

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES S. LIPSCOMB, LURNG-KUO LIU, and
LIANG-JIE ZHANG

Appeal 2008-4839
Application 09/749,407
Technology Center 2400

Decided: December 15, 2008

Before ROBERT E. NAPPI, JOHN A. JEFFERY
and KEVIN F. TURNER, *Administrative Patent Judges*.

NAPPI, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 6(b) of the final rejection of claims 1 through 14, 16 through 22, and 24 through 44.

We affirm the Examiner's rejections of these claims.

INVENTION

The invention is directed towards a system that allows a viewer to surf from one related television program to another through hyperlinking. See

page 29 of Appellants' Specification. Claim 41 is representative of the invention and reproduced below:

41. A receiver for surfing hyperlinked information in a television system, comprising:
storing apparatus, which receives program content including hyperlinks and related channels;
classification information in the storing apparatus which relates program content related to related channels; and
control apparatus, which enables a viewer to access the classification information and surf among related channels as selected by the system based on a profile of the viewer and a program classification category of a program being viewed;
wherein the profile of the viewer is deduced by the system from television viewing habits of the viewer, and the program classification category is selected by the system from a plurality of classification categories for the program being viewed independent of viewer input.

REFERENCES

Naimpally	US 6,020,880	Feb. 1, 2000
Shoff	US 6,240,555 B1	May, 29, 2001
Lasky	US 6,367,078 B1	Apr. 2, 2002
Finseth	US 6,665,870 B1	Dec. 16, 2003
Tsukidate	US 6,714,722 B1	Mar. 30, 2004
Schein	US 6,732,369 B1	May 4, 2004
Brown	US 6,973,663 B1	Dec. 6, 2005

REJECTIONS AT ISSUE

The Examiner has rejected claims 39 through 44 under 35 U.S.C. § 103(a) as being unpatentable over Finseth in view of Naimpally and Brown.¹ The Examiner's rejection is on pages 3 through 13 of the Answer².

The Examiner has rejected claims 14, 16, 17, 19 through 22, 24, and 25 under 35 U.S.C. § 103(a) as being unpatentable over Finseth in view of Shoff, Naimpally, and Brown. The Examiner's rejection is on pages 13 through 18 of the Answer.

The Examiner has rejected claims 1 through 4, 6, 27 through 30, 32 through 36, and 38 under 35 U.S.C. § 103(a) as being unpatentable over Finseth in view of Lasky, Naimpally, and Brown. The Examiner's rejection is on pages 18 through 27 of the Answer.

The Examiner has rejected claims 7 through 11 under 35 U.S.C. § 103(a) as being unpatentable over Finseth in view of Shoff, Lasky, Naimpally, and Brown. The Examiner's rejection is on pages 27 through 32 of the Answer.

The Examiner has rejected claims 5, 31, and 37 under 35 U.S.C. § 103(a) as being unpatentable over Finseth in view of Lasky, Naimpally, and Brown. The Examiner's rejection is on pages 32 through 34 of the Answer.

¹ We note that the Examiner states that the statutory basis for the rejection is 35 U.S.C. § 102(e) and not 35 U.S.C. § 103(a). We consider this to be a harmless typographical error as the rationale supporting the rejection relies on an obviousness analysis.

² Throughout the opinion, we make reference to the Answer, mailed September 10, 2007, for the respective details thereof.

The Examiner has rejected claim 13 under 35 U.S.C. § 103(a) as being unpatentable over Finseth in view of Shoff, Lasky, Naimpally, Brown, and Tsukidate. The Examiner's rejection is on pages 34 and 35 of the Answer.

The Examiner has rejected claims 18 and 26 under 35 U.S.C. § 103(a) as being unpatentable over Finseth in view of Shoff, Naimpally, Brown, and Tsukidate. The Examiner's rejection is on pages 35 and 36 of the Answer.

The Examiner has rejected claim 12 under 35 U.S.C. § 103(a) as being unpatentable over Finseth in view of Shoff, Lasky, Naimpally, Brown, and Schein. The Examiner's rejection is on pages 36 and 37 of the Answer.

ISSUES

Rejection of claims 39 through 44

Appellants argue on page 14 through 17 of the Brief³ that the Examiner's rejection of claims 39 through 44⁴ under 35 U.S.C. § 103(a) is in error.⁵ Appellants assert that the Examiner erred in finding that Finseth

³ Throughout the opinion, we make reference to the Brief, received April 5, 2007, and Reply Brief, received Nov. 13, 2007 for the respective details thereof.

