

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRIAN P. DOUGHERTY, ALLAN C. THYGESEN
and MICHAEL CAPUANO

Appeal No. 2002-1952
Application No. 09/071,373¹

HEARD: APRIL 3, 2003

Before BARRETT, FLEMING, and SAADAT, Administrative Patent Judges.
SAADAT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the Examiner's final rejection of claims 1 and 3-27. Claim 2 has been cancelled.

We reverse.

BACKGROUND

Appellants' invention is directed to establishing a reminder to a viewer about future broadcast and non-broadcast events without having to traverse through a program listing. As

¹ Application for patent filed April 30, 1998.

depicted in Figure 1, broadcast server 110, through data insertion unit 116, transmits interactive application 115 to broadcast receiver 120 for establishing reminders for such events (specification, pages 9 and 11). The reminder is stored in a memory of the broadcast receiver which establishes a timer based on the reminder data for future display of the reminder to the viewer (specification, page 17). Thus, the viewer can activate the reminder interactive application concurrently while viewing a broadcast or a non-broadcast program without having to access and traverse through a separate and complex program guide which usually does not include any non-broadcast programs.

Representative independent claim 1 is reproduced as follows:

1. A computer implemented method of operating a broadcast receiver for establishing reminders for events related to broadcast programs, the broadcast receiver including a local memory, the method comprising:

receiving at the broadcast receiver broadcast data including at least one broadcast program and separate reminder data associated with the broadcast program;

displaying the broadcast program on a display device coupled to the broadcast receiver;

during the display of the broadcast program, and without requiring a previous display of a program listing, receiving a user input to establish a reminder for an event related to the broadcast program;

storing in the local memory of the broadcast receiver the reminder data for the event, including data for determining a future time to display the reminder, and

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a description of the event, the reminder data stored in the local memory until the future time;

determining in the broadcast receiver from the locally stored reminder data whether to display the reminder at the future time; and

responsive to the future time, displaying on the display device the reminder including the description of the event.

The prior art references of record relied upon by the Examiner in rejecting the appealed claims are:

Florin et al. (Florin)	5,594,509	Jan. 14, 1997
Kelly et al. (Kelly)	5,907,322	May 25, 1999 (filed Oct. 16, 1996)

Claims 1 and 3-27 stand rejected under 35 U.S.C. § 103 as being unpatentable over Florin and Kelly.

We make reference to the answer (Paper No. 20, mailed March 22, 2002) for the Examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 18, filed February 12, 2002) and the reply brief (Paper No. 21, filed June 6, 2002) for Appellants' arguments thereagainst.

OPINION

The Examiner relies on Florin for teaching the steps of receiving and displaying of broadcast data, receiving a user input to establish a reminder and displaying the reminder at a future time (answer, page 3). The Examiner, however, indicates

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that Florin does not disclose that the programs are marked for establishing reminders without requiring a previous display of a program listing (answer, page 4). The Examiner bases a conclusion of obviousness on teachings of Kelly that TV events may be bookmarked as they are broadcast since user does not need to sort through the program listing (answer, page 5).

Appellants argue that Florin's mark button performs one of the two functions of jumping among currently-viewed programs which are marked and establishing a reminder for a future program using a program listing (brief, page 6). Additionally, Appellants assert that the jump feature is accessed by pressing the mark button while viewing a program, whereas the reminder feature is accessed by pressing the mark button while viewing the program listing (id.). Appellants further point out that the bookmarking function of Kelly is similar to creating a list of web sites and is unrelated to providing a reminder for an event related to a program (brief, pages 7 & 8).

In response, the Examiner argues that Florin's jump feature is used for jumping to a program that "had been 'marked' or 'reminded' at an earlier point in time so that one can viewed [sic.] the marked program at a later time by pressing the jump button" (answer, page 6). Furthermore, the Examiner makes the

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assertion that Kelly's "bookmark" feature is equivalent to the teaching of setting a reminder for later viewing (answer, page 7).

