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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MICHAEL D. ELLIS, WILLIAM L. THOMAS,
and THOMAS R. LEMMONS

Appeal 2016-007168
Application 13/295,026
Technology Center 2400

Before ST. JOHN COURTENAY III, JENNIFER S. BISK, and
JOYCE CRAIG, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) from the Examiner’s Final rejection of claims 330, 332–335, 337–339, 342, and 343, which are all the claims pending in this application.¹ Claims 1–329, 331, 336, 340, and 341 are cancelled. An oral hearing was conducted on February 6, 2018. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

¹ We refer herein to the Final Office Action (“Final Act.”), mailed March 25, 2015; the Appeal Brief (“App. Br.”), filed December 7, 2015; the Examiner’s Answer (“Ans.”), mailed May 18, 2016; and the Reply Brief (“Reply Br.”), filed July 15, 2016.

STATEMENT OF THE CASE

The disclosed and claimed invention on appeal “relates to interactive television program guide systems, and more particularly, to interactive television program guide systems that allow users to record programs and program guide data on a media server.” Spec. 1.

Illustrative independent claim 330 is reproduced below:

330. A method comprising:

receiving a first user input to access a broadcast program;
accessing the broadcast program;

storing the accessed broadcast program on a user equipment;

receiving a second user input after a portion of the broadcast program is accessed, while the broadcast program is broadcast;

[L1] *determining whether the second user input indicates a request to rewind the broadcast program to a point **after** the broadcast program was accessed **or** to a point **prior** to when the broadcast program was accessed;*

[L2] *when it is determined that the second user input indicates a request to rewind the broadcast program to a point **after** the broadcast program was accessed, retrieving the broadcast program **stored on the user equipment; and***

[L3] *when it is determined that the second user input indicates a request to rewind the broadcast program to a point **prior** to when the broadcast program was accessed, retrieving a version of the broadcast program that is **stored on a server.***

(Contested limitations L1, L2, and L3 emphasized in **bold** and *italics*).

Rejections

- A. Claims 330, 332–335, and 337–339 are rejected under pre-AIA 35 U.S.C. § 103(a) as being obvious over the combined teachings and suggestions of Girard et al. (US 5,751,282, May 12, 1998) (hereinafter “Girard”), in view of O’Connor (US 6,480,667 B1, Nov. 12, 2002). (Final Act. 6).
- B. Claims 342 and 343 are rejected under pre-AIA 35 U.S.C. § 103(a) as being obvious over the combined teachings and suggestions of Girard, O’Connor, and Baker et al. (US 5,583,561, Dec. 10, 1996) (hereinafter “Baker”). (Final Act. 10).

ANALYSIS

In reaching this decision, we consider all the evidence presented and all arguments actually made by Appellants. We focus our analysis on the contested “determining” step or act of independent method claim 330 (limitation L1), which we find is dispositive to this appeal. Independent “system” claim 335 recites similar functional language having commensurate scope.

Rejection A – Independent Claim 330

Issue: Under pre-AIA 35 U.S.C. § 103(a), did the Examiner err in finding the cited Girard and O’Connor references collectively teach or suggest contested limitation L1:

determining *whether the second user input indicates a request to rewind the broadcast program to a point **after** the broadcast program was accessed **or** to a point **prior** to when the broadcast program was accessed[,]*

within the meaning of independent claim 330? (Emphasis added).

Rejection A – Independent Claim 335

Independent system claim 335 similarly recites:

processing circuitry configured to:

determine *whether the second user input indicates a request to rewind the broadcast program to a point **after** the broadcast program was accessed **or** to a point **prior** to when the broadcast program was accessed;*

Claim Construction

We give the contested claim limitations the broadest reasonable interpretation consistent with the Specification. *See In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997). Independent claim 330 is exemplary of the unique issues that are presented by a method claim that recites conditional steps or acts, i.e., steps or acts that are not required to be performed within the scope of the claim *unless and until the recited condition precedent is satisfied*. Here, the recited *condition precedents* further involve two **temporal** conditions (“when it is determined” . . . “after” or “prior to”), which further depend upon the outcome of a preceding recited step or act of “determining.” (*See* method independent claim 330).

