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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte THOMAS J. QUIGLEY

Appeal 2016-008265
Application 13/735,930
Technology Center 2400

Before STEPHEN C. SIU, KRISTEN L. DROESCH, and CATHERINE SHIANG, *Administrative Patent Judges*.

SHIANG, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1–20, which are all the claims pending and rejected in the application. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

STATEMENT OF THE CASE

Introduction

According to the Specification, the present invention relates to communication systems. *See generally* Spec. 1. Claim 1 is exemplary:

1. A method, comprising:

receiving a request to access an item of content using a communication system;

establishing a relationship between a first channel and a second channel;

sending, at a faster rate than the item of content can be viewed on a user device of the communication system, a first portion of the item of content and a second portion of the item of content to a modem using the communication system via the first channel and the second channel, respectively, to enable, based on the faster rate, a trick mode for playback of the item of content.

References and Rejections

Claims 1–20 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1–34 of Quigley (US 8,351,468 B2; issued Jan. 8, 2013).

Claims 1–18 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that applicant regards as the invention.

Claims 1–20 are rejected under 35 U.S.C. § 102(e) as being anticipated by Pullen (US 2005/0135419; A1 published June 23, 2005).

ANALYSIS

Non-Statutory Double Patenting

Because Appellant does not contest the merits of the Examiner's rejection, we summarily affirm the Examiner's rejection of claims 1–20 on the ground of non-statutory double patenting in light of the claims of Quigley.

Indefiniteness

Each of claims 1–18 recites "a faster rate than the item of content can be viewed on a user device of the communication system." Claims 1–18. The Examiner rejects claims 1–18 as being indefinite. *See* Ans. 3–4. In

particular, the Examiner determines the claimed "a faster rate than the item of content can be viewed on a user device of the communication system" is meaningless, because one skilled in the art would not understand what "the item of content can be viewed on a user device" means. *See* Ans. 3–4; 10–13.

We disagree. Claims must "particularly point[] out and distinctly claim[] the subject matter which the applicant regards as his invention." 35 U.S.C. § 112, second paragraph.

> [W]e read § 112, ¶2 to require that a patent's claims, viewed in light of the specification and prosecution history, inform those skilled in the art about the scope of the invention with reasonable certainty. The definiteness requirement, so understood, mandates clarity, while recognizing that absolute precision is unattainable. The standard we adopt accords with opinions of this Court stating that "the certainty which the law requires in patents is not greater than is reasonable, having regard to their subject-matter."

Nautilus, Inc. v. Biosig Instruments, Inc, 134 S.Ct. 2120, 2129 (2014) (citations omitted).

We agree with Appellant that in light of the Specification's description, one skilled in the art would understand the claim element "the item of content can be viewed on a user device" means the playback rate. *See* App. Br. 6–7; Reply Br. 4; Spec. ¶ 75. Further, we agree with Appellant that in light of the Specification's description, one skilled in the art would understand the scope of the playback rate with reasonable certainty. *See* App. Br. 5–7; Reply Br. 4; Spec. ¶¶ 67, 70, 75, 80. Therefore, we agree with Appellant that, in light of the Specification's description, one skilled in the art would understand the scope of the claimed "a faster rate than the item of

content can be viewed on a user device" with reasonable certainty. *See* App. Br. 5–7; Reply Br. 4; Spec. ¶¶ 67, 70, 75, 80.

Accordingly, we reverse the Examiner's indefiniteness rejection of claims 1–18.

Anticipation[1]

We have reviewed the Examiner's rejection in light of Appellant's contentions and the evidence of record. We concur with Appellant's contention that the Examiner erred in finding Pullen discloses "sending . . . a first portion of the item of content and a second portion of the item of content . . . *to enable . . . a trick mode for playback of the item of content*," as recited in independent claim 1 (emphasis added). *See* App. Br. 8–12; Reply Br. 4–8.

Initially, the Examiner cites Pullen's Figures 1–2, and paragraphs 48–50, and 53 for disclosing the disputed claim limitation. *See* Final Act. 4. However, the Examiner does not specifically map or provide any finding about the italicized claim limitation. *See* Final Act. 4. We have reviewed the cited Pullen excerpts, and they do not discuss "sending . . . a first portion of the item of content and a second portion of the item of content . . . *to enable . . . a trick mode for playback of the item of content*," as required by the claim (emphasis added). In response to Appellant's arguments, the Examiner advances two theories:

[1] Appellant raises additional arguments with respect to the anticipation rejection. Because the identified issue is dispositive of the appeal, we do not reach the additional arguments.

First, the Examiner asserts the italicized claim limitation merely states an intended use or result, and does not constitute a patentable distinction. *See* Ans. 13–14.

We disagree. "It is well settled that the recitation of a new intended use for an old product does not make a claim to that old product patentable." *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997) (citations omitted). Claim 1 is a method—not a product—claim, and Schreiber's intended-use doctrine is inapplicable here. In any event, the Examiner has not established why "sending . . . a first portion of the item of content and a second portion of the item of content . . . *to enable . . . a trick mode for playback of the item of content*" (emphasis added) merely constitutes intended use or result, and should not have patentable weight. *See* Reply Br. 5–6. Further, the Examiner's unsupported assertion that "any method or apparatus capable of '*sending* . . . a first portion of [the] item of content and a second portion of [the] item of the content' . . . will meet this limitation" (Ans. 14) is speculative and contradicts the requirement of the anticipation rejection. *See* Reply Br. 8.

Second, the Examiner asserts Pullen is *inherently capable of* performing trick mode, because a trick mode was known in the art, as evidenced by U.S. Publication No. 2003/0043260A1. *See* Ans. 14–17.

It is well established that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros., Inc. v. Union Oil Co. of California,* 814 F.2d 628, 631 (Fed. Cir. 1987) (citations omitted). Inherency can only be established when "prior art necessarily functions in accordance with, or includes, the claimed limitations." *In re*

Cruciferous Sprout Litig., 301 F.3d 1343, 1349 (Fed. Cir. 2002) (citations omitted).

Here, the Examiner cites no evidence for showing Pullen *necessarily* discloses the italicized claim limitation. *See* Reply Br. 7. Further, the Examiner's *unsupported* assertion that Pullen is *capable of* performing the trick mode—even if it is true—is insufficient to support the anticipation rejection. *See* Reply Br. 8. Similarly, the Examiner's assertion that the claimed trick mode was known in the art is insufficient, as the Examiner fails to show Pullen *itself* discloses the disputed claim limitation. *See* Reply Br. 6.

Because the Examiner fails to provide sufficient evidence or explanation to support the anticipation rejection, we are constrained by the record to reverse the Examiner's rejection of claim 1.

Each of independent claims 10 and 19 recites a claim limitation that is substantively similar to the disputed limitation of claim 1. *See* claims 10 and 19. The Examiner states "the foregoing reason of rejection [regarding claim 1] is also applicable to claims 10 and 19." Ans. 17. Therefore, for similar reasons, we reverse the Examiner's rejection of independent claims 10 and 19.

We also reverse the Examiner's rejection of corresponding dependent claims 2–9, 11–18, and 20, which are rejected under the same anticipation rejection.

DECISION

We affirm the Examiner's decision rejecting claims 1–20 on the ground of nonstatutory obviousness-type double patenting.

We reverse the Examiner's decision rejecting claims 1–18 under 35 U.S.C. § 112, second paragraph.

We reverse the Examiner's decision rejecting claims 1–20 under 35 U.S.C. § 102.

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