

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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,
JAMES N. CONWAY, JR., ROBERT P. LILLENES,
AND PAUL D. ARLING

Appeal No. 2007-0421
Application No. 10/151,635

ON BRIEF

Before THOMAS, KRASS, and JERRY SMITH, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 20-34 and 36. Claims 35 and 37-39 have been indicated by the examiner in the answer as being directed to allowable subject matter and are no longer on appeal before us.

The invention is directed to universal remote controllers. In particular, the inventive method involves using identity data regarding a particular appliance to be controlled, wherein that identity data is uploaded from the controlling device to an internet server to retrieve from an internet database control codes to which the identified appliance is adapted to respond.

Independent claim 20 is reproduced as follows:

20. A method for configuring a controlling device to command the operation of an appliance, comprising:

receiving into the controlling device data that functions to identify the appliance;

causing the data that functions to identify the appliance to be uploaded from the controlling device to a device having Internet connectivity;

causing the data that functions to identify the appliance to be uploaded from the device having Internet connectivity via a wide area communication link to an Internet server having access to a database of control codes for commanding the operation of a plurality of appliances of different types and different manufacturers;

using at the Internet server the data that functions to identify the appliance to retrieve from the database control codes to which the appliance is adapted to respond;

receiving the control codes retrieved from the database at the device having Internet connectivity;

causing the control codes retrieved from the database to be downloaded from the device having Internet connectivity into the controlling device; and

storing the control codes retrieved from the database in the controlling device whereby the control codes are available for the use in commanding the operation of the appliance.

The examiner relies on the following references:

Allport	6,104,334	Aug. 15, 2000
Yang	6,133,847	Oct. 17, 2000
LoVasco et al. (LoVasco)	6,208,853	Mar. 27, 2001
Foster	6,211,870	Apr. 03, 2001
Walsh et al. (Walsh)	6,230,970	May 15, 2001

Appeal No. 2007-0421
Application No. 10/151,635

Claims 20-34 and 36 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner offers Yang and Allport with regard to claims 20-24, 27, 34, and 36, adding Foster with regard to claims 25, 29, and 30, but adding LoVasco with regard to claims 26 and 31-33. With regard to claim 28, the examiner offers Yang, Allport, LoVasco and Walsh.

Reference is made to the briefs and answer for the respective positions of appellants and the examiner.

OPINION

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). The examiner must articulate reasons for the examiner's decision. In re Lee, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). In particular, the examiner must show that there is a teaching, motivation, or suggestion of a motivation to combine references relied on as evidence of obviousness. Id. at 1343, 61 USPQ2d at 1433-34. The examiner cannot simply reach conclusions based on the examiner's own understanding or experience – or on his or her assessment of what would be basic knowledge or common sense. Rather, the examiner must point to some concrete evidence in the record in support of these findings. In re Zurko, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Thus the examiner must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the examiner's conclusion. However,

Appeal No. 2007-0421
Application No. 10/151,635

a suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. In re Kahn, 441 F.3d 977, 987-88, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) citing In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313 (Fed. Cir. 2000). See also In re Thrift, 298 F.3d 1357, 1363, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002). These showings by the examiner are an essential part of 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, 1040, 228 USPQ 685, 687 (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, 1051, 189 USPQ 143, 146-147 (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 and are deemed to be waived [see 37 CFR § 41.37(c)(1)(vii) (2004)].

Turning first, to independent claim 20, the examiner finds that Yang describes the claimed subject matter but for causing the data that functions to identify the appliance to be uploaded from the remote controller having internet connectivity via a wide area communication

Appeal No. 2007-0421
Application No. 10/151,635

link to an internet server, and using, at the internet server, the data that functions to identify the appliance to retrieve from the database control codes to which the appliance is adapted to respond, and receiving the control codes retrieved from the database at the device having internet connectivity.

The examiner turns to Allport for these limitations, pointing specifically to column 22, lines 10-32 (for causing data that functions to identify the appliance to be uploaded from the device), to column 26, lines 11-16 (for uploading data associated with the appliance identification to specify a device IPS associated library data or command data), and to column 29, lines 12-15 (for the rest of the deficient limitations). See page 5 of the answer.

The examiner concludes that it would have been obvious to include causing the data that functions to identify the appliance learned by the remote control to be uploaded from the remote control using internet connectivity to an internet server having a database of control codes, sending the database control codes to the remote controller to program the remote controller in the device of Yang because Allport teaches using data that specifies the appliance to be uploaded from the controller using the internet to retrieve from the database control codes to which the appliance is adapted to respond, and receiving the control codes retrieved from the database at the device for the purpose of providing wider product availability. See pages 5-6 of the answer.

Appellants' response is to argue that neither reference teaches or suggests a download mechanism including accessing, via a network, a database of control codes for commanding operations of a plurality of different appliances and using identity data uploaded from the controlling device to retrieve from that database those control codes to which the appliance so

identified is adapted to respond. Appellants note the examiner's reliance on column 22, lines 10-32, of Allport, but find nothing therein describing that anything is uploaded from the remote control to an internet server, let alone for the purpose of retrieving those control codes to which an identified appliance is adapted to respond (see page 8 of the principal brief).

We agree with appellants.

The claimed feature of uploading the identifying data to an internet server and using that server to retrieve control codes from a database is nowhere suggested in Yang and the examiner admits as much. Therefore, in order for the outstanding rejection to have any legs at all, such a feature must be described or suggested in Allport before we even reach the question of combinability.

We simply do not find such features to be suggested by Allport. It is true that Allport suggests, at column 26, lines 12-16, for example, that data for specific devices may be stored on an internet server and then retrieved, as needed. But we find no indication therein of receiving into the controlling device data that functions to identify an appliance and then uploading data identifying a particular appliance *from the controlling device* which then uploads data to a device having internet connectivity which device then uploads the data identifying the appliance to an internet server and then using that server to retrieve control codes from a database.

In short, we agree with appellants, at pages 3-4 of the reply brief, when they state that Allport fails to disclose or suggest "the desirability of using identity data uploaded from the controlling device to an internet server to retrieve from an internet database those control codes to which the appliance so identified to the internet server is adapted to respond." The examiner

Appeal No. 2007-0421
Application No. 10/151,635

has offered nothing to convince us otherwise.

Since these features of the independent claim are not taught or suggested by the applied references, and the references (LoVasco, Walsh, and Foster) applied to dependent claims 25, 26, and 28-33 do not provide for the deficiencies of Yang and Allport, we will not sustain any of the rejections under 35 U.S.C. § 103.

Accordingly, the examiner's decision rejecting claims 20-34 and 36 under 35 U.S.C. § 103 is reversed.

Appeal No. 2007-0421
Application No. 10/151,635

REVERSED

JAMES D. THOMAS
Administrative Patent Judge

ERROL A. KRASS
Administrative Patent Judge

JERRY SMITH
Administrative Patent Judge

)
)
)
)
) BOARD OF PATENT
) AND
)
) INTERFERENCES
)
)
)
)
)

EAK/kis

Appeal No. 2007-0421
Application No. 10/151,635

GREENBERG & TRAUIG, L.L.P.
77 WEST WACKER DRIVE
SUITE 2500
CHICAGO, IL 60601-1732