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). To reach a conclusion of obviousness under § 103, the examiner must produce a factual basis supported by teaching in a prior art reference or shown to be common knowledge of unquestionable demonstration. Our reviewing court requires this evidence in order to establish a prima facie case. In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). The Examiner must not only identify the elements in the prior art, but also show "some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead the individual to combine the relevant teachings of the references." In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

A review of Florin confirms that the reference relates to a system for viewing and interacting with programs and services from a number of sources and to a controller for managing the

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selection and interaction with the programs (col. 1, lines 25-32). Florin further describes a remote control for communicating with a transceiver that includes a number of user selectable interactive functions such as, among others, a mark button and a jump button (Figs. 5a and 5b, col. 3, lines 9-16). The programs that are listed by using list button 138, may be marked by mark button 142 for setting reminders, recalling or switching between programs (col. 12, lines 6-12 and col. 17, lines 31-42). The user may then switch among the programs that were marked by the mark button by pressing jump button 132 (col. 12, lines 12-20). Therefore, Florin's interactive system is incapable of setting reminders at the same time a broadcast program is displayed and performs the mark and jump functions only when a program listing is displayed.

Kelly, on the other hand relates to a system for marking a number of TV broadcast events selected by a viewer and storing a set of data associated with each selected broadcast, which are later transmitted to an on-line database (col. 1, lines 54-64). As depicted in Figure 1, Kelly provides a system for marking broadcast events that retrieves the associated information from on-line service 60 (col. 2, lines 37-44) and allows the viewer to "bookmark" a set of TV events as they are being broadcast (col.

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2, lines 44-48). Kelly, in fact, provides for entry of data for describing date, time and channel of the selected event in the form of a bookmark entry for custom programming (col. 3, lines 44-50), that may also be used to evaluate viewer preferences and viewing patterns (col. 4, lines 34-37).

Based on our findings above, we agree with Appellants' argument (reply brief, page 2) that even if Kelly's bookmarking of TV programs may be used in the interactive system of Florin for marking programs from a program listing, it does not provide for establishing reminders for future broadcasts while viewing the program, as required by Appellant's claim 1. In that regard, while Florin indicates that programs are marked for reminders (col. 12, lines 9-12) and Kelly marks a program for date, time and channel, the combination fails to teach or suggest establishing a reminder for an event or a future broadcast related to the broadcast program as the broadcast program is being displayed and without requiring a previous display of a program listing. In fact, Kelly accesses the on-line broadcast listings in central database 40 for bookmarking a selected broadcast event or website for automated future viewing. Therefore, contrary to the Examiner's assertion (answer, page 7) that "Kelly's 'bookmark' feature is equivalent to the teaching of

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setting a reminder for later viewing," Kelly still bookmarks broadcast events or sets reminders from a program listing and cannot cure the deficiencies of Florin.

Appellants further argue that there is no motivation to combine the teachings of Florin and Kelly because each reference deals with a problem different from the claimed establishing a reminder without the requirement of previously displaying a program listing (brief, pages 9 & 10). Additionally, Appellants point to the lack of concern for allowing a user to set a reminder without using a program listing in the applied art (brief, page 10). Appellants assert that Kelly merely adds data associated with a current broadcast to a database and therefore, provides no suggestion for modifying Florin to result in the claimed invention (id.).

The Examiner repeatedly states that saving the user's time spent for "sorting through extraneous menu layers" (answer, pages 9 & 10), is the reason for combining Florin and Kelly. However, the Examiner has not pointed to any specific teachings in the prior art related to saving the user's time or other teachings that would have motivated one of ordinary skill in the art to combine Kelly and Florin, nor do we find such reasons in the references. We agree with Appellants that the disclosure of

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Florin would not have suggested the desirability of setting a reminder without using a program listing based on the teachings of Kelly. In that regard, while Florin is concerned with marking programs from a program listing and Kelly uses bookmarks associated with display programs for adding their relevant information to a database, their combination does not suggest establishing a reminder without requiring a previous display of a program listing.

Thus, the Examiner has failed to establish a prima facie case of obviousness as the necessary teachings and suggestions to establish a reminder for an event related to a program without using a program listing are not present in the applied prior art. We note that independent claims 7, 9, 13, 14, 15 and 20 all recite limitations related to the user input for establishing a reminder for the future broadcast of a program without requiring a previous display of a program listing, which are neither taught nor suggested by the combination of the applied prior art. Accordingly, we do not sustain the rejection of independent claims 1, 7, 9, 13, 14, 15 and 20 as well as claims 3-6, 8, 10-12, 16-19 and 21-27, which are dependent thereupon, under 35 U.S.C. § 103 over Florin and Kelly.

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CONCLUSION

In view of the foregoing, the decision of the Examiner
rejecting claims 1 and 3-27 under 35 U.S.C. § 103 is reversed.

REVERSED

LEE E. BARRETT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
MICHAEL R. FLEMING)	APPEALS
Administrative Patent Judge)	AND
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