Final Act. 8. Because Appellants do not contest this rejection, it is summarily sustained. *See* MPEP § 1205.02 (“If a ground of rejection stated by the examiner is not addressed in the appellant’s brief, appellant has waived any challenge to that ground of rejection and the Board may summarily sustain it, unless the examiner subsequently withdrew the rejection in the examiner’s answer.”).

THE REJECTIONS LACKING MITCHELL

Because our decision is dispositive regarding patentability of all appealed claims based on the foregoing prior art references, we need not

reach the merits of the Examiner's decision to also reject (1) claims 1, 2, 4, 5, 10–15, 17, 18, and 23–26 as anticipated by Dubil; (2) claims 3, 7, 8, 16, 20, and 21 as obvious over Dubil and Houghton; and (3) claims 6 and 19 under 35 U.S.C. § 103(a) as obvious over Dubil and Darbee. Final Act. 2–8. *See Beloit Corp. v. Valmet Oy*, 742 F.2d 1421, 1423 (Fed. Cir. 1984) (approving ITC's determination based on a single dispositive issue, and not reaching other issues not decided by the lower tribunal).

CONCLUSION

Under § 103, the Examiner did not err in rejecting (1) claims 1, 2, 4, 5, 10–15, 17, 18, and 23–26 as obvious over Dubil and Mitchell; (2) claims 3, 7, 8, 16, 20, and 21 as obvious over Dubil, Mitchell, and Houghton; and (3) claims 6 and 19 as obvious over Dubil, Mitchell and Darbee.

We do not reach the other rejections of these claims.

DECISION

Because we have affirmed at least one ground of rejection with respect to each claim on appeal, the Examiner's decision rejecting claims 1–8, 10–21, and 23–26 is affirmed. *See* 37 C.F.R. § 41.50(a)(1).

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).

AFFIRMED