

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* TAKEHIRO ONOMATSU

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Appeal 2008-3468  
Application 10/449,493  
Technology Center 2600

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Decided: November 14, 2008

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Before ROBERT E. NAPPI, SCOTT R. BOALICK, and JOHN A.  
JEFFERY, *Administrative Patent Judges*.

JEFFERY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134 from the Examiner's rejection of claims 1-5. We have jurisdiction under 35 U.S.C. § 6(b), and we heard the appeal on October 21, 2008. We affirm.

## STATEMENT OF THE CASE

Appellant invented a digital contents playback apparatus with a user-friendly interface for playing back any desired content without requesting the user for action or identification of the type of recording medium. To this end, a list of digital contents is displayed automatically upon switching on the power of the playback apparatus.<sup>1</sup> Claim 1 is illustrative:

1. A digital contents playback apparatus having two or more playback means for playing back different types of recording mediums on which digital contents of data are stored, comprising:

an automatic contents retrieving means for automatically retrieving reproducible data of the digital contents from each recording medium upon switching on a power of the digital contents playback apparatus; and

a contents data displaying means for producing a list of the contents from the data retrieved by the automatic contents retrieving means and displaying the list on an externally connected display device, wherein

the contents data displaying means is arranged to display at once a list of the available digital contents retrieved over all the applicable recording mediums by the automatic contents retrieving means upon switching on the power of the apparatus.

The Examiner relies on the following prior art reference to show unpatentability:

Levitt	US 2002/0151327 A1	Oct. 17, 2002 (filed Dec. 20, 2001)
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Claims 1-5 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Levitt (Ans. 3-4).

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<sup>1</sup> See generally Spec. 2-4; Abstract.

Rather than repeat the arguments of Appellant or the Examiner, we refer to the Briefs and the Answer<sup>2</sup> for their respective details. In this decision, we have considered only those arguments actually made by Appellant. Arguments which Appellant could have made but did not make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Regarding representative claim 1,<sup>3</sup> Appellant argues that Levitt fails to perform the identical function recited in the means-plus-function limitation calling for *automatically* retrieving reproducible data of the digital contents from *each* recording medium *upon switching on a power* of the digital contents playback apparatus (App. Br. 4; emphases added). Although Appellant acknowledges that Levitt's system setup may perform synchronization operations with a networked device and that power must be turned on to perform these operations, Appellant emphasizes there is simply no disclosed relationship between retrieving the data and turning on the power as claimed. Rather, Appellant argues, the user must provide input prior to performing a synchronization (i.e., pressing a "HotSync" button) (App. Br. 5-7; Reply Br. 2-4). Appellant adds that Levitt fails to teach or suggest that its retrieval of reproducible data of digital contents is from *each* recording medium as claimed (Reply Br. 4-5; emphasis in original).

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<sup>2</sup> Throughout this opinion, we refer to (1) the Appeal Brief filed Jan. 18, 2007; (2) the Examiner's Answer mailed Aug. 7, 2007; and (3) the Reply Brief filed July 27, 2007.

<sup>3</sup> Appellant argues claims 1-5 together as a group. *See* App. Br. 4-8. Accordingly, we select claim 1 as representative. *See* 37 C.F.R. § 41.37(c)(1)(vii).

The Examiner responds that the breadth of the limitation “upon switching on a power” does not require a *causal* relationship between automatically retrieving data and turning on the power. Rather, the Examiner contends, the term merely requires a *sequential* relationship in view of the meaning of the term “upon” (i.e., “immediately or very soon after”) (Ans. 5; emphases added). As such, the Examiner reasons that since power must be turned on before initiating system setup or maintenance procedures in Levitt, then data is automatically retrieved at some point sequentially after turning on the power (Ans. 5-6). The Examiner adds that Levitt does not require user intervention for synchronization and ultimately retrieval of the data since the reference teaches that a continuous Internet connection can be employed (Ans. 6-7).

