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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JIM PRESTON and IRVAN KRANTZLER

Appeal 2017-002363
Application 13/651,248
Technology Center 2400

Before ELENI MANTIS MERCADER, LINZY T. McCARTNEY, and
CARL L. SILVERMAN, *Administrative Patent Judges*.

McCARTNEY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134 from a rejection of claims 1–
30. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

BACKGROUND

The present patent application “relates to techniques for channel searching and filtering.” Spec. ¶ 1, filed October 12, 2012. Claims 1, 11, and 21 are independent. Claim 1 illustrates the claimed subject matter:

1. A method comprising:

receiving user input specifying one or more characters;

using an initial character of the one or more characters to select a specific channel filtering method for filtering a plurality of channels from at least two channel filtering methods, the at least two channel filtering methods comprising a first channel filtering method for filtering the plurality of channels by channel number and a second channel filtering method for filtering the plurality of channels by channel name, each channel in the plurality of channels being associated with a unique channel name for identifying a content provider for that channel and a unique channel number for a user of a multimedia device to use to tune the multimedia device to that channel;

in response to using the initial character of the one or more characters to select the second channel filtering method for filtering the plurality of channels by channel name, identifying one or more channels by identifying one or more channel names, of the plurality of channel names, that contain the one or more characters as a substring;

causing a subset of the one or more channel names to be displayed to a user;

causing the multimedia device to tune to a particular channel associated with a particular channel name of the one or more channel names, the particular channel representing one of the one or more channels identified by identifying the one or more channel names;

wherein the method is performed by one or more computing devices.

App. Br. 25, filed July 22, 2016 (formatting modified).

REJECTIONS

Claims Rejected	Basis	Reference(s)
1–30	§ 112	N/A
1–30	§ 103	Chin ¹ and Ellis ² or Robarts ³
1–30	§ 103	Javvji ⁴ and Ellis or Robarts

ANALYSIS

§ 112

Claim 1 recites “using an initial character of the one or more characters to select a specific channel filtering method for filtering a plurality of channels from at least two channel filtering methods.” App. Br. 25. Independent claims 11 and 21 recite similar limitations. *See* App. Br. 28, 32. The Examiner found Appellants’ written description does not provide support for these limitations and rejected claims 1–30 for failing to comply with the written description requirement. *See* Final Act. 2–3, 6–7, mailed January 26, 2016. Appellants argue the Examiner erred, as at least paragraphs 21, 60, 64, and 66 of Appellants’ written description provide support for these limitations. *See* App. Br. 6–10; Reply Br. 1–5.

We agree with Appellants. To satisfy the written description requirement, Appellants’ disclosure “must ‘clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed.’” *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010)

¹ Chin et al. (US 2003/0137605 A1; July 24, 2003).

² Ellis (US 6,766,526 B1; July 20, 2004).

³ Robarts et al. (US 2005/0278741 A1; December 15, 2005).

⁴ Javvji et al. (US 2010/0088728 A1; April 8, 2010).

(en banc) (quoting *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1562–63 (Fed. Cir. 1991)). That is, Appellants’ disclosure must “reasonably convey[] to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.” *Ariad Pharms.*, 598 F.2d at 1351. At least paragraph 60 of Appellants’ written description meets this standard. Paragraph 60 discloses

[t]he filtering techniques that will be described hereafter can be based on any number of criteria associated with the channel including, but not limited to, *channel number, channel name, call sign, programs playing on the channel, etc. . . .* In another embodiment, multimedia device 100 *determines which criteria will be used for filtering based on user input.* For example, user input *that starts with a number* may be interpreted as *filtering by channel number*, whereas user input *that starts with a letter* may be interpreted as *filtering by channel name.*

Spec. ¶ 60 (emphases added). This disclosure shows that the inventors possessed as of the filing date of the invention “using an initial character of the one or more characters to select a specific channel filtering method for filtering a plurality of channels” (selecting one of two channel filtering methods based on the user input that starts with a number or letter) “from at least two channel filtering methods” (filtering channels by letter or number). We therefore do not sustain the Examiner’s rejection of claims 1–30 under 35 U.S.C. § 112.

§ 103

Appellants argue the Examiner’s combinations of (1) Chin and Ellis or Robarts and (2) Javvji and Ellis or Robarts fail to teach or suggest the following limitation recited in claim 1:

using an initial character of the one or more characters to select a specific channel filtering method for filtering a plurality of channels from at least two channel filtering methods, the at least

two channel filtering methods comprising a first channel filtering method for filtering the plurality of channels by channel number and a second channel filtering method for filtering the plurality of channels by channel name.