As an initial matter of claim construction, we conclude the contested dispositive “**determining**” step or act of independent method claim 330 is positively recited as being **unconditionally performed** within the scope of the claim.² To the extent the two recited “when it is determined” steps or

² We note the alternative “or” language recited in the “determining” step or act of method claim 335 (“to a point *after*” . . . **or** to a point *prior*”) (emphasis added). When a claim covers several alternatives (e.g., using “**or**” language), the claim may be unpatentable if any of the alternatives within the scope of the claim are taught by the prior art. *See Brown v. 3M*, 265 F.3d 1349, 1351 (Fed. Cir. 2001).

acts of method claim 330 are **conditionally performed** in a mutually exclusive manner (or never performed) as a result of the outcome of the claimed “**determining**” step, we find the guidance of *Ex parte Schulhauser*, No. 2013-007847, 2016 WL 6277792 at *4 (PTAB April 28, 2016) (precedential) is inapplicable here, because we find the contested, unconditionally performed “**determining**” step is dispositive of this appeal, for the reasons discussed *infra*.³

We emphasize that if the recited “second user input indicates a **request to rewind** the broadcast program” (and not some other type of user input, such as a request to **fast-forward** or **pause**), then both possibilities of the **temporal condition precedent** (“after” and “prior to”) are covered within the scope of the claim, as pertaining to the two conditional “when it is determined” steps or acts of method claim 330.⁴

Nor do we apply *Schulhaser* to independent system (apparatus) claim 335, which is not a *method* or a *means-plus-function* claim, these being the two specific types of claims addressed within the limited holding of

³ *See also* the commensurate “determine” function, as recited in independent “system” independent claim 335.

⁴ We particularly note if the second user input indicates any other type of input that is **not a request to rewind** the broadcast, then **neither** of the “when it is determined” steps or acts is reached. Nor is method claim 330 limited in terms of who or what performs the steps or acts of the method.

Schulhauser.^{5 6}

Appellants contest the aforementioned “**determining**” limitation L1 in both the Appeal Brief (8–11), and the Reply Brief (3–4). Appellants contend, *inter alia*:

The Examiner has failed to present a *prima facie* case of obviousness in rejecting independent claims 330 and 335 at least because the Examiner **has not identified any teaching in Girard or O'Connor of a determination of whether a user input indicates a request to rewind a broadcast program to a point before or after a time the broadcast program was accessed.**

(App. Br. 8) (emphasis added).

Appellants further contend:

Girard discloses the simple proposition that, if a user wishes to access a portion of a program that is earlier than the presently

⁵ See *Schulhauser*, No. 2013-007847, 2016 WL 6277792 at *4 (PTAB April 28, 2016) (precedential) (holding “[t]he Examiner did not need to present evidence of the obviousness of the remaining method steps of claim 1 that are not required to be performed under a broadest reasonable interpretation of the claim”); see also *Ex parte Katz*, No. 2010-006083, 2011 WL 514314, at *4–5 (BPAI Jan. 27, 2011).

⁶ See also *Applera Corp. v. Illumina, Inc.*, 375 F. App’x 12, 21 (Fed. Cir. 2010) (unpublished) (affirming a district court’s interpretation of a method claim as including a step that need not be practiced if the condition for practicing the step is not met); accord *Cybersettle, Inc. v. Nat’l Arbitration Forum, Inc.*, 243 F. App’x 603, 607 (Fed. Cir. 2007) (unpublished) (“It is of course true that method steps may be contingent. If the condition for performing a contingent step is not satisfied, the performance recited by the step need not be carried out in order for the claimed method to be performed.”).

broadcast portion of the program, the user will do so by receiving a video stream from Girard's head end. **This is without regard to whether the user wishes to access a point of a program that is after the broadcast program was accessed, or prior to the point the program was accessed.** Thus, Girard certainly does not disclose the claimed “**determining**” element at least because Girard does not, and has no need to, **determine whether a user is rewinding to a point that is before or after a program was accessed: whatever the case, the user will receive a video stream from Girard's head end.** And for the same reason, Girard similarly does not disclose conditionally retrieving the broadcast program from user equipment, as is claimed.

