

1      The opinion in support of the decision being entered today was *not* written  
2      for publication and is *not* binding precedent of the Board  
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7                    UNITED STATES PATENT AND TRADEMARK OFFICE  
8                    \_\_\_\_\_  
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10                  BEFORE THE BOARD OF PATENT APPEALS  
11                  AND INTERFERENCES  
12                  \_\_\_\_\_  
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14                  *Ex parte* THOMAS N. MILLIKAN and CHARLES E. McCALLUM  
15                  \_\_\_\_\_  
16

17                  Appeal 2007-0588  
18                  Application 10/202,349  
19                  Technology Center 2100  
20                  \_\_\_\_\_  
21

22                  Decided: May 22, 2007  
23                  \_\_\_\_\_  
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27                  *Before:* MAHSHID D. SAADAT, ALLEN R. MACDONALD, and  
28                  JAY P. LUCAS, *Administrative Patent Judges.*  
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30                  MACDONALD, *Administrative Patent Judge.*  
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34                  DECISION ON APPEAL

35                  STATEMENT OF CASE

36                  Appellants appeal under 35 U.S.C. § 134 from a Final Rejection of  
37                  claims 1-6 and 19-21. We have jurisdiction under 35 U.S.C. § 6(b).

1 Appellants invented a method and apparatus for placing a playlist on a  
2 compact disc (CD) (Specification 3:8-9).

3 Representative independent claims 1 and 19 under appeal read as  
4 follows:

5           1. A method for creating a playlist for a compressed audio CD,  
6 comprising the steps of:

8 selecting a plurality of audio files associated with the compressed  
9 audio CD;

10                selecting a sequence of playback for the selected audio files;  
11                and

14 placing the playlist in a memory location in the compressed audio CD.

17            19. A compressed audio CD, comprising:

19            a plurality of audio files compressed according to a selected  
20 compression format; and

22 a playlist associated with a selected portion of the audio files  
23 contained on the CD.

25 The Examiner rejected claims 1-6 and 19-21 under 35 U.S.C.  
26 § 102(e).

27 The prior art relied upon by the Examiner in rejecting the claims on  
28 appeal is:

29 Ho Yuen Lok US 2002/0129036 A1 Sept. 12, 2002  
30 (Filed Jan. 5, 2001)

31 The prior art relied upon by the Board is:

32 Van Ryzin US 6,446,080 B1 Sept. 3, 2002  
33 (Filed May 8, 1998)

1 Appellants contend that the claimed subject matter is not anticipated  
2 by Ho Yuen Lok. More specifically, Appellants contend that Ho Yuen Lok  
3 fails to teach that (1) his saved playlist is saved on the CD as required by  
4 claims 1 and 19 (Br. 5-8), (2) “the compressed audio CD comprises a file  
5 tree” as required by claim 2 (Br. 8), (3) “the file tree contains a folder” and  
6 “the memory location is the folder” as required by claim 3 (Br. 9), and (4)  
7 “each audio file has an associated file path” or “the playlist contains the file  
8 path” as required by claims 4, 5, or 20 (Br. 10). With regards to (2)-(4)  
9 Appellants further contend that “[c]onventional audio CDs do not include a  
10 file system.” (Br. 9 and 11).

11 The Examiner contends that with respect to claims 1 and 19, because  
12 Ho Yuen Lok describes that “users are able to write onto a CD their favorite  
13 tracks to bring along with them for portable use”, these “favorite tracks are  
14 equivalent to a list of songs” (i.e. a playlist) as required by Appellants’  
15 claims 1 and 19. (Answer 7:19-20 and 8:6-7). The Examiner further  
16 contends that because of this the other argued features are also found on the  
17 compressed audio CD of Ho Yuen Lok. (Answer 14:last paragraph, 15:last  
18 paragraph, and 17:first paragraph).

19 We reverse.

ISSUE

21 Have Appellants shown that the Examiner has failed to establish Ho  
22 Yuen Lok describes “a playlist . . . in the compressed audio CD” or “[a]  
23 compressed audio CD, comprising . . . a playlist” as required by claims 1  
24 and 19 respectively?

## FINDINGS OF FACT

2 Appellants invented a method and apparatus for placing a playlist on a  
3 compact disc (CD) (Specification 3:8-9).

A “playlist” is defined in the art by various sources as “a list of the recordings to be played on the radio during a particular program or time period, often including their sequence, duration, etc,” “A list of musical selections for broadcast or performance,” or “a list of musical selections for performance or for broadcast by radio.”<sup>1</sup>

9 The prior art Ho Yuen Lok reference describes that “users are able to  
10 write onto a CD their favorite tracks to bring along with them for portable  
11 use” (Paragraph [0004]).