⁴ Appellants' arguments group these claims together, thus in accordance with 37 CFR § 41.33 (c)(1)(vii) we select claim 41 as representative of the group.

⁵ We note, that on page 14 of the Brief, Appellants state that they intend to incorporate arguments presented in prior responses (documents) to the Examiner. In reaching this decision we have not considered arguments presented to the Examiner in other documents. In accordance with 37 CFR

discloses a dynamic table of correspondence between program classification categories and television channel numbers. Brief 16, Reply Brief 1 and 2. Further, Appellants argue that the Examiner erred in finding that Naimpally teaches that the service provider filters information based upon selected program categories and a user profile. Brief. 16, Reply Brief 2. Rather, Appellants assert “[t]he list of channels provided to the user in Naimpally is not based on a classification category selected by the system for the program being viewed, and therefore, does not necessarily contain the same nature of the program.” Brief 16. Additionally Appellants argue that the combination of Finseth, Naimpally, and Brown does not disclose that the channels are selected based upon the category of a program viewed and the program category selected by the system from a plurality of classification categories for the program being viewed. Brief 17. Specifically, Appellants argue that while Brown teaches a similar search that uses attributes of a program but “Brown fails to disclose the section of a category for the program by the system” and that “Brown fails to disclose that a single attribute for a television program being viewed is selected by the system for use in selecting similar programs.” Brief 17. Finally, on page 3 of the Reply Brief, Appellants allege that the Examiner’s rationale for combining the references is inadequate to support a finding of obviousness.

Thus, the issues before us are whether the Appellants shown that the Examiner erred in:

1) finding that Finseth teaches a dynamic table of correspondence between program classification categories and channel numbers as claimed?

§ 41.33 (c)(1)(vii), the appeal is limited to arguments made in the Brief and Reply Brief, all other arguments are waived.

2) finding that the combination of Finseth and Naimpally teaches that the service provider filters information based upon selected program categories and a user profile as claimed?;

3) finding that the combination of Finseth, Naimpally, and Brown teaches that the channels identified to the user are selected based upon the category of a program viewed and the program category selected by the system from a plurality of classification categories for the program being viewed and that the selection is independent of viewer input?; and

4) concluding that one skilled in the art would combine the teachings of Finseth, Naimpally, and Brown?

Rejections of claims 1 through 14, 16 through 22, and 24 through 39

Appellants present additional arguments directed to the rejections of 1 through 14, 16 through 22, and 24 through 38 on pages 17 through 21 of the Brief, we address these arguments *supra* in the analysis section of our decision.

PRINCIPLES OF LAW

In analyzing the scope of the claim, Office personnel must rely on Appellants' disclosure to properly determine the meaning of the terms used in the claims. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 980 (Fed. Cir. 1995). “[I]nterpreting what is *meant* by a word *in* a claim ‘is not to be confused with adding an extraneous limitation appearing in the specification, which is improper.’” (Emphasis original) *In re Cruciferous Sprout Litigation*, 301 F.3d 1343, 1348 (Fed. Cir. 2002) (citations and quotations omitted).

On the issue of obviousness, the Supreme Court has stated that “the obviousness analysis cannot be confined by a formalistic conception of the words teaching, suggestion, and motivation.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007). The mere existence of differences between the prior art and the claim does not establish nonobviousness. *Dann v. Johnston*, 425 U.S. 219, 230(1976). The issue is "whether the difference between the prior art and the subject matter in question 'is a difference sufficient to render the claimed subject matter unobvious to one skilled in the applicable art.'" *Dann*, 425 U.S. at 228 (citation omitted) (finding system for automatic record keeping of bank checks and deposits obvious in view of nature of extensive use of data processing systems in banking industry and "closely analogous" patent for an automatic data processing system used in a large business organization for keeping and updating system transaction files for each department of the organization). To be nonobvious, an improvement must be "more than the predictable use of prior art elements according to their established functions." *KSR*, 127 S. Ct. at 1740.