O'Connor does nothing to remedy this deficiency in Girard's supposedly pertinent disclosure: **O'Connor, like Girard, is agnostic as to when a program was accessed, and simply discloses a system that allows a user to rewind a program without interrupting a recording process.** Thus, it is no surprise that there is **no teaching or suggestion in either reference to make the claimed determination,** as there is no need, or even utility, in either reference, **to have a decision point based around when a broadcast program was accessed, as is claimed.**

(App. Br. 10) (emphasis added).

The Examiner disagrees (Ans. 3–4), and finds Girard teaches:

rewinding a video data stream stored in a storage at a server **and playback [of] the video data stream from any point in the video stream based on the user input** (see col. 7, lines 5-25 for disclosing retrieving video data stream directly from digital storage and the viewer can manipulate the video data stream as desired in a manner similar to controlling conventional VCR systems and scan the stored video segment). In addition, Girard discloses **determining whether a user input indicates a request to playback past program or current program** (see fig. 6-8 and col. 5, lines 56- 67 and col. 6, lines 1-7, 34-68, col. 7, lines 1-25 for disclosing *when the viewer selects a past program, the head end server retrieves a stored video data stream of the selected past program and transmits it to the set-*

top box and when the viewer selects a future program, the head end server retrieves a stored video preview clip of the future program and transmits it to the set-top box). (Emphasis added).

Turning to the secondary O'Connor reference, the Examiner finds O'Connor teaches (Ans. 4–5):

[A] method of providing a time-shifted video stream received and recorded to a storage unit (see abstract). O'Connor further discloses a portion of the video stream is retrieved from the storage unit and provided at an output while the video stream continues to be recorded (see abstract and fig. 2). O'Connor further discloses storing the accessed broadcast program on a user equipment and retrieving the broadcast program stored on the user equipment based on user input (see col. 5, lines 9-35 for teaching fast forwarding (or **rewinding**) through the time-shifted video stream and an image frame from the video stream can be retrieved from the storage unit and when playback of the time-shifted video stream catches up to the point at which the incoming video stream is being recorded, the record and playback system 100 may display the incoming video stream directly from incoming video stream without retrieving the video stream from the storage unit).

Regarding the combined teachings and suggestions of Girard and O'Connor, the Examiner finds (Ans. 4–5):

Therefore, the combination of Girard and O'Connor discloses **determining** whether a second user input indicates a request to rewind to a point after a broadcast program was accessed or to a point prior to when the broadcast program was accessed, and retrieving the broadcast program from a user equipment or from a server, **based on the determination**. Since all claimed elements are known in the art, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Girard's method with the teaching of retrieving recorded data from *local storage* **based on determined user input**, as

taught by O'Connor, in order to provide a method that allows relatively quick access to any portion of the stored video stream. (Emphasis added).

Thus, based upon our review of the record, and as found by the Examiner (Ans. 3), Girard “discloses rewinding a video data stream stored in a storage at a server and playback [of] the video data stream from **any point** in the video stream **based on the user input.**” (emphasis added). As also found by the Examiner (Ans. 4): “Girard discloses **determining** whether a **user input** indicates a request to playback [a] past program or current program (see fig. 6-8 and col. 5, lines 56- 67 and col. 6, lines 1-7, 34-68, **col. 7, lines 1-25.**” (Emphasis added). We note a request to *playback a past program* is not necessarily (i.e., inherently) a rewind request.⁷

After reviewing the portions of Girard cited by the Examiner, we find the only mention of “rewind” or “rewinding” is found at column 7, lines 11–25:

It is further noted that a combination of viewing current and past programs can be employed. For instance, suppose a viewer is watching the real-time video data stream of the current “Seinfeld” program, but is distracted during the middle portion of the show. The viewer could simply “**rewind**” to the point at which they were distracted and replay it. The viewer is not really **rewinding** the show, in the sense of a VCR cassette, but instead is changing from the real-time video data stream of the current “Seinfeld” program to the stored video data stream of the earlier segment

