

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HENRY C. DEBEY

Appeal No. 2000-1643
Application 08/897,900

ON BRIEF

Before JERRY SMITH, FLEMING, and BLANKENSHIP, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 22 and 30, which constitute all the claims remaining in the application.

The disclosed invention pertains to a method for optimizing transmission of a program over a distribution system for multiple users. The program is divided into a plurality of segments, at least some of which are further divided into a plurality of fragments, and during each time interval one fragment of each segment is transmitted

to the users' receivers.

Representative claim 22 is reproduced as follows:

22. A method of transmitting a program to multiple users over a distribution system comprising:

providing a program divided into a plurality of segments wherein at least some of the segments are divided into a plurality of fragments; and

during each predetermined time interval transmitting one fragment of each segment to users' receivers.

The examiner relies on the following references:

Dancis et al. (Dancis)	3,731,282	May 1, 1973
Gimple et al. (Gimple)	4,430,731	Feb. 7, 1984
Yarbrough et al. (Yarbrough)	4,598,288	Jul. 1, 1986

Claims 22 and 30 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Yarbrough in view of Gimple with respect to claim 22, and the examiner adds Dancis to this combination with respect to claim 30.

Rather than repeat the arguments of appellant or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the briefs

Appeal No. 2000-1643
Application No. 08/897,900

along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 22 and 30. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of

Appeal No. 2000-1643
Application No. 08/897,900

complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered [see 37 CFR § 1.192(a)].

With respect to independent claim 22, the examiner cites Yarbrough as teaching a system which provides a program divided into a plurality of segments wherein at least some of the segments are combined and transmitted. The examiner acknowledges that Yarbrough does not disclose that the segments are divided into fragments and transmitted to the user as claimed. The examiner cites Gimple as teaching a CATV system for dividing a segment (192 bits) into a plurality of fragments (24 frames) and transmitted to users in time intervals (time slots). The examiner finds that it would have been obvious to the artisan to divide the Yarbrough program segments into fragments as taught by Gimple to control the ability of Yarbrough to more dynamically adapt to

specific parameters of the broadcasted segments in Yarbrough [answer, pages 3-4].

Appellant argues that the examiner's rejection does not address the last step of claim 22. Specifically, appellant argues that the cited references do not teach or suggest the transmission of one fragment of each segment during each predetermined time interval. Appellant also argues that Yarbrough and Gimple cannot be combined because the packetized transmission protocol of Gimple is irrelevant to the program segments of Yarbrough. Appellant also notes that there is no explicit or implicit suggestion within the references that they could be combined. Appellant argues that the motivation to combine provided by the examiner is not suggested anywhere within the cited references [brief, pages 4-8].

The examiner responds that the step of transmitting one fragment of each segment during each time interval is "inherent to the claimed invention" [answer, page 5]. The examiner also notes that Yarbrough and Gimple both relate to program distribution systems so that they are properly combinable. Finally, the examiner responds that his motivation to combine is supported by Yarbrough [id., pages 6-7].

Appellant responds that the examiner has still not cited any art which teaches transmitting one fragment of each segment during each time interval. Appellant argues that there is nothing in Yarbrough to suggest dividing the program into individual fragments that can be transmitted nonsequentially, resulting in noncontiguous transmission of the program. Appellant also responds that the fact that Yarbrough and

Appeal No. 2000-1643
Application No. 08/897,900

Gimple both relate to program distribution systems is insufficient as a basis to combine them. Appellant asserts that the two references are nonanalogous art because they relate to different fields of endeavor. Finally, appellant responds that each of the portions of the prior art cited by the examiner fails to support the findings as asserted by the examiner [reply brief].

We will not sustain the examiner's rejection of claim 22 because the examiner has failed to establish a prima facie case of obviousness. The teachings of the applied prior art establish nothing more than the fact that the program segments of Yarbrough can be comprised of a plurality of bits, frames or superframes. Thus, the applied prior art teaches that as program segments in Yarbrough are transmitted to the users, these segments may include a plurality of bits, frames or superframes. Even if the applied prior art teaches this much, however, we agree with appellant that there is no teaching that within any predetermined time interval a single (one) fragment of each program segment is sent to the users' receivers as claimed. The examiner asserts that this is inherent to appellant's invention, but this assertion is not relevant to the obviousness of the claimed invention. The examiner has failed to identify where within the applied prior art there is any suggestion to transmit one fragment of each program segment to users' receivers as recited in claim 22. We agree with appellant that the portions of the prior art cited by the examiner do not support the examiner's position. Therefore, we do

Appeal No. 2000-1643
Application No. 08/897,900

not sustain the rejection of claim 22.

With respect to claim 30, appellant argues that Dancis does not teach the claimed relationship between the predetermined time interval during which one fragment from each of a plurality of segments is transmitted and the playback interval of a segment [brief, pages 8-9]. The examiner responds that the playback time interval in Dancis is monostable [answer, page 7]. Appellant responds that this assertion, even if true, is irrelevant to the claimed invention [reply brief].

We do not sustain the examiner's rejection of claim 30 for the reasons asserted by appellant in the briefs. We also note that Dancis does not overcome the deficiencies in the basic combination of Yarbrough and Gimple which were discussed above.

In summary, we have not sustained either of the examiner's rejections of the claims on appeal. Therefore, the decision of the examiner rejecting claims 22 and 30 is

Appeal No. 2000-1643
Application No. 08/897,900

reversed.

REVERSED

JERRY SMITH)	
Administrative Patent Judge)	
)	
MICHAEL R. FLEMING)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
HOWARD B. BLANKENSHIP)	
Administrative Patent Judge)	

JS:yr

cc: Barry D. Rein, Esq.
PENNIE & EDMONDS
1155 Avenue of the Americas
New York, N.Y. 10036-2711