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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ANDREW HEY

Appeal 2018-001867
Application 12/700,430¹
Technology Center 2400

Before MICHAEL J. STRAUSS, NABEEL U. KHAN,
and DAVID J. CUTITTA II, *Administrative Patent Judges*.

CUTITTA, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant seeks our review under 35 U.S.C. § 134(a) of the Examiner's decision rejecting claims 13, 26, and 30–40, which are all the claims pending in the application.² We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART.

¹ Appellant identifies Echostar Technologies International Incorporation as the real party in interest. *See* Appeal Br. 2.

² Claims 1–12, 14–25, and 27–29 are canceled. *See* Appeal Br. 36, 37.

STATEMENT OF THE CASE

Invention

Appellant's invention relates to "providing one or more highlights of premium multimedia content that may be of interest to a user of a television system." Spec. ¶ 13.³

Exemplary Claim

Independent claims 13 and 26 are exemplary and are reproduced below.

13. A television receiver for providing a highlight of a multimedia program to a user of a television system including a headend, the television receiver comprising:

a microprocessor; and

a computer-readable storage medium, the computer readable storage medium storing a computer-executable code that, when executed by the microprocessor, causes the television receiver to perform the operations of:

transmitting to the headend at least one of the group consisting of (i) user preferences for multimedia content and (ii) information from which the user preferences for multimedia content can be determined;

in response to transmitting the user preferences or the information to the headend, receiving from the headend instructions to collect and store highlights for premium multimedia programs correlating to the user preferences by recording selected portions of the premium multimedia programs specified by the instructions; and

³ Throughout this Decision, we refer to the following documents: (1) Appellant's Specification, filed February 4, 2010 ("Spec."); (2) the Non-Final Office Action ("Non-Final Act."), mailed February 1, 2017; (3) the Appeal Brief filed June 30, 2017 ("Appeal Br."); (4) the Examiner's Answer ("Ans.") mailed November 3, 2017; and (5) the Reply Brief filed December 12, 2017 ("Reply Br.").

after receiving instructions to collect and store the highlights from the headend, automatically and without requiring input from the user (i) collecting and storing the highlights in the computer-readable storage medium and (ii) subsequently presenting the highlights to the user of the television system.

26. A method for providing highlights of premium content to a user of a television system including a receiver and a headend, the premium content comprising pay to watch programs, the method comprising:

at the headend, obtaining one or more viewing preferences of the user by receiving information from the receiver indicative of the viewing preferences or by analyzing the viewing history of the user to determine the viewing preferences;

at the headend, identifying highlights of premium content matching the viewing preferences of the user; and

at the headend, transmitting instructions to the receiver to, automatically and without requiring input from the user, collect and store the highlights of premium content by recording specified segments of the premium content for presentation to the user of the television system.

Appeal Br. 36, 37.

REFERENCES

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

Ellis et al. (“Ellis”)	US 2002/0174430 A1	Nov. 21, 2002
Gorbatov et al. (“Gorbatov”)	US 2003/0018980 A1	Jan. 23, 2003
Swix et al. (“Swix”)	US 2004/0163101 A1	Aug. 19, 2004
Kawai et al. (“Kawai”)	US 2007/0300253 A1	Dec. 27, 2007
Schnell et al. (“Schnell”)	US 2008/0255994 A1	Oct. 16, 2008
Whitehead	US 2009/0178071 A1	July 9, 2009
Subramanian et al. (“Subramanian”)	US 2011/0123174 A1	May 26, 2011

REJECTIONS

Claims 13 and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Whitehead and Subramanian. Non-Final Act. 3–12.

Claims 30, 31, 37, and 38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Whitehead, Subramanian, and Gorbatov. Non-Final Act. 12–17.

Claims 32 and 33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Whitehead, Subramanian, and Swix. Non-Final Act. 17–19.

Claim 34 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Whitehead, Subramanian, Swix, and Ellis. Non-Final Act. 19–20.

Claims 35 and 39 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Whitehead, Subramanian, and Kawai. Non-Final Act. 20–22.

Claim 36 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Whitehead, Subramanian, and McClellan. Non-Final Act. 22–23.

Claim 40 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Whitehead, Subramanian, and Schnell. Non-Final Act. 23–25.

Our review in this appeal is limited to the above rejections and the issues raised by Appellant. Arguments not made are waived. *See* 37 C.F.R. §§ 41.37(c)(1)(iv).

CONTENTIONS AND ANALYSIS

Rejection Under 35 U.S.C. § 103(a) of Claim 13

Issue: Based on Appellant’s arguments, the dispositive issue presented on appeal is whether the Examiner errs in finding Whitehead teaches or suggests “after receiving instructions to collect and store the highlights from the headend, automatically and without requiring input from the user (i) collecting and storing the highlights in the computer-readable storage medium and (ii) subsequently presenting the highlights to the user of the television system,” as recited in claim 13.

In interpreting the limitation at issue, the Examiner determines that the limitation “automatically and without requiring input from the user” applies only to “(i) collecting and storing the highlights in the computer-readable storage medium” and *not* to “(ii) subsequently presenting the highlights.” Specifically, the Examiner determines that

the language of the claim does not clearly indicate the steps for “collecting and storing the highlights in the computer-readable storage medium” and “subsequently presenting the highlights to the user of the television system” both occur “automatically and without requiring input from the user.” As set forth above in the rejection of the claim, the examiner has construed the language of the claim such that “automatically and without requiring input from the user” is associated with the step for “collecting and storing the highlights in the computer-readable storage medium.” The step for “subsequently presenting the highlights to the user of the television system” has been construed as being unassociated with “automatically and without requiring input

from the user.” Rather, the examiner has interpreted this presentation step as merely occurring subsequent to the recited . . . (i) collecting and storing.

