



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
**United States Patent and Trademark Office**  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
14/285,885	05/23/2014	Kevin Yao	P2010-03-22.1	1349
132861	7590	02/04/2020	EXAMINER	
Perkins Coie LLP - DISH Network			RYAN, PATRICK A	
P.O. Box 1247			ART UNIT	PAPER NUMBER
Seattle, WA 98111-1247			2426	
			NOTIFICATION DATE	DELIVERY MODE
			02/04/2020	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentprocurement@perkinscoie.com

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

*Ex parte* KEVIN YAO

---

Appeal 2018-004466  
Application 14/285,885  
Technology Center 2400

---

Before CAROLYN D. THOMAS, ADAM J. PYONIN, and  
MICHAEL M. BARRY, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellant<sup>1</sup> appeals from the Examiner's decision to reject claims 1, 3–6, 8–10, and 13–24. Claims 2, 7, 11, and 12 are canceled. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We REVERSE.

---

<sup>1</sup> We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as EchoStar Broadcasting Holding Parent L.L.C. Appeal Br. 1.

The present invention relates generally to pre-tuning a second tuner in anticipation of a channel surfing activity. *See Spec., Abstract.*

Claim 1 is illustrative:

1. A channel surfing method implemented in a media device having at least a first tuner and a second tuner, wherein the first tuner is tuned to a first program channel that is associated with a first program channel identifier, the method comprising:

receiving a user specification from a user,

wherein the user specification predefines a second program channel identifier that is specified by the user to control tuning of the second tuner when the first tuner is tuned to the first program channel, and

wherein the user specification of the predefined second program channel identifier is received before detecting an initiation of a channel surfing activity during presentation of the first content stream to the user;

storing the predefined second program channel identifier of the user specification in a memory of the media device;

operating, after receiving and storing the predefined second program channel identifier, the first tuner to become tuned to the first content stream associated with the first program channel identifier being broadcast to the media device via a broadcast system;

presenting the first content stream on a display;

retrieving the predefined second program channel identifier from the memory of the media device in response to operating the first tuner to become tuned to the first content stream;

operating the second tuner to become tuned to a second content stream being broadcast to the media device via the broadcast system in response to retrieving the predefined second program channel identifier from the memory of the media device, wherein the second content stream is associated with a second program channel identified by the predefined second program channel identifier;

receiving the second content stream associated with the second program channel identified by the user specification at the second tuner;

detecting, after the second tuner has become tuned to the second content stream, the initiation of the channel surfing activity;  
and

presenting at least a video portion of the second content stream associated with the second channel that is received at the second tuner in response to detecting the initiation of the channel surfing activity, wherein the video portion of the second content stream and a video portion of the first content stream are concurrently presented on the display.

Appellant appeals the following rejections:<sup>2</sup>

R1. Claims 1, 4, 8, 9, 14, 15, 18, 20, and 22–24<sup>3</sup> are rejected under 35 U.S.C. § 103(a) as being unpatentable over MacInnis (US 2005/0216951 A1, Sept. 29, 2005) and Greenberg (US 7,532,253 B1, May 12, 2009);

R2. Claims 3, 10, 16, and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over MacInnis, Greenberg, and Liebhold (WO 2005/081660 A2, Sept. 9, 2005); and

R3. Claims 5, 6, 13, 19, and 21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over MacInnis, Greenberg, and Potrebic (US 6,804,824 B1, Oct. 12, 2004).

We review the appealed rejections for error based upon the issues identified by Appellant, and in light of the arguments and evidence produced thereon. *Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential).

---

<sup>2</sup> The Examiner withdrew the rejection under § 112, first paragraph (*see* Final Act. 2–3), in light of Appellant’s Amendment after Final. *See* Advisory Action, July 12, 2017.

<sup>3</sup> Although the statement of the rejection lists claims 1, 4–6, 8, 9, 13–15, and 18–22 (*see* Final Act. 4), the body of the rejection omits some claims and only discusses claims 1, 4, 8, 9, 14, 15, 18, 20, 22, 23, and 24. *Id.* at 4–16. As such, we shall treat this rejection as including claims 1, 4, 8, 9, 14, 15, 18, 20, 22, 23, and 24.

## ANALYSIS

**Issue:** Did the Examiner err in finding that *MacInnis* teaches retrieving the predefined second program channel identifier . . . *in response to* operating the first tuner to become tuned to the first content stream, as set forth in representative claim 1?

Appellant contends:

Nowhere in *MacInnis* Paragraphs 0005, 0019, 0043, 0055, 0067, 0080, or 0106 is there any disclosure of a user specification that is used to pre-tune a second tuner to an anticipated channel associated with a content stream identified by the user specified predefined program channel identifier (where the first tuner is tuned to receive the currently presenting content stream).

Further, Appellant proffers that *MacInnis* paragraphs 005, 0019, 0043, 0055, 0067, 0080, and 0106 do not *inherently* disclose the above-recited features of Claims 1, 8, and 14.

Appeal Br. 15; *see also* Substitute Appeal Br. 15.

Appellant further contends that

[w]ith respect to the *MacInnis* favorites list, it does not necessarily follow that the user specification of a channel that is stored in the *MacInnis* favorite list is the same as a user specification of a channel that controls tuning of a second tuner while the first tuner is receiving the first content stream that is presented on a display.

Appeal Br. 16; *see also* Substitute Appeal Br. 16.

Appellant's contention emphasizes that the claimed "second program channel identifier," predefined by the "user specification," is received *in response to* the first tuner receiving the first content stream, and *MacInnis* fails to teach or suggest such an arrangement. We agree with Appellant.

Although the Examiner finds, and we agree, that “the claimed ‘user specification’ is not described in sufficient detail as to preclude a list of favorite content items or a selection of content items based on monitored historic user behavior” (*see* Ans. 3), and “Appellant’s Specification demonstrates embodiments of the invention similar to the disclosure of *MacInnis* [including embodiments that] select the anticipated channel from a *favorite list* of program channel identifiers” (*Id.* at 4 (*citing* Appellant’s Specification ¶ 28)), the Examiner ignores the “in response to” language in the claims.

As a matter of claim construction, we note that the claims require that the “user specification,” which predefines a second program channel identifier, be retrieved *in response to* operating the first tuner to become tuned to the first content stream or *during* presentation of the first content stream to the user. *See* Claims 1, 8, 14.

As such, we find that although *MacInnis* teaches receiving a user specified predefined program channel identifier associated with a second channel (*see MacInnis* ¶ 55 – “favorite list”), the Examiner has not shown that *MacInnis*’ predefined program channel identifier is retrieved *in response to* operating the first tuner to become tuned to the first content stream, as required by the claims. Instead, *MacInnis* retrieves a first video stream and a second video stream simultaneously, as opposed to one after the other (i.e., in response to). *See MacInnis* Abstract; Figure 1, element 120.

In view of the above discussion, we are of the opinion that the proposed combination of references set forth by the Examiner does not support the obviousness rejection, given that the Examiner is specifically relying on *MacInnis* for this teaching. We, accordingly, do not sustain the

Appeal 2018-004466  
Application 14/285,885

rejection of independent claims 1, 8, and 14, or the rejection of claims 3–6, 9, 10, 13, and 15–24 which are dependent thereon.

### CONCLUSION

Appellant demonstrates that the Examiner erred in rejecting claims 1, 3–6, 8–10, and 13–24 as being unpatentable under 35 U.S.C. § 103 over *MacInnis* in combination with various other references.

In summary:

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
1, 3–6, 8–10, 13–24	103	(at least) <i>MacInnis</i>		1, 3–6, 8–10, 13–24

REVERSED