

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

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PATRICK H. HAYES, PAUL D. ARLING, and
ROBERT P. LILLENESS

Appeal 2006-3350
Application 10/287,411
Technology Center 2100

Decided: March 21, 2007

Before KENNETH W. HAIRSTON, ALLEN R. MACDONALD, and
JAY P. LUCAS, *Administrative Patent Judges*.

LUCAS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134 (2002) from a final rejection of claims 1 to 29. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

Appellants invented a handheld “remote control unit” for a television or the like appliance that displays a program guide representing the programs that will be available for viewing on the television. The user can

select a program to be viewed or recorded from that guide, which will be remembered by the handheld unit until it can establish communications with the appliance and schedule the recording of the program.

In the words of the Appellants:

In accordance with the description that follows, a system and method is provided for controlling the recording functionality of an appliance using an electronic program guide displayed on an electronic portable device. As will be appreciated, providing this functionality to a portable device overcomes the disadvantages seen in the prior art resulting from the fact that a consumer user is not necessarily in front of their recording appliance when browsing the program guide information. Rather, the consumer may be in another room, another building (e.g. at work), or even in another city.

To overcome this problem, the system and method described hereinafter will accept the consumer's recording requests, store them, and automatically convey them to a target recording apparatus at a later time when the portable device is able to communicate with the recording appliance.

Claim 1 is representative of the claims on appeal, and is reproduced below:

1. A method performed in a portable device to enable a user to effect recording of a program, the method comprising:

displaying to a user in a display of the portable device a program guide including a listing for the program;

in response to receiving input from the user requesting that the program be recorded, storing in a memory of the portable device data indicative of the recording request; and

causing the portable device to provide the data indicative of the recording request stored in the memory to an appliance capable of effecting a recording of the program in response to the portable device establishing communication with the appliance.

The prior art relied upon by the Examiner in rejecting the claims on appeal are:

Huang	US 6,437,836 B1	Aug. 20, 2002
Sai	US 6,822,661 B2	Nov. 23, 2004

The Examiner rejected claims 1 to 29 under 35 U.S.C. § 103(a) for being obvious over Huang in view of Sai.

Appellants contend that the claimed subject matter would not have been obvious. More specifically, Appellants contend that the reference disclosures cannot properly be combined because the Examiner has failed to establish an adequate reason to combine. The Examiner contends that it would have been obvious to incorporate Sai's teachings of memorizing a recording command into a method as disclosed by the program recorder of Huang.

We reverse.

ISSUE

The single issue is whether the Examiner erred in combining the Huang and the Sai references.

FINDINGS OF FACT

1. We find that Appellants invented a claimed method (and device) comprising the steps of [paraphrased] ... displaying a program guide in a portable device; receiving a request to record a program; storing data indicative of the recording request in the portable device; establishing communication with a recording appliance and causing the portable device to provide the recording request to the appliance. (*See claim 1 above for the exact language.*)
2. On review of the Huang reference, we find it teaches the display of a program guide in a handheld portable device (see Figure 1), and the receiving of a request to record a program (see col. 5, l. 28) which is transmitted to a TV or a recording appliance (see col. 8, ll. 22 to 32).
3. Careful study of the logic diagram in Figure 4 of Huang, and the supporting text (see col. 8, ll. 22 to 32) indicates that there is no teaching of the storing in a memory of the portable device data indicative of the recording request. Instead, the Huang device teaches an instantaneous action- if the request is received while the program is on, then the channel of the TV is turned to that program. If the TV program is not yet on, then the Huang device will program a VCR appliance to record the TV program. An essential element of the claimed invention is lacking.
4. Examiner presents the Sai reference to provide the teaching of the storage of the record request, and transmission of it to the recording

appliance when a communications channel is established. Examiner indicates in his Answer 3:

The Sai INFORMATION DISPLAY CONTROL APPARATUS AND METHOD patent discloses in response to receiving input from the user requesting that the program be recorded, storing in a memory of the portable device data indicative of the recording request; (see col. 8, ll. 8-67). It would have been obvious to one of an ordinary skill in the art, having the teaching of Huang and Sai before him at the time the invention was made, to modify in response to receiving input from the user requesting that the program be recorded, storing in a memory of the portable device data indicative of the recording request as taught by Sai to a PDA platform of Huang.

5. Though Sai teaches the storage of a request to record a TV program, we find that the device and method of Sai are significantly different from the claimed invention, and different from Huang. There is no provision in Sai for the display of the program guide on the handheld portable unit; rather the program guide is on the TV. (See the portable device in Figure 2, and the diagram including the Display 12 in Figure 1). We thus find that the system of Sai does not refer to a similar environment nor to a similar function as that claimed. A user of the Sai system cannot be outside of the range of viewing the program guide on the TV to make his selection, while the claimed environment is designed for the selection specifically while the user is outside of

the range of viewing the TV. Thus while Sai teaches storing in memory of a portable device data indicative of the recording request, we see no motivation to combine that teaching with that of Huang.

PRINCIPLES OF LAW

On appeal, Appellants bear the burden of showing that the Examiner has not established a legally sufficient basis for combining the teachings of Huang with those of Sai. Appellants may sustain this burden by showing that, where the Examiner relies on a combination of disclosures, the Examiner failed to provide sufficient evidence to show that one having ordinary skill in the art would have done what Appellants did. *United States v. Adams*, 383 U.S. 39 (1966); *In re Kahn*, 441 F.3d 977, 987-988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006); *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick, Co.*, 464 F.3d 1356, 1360-1361, 80 USPQ2d 1641, 1645 (Fed. Cir. 2006). The mere fact that all the claimed elements or steps appear in the prior art is not per se sufficient to establish that it would have been obvious to combine those elements. *United States v. Adams*, *id*; *Smith Industries Medical Systems, Inc. v. Vital Signs, Inc.*, 183 F.3d 1347, 1356, 51 USPQ2d 1415, 1420 (Fed. Cir. 1999).

ANALYSIS

The Examiner correctly shows where all the claimed elements appear in the Huang and Sai prior art references. However, Appellants correctly point out the Examiner premised the rejection on incorporation of Sai's storage of the recording request into Huang's portable device. Appellants further correctly point out the Examiner did not state a legally sufficient

basis for combining the disclosures of Sai and Huang. Accordingly, we determine that the Examiner has shown all claimed elements were known in the prior art but has not given any reason why one skilled in the art would have combined the prior art elements to make Appellants' claimed invention. On the record before us, it follows that the Examiner erred in rejecting claims 1 and 17 under § 103(a). Since claims 2-16 and 18-29 are narrower than claims 1 and 17, it also follows that those claims were not properly rejected under § 103(a) over Huang and Sai.

CONCLUSION OF LAW

Appellants have shown that the Examiner has not given sufficient reason why one skilled in the art would have incorporated Sai's storage of the recording request into the portable device of Huang so as to result in the claimed elements. On the record before us, claims 1-29 have not been shown to be unpatentable.

DECISION

The Examiner's rejection of claims 1-29 is Reversed.

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REVERSED

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GREENBERG TRAURIG, LLP
77 WEST WACKER DRIVE
SUITE 2500
CHICAGO, IL 60601-1732