In *KSR*, the Supreme Court emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," *id.* at 1739, and discussed circumstances in which a patent might be determined to be obvious. In particular, the Supreme Court emphasized that "the principles laid down in *Graham* reaffirmed the 'functional approach' of *Hotchkiss*, 11 How. 248 [(1850)]." *KSR*, 127 S. Ct. at 1739 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966) (emphasis added)), and reaffirmed principles based on its precedent that "[t]he combination of familiar

elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* The Court explained:

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

Id. at 1740. The operative question in this "functional approach" is thus, "whether the improvement is more than the predictable use of prior art elements according to their established functions." *Id.* at 1740.

FINDINGS OF FACT

1. Finseth teaches a system for providing an electronic television programming guide (EPG) to a user which makes use of hyperlinks in the guide. Abstract.
2. Finseth's EPG is in a narrative format. Col. 2, ll. 17-26, Figures 4-8 depict displays of the EPG.
3. Naimpally teaches a system for providing an EPG to a user. Col. 2, ll. 33-47.

4. Naimpally teaches that the EPG may be modified (i.e. portions deleted) by the receiver based upon a viewer profile. The viewer profile is created and updated based upon the user's desires (suggesting user input). Col. 6, ll. 43-57.
5. Naimpally teaches that the viewer preferences can include preferences based upon the category of programs on the channel, e.g. sports, movie ratings or classical music. Col. 6, ll. 52-56.
6. Brown teaches a system for finding and viewing similar television programs. This is performed by comparing attributes of television programs to each other to find matches. Abstract.
7. Brown's system makes use of an EPG (see Fig. 4) which contains information about television channels and programs. The attributes include information that is used to categorize the programs, such as movies, names of actors, directors etc. Col. 10, ll. 41-51.
8. A person viewing a program on the EPG can select a function to obtain similarity information (push button 107 on the remote control shown in figure 5) and information about similar programs is obtained and displayed. Brown col. 10, ll. 19-25.
9. The attributes of one program are compared to attributes of other programs to find a match (e.g. for the movie "Splash," there are several programs which are considered to be similar, the movie "Apollo 13" is considered similar because in the category of director there is a match, the movie "Grumpy Old Men" is considered to be similar because in the category actress there is a match, see Figures 8, 9a, and 9b). Brown, col. 11, ll. 21-37.

10. Brown also teaches that categories used in the similarity matching can be performed based upon user preferences gathered from the viewers viewing history. Col. 13, ll. 53-59.

ANALYSIS

Rejection under 35 U.S.C. § 103(a) as being unpatentable over Finseth in view of Naimpally and Brown

Issue 1)

Appellants' arguments have not persuaded us that the Examiner erred in finding that Finseth teaches a dynamic table of correspondence between program classification categories and channel numbers as claimed. As discussed *supra*, Appellants' arguments have grouped claims 39 through 44 together, and we select claim 41 to be representative of the group. Claim 41 does not recite a limitation directed to a correspondence table of correspondence between program classification categories and television channel numbers. Thus, Appellants' have not persuaded us that the Examiner's rejection is in error as this argument is not commensurate with the scope of claim 41.

In as much as this argument may be applicable to the rejections of other claims, discussed *infra* we note that the Examiner states in the Answer:

Finseth does teach a dynamic table of correspondence between program classification categories and television channel numbers. Finseth, in columns 6 and 7, lines 58-67 and 1-10, discloses a program guide database that links channels to channel numbers. This program guide database also contains scheduling data and editorial information (col. 7, lines 11-23) which can be created for the program guide. This also includes channel information, including category information, that is also associated with the channels. Therefore, Finseth teaches a dynamic table (such as an alterable database) of correspondence

between program classification categories and television channel numbers.
Answer 39.

We concur with the Examiner's interpretation of the claim term "dynamic table" as being an alterable database. Appellants' Specification does not provide a definition of the term. Further, Appellants have not provided a definition, nor shown that the Examiner's interpretation is inconsistent with Appellants' Specification. Thus, we consider the Examiner's interpretation of the term to be reasonable. Further, Appellants' arguments have not persuaded us that the Examiner erred in finding that Finseth teaches an alterable database. Appellants' statement, on pages 1 and 2 of the Reply Brief, "the ability to manually enter editorial comments into a program guide, as disclosed by Finseth, does not teach the dynamic table recited in the claims" appears to support the Examiner's finding since this statement shows that Appellants acknowledge that Finseth teaches that the database program guide is an alterable database. Further, Appellants have not shown how the claim limitation defines a different table than taught by Finseth. Accordingly, on the first issue, Appellants have not persuaded us that the Examiner erred in rejecting claim 41.

