

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KWANG-YOUN PARK and YONG-HO KIM

Appeal No. 2003-0523
Application No. 09/100,952

HEARD: November 20, 2003

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

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-12, which are all the claims in the application.

We affirm.

BACKGROUND

The invention is directed to method and apparatus for “reserve-recording” of a television broadcast while a user views the program. According to appellants (specification at 4, ll. 5-11), in the prior art a user must exit viewing of the broadcast to enter information for the recording. Representative claim 1 is reproduced below.¹

1. A method for reserve-recording a broadcast program during viewing by a user, comprising the steps of:

- (a) pre-storing program identification information contained in broadcast signals of broadcast stations;
- (b) selecting a given broadcast program for reserve-recording during viewing of the given broadcast program;
- (c) maintaining the viewing of the given broadcast program selected at step (b) without interruption while reading program identification information corresponding to the selected given broadcast program from the program identification information pre-stored at step (a); and
- (d) setting reserve-recording data using the program identification information read at step (c).

The examiner relies on the following references:

Young et al. (Young)	5,479,266	Dec. 26, 1995
Lawler et al. (Lawler)	5,699,107	Dec. 16, 1997 (filed Apr. 10, 1996)
Yuen et al. (Yuen)	6,154,203	Nov. 28, 2000 (effectively filed May 4, 1998)

¹ We note that the amendment to the claims filed August 23, 2001 has not been formally entered in the file wrapper.

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Claims 1-12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Young, Lawler, and Yuen.

We refer to the Final Rejection (Paper No. 9) and the Examiner's Answer (Paper No. 15) for a statement of the examiner's position and to the Brief (Paper No. 14) and the Reply Brief (Paper No. 17) for appellants' position with respect to the claims which stand rejected.

OPINION

Instant claims 1-12 are rejected over the combined teachings of Young, Lawler, and Yuen, as set forth at pages 3 through 6 of the Final Rejection. Appellants' arguments in response to the rejection focus on admitted deficiencies of individual references. However, the arguments do not speak to the combination of the references applied. Nonobviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references. In re Merck & Co., 800 F.2d 1091, 1097, 231 USPQ 375, 380 (Fed. Cir. 1986) (citing In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981)).

We agree, for example, that Yuen fails to teach "reserve-recording" as claimed. The reference thus cannot, by itself, teach reserve-recording in combination with any other feature. However, the rejection does not rely on Yuen for "reserve-recording," nor for any combination of features that includes reserve-recording. The arguments are thus directed to issues not in controversy.

Yuen teaches maintaining viewing of a broadcast program (i.e., the program to which the equipment is currently tuned) while allowing management of menu operations related to program listings. The reference discloses keeping a record of the latest channel tuned while in the full screen viewing mode. Col. 3, l. 66 - col. 4, l. 16. As shown in Figure 2, the currently-tuned video program is maintained in picture-in-picture (PIP) window 42 as the user views text information. Upon switching from the full screen mode, the currently-tuned program is displayed in the PIP window. The channel tuning may subsequently be changed from the menu, but is not necessarily changed, depending on the user's entries. Col. 4, l. 17 - col. 5, l. 10. The reference discloses several embodiments (e.g., col. 7, l. 32 - col. 8, l. 17) that reflect the artisan's skill in designing flexible user interfaces.

Young discloses a system (Figs. 22A and 22B) including a programmable tuner 202 that acquires program identification information from broadcast signals of broadcast stations. The information is stored in schedule memory 232. Col. 12, l. 47 - col. 13, l. 11. Young further describes Record Memo RAM 236 which receives the information when time-shift recording is selected (col. 13, ll. 25-35) or when recording is manually controlled (col. 13, l. 64 - col. 14, l. 11).

In Young's menu that displays current and future program information, a channel to which the tuner is tuned is highlighted on grid 24, as shown at 56 (Fig. 1). Col. 7, ll. 7-17. Young further shows, in Figure 12, an express recording screen 74. Col. 8, ll. 14-21.

Young's description of manually controlled recording, and likely the description of express recording, teaches the recording of a program currently being broadcast. Lawler, also teaching recording of a current broadcast program, may thus be viewed as merely cumulative in the teachings of the applied references.

We agree with the examiner's finding² that the combined teachings of Young and Yuen would have suggested maintaining the viewing of the currently-viewed broadcast program in a PIP window, to avoid interruption of viewing of the program while viewing the menu displays described by Young. Suggestion for combination may come explicitly from the statements in the prior art. However, contrary to appellants' view, there is no requirement that the prior art contain an express suggestion to combine known elements to achieve the claimed invention. Rather, the suggestion to combine may come from the prior art, as filtered through the knowledge of one skilled in the art. Motorola, Inc. v. Interdigital Tech. Corp., 121 F.3d 1461, 1472, 43 USPQ2d 1481, 1489 (Fed. Cir. 1997); see also Cable Elec. Prods., Inc. v. Genmark, Inc., 770 F.2d 1015, 1025, 226 USPQ 881, 886-87 (Fed. Cir. 1985) ("[T]he suggestion to modify the art to produce the claimed invention need not be expressly stated in one or all of the references used to show obviousness. 'Rather, the test is what the combined teachings

² The presence or absence of a motivation to combine references in an obviousness determination is a pure question of fact. In re Gartside, 203 F.3d 1305, 1316, 53 USPQ2d 1769, 1776 (Fed. Cir. 2000).

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of the references would have suggested to those of ordinary skill in the art.”) (quoting In re Keller, 642 F.2d at 425, 208 USPQ at 881).

Appellants also contend that displaying the current broadcast program in a smaller (i.e., PIP) window would not be “maintaining viewing of the given broadcast program” as claimed. We do not see how claims of the scope presented might be thought to distinguish over Yuen’s use of a smaller window. We are also unpersuaded by appellants’ arguments that program guide information is a “prospective” prediction of broadcast, while the claimed program identification is a “contemporary” identification of the broadcast. Again, we see nothing in the claims that sets forth the allegedly distinguishing feature.

Appellants do not rely on the particulars of any claim in the arguments with respect to patentability over the prior art. Appellants’ Brief, however, purports separate groupings of the claims, and repeats limitations of the claims at pages 6 through 8. We do not consider the remarks to rise to the level of arguments for separate patentability, under the current rules, which were also in effect at the time of appellants’ filing of the Brief. See 37 CFR § 1.192(c)(7) (“Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.”). See also 37 CFR § 1.192(c)(8)(iv) (“For each rejection under 35 U.S.C. 103, the argument shall specify the errors in the rejection and, if appropriate, the specific limitations in the rejected claims which are not described in the prior art relied on in the rejection, and

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shall explain how such limitations render the claimed subject matter unobvious over the prior art.”).

We thus select instant claim 1 as representative of the invention. To the extent that appellants’ remarks might be considered to include arguments for separate patentability, we refer to the examiner’s findings in the Final Rejection and the Answer in support of the instant rejection. We have considered all of appellants’ arguments, but are not persuaded of error in the examiner’s determination of obviousness as to any of the claims.

We therefore sustain the rejection of claims 1-12 under 35 U.S.C. § 103 as being unpatentable over Young, Lawler, and Yuen.

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CONCLUSION

The rejection of claims 1-12 under 35 U.S.C. § 103 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

JERRY SMITH
Administrative Patent Judge

MICHAEL R. FLEMING
Administrative Patent Judge

HOWARD B. BLANKENSHIP
Administrative Patent Judge

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