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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* PARITOSH PATEL

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Appeal 2015-006808  
Application 11/967,155<sup>1</sup>  
Technology Center 2400

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Before ST. JOHN COURTENAY III, THU A. DANG, and  
LARRY J. HUME, *Administrative Patent Judges*.

HUME, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) of the final rejection of claims 1–7. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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<sup>1</sup> According to Appellant, the real party in interest is IBM Corp. App. Br. 2.

STATEMENT OF THE CASE<sup>2</sup>

*The Invention*

Appellant's disclosed and claimed inventions relate to methods, systems, and computer program products for simultaneous recording of a live event and third party information. Abstract.

*Exemplary Claim*

Claim 1, reproduced below, is representative of the subject matter on appeal (*emphasis* added to contested limitations):

1. A live event recording method comprising:

[L1] *wirelessly acquiring through a network interface of a handheld video recorder recording a live performance, third party information regarding the live performance from a third party information source over a computer communications network, the live performance including a live sporting event;*

simultaneously recording both the live performance and also the third party information onto a single recordable medium in the handheld video recorder; and,

[L2] *periodically polling the third party information source and upon determining that there is updated third party information, retrieving the updated third party information and simultaneously recording both the live performance and also the updated third party information.*

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<sup>2</sup> Our decision relies upon Appellant's Appeal Brief ("App. Br.," filed Jan. 19, 2015 ); Reply Brief ("Reply Br.," filed July 13, 2015 ); Examiner's Answer ("Ans.," mailed May 20, 2015 ); Final Office Action ("Final Act.," mailed Aug. 28, 2014 ); and the original Specification ("Spec.," filed Dec. 29, 2007 ).

*Prior Art*

The Examiner relies upon the following prior art as evidence in rejecting the claims on appeal:

Neale et al. ("Neale")	US 2005/0187644 A1	Aug. 25, 2005
Minnich	US 2007/0081678 A1	Apr. 12, 2007
Meek et al. ("Meek")	US 2008/0209482 A1	Aug. 28, 2008

*Rejections on Appeal*

R1. Claims 1, 2 and 4–6 stand rejected under 35 USC § 103(a) as being unpatentable over the combination of Minnich and Meek. Ans. 2; Final Act. 4.

R2. Claims 3 and 7 stand rejected under 35 USC § 103(a) as being unpatentable over the combination of Minnich, Meek, and Neale. Ans. 2; Final Act. 9.

CLAIM GROUPING

Based on Appellant's arguments (App. Br. 5–13), we decide the appeal of Rejection R1 of claims 1, 2, and 4–6 on the basis of representative independent claim 1. We decide Rejection R2 of dependent claims 3 and 7, not separately argued, *infra*.

ISSUES AND ANALYSIS

In reaching this decision, we consider all evidence presented and all arguments actually made by Appellant. We do not consider arguments which Appellant could have made but chose not to make in the Briefs so that we deem any such arguments as waived. 37 C.F.R. § 41.37(c)(1)(iv).

We disagree with Appellant's arguments with respect to claim 1, and we incorporate herein and adopt as our own: (1) the findings and reasons set forth by the Examiner in the action from which this appeal is taken, and (2) the reasons and rebuttals set forth in the Examiner's Answer in response to Appellant's arguments. We incorporate such findings, reasons, and rebuttals herein by reference unless otherwise noted. However, we highlight and address specific findings and arguments regarding claim 1 for emphasis as follows.

1. § 103 Rejection R1 of Claims 1, 2, and 4–6

Issue 1

Appellant argues (App. Br. 5–13; Reply Br. 2–8) the Examiner's rejection of claim 1 under 35 U.S.C. § 103(a) as being obvious over the combination of Minnich and Meek is in error. These contentions present us with the following issue:

Did the Examiner err in finding the cited prior art combination teaches or suggests limitations L1 of "wirelessly acquiring through a network interface . . ." and L2, "periodically polling the third party information source . . .," as recited in claim 1?

Analysis

*Limitation L1 – "Network Interface"*

Regarding limitation L1, Appellant argues the Examiner's claim mapping is incorrect because "a network interface is not equivalent to a radio receiver." App. Br. 7–8.

Claim terms are to be given their broadest reasonable interpretation, as understood by those of ordinary skill in the art and taking into account whatever enlightenment may be had from the Specification. *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997).<sup>3</sup>

The Examiner finds, under a broad but reasonable interpretation, Minnich's radio receiver interface teaches or at least suggests "a network interface." Ans. 4; Final Act. 4, citing Minnich ¶ 7. We agree with the Examiner's finding because the terms of the disputed claim limitation "wirelessly acquiring through a network interface" are not defined in Appellant's Specification, nor has Appellant pointed to any evidence of record that would support their desired narrower construction. Ans. 3. We note the claim term "network interface" was not in the originally filed claims but was added during prosecution. We further agree with the Examiner because Appellant's Specification describes Bluetooth (using radio transmitters and receivers), as a known protocol of wirelessly connecting to a network interface. Ans. 3, citing Spec. 14. Furthermore, the Examiner supports his findings with Meek's radio frequency signal acquisition combined with its network interfaces teaching or at least suggesting the limitation "wirelessly acquiring through a network interface." Ans. 4, citing Meek ¶¶ 23–26. On this record, we conclude the plain language of the claim