Issue 2)

Appellants' arguments have not persuaded us that the Examiner erred finding that the combination of Finseth and Naimpally teaches that the service provider filters information based upon selected program categories and a user profile. Claim 41 does not recite limitations directed to either a service provider or filtering information. Rather, Claim 41 recites that there is "classification information" which relates program content to channels and that the viewer is able to "surf" among channels selected by the system

based upon a profile of the viewer and a classification category of the program being viewed. We construe the term “surf” to mean to view or skim the contents of a document. Further, we note that the claim does not define what is meant by the term “program being viewed.” Appellants’ arguments imply that this term should be construed as viewing the video of the program. While Appellants’ Specification may disclose that the system operates in this manner, we decline to import such a limitation. We therefore construe the claim more broadly and consider the limitation to include viewing the program description on the EPG. Thus, the scope of the claim includes that the user is provided with information and able to view information about channels, where the information is selected based upon a user profile and the classification of the program being viewed.

The Examiner has found that Naimpally teaches allowing a user to surf among channels selected based upon the user’s profile and the program being viewed. Answer 39. We find that the disclosure of Naimpally supports the Examiner’s finding. Specifically, Naimpally teaches modifying an EPG to include only programs which meet the user’s profiles. Fact 4. The user’s preference can include a classification category of programs the user desires to watch, e.g. sports. Fact 5. Thus, only those programs which are classified in the same category as identified in the user’s preferences will be displayed in the user’s EPG (i.e. the user in viewing the modified EPG is viewing programs (program being viewed and others in the EPG) selected based upon classification of the program and the user’s preferences). Further, as discussed *infra*, the additional teachings of Brown also include a teaching that programs are selected to be displayed to the user based upon information selected based upon a user profile and the classification of the

program being viewed. Thus, Appellants' arguments directed to the second issue have not persuaded us that the Examiner erred in rejecting claim 41.

Issue 3)

Appellants' arguments have not persuaded us that the combination of Finseth, Naimpally, and Brown teaches that the channels identified to the user are selected based upon the category of a program viewed which is selected by the system from a plurality of classification categories for the program being viewed and that the selection is independent of viewer input. Claim 41 recites that the "program classification is selected by the system from a plurality of classification categories for the program being viewed independent of viewer input." Thus, the scope of the claim includes that the classification category, which is a basis of the information provided to the user, is selected without user input. While we concur with Appellants that Naimpally teaches that the classification categories are provided by the user, we note that the Examiner relies upon Brown to teach this feature. Brown teaches that programs similar to the program being viewed in the EPG are found based upon matches in attributes. Fact 8. Brown does not teach that the user has input as to which attributes are selected to perform the match; rather Brown teaches that the system finds matches. Fact 9. Further, Brown teaches that the viewing habits of the viewer are also used in determining the category or categories to be considered in finding a match. Fact 10. Thus, Appellants' arguments directed to the third issue have not persuaded us that the Examiner erred in rejecting claim 41.

Issue 4)

Appellants' argument has not persuaded us that the Examiner erred in concluding that one skilled in the art would combine the teachings of

Finseth, Naimpally, and Brown. Appellants argue on page 3 of the Reply Brief “[t]here has been no showing in the present § 103(a) rejection of objective evidence of record that would motivate one skilled in the art to combine Naimpally, Finseth, and Brown to produce the particular limitations in question.” We disagree with the Appellants, the Examiner has found that the elements of the claim are known in the art, each are different manipulations of information used in an electronic program guide, their combination merely performs the predictable result of providing information to the user. Thus, the as Examiner has shown that the claim limitations are merely a predictable use of prior art elements according to their established functions to achieve a predictable result. *KSR*, 127 S. Ct. at 1740. We are not persuaded that the Examiner erred in concluding that one skilled in the art would combine the teachings of Finseth, Naimpally, and Brown.

The issues raised by Appellants’ arguments directed to the Examiner’s rejection of claim 41 under 35 U.S.C. § 103(a) as being unpatentable over Finseth in view of Naimpally and Brown have not persuaded us that the Examiner erred in rejecting these claims. Accordingly, we sustain the Examiner’s rejection of claims 39 through 44 which are grouped with claim 41.

