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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ALBERT STRAUB

Appeal 2019-002468
Application 15/331,828
Technology Center 2400

Before CATHERINE SHIANG, JASON J. CHUNG, and
MICHAEL T. CYGAN, *Administrative Patent Judges*.

CYGAN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 1–20, which are all of the pending claims in the application. *See generally* Appeal Br. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM IN PART.

¹ 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 Time Warner Cable, Inc. Appeal Br. 2.

CLAIMED SUBJECT MATTER

The claimed invention generally relates to user selection of interactive video software components in a television set-top box. Spec. 2:19–22.

Independent claim 1 is illustrative:

1. A method for allowing user selection of interactive video software components in a television set-top box operatively coupled to a video content network, the method comprising the steps of:

affording a user a selection of interactive video software components to run on the set-top box so as to form a list of selected interactive video software components;

matching the selected interactive video software components on the list to corresponding interactive software components available to load on the set-top box via one or more remote servers;

updating in response to the matching the list to reflect only corresponding interactive video software components available to load on the set-top box via download from one or more remote servers; and

loading the selected interactive video software components on the updated list onto the set-top box from the one or more remote servers.

Appeal Br. 11 (Claims App.). Independent claims 17 and 20 recite devices having limitations similar to that of claim 1. Appeal Br. 13–15. Dependent claims 2–16, 18, and 19 each incorporate the limitations of their respective independent claims. *Id.* at 11–15.

REFERENCES

Name	Reference	Date
Heredia	US 2003/0217369 A1	Nov. 20, 2003
Toft	US 7,072,950 B2	July 4, 2006
McCarthy et al. (McCarthy)	US 2008/0040767 A1	Feb. 14, 2008

Poli et al. (Poli)	US 2009/0007215 A1	Jan. 1, 2009
Straub	US 9,479,812 B2	Oct. 25, 2016

REJECTIONS

Claims 1–4, 6–8, and 17–20 are rejected under nonstatutory double patenting over Straub, Toft, and McCarthy.

Claims 1–4, 6–8, and 17–20 are rejected under 35 U.S.C. § 103(a) as being obvious over the combination of Toft and McCarthy.

Claims 5, 9, 15, and 16 are rejected under 35 U.S.C. § 103(a) as being obvious over the combination of Toft, McCarthy, and Poli.

Claims 10–14 are rejected under 35 U.S.C. § 103(a) as being obvious over the combination of Toft, McCarthy, and Heredia.

OPINION

1. Double Patenting

Appellant has not contended that the Examiner erred in rejecting claims 1–4, 6–8, and 17–20 on the ground of nonstatutory double patenting as being unpatentable over claims 1–4, 6–8, 13, 17, and 19 of Straub in view of Toft and McCarthy. App. Br. 5. Although Appellant has submitted a Terminal Disclaimer, the Examiner has not made a determination that the nonstatutory double patenting rejection is withdrawn. Accordingly, we sustain, *pro forma*, the rejection of claims 1–4, 6–8, and 17–20 on the ground of nonstatutory double patenting. *See* 37 C.F.R. § 41.37(c)(1)(iv); *see also* Manual of Patent Examining Procedure (MPEP) § 1205.02 (9th ed. Rev. 08. 2017, Jan. 2018).²

² *See* MPEP 1214.06 (I) for procedures for seeking to overcome a nonstatutory double patenting rejection following a Board decision.

2. *Obviousness*

a) *Claims 1–4, 6–8, and 17–20*

We have reviewed the Examiner’s obviousness rejections (Final Act. 14–22, Ans. 3–7) in light of Appellant’s contentions that the Examiner has erred (Appeal Br. 5–8, Reply Br. 2–4). Appellant contends that the Examiner errs in finding McCarthy to teach the claimed “matching” and “updating” steps recited in claim 1, i.e.,

matching the selected interactive video software components on the list to corresponding interactive software components available to load on the set-top box via one or more remote servers;

updating in response to the matching the list to reflect only corresponding interactive video software components available to load on the set-top box via download from one or more remote servers

Appeal Br. 11 (Claims App.). We are not persuaded by Appellant’s contention of Examiner error in rejecting claims 1–4, 6–8, and 17–20 under 35 U.S.C. § 103. We begin with claim 1.

The Examiner finds the claimed “matching” and “updating” steps to be missing from Toft, but taught by McCarthy. Final Act. 14–15 (citing McCarthy ¶¶ 36, 37, 41, and 42); Ans. 4–6.

Appellant argues that claim 1 addresses a situation in which a software component is not *available* for download via one or more servers. Appeal Br. 6. Appellant argues that McCarthy assumes that the requested applications are necessarily available for download, and instead determines whether the applications can be run on the existing equipment. *Id.* Appellant argues, “McCarthy therefore foregoes *matching* and *updating* steps in the manner of independent claim 1 to address non-availability for

download.” *Id.* at 7. Appellant further argues that such non-availability is functionally the same as the claimed “updating in response to the matching the list *to reflect only corresponding interactive video software components available for download.*” Reply Br. 2–3.

We are not persuaded by Appellant’s arguments. Appellant’s Specification discusses availability of software components; i.e., “available applications for this type of hardware.” Spec. 18:1–8; Fig. 8, item 7018. This type of availability is consistent with McCarthy’s determination of whether the set-top box “can support execution of the requested application.” McCarthy ¶¶ 37, 38. McCarthy, in determining whether an application can be run on existing equipment, makes a determination whether (or not) an alternate version of the application is available for download. McCarthy ¶¶ 40, 41. If such an alternate version is available, the application can send that version to the set-top box. *Id.* Consequently, we are not persuaded by Appellant’s argument that McCarthy assumes that the requested applications are necessarily available for download.