See App. Br. 13–24; Reply Br. 8–13. According to Appellants, the cited art not only fails to teach or suggest this limitation but also at least Ellis, Robarts, and Javvji teach away from the subject matter recited in claim 1. *See* App. Br. 13–24; Reply Br. 8–13. Appellants also argue the Examiner improperly concluded the terms “channel name” and “channel names” are non-functional descriptive material. *See* App. Br. 10–13; Reply Br. 5–8.

Although we agree with Appellants that the Examiner has not established either Chin, Ellis, or Javvji alone teaches or suggests “using an initial character” in the recited manner, we do not agree that the Examiner erred. The Examiner also found Robarts teaches or suggests the disputed “using an initial character” limitation and concluded claim 1 would have been obvious in light Chin and Robarts and Javvji and Roberts. *See* Final Act. 7–11, 18–21 (citing Robarts ¶¶ 106–144). The cited portions of Robarts disclose that when a “viewer first depresses the ‘6’-key [on a remote control], which has the associated letters M, N, and O” an electronic program guide “constructs a query for all [electronic program guide] items beginning with the digit ‘6,’ ‘M,’ ‘N,’ or ‘O.’” Robarts ¶ 106. The cited portions of Robarts also disclose that this query returns a list of channel names that include the letters “M,” “N,” or “O” and channel numbers that include the number “6.” *See* Robarts ¶¶ 106–121.

These disclosures teach or suggest using the number “6” (“using an initial character of the one or more characters”) to filter channel numbers and the letters associated with the number “6” to filter channel names (“to

select a specific channel filtering method for filtering a plurality of channels from at least two channel filtering methods, . . . comprising . . . filtering the plurality of channels by channel number and . . . filtering the plurality of channels by channel name”). These disclosures also suggest that when a viewer selects a number that does not have associated letters (e.g., the number “0”) Roberts’s method filters only by channel number, as there are no associated letters to filter channel names by. *See* Roberts Table 2 (showing no associated letters for the number “0”), ¶¶ 106–121 (describing an exemplary filtering process). In any event, we note that claim 1 encompasses selecting *both* filtering methods, as the claim uses open-ended “comprising” language and does not explicitly prohibit selecting additional filtering methods. *See, e.g., Invitrogen Corp. v. Biocrest Mfg., L.P.*, 327 F.3d 1364, 1368, (Fed. Cir. 2003) (“The transition ‘comprising’ in a method claim indicates that the claim is open-ended and allows for additional steps.”).

With respect to Appellants’ assertions that Ellis, Roberts, and Javvji teach away from the claimed invention, we find these assertions unpersuasive. “A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994). Furthermore, teaching an alternative method does not teach away from the use of a claimed method. *In re Dunn*, 349 F.2d 433, 438 (CCPA 1965); *see also, Ex parte Shuping*, No. 2008-0394, 2008 WL 336222, at *2 (BPAI 2008) (“[T]eaching a way is not teaching away.”) (citation omitted).

Here, Appellants simply assert that Ellis and Robarts teach away from the subject matter recited in claim 1 without explaining why that is the case. *See* App. Br. 17–18, 23. This unsupported assertion does not establish the Examiner erred. *Cf. In re Lovin*, 652 F.3d 1349, 1357 (Fed. Cir. 2011) (“[W]e hold that the Board reasonably interpreted Rule 41.37 to require more substantive arguments in an appeal brief than a mere recitation of the claim elements and a naked assertion that the corresponding elements were not found in the prior art.”). And Appellants forfeited the argument that Javvji teaches away from the claimed invention by failing to raise this argument in the Appeal Brief. *See* 37 C.F.R. § 41.41(b)(2) (“Any argument raised in the reply brief which was not raised in the appeal brief . . . will not be considered by the Board for purposes of the present appeal.”). In any event, we see nothing in Ellis, Robarts, or Javvji that would discourage the path taken by Appellants.

As for Appellants’ assertion that the Examiner improperly concluded the terms “channel name” and “channel names” are non-functional descriptive material, the Examiner explicitly found “the cited prior art discloses all claimed limitations, *including non-functional descriptive materials*.” Final Act. 6 (emphasis added). Therefore, even if we were to agree with Appellants that the terms are functional, the Examiner found the cited art teaches or suggests these elements, *see* Final Act. 7–11, 18–22, and Appellants have not persuaded us the Examiner erred in this regard.

For the above reasons, we sustain the Examiner’s rejection of claim 1. Because Appellants have not presented separate, persuasive patentability arguments for claims 2–30, we also sustain the Examiner’s rejections of these claims.

CONCLUSION

Claims Rejected	Basis	Reference(s)	Affirmed	Reversed
1-30	§ 112	N/A		1-30
1-30	§ 103	Chin and Robarts	1-30	
1-30	§ 103	Javvji and Robarts	1-30	
Summary			1-30	

Because we have affirmed at least one ground of rejection with respect to each claim on appeal, we affirm the Examiner's decision. *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). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED