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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte REX XU and CESAR ALVARADO

Appeal 2018-001595
Application 12/491,688
Technology Center 2100

Before JOHN A. EVANS, LINZY T. McCARTNEY, and
JOYCE CRAIG, *Administrative Patent Judges*.

EVANS, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants¹ seek our review under 35 U.S.C. § 134(a) of the Examiner’s Non-Final Rejection of Claims 1–9 and 12–18. App. Br. 1. Claims 10 and 11 have been withdrawn. Non-Final Act. 2. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.²

¹ The Appeal Brief identifies Universal Electronics Inc., as the real party in interest. App. Br. 2.

² Rather than reiterate the arguments of Appellants and the Examiner, we refer to the Appeal Brief (filed August 22, 2017, “App. Br.”), the Reply Brief (filed December 1, 2017, “Reply Br.”), the Examiner’s Answer (mailed October 19, 2017, “Ans.”), the Non-Final Office Action (mailed December 23, 2016, “Non-Final Act.”), the Specification (filed June 25, 2009, and as amended May 17, 2012, “Spec.”), and our prior Decision

STATEMENT OF THE CASE

Related Proceedings

The present Application was the subject of Appeal 2014-007712 heard by the present Panel of the Board. Our Decision of August 30, 2016 affirmed the rejection of Claims 1–4, 7–9, 12–14, 17, and 18 as anticipated and affirmed the rejection of Claims 5, 6, 15, and 16 as obvious. Subsequent to our Decision, Appellants amended the claims.

The Invention

The claims relate to a method to configure a macro command sequence used by a controlling device to command functions of one or more target devices. *See* App. Br. 2.

Claims 1 and 9 are independent. An understanding of the invention can be derived from a reading of exemplary Claim 1, which is reproduced below with some formatting added:

1. A method for configuring a macro command sequence for use by a controlling device having programming for commanding functions of one or more target devices, comprising:
 - displaying in a display an exact image of an original equipment manufacturer remote control device that is provided with at least one of the one or more target devices where each displayed image of the original equipment manufacturer remote control device includes images of buttons that would be used to control controllable functions of a corresponding one of the one or more target devices;
 - accepting a first input by which one or more of the displayed images of buttons of the displayed image of the one

(mailed August 30, 2016, “Decision”) for their respective details.

or more of the original equipment manufacturer remote control devices are selected; and

using the selection of the one or more displayed images of buttons of the displayed image of the one or more of the original equipment manufacturer remote control devices to configure a macro button of the controlling device whereupon activation of the macro button will cause a transmission of commands from the controlling device to control controllable functions of the one or more target devices that correspond to the selected one or more of the displayed images of buttons of the displayed one or more images of the original equipment manufacturer remote control devices.

References and Rejections

The Examiner relies upon the prior art as follows:

Muto <i>et al.</i>	US 2005/0220038 A1	Oct. 6, 2005
Scott <i>et al.</i>	US 2006/0050142 A1	Mar. 9, 2006

The following claims are before us for review:

1. Claims 1–9 and 12–18 stand rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. Non-Final Act. 4.
2. Claims 1–9 and 12–18 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Non-Final Act. 5.
3. Claims 1–4, 7–9, 12–14, 17, and 18 stand rejected under 35 U.S.C. § 102(e) as anticipated by Scott. Non-Final Act. 5–8.
4. Claims 5, 6, 15, and 16 stand rejected under 35 U.S.C. § 103(a) as obvious over Scott and Muto. Non-Final Act. 8–9.

ANALYSIS

We have reviewed the rejections of Claims 1–9 and 12–18 in light of Appellants’ arguments that the Examiner erred. We provide the following

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explanation to highlight and address specific arguments and findings primarily for emphasis.

CLAIMS 1–9 AND 12–18: NON-STATUTORY SUBJECT MATTER

The Examiner finds the independent claims recite a “method” for configuring a macro command sequence comprising steps that may be performed manually and/or mentally. Non-Final Act. 4. The Examiner, thus, finds the recited method is an abstract idea because it is not tied to a particular machine or apparatus, nor does it transform a particular article into a different state or thing. *Id.*

Appellants contend the claims set forth a method requiring a controlling device, which has programming for controlling a target device. App. Br. 6. Appellants argue the claimed method is tied to a particular device and cannot be performed by a human either mentally or with paper and pencil. *Id.* Appellants contend the claims set forth a method including activation of a macro button to transmit commands to control functions of a target device. Reply Br. 2. Appellants further argue the Examiner’s finding is not supported by any analysis that demonstrates that the claimed elements, considered both individually and as an ordered combination, are insufficient to ensure that the claims as a whole amount to significantly more than the (unidentified) exception itself under *Alice*³. *Id.*

The Examiner finds it is unclear what hardware component(s) of the controlling device are needed for configuring a macro command sequence to command target devices. Ans. 8.

