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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 14/342,917 | 03/05/2014 | Jun Kitahara | 429764US | 8200 |

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| 22850 7590 03/09/2020 | | EXAMINER | |
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| 1940 DUKE STREET | | | |
| ALEXANDRIA, VA 22314 | | ART UNIT | PAPER NUMBER |
| | | 2426 | |

| NOTIFICATION DATE | DELIVERY MODE |
|---|---|
| 03/09/2020 | ELECTRONIC |

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UNITED STATES PATENT AND TRADEMARK OFFICE
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BEFORE THE PATENT TRIAL AND APPEAL BOARD
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*Ex parte* JUN KITAHARA and NAOHISA KITAZATO
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Appeal 2018-006914
Application 14/342,917
Technology Center 2400
_____


Before CAROLYN D. THOMAS, CARL W. WHITEHEAD JR., and
MICHAEL J. STRAUSS, *Administrative Patent Judges.*

STRAUSS, *Administrative Patent Judge.*


DECISION ON APPEAL[1]

Pursuant to 35 U.S.C. § 134(a), Appellant[2] appeals from the
Examiner's decision to reject claims 1–7.  *See* Final Act. 1.  We have
jurisdiction under 35 U.S.C. § 6(b).  Oral argument was held on February
25, 2020.  A copy of the transcript will be added to the record in due course.

We AFFIRM.

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[1] We refer to the Specification, filed March 5, 2014 ("Spec."); Final Office
Action, mailed August 30, 2017 ("Final Act."); Appeal Brief, filed January
30, 2018 ("Appeal Br."); Examiner's Answer, mailed April 19, 2018
("Ans."); and Reply Brief, filed June 19, 2018 (Reply Br.).
[2] 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 the assignee, Saturn
Licensing LLC.  Appeal Br. 3.

CLAIMED SUBJECT MATTER

According to Appellant, the claims are directed to:

In an information processing system capable of controlling an application related to a broadcast content by an AIT [(Application Information Table), a] "SUSPEND" [control code] is newly added to a set of application control codes of an ETSI [(European Telecommunications Standards Institute)] standard. By executing "SUSPEND", a new function of setting an application from an executed state to a pause state can be added. As a result, control involving storing a processing result up to an application end point and resuming processing while taking over the past processing result when the application is activated next time can be realized.

Abstract.

Claim 1, reproduced below with element labels added in brackets, is

illustrative of the claimed subject matter:

1. An information processing apparatus, comprising:
   circuitry configured to
      [(i)] receive and process a broadcast content to be reproduced:
      [(ii)] acquire an application information table with which suspend information can be set as control information for controlling a first application related to the broadcast content set, when the application information table including the suspend information is acquired, the first application being executed to a pause state based on the suspend control information;
      [(iii)] acquire a new application information table in which information is set to start a second application;
      [(iv)] determine from the new application table whether the first application is to be paused, ended, or run concurrently with the second application;
      [(v)] set the first application to be paused, ended, or run concurrently with the second application in accordance with the new application information table; and

[(vi)] run the first application concurrently with the second application when the first application is set to be run concurrently with the second application,

[(vii)] wherein running the first application and the running second application are distinct from reproduction of the broadcast content.

## REFERENCES

The prior art relied upon by the Examiner is:

| Name | Reference | Date |
|------|-----------|------|
| Menand et al. | US 5,563,648 | Oct. 8, 1996 |
| Wilcox et al. | US 2003/0028885 A1 | Feb. 6, 2003 |

## REJECTION

Claims 1–7 are rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Menand in view of Wilcox. Final Act. 2–7.

## OPINION

We review the appealed rejection 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). Arguments not made are waived. *See* 37 C.F.R. § 41.37(c)(1)(iv) (2017).

We select claim 1 as the representative claim for the rejection. Appellant does not argue separate patentability for claims 2–7. Except for our ultimate decision, we do not address the § 103(a) rejection of claims 2–7 further herein.

Having reviewed the Appellant's arguments regarding this § 103(a) rejection, we are not persuaded the Examiner erred. We agree with and adopt the Examiner's findings and reasoning in the Final Office Action and the Answer as our own and add any additional findings of fact appearing below for emphasis.

ANALYSIS

The Examiner finds Menand's audio video interactive (AVI) receiver teaches circuitry performing the steps of elements (i) through (v) of claim 1, i.e., all steps except that the reference is not explicit that the first and second applications run concurrently and distinct from reproduction of the broadcast content as recited by claim elements (vi) and (vii). Final Act. 3–4. To cure the noted deficiency of Menand, the Examiner applies Wilcox's disclosure of a navigational user interface for interactive television. *Id.* at 4. According to the Examiner:

> In an analogous art, Wilcox discloses a resident application (the first application) may be set to initiate another application such as pizza ordering application (the second application) and run concurrently with the second application on the client terminal, wherein running the first application and the running second application are distinct from reproduction of the broadcast content (e.g., see Para 174; the resident application as described in Para 173 and pizza order application are distinct from reproduction of the broadcast content).