12 The prior art Ho Yuen Lok reference further describes that the tracks  
13 may be “digital audio in compressed and non-compressed forms” (Paragraph  
14 [0021]).

15 The prior art Ho Yuen Lok reference describes that “playlists are  
16 created” (Paragraph [0083]).

17 The prior art Ho Yuen Lok reference further describes that playlists  
18 are “lists of tracks” (Paragraph [0082]).

19 The prior art Ho Yuen Lok reference further describes that his  
20 “playlists are only links to the actual tracks” (Paragraph [0090]).

21 The prior art Ho Yuen Lok reference further describes that his  
22 playlists are “sayed” (Paragraph [0091]).

23 Appellants submit that “Ho Yuen Lok et al imply storing the playlist  
24 on a different structure than the CD” (Br. 6).

<sup>1</sup> See Dictionary.com.

Further findings of fact as necessary appear in the new rejection below.

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## PRINCIPLES OF LAW

5 On appeal, Appellants bear the burden of showing that the Examiner  
6 has not established a legally sufficient basis for anticipation based on the Ho  
7 Yuen Lok reference. Appellants may sustain this burden by showing that  
8 the prior art reference relied upon by the Examiner fails to disclose an  
9 element of the claim. It is axiomatic that anticipation of a claim under § 102  
10 can be found only if the prior art reference discloses every element of the  
11 claim. See *In re King*, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir.  
12 1986) and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick*  
13 Co.

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## ANALYSIS

16 The Examiner does not show where all the claimed elements appear in  
17 the Ho Yuen Lok prior art reference.

With respect to claims 1 and 19, as argued by Appellants and contrary to the Examiner’s contention, a group of actual tracks is not equivalent to a playlist. Rather, the art accepted definition, Appellants’ Specification, and the Ho Yuen Lok reference all use the term playlist to mean a list of the tracks distinct from the actual tracks themselves.

With respect to claims 2-6 and 20-21, even if we adopt as correct the Examiner’s position that a group of favorite tracks are equivalent to a playlist, the Examiner’s analysis (e.g. Answer 14) rests on taking the Ho Yuen Lok teachings with respect to the structure of “playlists” *as defining by*

1     Appellants and applying (or layering) those teachings onto a playlist *as*  
2     *defined by the Examiner* (a group of favorite tracks). Nothing in the  
3     Examiner's analysis provides any reasoning to show that a group of favorite  
4     tracks has any relationship to the structure of a standard playlist as taught by  
5     Ho Yuen Lok.

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7       REJECTION OF CLAIMS 1 AND 19 UNDER 37 C.F.R. § 41.50(b)

8       We make the following new grounds of rejection using our authority  
9     under 37 C.F.R. § 41.50(b).

10      Claims 1 and 19 rejected under 35 U.S.C. 103(a) as being  
11     unpatentable over Ho Yuen Lok in view of Van Ryzin.

12      The Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 17-18, 148  
13     USPQ 459, 467 (1966), stated that three factual inquiries underpin any  
14     determination of obviousness:

15      Under § 103, the scope and content of the prior art are to be  
16     determined; differences between the prior art and the claims at  
17     issue are to be ascertained; and the level of ordinary skill in the  
18     pertinent art resolved. Against this background, the obviousness  
19     or nonobviousness of the subject matter is determined. Such  
20     secondary considerations as commercial success, long felt but  
21     unsolved needs, failure of others, etc., might be utilized to give  
22     light to the circumstances surrounding the origin of the subject  
23     matter sought to be patented. As indicia of obviousness or  
24     nonobviousness, these inquiries may have relevancy.

25      The Supreme Court reaffirmed and relied upon the *Graham* three  
26     pronged test in its consideration and determination of obviousness in the fact  
27     situation presented in *KSR Int'l. v. Teleflex Inc.*, 127 S. Ct. 1727,  
28     82 USPQ2d 1385 (2007). The Court stated:

1       While the sequence of these [Graham] questions might be  
2       reordered in any particular case, the factors continue to define  
3       the inquiry that controls. If a court, or patent examiner,  
4       conducts this analysis and concludes the claimed subject matter  
5       was obvious, the claim is invalid under § 103.

