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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* STEVE LANPING HUANG, CHERYL SCOTT,  
and WAYNE SCOTT

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Appeal 2015-006186  
Application 12/855,501  
Technology Center 2100

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Before JOHN A. JEFFERY, ST. JOHN COURTENAY III, and  
MARC S. HOFF, *Administrative Patent Judges*.

JEFFERY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's decision to reject claims 1–19. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

STATEMENT OF THE CASE

Appellants' invention is a hand-held electronic device with a remote control application user interface that displays operational mode information to a user. The interface can be used to (1) set up the application to control appliances for users in various rooms; (2) perform activities; and (3) access favorites. *See generally* Abstract. Claim 1 is illustrative:

1. A remote control device for controlling one or more consumer devices of various device types, the remote control comprising:

a user defined action map having a plurality of action map entries, each action map entry including at least one function for controlling at least one consumer device;

a plurality of user input elements each having an assignment to at least one of the plurality of action map entries and capable of activating the at least one function included in the action map entry;

a plurality of device command code sets, each having a plurality of functions for controlling at least one consumer device;

a selector for selecting individual functions from the device command code sets appropriate for controlling the one or more consumer devices; and

an activator configured for creation of one or more links between at least one of the selected individual functions of the plurality of device command code sets and action map entries of the user defined action map assigned to an user input element.

#### RELATED APPEALS

Appellants inform us of eight related appeals, four of which are said to have resulted in decisions of this Board. App. Br. 2 (citing four Board decisions). The Board, however, also issued decisions in the other four identified appeals as well. *See Ex parte Huang*, No. 2014-001814 (PTAB Apr. 4, 2016); *Ex parte Thompson*, No. 2013-003049 (PTAB July 28, 2015); *Ex parte Huang*, No. 2012-009621 (PTAB Feb. 3, 2015); *Ex parte Arling*, No. 2012-012188 (PTAB Sept. 1, 2015). Nevertheless, the issues in the identified related appeals are not germane to those before us in this appeal.

### THE REJECTIONS

The Examiner rejected claims 1–19 under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. Final Act. 2–5.<sup>1</sup>

The Examiner rejected claims 1–19 under 35 U.S.C. § 102(b)<sup>2</sup> as anticipated by Wouters (US 7,746,244 B2; iss. June 29, 2010). Final Act. 5–8.

The Examiner rejected claims 1–19 under 35 U.S.C. § 103(a) as unpatentable over Sony Corp., *Integrated Remote Commander Operating Instructions*, RM-AV2100/AV2100B (2000) (“Sony”), Foster (US 6,211,870 B1; iss. Apr. 3, 2001), and Lambrechts (US 6,909,378 B1; iss. June 21, 2005). Final Act. 9–14.

### THE WRITTEN DESCRIPTION REJECTION

Regarding independent claims 1, 9, and 15, the Examiner finds that Appellants’ Specification does not support the recited (1) user-defined<sup>3</sup> action map; (2) user input elements each having an assignment to at least

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<sup>1</sup> Throughout this opinion, we refer to (1) the Final Rejection mailed October 16, 2014 (“Final Act.”); (2) the Appeal Brief filed December 10, 2014 (“App. Br.”); (3) the Examiner’s Answer mailed April 6, 2015 (“Ans.”); and (4) the Reply Brief filed June 3, 2015 (“Reply Br.”).

<sup>2</sup> Although Wouters qualifies as prior under §§ 102(a) and (e)—not § 102(b)—since it issued less than one year before the present application’s filing date of August 12, 2010, we treat the Examiner’s error in this regard as harmless.

<sup>3</sup> Although Appellants’ claims recite a “user defined action map” without a hyphen between “user” and “defined,” we nonetheless include the hyphen when referring to this element for proper grammatical form.

one action map entry; (3) selector for selecting individual functions from the recited device command code sets; and (4) activator for creating one or more links between at least one selected individual function and action map entries assigned to a user input element. Final Act. 2–5; Ans. 2–5. The Examiner adds that the limitations of dependent claim 8 are also unsupported by Appellants’ Specification. Final Act. 5.