*Id.* The Examiner determines it would have been obvious to modify Menand's system to include concurrently running first and second applications as disclosed by Wilcox "to eliminate the need to exit from the active state, thus reduce the processing overhead when reactivated." *Id.*

Appellant's first contention of error is that:

> [W]hile the portions of Menand et al. cited for that teaching describe minimizing or suspending an application, they are silent with regard to running it concurrently with a second application. Therefore, insofar as the rejection depends on that alleged teaching of Menand et al., it does not make out even a *prima facie* case of obviousness.

Appeal Br. 11 (emphasis added).  The Examiner responds, explaining claim 1 recites the argued concurrent running functionality, alleged as missing from Menand, in the alternative to other qualifying functions including pausing, which is taught by Menand.  Ans. 7.  "Menand discloses at least one of the limitations which, in this case, is setting the first application to be paused."  *Id.*

Appellant's first contention is unpersuasive for the reason explained by the Examiner.  *Id.*  The Examiner applies Wilcox, not Menand as argued, for teaching concurrent running limitation (vi).  In particular, Appellant's argument fails to address the Examiner's finding that (i) Menand teaches one of the three claimed functions recited in the alternative,[3] i.e., to set the first application to be paused (Final Act. 3–4, citing Menand col. 12, l. 62 – col. 13, l. 2)[4] and (ii) Wilcox's resident application running together with a pizza ordering application teaches the disputed first and second applications are run concurrently (Final Act. 4, citing Wilcox ¶¶ 173–174).[5]  Thus, Appellant's argument is an improper attack on the references individually where the rejection is based on the combination of references.  *See In re Keller*, 642 F.2d 413, 426 (CCPA 1981); *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

Appellant next contends the combination is improper because the result would render Wilcox's user interface unsatisfactory for its intended

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[3] "[D]etermine from the new application table whether the first application is to be [1] paused, [2] ended, or [3] run concurrently with the second application."  Claim 1, element (iv).

[4] "Each [special signal] packet contains data directing that the currently executing AVI program is to suspend execution."  Menand col. 12, ll. 59–61.

[5] "Once executed, both the resident application and the pizza application run concurrently on the client terminal 9."  Wilcox ¶ 174.

purpose or would have changed it principle of operation. Appeal Br. 12–13. According to Appellant, combining Menand's pause function with Wilcox's interface would result in inconsistent, unpredictable behavior by pausing or ending functionality provided by the resident application. *Id.* The Examiner responds, explaining Wilcox is relied upon for teaching running applications concurrently, not for pausing or ending an application. Ans. 8. The Examiner further disagrees with Appellant's premise that Wilcox's resident application cannot be paused. *Id.* at 9.

Appellant's contention is unpersuasive. As noted by the Examiner, Wilcox is relied upon for running applications concurrently. It is Menand that is to be modified by incorporating Wilcox's concurrent running of applications, not Wilcox to incorporate Menand's pause feature. Final Act. 4. Thus, Appellant's argument does not address the combination made by the Examiner.

Furthermore, Appellant's argument is unpersuasive because it (i) is not supported by sufficient evidence and (ii) relies on bodily incorporation of one reference into another. In particular, Appellant fails to provide sufficient evidence that Wilcox's resident application could not be paused, particularly for some short period of time, without causing substantial degradation to its operation, e.g., resulting in an unacceptable delay in responding to user input. Mere attorney argument and conclusory statements, which are unsupported by factual evidence, and are entitled to little probative value. *In re Geisler*, 116 F.3d 1465, 1470 (Fed. Cir. 1997); *In re De Blauwe*, 736 F.2d, 699 705 (Fed. Cir. 1984). Attorney argument is not evidence. *In re Pearson*, 494 F.2d 1399, 1405 (CCPA 1974). Nor can such argument take the place of evidence lacking in the record.

Furthermore, Appellant's argument improperly relies on bodily incorporation of Menand's teachings rather than what the combination of Menand and Wilcox fairly suggests.

> The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.

*Keller*, 642 F.2d at 425 (citations omitted). The artisan is not compelled to mechanically follow the teaching of one prior art reference over the other without the exercise of independent judgment. *See Lear Siegler, Inc. v. Aeroquip Corp.*, 733 F.2d 881, 889 (Fed. Cir. 1984). Instead, the skilled artisan would "be able to fit the teachings of multiple patents together like pieces of a puzzle" because the skilled artisan is "a person of ordinary creativity, not an automaton." *KSR*, 550 U.S. at 420–21. Here, Appellant has not demonstrated that the Examiner's proffered combination in support of the conclusion of obviousness would have been "uniquely challenging or difficult for one of ordinary skill in the art." *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007) (citing *KSR*, 550 U.S. at 419–20). Thus, we are not persuaded that the combination of Menand and Wilcox would result in the invention of either reference being rendered unsatisfactory for its intended purpose or changed its principle of operation.

For the reasons discussed above, Appellant's contentions are not persuasive of reversible Examiner error. Accordingly, we sustain the rejection of claim 1 under 35 U.S.C. § 103(a) over Menand and Wilcox

together with the rejection of claims 2–7, which are not argued separately with particularity.

## CONCLUSION

The Examiner's rejection is affirmed.

## DECISION SUMMARY

| Claims Rejected | 35 U.S.C. § | Reference(s)/Basis | Affirmed | Reversed |
|---|---|---|---|---|
| 1–7 | 103(a) | Menand, Wilcox | 1–7 | |

## TIME PERIOD FOR RESPONSE

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