⁷ Thus, in considering a finding of inherency under §103, we find the evidence cited by the Examiner (Ans. 4) insufficient to show that “the natural result flowing from the operation as taught would result in the performance of the questioned function.” *PAR Pharm., Inc. v TWI Pharms., Inc.*, 773 F.3d 1186, 1194–95 (Fed. Cir. 2014) (internal citation omitted).

of the same “Seinfeld” program. The viewer will be able to scan the stored segment and catch up to the real-time video data stream. The possibilities afforded by this fully interactive television system offer tremendous flexibility and control to the viewer.

(Emphasis added).

Given this description in Girard of “not really rewinding the show” and given the Examiner’s findings that Girard actually rewinds directly to a **point** in the video based solely upon the **user input** (Ans. 3–4), we find a preponderance of the evidence supports Appellants’ contention that Girard accesses a particular point in the video content as stored in the head end (server 22, Fig. 1, program storage 72) “**without regard** to whether the user wishes to access **a point of a program** that is **after** the broadcast program was **accessed**, or **prior** to the point the program was **accessed**.” (App. Br. 10).

Thus, in Girard, we agree with Appellants there would have been no need to **determine** “*whether the second user input indicates a request to rewind the broadcast program to a point **after** the broadcast program was accessed **or** to a point **prior** to when the broadcast program was accessed*” (claims 330, 335), because the access taught by Girard is based **solely** upon the **user input** which **indicates** what point to go to in the video.

We note the Examiner also finds O’Connor teaches “retrieving the broadcast program stored on the user equipment **based on user input**.” (Ans. 4) (emphasis added). This finding is supported by the evidence which teaches that **rewinding** to a different part of the video in O’Connor is performed **based solely on user input**: “The **user** may then view the video stream time shifted by the amount of time that **he suspended** the incoming

video stream, or **he** may fast forward (or **rewind**) through the time-shifted video stream.” (O’Connor, col. 5, ll. 16–19).

The Examiner has not shown where O’Connor teaches the claimed contested step of **determining** “*whether the second user input indicates a request to rewind the broadcast program to a point **after** the broadcast program was accessed or to a point **prior** to when the broadcast program was accessed*” (claims 330, 335), because the access taught by O’Connor is based **solely** upon the **user input** which **indicates** what point to go to in the video.

Therefore, based upon our review of the portions of O’Connor cited by the Examiner (Final Act. 7, citing O’Connor fig. 5, step 510, col. 4, ll. 27–33, fig. 2, col. 5, ll. 9–26), we find a preponderance of the evidence supports Appellants’ contention that “O’Connor, like Girard, is **agnostic as to when a program was accessed**, and simply discloses a system that allows a user to rewind a program without interrupting a recording process.” (App. Br. 10) (emphasis added).

Accordingly, we find the Examiner’s proffered combination of Girard and O’Connor does not teach or reasonably suggest the contested L1 step or act of “**determining**.” (Claim 330). Moreover, neither Girard nor O’Connor contemplate the **selective retrieval** of the broadcast program from **user equipment storage** or from a **server**, based upon the claimed **determining step**, in the manner recited in independent method claim 330. As noted above, independent system claim 335 recites “processing circuitry *configured to*” perform a similar “determine” function using language of commensurate scope. (emphasis added).

Because we find O'Connor does not remedy the deficiency of Girard, we are constrained on this record to reverse the Examiner's rejection A of independent claims 330 and 335, and of associated respective dependent claims 332–334, and 337–339, also rejected under rejection A.

Rejection B of claims 342 and 343

Regarding rejection B of claims 342 and 343, on this record, the Examiner has not shown how the additionally cited Baker reference overcomes the aforementioned deficiencies of Girard and O'Connor, as discussed above regarding rejection A of independent claims 330 and 335. Accordingly, we reverse the Examiner's rejection B of dependent claims 342 and 343.

DECISION

We reverse the Examiner's decision rejecting claims 330, 332–335, 337–339, 342, and 343 under pre-AIA 35 U.S.C. § 103(a).

REVERSED