#### ISSUE

The issue before us, then, is whether Appellant has shown that the Examiner erred in finding that Levitt automatically retrieves reproducible data of the digital contents from each recording medium upon switching on a power of the digital contents playback apparatus as claimed, and whether this limitation is met despite the requisite synchronization needed in Levitt for data retrieval.

#### FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence:

1. Levitt discloses an interactive media selection system that uses a handheld device 22 (e.g., a personal digital assistant (PDA)) that can enact

and review media choices through wireless control of media-playing devices (i.e., entertainment devices 24). Content directory choices, such as TV program schedule items or CD music track titles, are provided via Internet, modem, or other network connectivity of the handheld device (Levitt, Abstract, ¶¶ 0066-67, 0069; Fig. 1).

2. The handheld device enables the user to navigate a hierarchical database of entertainment devices and content including multiple views of program choices available of multiple media playback devices (e.g., multiple CDs and DVDs in each player in each home, as well as radio and digital video recorder (DVR) programs in devices) (Levitt, ¶¶ 0062, 0221; Fig. 6).

3. The handheld device can exchange information with another computer in the home or on the Internet. Such communication can be asynchronous (e.g., sync on demand by placing the handheld device in its cradle, or periodically connecting to the Internet) and/or continuous (e.g., persistent wireless connection directly from the handheld device to the Internet) (Levitt, ¶ 0072).

4. In addition to sending commands to entertainment devices 24, the handheld device can exchange information with a PC 28 and/or server system 32 to, among other things, update/synchronize personal preferences and content databases (Levitt, ¶ 0073).

5. Information pertaining to newly added content and services (e.g., new CDs or new DirecTV channels) can be entered into the handheld device, PC 28, or server system 32. The information can be synchronized continuously. Alternatively, the information can be synchronized asynchronously (e.g., periodically between the PC and the server system, and upon demand between the PC and the handheld device via the cradle),

so that the user would not need to enter the information again. As such, product information can be transferred to the handheld device automatically (Levitt, ¶ 0074).

6. The wireless data network connection used by the handheld device may be intermittent, temporary, on demand, or always on (Levitt, ¶ 0230).

7. For PDA handheld devices, the PDA's native data synchronization capabilities can be used (e.g., PalmOS HotSync) so that the handheld program schedule is updated when the user performs synchronization and backup operations for other data, typically by pressing a single button (Levitt, ¶ 0230).

8. Upon synchronization of the handheld device with the network, the handheld device and server system databases are updated to sustain device control and content directory services (Levitt, ¶¶ 0233-41).

9. These updates include, among other things, transferring updates to device, service, collection, and preference databases from network databases to the handheld device (Levitt, ¶ 0237).

#### PRINCIPLES OF LAW

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. *RCA Corp. v. Appl. Dig. Data Sys., Inc.*, 730 F.2d 1440, 1444 (Fed. Cir. 1984); *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554 (Fed. Cir. 1983).

## ANALYSIS

Based on the functionality of Levitt noted in the Findings of Fact section above, we will sustain the Examiner's anticipation rejection of representative claim 1. At the outset, we note that the disputed limitations of claim 1 are drafted in means-plus-function format and must therefore be construed to cover the corresponding structure, material, or acts described in the Specification and their equivalents. *In re Donaldson Co., Inc.*, 16 F.3d 1189, 1193 (Fed. Cir. 1994) (en banc). In this regard, Appellant does not argue that the components of Levitt's system identified by the Examiner are not the same or equivalent to the corresponding structure in Appellant's Specification, but rather argues that Levitt fails to perform the identical function recited.<sup>4</sup> We therefore confine our discussion to this argument.

We agree with the Examiner that the scope and breadth of the limitation "*upon* switching on a power of the digital contents playback apparatus" does not preclude Levitt's data retrieval process that occurs after power is switched on. While Levitt is unclear as to the exact temporal relationship between turning on the power and data retrieval, the scope and breadth of the claim language simply does not preclude a delay (if any) between these two events.