Ans. 40. Thus, the Examiner interprets the limitation as *not* requiring the claimed presenting the highlights to be performed “automatically and without requiring input from the user.”

Appellant argues the Examiner’s claim interpretation is unreasonable in view of Appellant’s use of romanettes in the claim:

usage of romanettes as appearing in the final clause of Claim 13 plainly indicates that the qualifier of “automatically and without requiring input from the user” clearly applies to both the television receiver function prefaced by romanette (i) (collecting and storing the highlights in the computer-readable storage medium) *and* the television receiver function prefaced by romanette (ii) (subsequently presenting the highlights to the user of the television system).

Reply Br. 13.

We find Appellant’s argument persuasive because, in view of the romanettes, which are commonly used to present a list of items, we interpret the claimed limitation in the conjunctive to require that *both* the (i) collecting and storing the highlights in the computer-readable storage medium *and* the (ii) “subsequently presenting the highlights to the user of the television system,” be performed “automatically and without requiring input from the user.” The Examiner has not shown that this interpretation is inconsistent with Appellant’s Specification. *See* Spec. ¶ 13.

In view of our claim interpretation, we agree the Examiner has not established that either Whitehead or Subramanian, alone or in combination, teach or suggest “after receiving instructions to collect and store the highlights from the headend, automatically and without requiring input from

the user . . . presenting the highlights to the user of the television system,” as recited in claim 13.

Because we agree with at least one of the dispositive arguments advanced by Appellant for claim 13, we need not reach the merits of Appellant’s other arguments. We, therefore, do not sustain the Examiner’s 35 U.S.C. § 103(a) rejection of claim 13. We, likewise, do not sustain the rejections of dependent claims 37–40, which each depend from claim 13.

Rejection Under 35 U.S.C. § 103(a) of Claim 26

The Examiner relies on the combination of Whitehead and Subramanian to teach the method recited in independent claim 26. *See* Non-Final Act. 8–12; Ans. 41–45.

Appellant argues neither Whitehead nor Subramanian teach “a television system headend that cooperates with a television system receiver to support the automatic highlight recording and presentation functionalities described in Appellant’s Application.” Appeal Br. 29–30.

We find Appellant’s arguments unpersuasive because the Examiner’s findings are supported by a preponderance of the evidence. We refer to, rely on, and adopt the Examiner’s findings and conclusions for claim 26, insofar as they relate to issues raised in this appeal, as set forth in the Office Action and Answer. *See* Non-Final Act; 8–12; Ans. 41–45. Our discussion is limited to the following points of emphasis.

Appellant argues “the Whitehead references [*sic*] provides no indication that server 210 identifies highlights of premium content matching the viewing preferences of the user” or “that server 210 transmits instructions to a television receiver to collect and store the highlights of

premium content by recording specified segments of the premium content for presentation to the user of the television system.” Appeal Br. 30.

We find this argument unpersuasive because the Examiner relies on Subramanian, rather than Whitehead, to teach the argued limitation. Specifically, the Examiner finds “Subramanian teaches providing highlights of premium content to a user, the premium content comprising pay to watch programs, identifying highlights of premium content matching the viewing preferences of the user, and collecting and storing the highlights of premium content by recording specified segments of the premium content” for presentation to the user. Ans. 43. Appellant’s arguments directed to Whitehead do not address the Examiner’s findings from Subramanian.

Next, Appellant argues

the Subramanian reference expressly pertains to the automatic recording of “sneak peaks” of television programming at the STB or television receiver level; and, accordingly, also fails to provide any indication as to the possibility or desirability of transmitting instructions to a television receiver from a television system headend (or another remote entity) to collect and store the highlights of premium content in any manner.

Appeal Br. 30.

We find this argument unpersuasive because the Examiner relies on Whitehead, rather than Subramanian, to teach transmitting instructions to a television receiver from a television system headend. Specifically, the Examiner finds Whitehead’s ““server 210 may include a server entity that may also include IA DVR functionality 250 that may monitor and record a user's TV viewing habits, based on a user's interaction with STB 220, and may automatically cause TV programs to be recorded by DVR 245 based on the user’s viewing habits.”” Ans. 42 (citing Whitehead 35–40). Appellant’s

arguments directed to Subramanian do not address the Examiner's findings from Whitehead.

We, therefore, agree with the Examiner that Appellant's arguments unpersuasively attack the findings from Whitehead and Subramanian individually (*see* Appeal Br. 41) when the rejection is based on the combined teachings of the references. *See In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986) ("Non-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references") (citation omitted). Appellant's arguments fail to take into account what the collective teachings of Whitehead and Subramanian would have suggested to one of ordinary skill in the art.

For the reasons discussed, Appellant has not shown error in the Examiner's factual findings or conclusion of obviousness. Accordingly, we sustain the Examiner's 35 U.S.C. § 103(a) rejection of independent claim 26, and of dependent claims 30–36, which are not argued separately. *See* Appeal Br. 31–33.

DECISION

We affirm the Examiner's decision rejecting claims 26 and 30–36.

We reverse the Examiner's decision rejecting claims 13 and 37–40.

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-IN-PART