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<sup>3</sup> See Spec ¶ 7 ("It is to be understood that both the foregoing general description and the following detailed description *are exemplary and explanatory only and are not restrictive of the invention, as claimed.*") (Emphasis added).

does not preclude interpreting receiving a radio broadcast as a "wireless connection."<sup>4</sup>

Accordingly, we find the Examiner's broad but reasonable claim interpretation of a "network interface" is not inconsistent with Appellant's Specification.<sup>5</sup>

Appellant also argues Minnich fails to teach the disputed limitation "wirelessly acquiring . . . third party information." App. Br. 9. The Examiner broadly but reasonably interprets "third party information" to include alternate audio sources. Ans. 5, citing Appellant's Spec. 13–16. We agree with the Examiner's finding that Minnich's radio interface system and alternate audio sources teach or at least suggest the disputed limitation "wirelessly acquiring . . . third party information." Ans. 4–5. We agree with the Examiner's findings because Appellant does not point to any evidence of

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<sup>4</sup> We note Appellant attempt to enter new evidence, and not dictionary definitions, into the record regarding a desired interpretation of the disputed phrase "network interface." *See* Reply Br. 3–4 n.1, n.2. *Cf.* 37 C.F.R. § 41.30 ("Evidence means something (including testimony, documents and tangible objects) that tends to prove or disprove the existence of an alleged fact, except that for the purpose of this subpart Evidence does not include dictionaries, which may be cited before the Board."); *and see* 37 C.F.R. § 41.41(b)(2) ("A reply brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other Evidence. *See* § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.33 for amendments, affidavits or other Evidence filed after the date of filing the appeal.").

<sup>5</sup> Because "applicants may amend claims to narrow their scope, a broad construction during prosecution creates no unfairness to the applicant or patentee." *In re ICON Health and Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007) (citation omitted).

record that demonstrates the Examiner's claim interpretation is overly broad, unreasonable, or inconsistent with Appellant's Specification.

*Limitation L2 – "Periodically Polling"*

Regarding limitation L2, "periodically polling the third party information," Appellant admits Meek teaches "searching for alternative audio sources," but argues this is "not equivalent to determining whether there is updated third party information when polling the third party information source." App. Br. 12–13.

The Examiner finds Meek's user interface, which allows a user to search for an alternative third party announcer for a sporting event, teaches or at least suggests the limitation "periodically polling the third party information. . . ." Final Act. 5, citing Meek, Figs. 4–5, ¶¶ 27–29, 33–36.<sup>6</sup>

The Examiner finds, under a broad but reasonable interpretation, Meek's continuing search for replacement content teaches or at least suggests the disputed limitation "periodically polling the third party

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<sup>6</sup> See e.g., Meek (¶33) describing an embodiment that searches for or queries (i.e., polls for) alternate audio sources: "The alternate audio sources identified in the listing, for example, may not appeal to the user. The user may, instead, wish to *conduct a search for additional alternate audio sources* not identified in the listing. The alternate audio application 34, then, may prompt to *search for alternate audio sources*, despite the listing (Step 104). When the user affirmatively responds to the prompt, *the alternate audio application 34 is authorized to query for additional alternate audio sources. The alternate audio application 34 calls or invokes the search application 50 and sends the query for any alternate audio sources associated with the video content identifier (Step 106).* A response to the query is received (Step 108), and the query result describes more alternate audio sources that may correspond to the same video content identifier." (Emphasis added).

information." Ans. 5–6. We note the claim term "periodically polling" is not found in the originally filed disclosure, including the originally filed claims, but was added during prosecution to overcome the cited art of record. We agree with the Examiner's finding because Meek teaches use of alternate audio content during a sporting event (Meek ¶ 3), and Meek's query result includes a listing of alternate audio sources, which the user selects from based his personal preference. Meek ¶ 27. We further agree with the Examiner because we find searching for alternate audio sources of a sporting event, as shown in the examples in Meek's Figures 4 and 5 (Josh Kendall's game day podcast, Kyle King's dawgsports podcast), teaches or at least suggests "periodically polling the third party information." See also n.6, *supra* (discussing Meek ¶ 33).