We acknowledge that synchronization of the handheld device with the network in Levitt is a key factor in achieving data retrieval (FF 8-9). And we further recognize that the handheld device can be synchronized manually (e.g., by pressing a button using the PDA's HotSync feature) (FF 7).

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<sup>4</sup> See App. Br. 4 ("Levitt fails to perform the identical function and thus it is not necessary to compare the structural components of Levitt's system with those in Appellant's specification.").

But Levitt is by no means limited to communication requiring this type of synchronization. Levitt notes that the handheld device can exchange information with another computer in the home or on the Internet. Such communication can either be (1) *asynchronous* (e.g., sync on demand by placing the handheld device in its cradle, or periodically connecting to the Internet); and/or (2) *continuous* (e.g., persistent wireless connection directly from the handheld device to the Internet) (FF 3).

Appellant argues that the synchronization capabilities of the handheld in this passage are limited to the sync on demand feature (i.e., by placing the handheld device in its cradle) and that the term “continuous” refers to *communication*, not synchronization (Reply Br. 4). While Levitt uses the terms “asynchronous” and “continuous” in connection with “communication” in Paragraph 0072, we note that Levitt also uses these terms in connection with *synchronization* as well.

In Paragraph 0074, Levitt notes that information pertaining to newly added content and services (e.g., a newly purchased CD or new channel subscription) can be entered into the system and the information *synchronized continuously or asynchronously* (e.g., periodically between the PC and the server system, and upon demand between the PC and the handheld device via the cradle), so that the user would not need to enter the information again. As such, product information can be transferred to the handheld device *automatically* (FF 5).

The import of these passages taken as a whole is that synchronized data exchange between the handheld device and the network can occur either (1) asynchronously (e.g., using techniques involving manual intervention such as sync on demand), or (2) synchronously via a continuous, persistent

wireless connection between the handheld device and the Internet. In either case, synchronization will occur with respect to the handheld device to facilitate the automatic exchange of data.

Using a continuous, persistent wireless Internet connection to facilitate this synchronized exchange of data would, in our view, involve an automatic retrieval of data of the digital contents from each recording medium upon switching on power as claimed. Even if we assume, without deciding, that synchronization occurred some time after powering on the system using a continuous Internet connection in Levitt, it will nonetheless automatically occur “upon” switching on power. The scope of the claim language simply does not preclude such a delay (if it exists at all). In this regard, the Examiner’s point regarding the claim not precluding a sequential relationship between the switching on of power and data retrieval (Ans. 5) is well taken. We add that data retrieval in Levitt likewise involves a causal relationship as data retrieval would not occur *but for* powering on the apparatus.

Furthermore, we find that the data retrieved upon synchronization would reasonably include reproducible data of the digital contents from each recording medium as claimed. As we noted above, upon synchronization of the handheld device with the network, various database updates are transferred from the network to the handheld device (FF 8-9). Moreover, the handheld device can exchange information with a PC and/or the server system to, among other things, update/synchronize personal preferences and content databases (FF 4).

As shown in Figure 6 of Levitt, aggregated information can be presented on the handheld device to enable the user to navigate a

hierarchical database of entertainment devices and content (e.g., multiple CDs and DVDs in each player in each home, as well as radio and digital video recorder (DVR) programs in devices) (FF 2). Updating this aggregated display of diverse recording media using Levitt's synchronized data exchange noted above would, in our view, involve retrieving data regarding the contents of each recording media as claimed.

For the foregoing reasons, Appellant has not persuaded us of error in the Examiner's rejection of representative claim 1. Therefore, we will sustain the Examiner's rejection of that claim, and claims 2-5 which fall with claim 1.

#### CONCLUSION OF LAW

Appellant has not shown that the Examiner erred in rejecting claims 1-5 under § 102.

#### DECISION

The Examiner's decision rejecting claims 1-5 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

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Application 10/449,493

AFFIRMED

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