Appellants argue that because the claims were copied from Wouters to invoke an interference, Wouters must be considered when evaluating the present application’s claims because both Wouters and the present application are said to disclose and claim the same elements. App. Br. 6–8; Reply Br. 2. Appellants add that although various terms (e.g., “code set”) used by Wouters in the present application were replaced with equivalent terms (e.g., “action map”) to advance prosecution, these replacement terms are nevertheless said to be supported by the original Specification to show possession of the recited elements, including those of dependent claim 8. App. Br. 8–10; Reply Br. 2–4.

#### ISSUE

Under § 112, first paragraph, has the Examiner erred in rejecting claims 1–19 by finding that the recited subject matter fails to comply with the written description requirement? This issue turns on whether Appellants’ original disclosure conveys with reasonable clarity to skilled artisans that Appellants possessed the invention recited in claims 1, 8, 9, and 15 as of the filing date.

ANALYSIS

*Claims 1–7 and 9–19*

We begin by noting that Appellants’ independent claims 1, 9, and 15 filed on August 12, 2010 are substantially similar to Wouters’ independent claims 1, 10, and 16, and that Appellants acknowledge that Wouters’ claims were copied to invoke an interference. *See* App. Br. 7; Reply Br. 2.

Notably, Appellants’ original independent claims were amended on July 29, 2014 to, among other things, replace various recited terms as summarized below:

<b>Terms in Original Independent Claims</b>	<b>Replacement Terms in Appealed Claims</b>
“code set”	“action map”
“cells”	“action map entries”
“object keys”	“user input elements”
“preset”	“device command”

**Table 1: Comparison of Key Terms in Original and Appealed Claims**

In effect, Appellants replaced Wouters’ terminology in the original claims with terminology more consistent with that used in Appellants’

Specification. According to Appellants, the above-noted terms are equivalent, and because Wouters and the present application allegedly disclose and claim the same elements, Wouters must be considered when evaluating the appealed claims with respect to the written description requirement. App. Br. 7–8; Reply Br. 2.

Appellants are correct that Wouters is relevant here, at least to the extent that the appealed claims were copied from that reference except for the above-noted replacement terms. Although copied claims are interpreted in light of the Specification of the patent from which the claims were copied, *In re Spina*, 975 F.2d 854, 856 (Fed. Cir. 1992), the claims must nevertheless be supported by the copier’s Specification. *See Cultor Corp. v. A.E. Staley Mfg.*, 224 F.3d 1328, 1332 (Fed. Cir. 2000).<sup>4</sup>

Turning to the rejection, we agree with the Examiner that Appellants’ original disclosure does not convey with reasonable clarity to skilled artisans that Appellants possessed the recited *user-defined* action map as of the filing date. As noted above, the term “action map” was not in the claims copied from Wouters, but instead was used to replace the term “code set” in the copied claims. Nevertheless, Appellants contend that the recited “user defined action map” is equivalent to the “user defined code set” in the copied claims. App. Br. 8. There is insufficient evidence on this record, however, to substantiate this assertion.

In the Appeal Brief, Appellants identify action map 514 in Figure 18 of the present application as corresponding to the recited user-defined action

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<sup>4</sup> *See also Ex parte Harari*, No. 2009-003212, 2011 WL 6960278, at \*5 (expanded panel) (non-precedential) (citing *Agilent Technologies, Inc. v. Affymetrix, Inc.*, 567 F.3d 1366, 1375 (Fed. Cir. 2009)).

map. App. Br. 3 (citing Spec. 17:2–6; 48:17–49:14; 50:1–13). As shown in that figure, action map 514 contains a number of actions including “0Xa1 HOME THEATRE – POWER ON,” “0Xa2 HOME THEATRE – POWER OFF,” etc. The Specification, however, provides little description of this action map, let alone that it is user-defined.

On page 15, lines 13 to 15 of Appellants’ Specification (which was not cited by Appellants in their Briefs), action map 514 in Figure 18 is said to control all actions the user can perform for each device type; thus, user input events are processed in terms of the action map. Notably, this is the *only* specific reference to an action map in the Specification, and this description falls well short of supporting the recited *user-defined* action map as the Examiner indicates. See Final Act. 2–3; Ans. 3. That the action map can control all user actions for each device type does not mean that the map is defined by a user: it could be preprogrammed or otherwise defined by the *system*—not necessarily a *user*.