6       KSR, 127 S. Ct. at 1734, 82 USPQ2d at 1391. Further, the Court stated:

7           To facilitate review, this analysis should be made explicit. *See*  
8           *In re Kahn*, 441 F.3d 977, 988 [78 USPQ2d 1329] (C.A. Fed.  
9           2006) (“[R]ejections on obviousness grounds cannot be  
10          sustained by mere conclusory statements; instead, there must be  
11          some articulated reasoning with some rational underpinning to  
12          support the legal conclusion of obviousness”). As our  
13          precedents make clear, however, the analysis need not seek out  
14          precise teachings directed to the specific subject matter of the  
15          challenged claim, for a court can take account of the inferences  
16          and creative steps that a person of ordinary skill in the art  
17          would employ.

18       KSR, 127 S. Ct. at 1741, 82 USPQ2d at 1396. Additionally, the Court  
19       stated:

20           When a work is available in one field of endeavor, design  
21          incentives and other market forces can prompt variations of it,  
22          either in the same field or a different one. If a person of  
23          ordinary skill can implement a predictable variation, § 103  
24          likely bars its patentability. For the same reason, if a technique  
25          has been used to improve one device, and a person of ordinary  
26          skill in the art would recognize that it would improve similar  
27          devices in the same way, using the technique is obvious unless  
28          its actual application is beyond his or her skill.

29       KSR, 127 S. Ct. at 1741, 82 USPQ2d at 1396.

30           As we have already found (and as argued by Appellants), the prior art  
31          Ho Yuen Lok reference describes the features of claims 1 and 19 except for  
32          saving a playlist on Ho Yuen Lok’s compressed audio CD. We turn to Van  
33          Ryzin for two explicit teachings related to saving a playlist.

1       First, Van Ryzin describes a problem in the art with utilizing a custom  
2 playlist (Col. 2, ll. 14-20):

3       A further difficulty with utilizing a custom playlist is that the  
4 created playlist is itself stored in volatile memory of the digital  
5 audio/visual actuator device and not in a permanent digital  
6 storage device such as a CD. Because the playlist is stored in  
7 volatile memory, it is lost whenever power to the CD player is  
8 lost, whether by turning off the digital audio/visual actuator  
9 device or accidentally losing power.

10      Second, Van Ryzin describes solving this problem where “the playlist  
11 is saved in non-volatile memory in digital audio/visual actuator device 10”  
12 (Col. 5, ll. 43-44) and “the playlist may be received and permanently stored  
13 for later use” (Col. 6, ll. 50-52).

14      Given the teachings of Ho Yuen Lok combine with Van Ryzin’s  
15 teaching to permanently store the playlist, and further taking into account  
16 Van Ryzin’s explicit framing of the problem as one where the playlist is “not  
17 in a permanent digital storage device such as a CD” we conclude that  
18 Appellants claims 1 and 19 fail to meet the requirements of 35 U.S.C. § 103.

19      This decision contains a new ground of rejection pursuant to  
20 37 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960  
21 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)).

22      37 C.F.R. § 41.50(b) provides that, “[a] new grounds of rejection  
23 pursuant to this paragraph shall not be considered final for judicial review.”

24      37 C.F.R. § 41.50(b) also provides that the Appellants, *WITHIN TWO*  
25 *MONTHS FROM THE DATE OF THE DECISION*, must exercise one of the  
26 following two options with respect to the new grounds of rejection to avoid  
27 termination of proceedings (37 C.F.R. § 1.197 (b)) as to the rejected claims:

(1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner ...

(2) Request rehearing. Request that the proceeding be reheard under 37 C.F.R. § 41.52 by the Board upon the same record ...

## OTHER ISSUES

The Board of Patent Appeals and Interferences is a review body, rather than a place of initial examination. We have made a rejection above under 37 C.F.R. § 41.50(b). However, we have not reviewed claims 2-6 and 20-21 to the extent necessary to determine whether these claims are patentable under 35 U.S.C. § 103 over the Ho Yuen Lok and/or Van Ryzin references and/or standard file directory techniques in the data processing arts. We leave it to the instant Examiner to determine the appropriateness of any further rejections based on these or other references.

## CONCLUSION OF LAW

(1) Appellants have established that the Examiner erred in rejecting claims 1-6 and 19-21 as being unpatentable under 35 U.S.C. § 102(e) over Ho Yuen Lok.

(2) Claims 1 and 19 fail to meet the requirements of 35 U.S.C. § 103.

(3) Claims 1 and 19 are not patentable.

(4) On this record, claims 2-6 and 20-21 have not been shown to be entable.

1 DECISION

2 The Examiner's rejections of claims 1-6 and 19-21 are reversed.  
3 Claims 1 and 19 do not meet the requirements of 35 U.S.C. § 103.  
4 No time period for taking any subsequent action in connection with  
5 this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

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7 REVERSED  
8 37 C.F.R. § 41.50(b)  
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