Rejection of claims 14, 16, 17, 19 through 22, 24, and 25 under 35 U.S.C. § 103(a) as being unpatentable over Finseth in view of Shoff, Naimpally, and Brown

On pages 17 and 18 of the Brief Appellants argue that independent claims 14 and 22 recite limitations similar to those discussed with respect to claims 39 through 44 and as such the Examiner’s rejection of these claims is

in error. These arguments are not persuasive. As discussed above with respect to claims 39 through 44, Appellants have not persuaded us that the Examiner erred in finding that the combination of the references teaches the identified claim limitations. Accordingly, we sustain the Examiner's rejection of claims 14, 16, 17, 19 through 22, 24, and 25 for the reasons discussed with respect to claims 39 through 44.

Rejection of claims 1 through 4, 6, 27 through 30, 32 through 36, and 38 under 35 U.S.C. § 103(a) as being unpatentable over Finseth in view of Lasky, Naimpally, and Brown

On page 18 of the Brief Appellants argue that independent claims 1, 27, and 33 recite limitations similar to those discussed with respect to claims 39 through 44 and as such the Examiner's rejection of these claims is in error. These arguments are not persuasive. As discussed above with respect to claims 39 through 44, Appellants have not persuaded us that the Examiner erred in finding that the combination of the references teaches the identified claim limitations. Accordingly, we sustain the Examiner's rejection of claims 1 through 4, 6, 27 through 30, and 32 through 36 for the reasons discussed with respect to claims 39 through 44.

Rejection of claims 7 through 11 under 35 U.S.C. § 103(a) as being unpatentable over Finseth in view of Shoff, Lasky, Naimpally, and Brown

On page 19 of the Brief Appellants argue that independent claim 7 recites limitations similar to those discussed with respect to claims 39 through 44 and as such the Examiner's rejection of these claims is in error. These arguments are not persuasive. As discussed above with respect to

claims 39 through 44, Appellants have not persuaded us that the Examiner erred in finding that the combination of the references teaches the identified claim limitations. Accordingly, we sustain the Examiner's rejection of claims 7 through 11 for the reasons discussed with respect to claims 39 through 44.

Rejection of claims 5, 31, and 37 under 35 U.S.C. § 103(a) as being unpatentable over Finseth in view of Lasky, Naimpally, and Brown

On page 19 of the Brief Appellants argue that claims 5, 31, and 27 are patentable by virtue of their dependency on independent claims 1, 27, and 33. These arguments are not persuasive. As discussed above, Appellants have not persuaded us that the Examiner erred in rejecting claims 1, 27, and 33. Accordingly, we sustain the Examiner's rejection of claims 5, 31, and 37 for the reasons discussed with respect to claims 1, 27, and 33.

Rejection of claim 13 under 35 U.S.C. § 103(a) as being unpatentable over Finseth in view of Shoff, Lasky, Naimpally, Brown, and Tsukidate

On page 20 of the Brief Appellants argue that claim 13 is patentable by virtue of its dependency on independent claim 7. These arguments are not persuasive. As discussed above, Appellants have not persuaded us that the Examiner erred in rejecting claim 7. Accordingly, we sustain the Examiner's rejection of claim 13 for the reasons discussed with respect to claim 7.

Rejection of claims 18 and 26 under 35 U.S.C. § 103(a) as being unpatentable over Finseth in view of Shoff, Nainpally, Brown and Tsukidate.

On page 20 of the Brief Appellants argue that claims 18 and 26 are patentable by virtue of their dependency on independent claims 14 and 22. These arguments are not persuasive. As discussed above, Appellants have not persuaded us that the Examiner erred in rejecting claim 14 and 22. Accordingly, we sustain the Examiner's rejection of claim 18 and 26 for the reasons discussed with respect to claim 14 and 22.

Rejection of claim 12 under 35 U.S.C. § 103(a) as being unpatentable over Finseth in view of Shoff, Lasyi, Nainpally, Brown, and Schein

On page 21 of the Brief Appellants argue that claim 12 is patentable by virtue of its dependency on independent claim 7. These arguments are not persuasive. As discussed above, Appellants have not persuaded us that the Examiner erred in rejecting claim 7. Accordingly, we sustain the Examiner's rejection of claim 12 for the reasons discussed with respect to claim 7.

ORDER

The decision of the Examiner to reject claims 1 through 14, 16 through 22, and 24 through 44 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).

Appeal 2008-4839
Application 09/749,407

AFFIRMED

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