Appellants’ reliance on the disclosed setup wizards for supporting a user-defined action map (App. Br. 9; Reply Br. 4) is unavailing. According to Appellants, to populate an “action map,” a user interacts with a setup wizard as shown, for example, in Figures 22A to 22G.<sup>5</sup> App. Br. 9. Appellants contend that these setup wizards allow the user to (1) define the action map and associated entries, and (2) select functions from device command code sets for linking to action map entries that are, in turn, assigned to user input elements. App. Br. 9; Reply Br. 4 (citing Spec. 17:2–

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<sup>5</sup> Because the present application does not have a “Figure 22” as cited by Appellants, but rather Figures 22A to 22G, we refer to the correct figure numbers here.

6; 48:17–49:14; 50:1–13). Notably, these cited passages match those cited in connection with the recited user-defined action map limitation in the Appeal Brief’s “Summary of the Claimed Subject Matter” on page 3.

But these cited passages do not reasonably support a user-defined action map. The first cited passage notes that Figure 18 is an example of how various maps relate each other as a user *performs* an action which, in this case, is a macro for powering a home theater. Our emphasis underscores that while a user *performs* actions in connection with the action map 514 in Figure 18, the user does not *define* that map based on this description.

Appellants’ reliance on pages 48 to 50 of the Specification (App. Br. 3, 9; Reply Br. 4) fares no better in this regard. Pages 48 and 49 describe how a user programs a macro, namely a sequence of actions that are assigned to a single button so that the sequence can be repeated by merely pressing the button. These user-generated macros are different than system-generated macros that are generated automatically or semi-automatically by a remote control application to facilitate common tasks, such as powering a home theater system on and off as noted previously in connection with Figure 18. *See* Spec. 48:4–16.

In Figures 22A to 22G, the user programs a new macro sequence by selecting the “add activity” icon which initiates an activity wizard in Figure 22B that records the user’s keystrokes, and allows the user to assign an icon and label to that activity (e.g., “WATCH DVD”). Spec. 48:17–49:14. Although this functionality enables users to create macros associated with button-based “user input elements” via a wizard, we fail to see how this functionality involves a *user-defined* action map as claimed. Although the

user defines the *macro* using this wizard, the disclosure does not convey with reasonable clarity that the user also defines an *action map*, let alone an action map such as action map 514 in Figure 18 even assuming, without deciding, that the functionality of Figure 18 is somehow involved in connection with the user-defined macro of Figures 22A to 22G.

Notably, apart from merely asserting that the user's interaction with a setup wizard populates the action map by adding activities *to that map* (App. Br. 9), the relied-upon passages from the original disclosure that are said to support such a "user-defined action map" do not convey such functionality with reasonable clarity to show possession of this feature and, therefore, fail to satisfy the written description requirement. *See Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc). To the extent that it would have been obvious for a user to define an action map, such as that shown in Figure 18, by, for example, populating it with activities via a wizard or otherwise, is insufficient. Although the written description requirement under § 112 does not demand any particular form of disclosure or require a verbatim recitation, a description that merely renders the invention obvious does not satisfy the requirement. *Id.* at 1352. Therefore, to the extent that Appellants contend that the recited user-defined action map would have been obvious from the cited passages from the original disclosure, such a position is unavailing in light of *Ariad*.

We reach our finding regarding the insufficiency of proffered support in the Specification, even assuming, without deciding, that the original disclosure enables the user to define soft keys for display as Appellants contend (Reply Br. 3–4), and that these soft keys are user input elements as claimed. Notably, Appellants' soft-key-based argument was

raised for the first time in the Reply Brief, and is, therefore, waived as untimely. *See* 37 C.F.R. § 41.41(b)(2).<sup>6</sup> Nevertheless, the original disclosure does not convey with reasonable clarity the recited user-defined action map in connection with this soft-key functionality. Not only do Appellants fail to cite particular passages from the Specification supporting such soft-key functionality, let alone passages that explicitly tie this functionality to that shown in Figure 18 (which was cited on page 3 of the Reply Brief), Appellants' reliance on the exemplary action map in this figure in connection with this newly-raised soft-key argument is unavailing for the reasons previously discussed.

