

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

## UNITED STATES PATENT AND TRADEMARK OFFICE

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### BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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Ex parte DANIEL T. DAUM and GEORGE E. SCOTT, III

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Appeal No. 2005-2184  
Application No. 09/457,728

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#### ON BRIEF

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Before THOMAS, CRAWFORD, and LEVY, Administrative Patent Judges.  
CRAWFORD, Administrative Patent Judge.

#### DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 7 and 9, which are all of the claims pending in this application. Claims 10 to 22 have been canceled. Claims 8 and 23 have been allowed.

The appellants' invention relates to a hardware circuit which may tune to radio frequency broadcast and media streams over a digital network (specification, pages 10) . A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

#### THE PRIOR ART

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

Göken	5,584,051	Dec. 10, 1996
Mackintosh et al. (Mackintosh)	6,317,784 B1	Nov. 13, 2001
		(filed Sep. 29, 1998)

#### THE REJECTION

Claims 1 to 7 and 9 stand rejected under 35 U.S.C. § 103 as being unpatentable over Göken in view of Mackintosh.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (mailed December 23, 2003 for the examiner's complete reasoning in support of the rejections, and to the brief (filed October 01, 2003) for the appellants' arguments thereagainst.

#### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The examiner has rejected claims 1 to 7 and 9 under 35 U.S.C. § 103 as being unpatentable over Göken in view of Mackintosh. We initially note that the test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). Moreover, in evaluating such references it is proper to take into account not only the specific teachings of the references but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

In the examiner's view Göken describes the invention as recited in claim 1 except that Göken does not describe an Internet interface. The examiner relies on Mackintosh for describing a receiver configured to receive audio program segments over the Internet from a broadcast service provider comprising an Internet interface. The examiner concludes:

. . . it would have been obvious to one having ordinary skill in the art at the time of the invention was made to use Mackintosh's receiver in Göken's invention in order to improve and provide the use of an analog and/or digital radio broadcast transmission system via Internet. [answer at page 4].

We will not sustain this rejection. When it is necessary to select elements of various teachings in order to form the claimed invention, we ascertain whether there

is any suggestion or motivation in the prior art to make the selection made by the appellants. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. The extent to which such suggestion must be explicit in, or may be fairly inferred from, the references, is decided on the facts of each case, in light of the prior art and its relationship to the appellants' invention. As in all determinations under 35 U.S.C. § 103, the decision maker must bring judgment to bear.

It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the appellants' structure as a template and selecting elements from references to fill the gaps. The references themselves must provide some teaching whereby the appellants' combination would have been obvious. In re Gorman, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (citations omitted). That is, something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. See In re Beattie, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992); Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick Co., 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984).

Göken describes a radio which has a hybrid receiver that is capable of receiving digital as well as analog signals. When the program is available in both digital and

analog formats, the receiver is capable of switching between the audio and digital systems so that the best reception is provided for the program. (Abstract).

Mackintosh describes a system for delivering broadcast material to a listener via the Internet (col. 3, lines 17 to 21). In Mackintosh, a radio station provides broadcast material to a broadcast Internet provider (col. 8, lines 41 to 44). The Internet service provider then provides the broadcast to the listener via the listener's computer (col. 3, lines 17 to 19).

The examiner does not direct our attention to anything in the prior art which would have motivated a person of ordinary skill in the art to provide an Internet interface available through a computer in the Göken radio. Rather, the examiner reasons, without reference to Göken or Mackintosh, that a person of ordinary skill in the art would have been motivated to include the internet interface described in Mackintosh in the Göken radio in order to improve and provide the use of an analog and/or digital radio broadcast transmission via Internet. As we stated above, the motivation must come from the references themselves. In addition, as Göken describes a radio that can receive both analog and digital broadcast and does not include a computer, it is not clear why a person of ordinary skill in the art would have been motivated to include an Internet interface. We agree with the appellants that there is no motivation to combine the teachings of Göken and Mackintosh. Therefore, we will not sustain the rejection.

The decision of the examiner is reversed.

REVERSED

JAMES D. THOMAS )  
Administrative Patent Judge )  
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MURRIEL E. CRAWFORD ) BOARD OF PATENT  
Administrative Patent Judge ) APPEALS  
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STUART S. LEVY )  
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**Comment [jvn1]:** Type address

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