We agree with the Examiner's findings cited above that "continuing to search for replacement content" teaches or at least suggests the recited "polling." The Examiner buttresses his findings by noting Minnich teaches that the content of a radio broadcast changes constantly over time, which at least suggests "polling."<sup>7</sup> *Id.*

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<sup>7</sup> Contrary to Appellant's contentions alleging " inherency is not a legally permissible tool with respect to an inquiry under 35 U.S.C. § 103" (Reply Br. 6), our reviewing court has long "recognized that inherency may supply a missing claim limitation in an obviousness analysis." *PAR Pharmaceutical, Inc. v TWI Pharmaceuticals, Inc.* 773 F.3d 1186, 1194–95 (Fed. Cir. 2014). Moreover,

[t]he mere fact that a certain thing may result from a given set of circumstances is not sufficient. If, however, the disclosure is sufficient to show that *the natural result flowing* from the operation as taught would result in the performance of the questioned function, it seems to be well settled that the disclosure should be regarded as sufficient. *In re Oelrich*, 666

Although not dispositive to our Decision, we further find polling (i.e., repeatedly searching or checking for new data, or a change in existing data) is notoriously well-known in the art, as evidenced by at least Meek (¶ 33). We find the Examiner (Final Act. 5) provides sufficient articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (quoting *Kahn*, 441 F.3d at 988). We find no error with the Examiner's conclusion of obviousness as it would have been obvious to someone of ordinary skill in the art to modify Meek's and Minnich's systems, in the manner proffered by the Examiner (Final Act. 5), to include polling for third party information, and to simultaneously record both the live performance and the third party information, which we find would have merely realized a predictable result. *See KSR*, 550 U.S. at 401 ("[A] combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.").

The U.S. Supreme Court has held "[t]he obviousness analysis cannot be confined by a formalistic conception of the words teaching, suggestion, and motivation, or by overemphasis on the importance of published articles

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F.2d at 581 (emphasis added) (citations and quotation marks omitted). Thus, our early precedent, and that of our predecessor court, established that the concept of inherency must be limited when applied to obviousness, and is present only when the limitation at issue is the "natural result" of the combination of prior art elements. *Id.*

*PAR Pharmaceutical, Inc.*, 773 F.3d at 1195 (quoting *In re Oelrich*, 666 F.2d 578, 581 (CCPA 1981)). Here, Appellants (Reply Br. 6) have not shown how the Examiner's finding of inherency regarding Minnich would not have been a "natural result" of the combination of cited prior art elements. Ans. 6.

and the explicit content of issued patents." *KSR*, 550 U.S. at 419. Instead, the relevant inquiry is whether the Examiner has set forth "some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (cited with approval in *KSR*, 550 U.S. at 418). Here, Appellant has provided no evidence that combining such teachings was "uniquely challenging or difficult for one of ordinary skill in the art," (*Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007)), nor has Appellant presented evidence that this incorporation yielded more than expected results. Further, Appellant has not provided objective evidence of secondary considerations which our reviewing court guides "operates as a beneficial check on hindsight." *Cheese Sys., Inc. v. Tetra Pak Cheese and Powder Sys.*, 725 F.3d 1341, 1352 (Fed. Cir. 2013).

We find Appellant's invention is simply a combination of known teachings that, at the time of the invention, would have realized a predictable result. We also find the Examiner has met the requisite burden by articulating a rationale to modify Minnich's teachings and suggestions with Meek's continuing search for replacement content, i.e., "polling," or alternatively, that a polling operation is notoriously well-known in the art. Thus, we find the Examiner has set forth sufficient "articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."

Accordingly, Appellant has not provided sufficient evidence or argument to persuade us of any reversible error in the Examiner's reading of the contested limitations on the cited prior art. Therefore, we sustain the

Examiner's obviousness Rejection R1 of representative independent claim 1 and claims 2 and 4–6 which fall therewith. *See Claim Grouping, supra.*

2. § 103 Rejection R2 of Claims 3 and 7

In view of the lack of any substantive or separate arguments directed to the obviousness Rejection R2 of dependent claims 3 and 7 under § 103 (*see App. Br. 13*), we sustain the Examiner's rejection of these claims, as they fall with their respective independent claims. Arguments not made are waived. *See 37 C.F.R. § 41.37(c)(1)(iv).*

REPLY BRIEF

To the extent Appellant may advance new arguments in the Reply Brief (Reply Br. 2–8) not in response to a shift in the Examiner's position in the Answer, we note arguments raised in a reply brief that were not raised in the appeal brief or are not responsive to arguments raised in the Examiner's Answer will not be considered except for good cause (*see 37 C.F.R. § 41.41(b)(2)*), which Appellant has not shown. We further note, no new or non-admitted affidavit or other evidence may be submitted in a Reply Brief. *See 37 C.F.R. § 41.41.*

CONCLUSION

(1) The Examiner did not err with respect to obviousness Rejection R1 of claims 1, 2, and 4–6 under 35 U.S.C. § 103(a) over the cited prior art combination of record, and we sustain the rejection.

(2) The Examiner did not err with respect to obviousness Rejection R2 of claims 3 and 7 under 35 U.S.C. § 103(a) over the cited prior art combination of record, and we sustain the rejection.

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DECISION

We affirm the Examiner's decision rejecting claims 1–7.

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