Lastly, Appellants' reliance on the Specification's page 50, lines 1 to 13 as ostensibly supporting the recited user-defined action map (App. Br. 3, 9; Reply Br. 4) likewise falls short of conveying possession of that element. Although this cited passage pertains to customizing and reassigning keys via a customization menu 1202 in Figure 20A, this passage does not convey with reasonable clarity that the user also defines an *action map*, let alone an action map such as action map 514 in Figure 18 even assuming, without deciding, that the functionality of Figure 18 is somehow involved in connection with the key customization and reassignment functionality of

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<sup>6</sup> Notably, the Examiner's articulated position on pages 3 to 5 of Answer in connection with the written description rejection—including the portion pertaining to hardware buttons noted by Appellants (Reply Br. 3–4)—matches the same position articulated in the Final Rejection. *Compare* Ans. 3–5 *with* Final Act. 2–5. Therefore, Appellants' soft-key-based argument raised for the first time in the Reply Brief was not prompted by new findings or conclusions made by the Examiner in the Answer, for the Examiner's position on which Appellants' argument was based was articulated in the Final Rejection.

Figure 20A. And to the extent that it would have been obvious for a user to define an action map, such as that shown in Figure 18, using the disclosed key customization and reassignment functionality of Figure 20A, is insufficient under *Ariad* as noted previously. *See Ariad*, 598 F.3d at 1352.

Therefore, because the original disclosure does not convey with reasonable clarity that Appellants possessed the recited user-defined action map, we are not persuaded that the Examiner erred in rejecting independent claim 1 as failing to satisfy the written description requirement for that reason alone. Nor are we persuaded that the Examiner erred in rejecting independent claims 9 and 15 which recite commensurate limitations, and the dependent claims, for similar reasons. Because we sustain the Examiner's written description rejection based solely on the lack of support for the user-defined action map in all appealed claims, we need not reach other issues associated with this rejection, including those in connection with dependent claim 8.<sup>7</sup>

#### THE ANTICIPATION REJECTION

The Examiner finds that Wouters discloses every recited element of claims 1–19. Final Act. 5–8.

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<sup>7</sup> We note in passing, however, that claim 8 recites limitations commensurate with those recited in claims 14 and 18. *Accord* Ans. 8 (noting this similar scope in connection with another rejection). Therefore, to the extent that claim 8 fails to satisfy the written description requirement for the additional reason regarding the lack of support for communicating unlinked user input elements to a user noted by the Examiner on page 5 of the Final Rejection—an issue that we do not reach—claims 14 and 18 are similarly deficient.

Appellants do not dispute that Wouters discloses all elements recited in the appealed claims, but instead contend that Wouters is not prior art because the claims of the present application are said to be fully supported by the disclosure of U.S. Provisional Application 60/344,020 filed December 20, 2001 (“the ’020 provisional”) which antedates Wouters’ earliest priority date. *See* App. Br. 10; Reply Br. 5.

The Examiner, however, finds that because (1) the claim limitations are not supported by the ’020 provisional, and (2) Appellants did not provide support in any related application, the claims have, at best, a filing date of the present application, namely August 12, 2010 and, therefore, Wouters qualifies as prior art to the claimed invention. Ans. 6.

#### ISSUE

Under § 102, has the Examiner erred in rejecting claims 1–19 as anticipated by Wouters? This issue turns on whether Wouters qualifies as prior art to the claimed invention.

#### ANALYSIS

The present application is a continuation of U.S. Application 12/421,065, filed April 9, 2009, which is a divisional of U.S. Application 11/340,442, filed January 26, 2006, which is a divisional of U.S. Application 10/288,727, filed November 6, 2002. The ’727 application claims benefit of two provisional applications, one of which is the ’020 provisional at issue here.