Accordingly, we are not persuaded of error in the Examiner’s obviousness rejection of claim 1. Claims 2–4, 6–8, and 17–20 are rejected under the same grounds of rejection as claim 1. Appellant has not argued those claims separately, and they fall with claim 1. 37 C.F.R. § 41.37(c)(1)(iv). Accordingly, we affirm the Examiner’s rejection of claims 1–4, 6–8, and 17–20.

b) Claims 5, 9, 15, and 16

Claims 5, 9, 15, and 16 are rejected under the combination of McCarthy and Toft, as applied to claim 1, further in view of Poli. Appellant has argued those claims on the same reasoning as for claim 1, and for the

reasons expressed in affirming the Examiner's rejection of claim 1, we affirm the Examiner's rejection of claims 5, 9, 15, and 16.

c) Claims 10–14

Claims 10–14 are rejected under the combination of McCarthy and Toft, as applied to claim 1, further in view of Heredia. Appellant has argued claims 11–14 on the same reasoning as for claim 1, and for the reasons expressed in affirming the Examiner's rejection of claim 1, we affirm the Examiner's rejection of claims 11–14.

Appellant argues against the rejection of claim 10 on the additional ground that the Examiner has improperly found Heredia to teach or suggest the claimed step of “determining whether two-way communication between the set-top box and a configuration database is unavailable.” Appeal Br. 8. We are persuaded by Appellant's argument.

The Examiner's rejection of claim 10 states that “Her[e]dia discloses” such a step at Figure 7 and paragraph 80. Final Act. 23. The Examiner finds that Heredia retrieves applications via communication lines/links 212–220. Ans. 8. (citing Heredia ¶¶ 70–71). The Examiner further finds that if a desired application is determined to be already stored locally, then there is no need to retrieve the application by activating the communication lines/links. *Id.*

None of those findings relate to the act set forth in the claim, which is the act of determining whether communication is unavailable. Heredia determines whether the application is locally stored, not whether communication is available via lines/links 210–220. Heredia “determine[s] what applications 316 are available and how to activate them,” and if the application is instead “located at application(s) 716 of proxy server 714 . . .

[and] not already stored as part of applications 316, then client device 108 retrieves the particular application from proxy server 714 [using] communications lines/links 212–220.” Heredia ¶¶ 70–71. If the application is determined to be locally stored, Heredia does not take any communicative steps, and thus, will not determine whether communication is available. *Id.* Accordingly, we determine that there is no explicit or implicit discussion in the cited portions of Heredia of determining whether communication is unavailable.

Instead, the Examiner reasons that if there was (hypothetically) a problem with the communications, Heredia would discover that problem. The Examiner notes that the communication lines/links indicate communication in both directions, such that if no communication received, then the application is not activated, “which can be a determination of communications.” Ans. 8.

However, the Examiner does not point to any teaching in Heredia of determining that an application is not activated. Heredia contemplates finding an application either locally or on a server, and then activating that application. Heredia ¶ 71. Thus, even were the Examiner’s reasoning correct, the Examiner has not pointed to any teaching or suggestion in Heredia of determining whether there has been a failure to activate an application that would indicate that communications are unavailable.

Furthermore, Appellant argues that any hypothetical failure to activate an application may result from a number of conditions, such that such failure does not necessarily indicate that communication is unavailable. Reply Br. 5 (citing other possible reasons such as broken server, corrupted file, or lack of

storage space). This accords with the Examiner's finding that a failure to indicate "may" (not "must") indicate unavailable communication. Ans. 8.

Consequently, we are persuaded the Examiner has not pointed to any teaching or suggestion in Heredia of determining that communication is unavailable. Because the Examiner has relied solely on Heredia for that teaching (Ans. 8), we determine that the Examiner has not shown that the combination of Toft, McCarthy, and Heredia teaches or suggests all of the limitations of claim 10. Accordingly, we reverse the Examiner's rejection of claim 10.

CONCLUSION

For the above-described reasons, we reverse the Examiner's rejection of claim 10 as being obvious over Toft, McCarthy, and Heredia under 35 U.S.C. § 103(a). We sustain the Examiner's rejections of claims 1–9 and 11–20 over the applied combinations of prior art under 35 U.S.C. § 103(a). We sustain, *pro forma*, the Examiner's rejection of claims 1–4, 6–8, and 17–20 on the grounds of non-statutory double patenting over claims 1–4, 6–8, 13, 17, and 19 of Straub in view of Toft and McCarthy.

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).

DECISION SUMMARY

In summary:

Claims Rejected	35 U.S.C. §	References/Grounds	Affirmed	Reversed
1-4, 6-8, 17-20	101	Non-Statutory Double Patenting	1-4, 6-8, 17-20	
1-4, 6-8, 17-20	103(a)	Toft, McCarthy	1-4, 6-8, 17-20	
5, 9, 15,16	103(a)	Toft, McCarthy, Poli	5, 9, 15,16	
10-14	103(a)	Toft, McCarthy, Heredia	11-14	10
Overall Outcome			1-9, 11-20	10

AFFIRMED IN PART