³ *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2357 (2014).

The Examiner has not sufficiently explained how the Examiner's findings apply to the steps of the *Alice* analysis. Moreover, the Examiner's objections (i.e., lack of clarity as to required hardware) sound in the written description requirement of § 112, not in § 101. We address the written description rejection below. We decline to sustain the rejection of Claims 1–9 and 12–18 under § 101.

CLAIMS 1–9 AND 12–18: WRITTEN DESCRIPTION REQUIREMENT

The claims as amended recite, *inter alia*, “displaying in a display an exact image of an original equipment manufacturer remote control device.”

The Examiner finds the recitation “exact image” occurs only once in the Specification:

in instances where exact image data is not available for the particular OEM remote control associated with the currently selected configured target device, a closest match image, a generic image, a drop-down list of available command function names, etc. may be substituted as necessary.

Ans. 8 (quoting Spec. ¶ 25). The Examiner finds the recitation is not presented in the summary of invention section and is recited in a hypothetical and negative tone. *Id.*

Appellants contend the recitation provides for substitutions where the exact image is unavailable and that Figure 7 illustrates an exact image of an OEM remote control. App. Br. 6–7. Appellants argue their disclosure is ample to convey to one skilled in the art that Appellants were in possession of the subject matter. *Id.* at 6.

We agree the Specification conveys with sufficient clarity the notion of an exact image. We decline to sustain the rejection of Claims 1–9 and 12–18 under § 112, first paragraph.

CLAIMS 1–4, 7–9, 12–14, 17, AND 18: ANTICIPATION BY SCOTT

Appellants contend Scott fails to disclose “displaying in a display an exact image of an original equipment manufacturer remote control device,” as recited in independent Claims 1 and 9. App. Br. 8. Specifically, Appellants argue Figures 9 and 10 of Scott disclose a system in which command function labels are presented to a user in panel 912 together with an image of a universal remote control device that is being programmed. *Id.*

The Examiner finds the claimed “exact image” is undefined and, therefore, the Examiner interprets the term to mean an “image of an original equipment manufacturer remote control device.” Ans. 9.

Appellants contend the Board determined that Scott does not disclose an “exact image” of a remote control, but rather, that Scott discloses the use of a drop down list. Reply Br. 4 (citing Decision 4).

Our Decision found:

[t]he plain language of claim 1 is not limited to “exact image data” for an OEM remote control device, and thus the disputed term is sufficiently broad also to encompass “a closest match image, a generic image, [and] a dropdown list of available command function names,” as described in the Specification [and disclosed by Scott]. Thus, we agree with the Examiner’s reasonable interpretation of “original equipment manufacturer remote control device.”

Decision 4. However, subsequent to our Decision, Appellants have amended their claims to recite an “exact image.” Our prior Decision found Claim 1 was “not limited to ‘exact image data’ for an OEM remote control device” such that a drop-down list of command names reasonable approximated the claimed “image of an original equipment

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manufacturer remote control device.” However, the claims have been amended to recite an “exact image,” which is not reasonably read-on by a drop-down list.

In view of the foregoing, we decline to sustain the rejection of Claims 1–4, 7–9, 12–14, 17, and 18 under § 102(e).

CLAIMS 5, 6, 15, AND 16: OBVIOUSNESS OVER SCOTT AND MUTO

The Examiner does not apply Muto to supply the deficiencies of Scott as discussed above. *See* Non-Final Act. 8–9; Ans. 7. Because we do not sustain the rejection of the independent claims, we similarly do not sustain the rejection of the dependent claims.

DECISION

The rejection of Claims 1–9 and 12–18 under 35 U.S.C. § 101 is REVERSED.

The rejection of Claims 1–9 and 12–18 under 35 U.S.C. § 112, first paragraph, is REVERSED.

The rejection of Claims 1–4, 7–9, 12–14, 17, and 18 under 35 U.S.C. § 102(e) is REVERSED.

The rejection of Claims 5, 6, 15, and 16 under 35 U.S.C. § 103(a) is REVERSED.

REVERSED