Although Wouters issued on June 29, 2010, Appellants acknowledge that Wouters’ earliest possible priority date is March 29, 2002. App. Br. 10; Reply Br. 4–5. Although this latter date precedes the filing date of the

earliest parent Application No. 10/288,727, namely November 6, 2002, Wouters' earliest possible priority date is after the filing date of the '020 provisional and, as such, Appellants contend that Wouters does not qualify as prior art. *See id.*

To be sure, if the present application's parent applications and the '020 provisional adequately provide (1) a written description of the subject matter of Appellants' claimed invention, and (2) an enabling disclosure to permit ordinarily skilled artisans to make and use the claimed invention, then Appellants would be entitled to the date of the '020 provisional application and, consequently, Wouters would not qualify as prior art. *See New Railhead Mfg., L.L.C. v. Vermeer Mfg. Co.*, 298 F.3d 1290, 1294 (Fed. Cir. 2002); *see also* Manual of Patent Examining Procedure (MPEP) §§ 211.05(I)(A), 706.02(VI)(C).

But there has been no such entitlement shown on this record, nor will we presume as much, for we have no basis on this record for doing so. *See Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1380 (Fed. Cir. 2015) (“[B]ecause the PTO does not examine priority claims unless necessary, the Board has no basis to presume that a reference patent is necessarily entitled to the filing date of its provisional application.”).

In addition, the Examiner finds that the claim limitations are *not* supported by the '020 provisional (Ans. 6)—a factual finding that has not been persuasively rebutted on this record. Although Appellants allege that the same figures and descriptions cited in the Briefs are found in the '020 provisional (App. Br. 10; Reply Br. 4), Appellants provide no pinpoint citations from the '020 provisional to support this contention, let alone specifically identify such disclosure. Nor do Appellants analyze or explain

how this currently-unidentified disclosure in the '020 provisional provides the requisite support for the claimed subject matter apart from mere conclusory statements.

Such conclusory statements, however, are insufficient to persuasively rebut the Examiner's findings to the contrary. The Board's precedential decision, *Ex parte Yamaguchi*, 88 USPQ2d 1606 (BPAI Aug. 29, 2008), is instructive in this regard. There, in relying on a cited U.S. patent's provisional application to show that the cited patent (Narayanan) was prior art, the Examiner found that both the cited patent and its provisional application "clearly show[ed] the same subject matter"—a factual finding. *Yamaguchi*, 88 USPQ2d at 1613. By making this factual finding, the Examiner then shifted the burden to Appellants to show why such a factual finding was erroneous—a burden that they failed to meet. *Id.*

Rather, the Appellants in *Yamaguchi* merely stated that the Examiner failed to furnish a copy of the provisional application which was allegedly improper (which it was not). *Id.* Nevertheless, the Appellants admitted that they obtained a copy of the cited patent's provisional application, but alleged that it did not "identically track" the patent. *Id.* Notably, the *Yamaguchi* panel held that this mere conclusory statement—totally devoid of explanation or analysis—was unpersuasive of error in the Examiner's factual findings pertaining to the cited patent and its underlying provisional application. *Id.* at 1613–14.

Similarly, the Examiner in this case finds that the claim limitations are not supported by the '020 provisional (Ans. 6)—a factual finding that shifted the burden to Appellants to show why this finding is erroneous. *See Yamaguchi*, 88 USPQ2d at 1613. But, as in *Yamaguchi*, Appellants' mere

conclusory statements to the contrary—without more—do not meet that burden. *See* App. Br. 10; Reply Br. 4. Accordingly, we find that the weight of the evidence on this record supports the Examiner’s conclusion that Wouters qualifies as prior art to the claimed invention.

Therefore, we are not persuaded that the Examiner erred in rejecting claims 1–19 as anticipated by Wouters.

#### THE OBVIOUSNESS REJECTION

Because our decision is dispositive regarding patentability of all appealed claims for the reasons previously discussed, we need not reach the merits of the Examiner’s decision to also reject claims 1–19 as obvious over Sony, Foster, and Lambrechts. *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

The Examiner did not err in rejecting claims 1–19 under §§ 112 and 102. We do not reach the Examiner’s obviousness rejection of those claims.

#### DECISION

The Examiner’s decision rejecting claims 1–19 is affirmed.

Appeal 2015-006186  
Application 12/855,501

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