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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,261	08/21/2008	5,734,961	ED 017 954 148 US	8409

7590 10/21/2010  
GOLDSTEIN, FAUCETT & PREBEG, LLP  
1177 WEST LOOP SOUTH  
SUITE 400  
HOUSTON, TX 77027

EXAMINER
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FOSTER, ROLAND G

ART UNIT	PAPER NUMBER
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10/21/2010

PAPER

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,839	12/07/2005	5734961	866093	1585

7590 10/21/2010  
JEAN-PAUL CASTILLE, PRESIDENT  
ANTOR MEDIA CORPORATION  
84440 ROBION  
CANTE PLOURE,  
FRANCE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,957	03/03/2006	5734961	04395.0003.000000	9567
	7590	10/21/2010	EXAMINER	
R. ROSS VIGUET			FOSTER, ROLAND G	
FULBRIGHT & JAWORSKI LLP			ART UNIT	
2200 ROSS AVE., SUITE 2800			PAPER NUMBER	
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SUITE 400  
HOUSTON, TX 77027

EXAMINER
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Patent Trial and Appeal Board

**Informative**

Standard Operating Procedure 2

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* ANTOR MEDIA CORPORATION

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Appeal 2010-007531

Reexamination Control 90/007,839; 90/007,936; 90/007,942; 90/007,957;  
and 90/009,261

Patent 5,734,961

Technology Center 3900

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Before RICHARD TORCZON, KARL EASTHOM, and STEPHEN C. SIU,  
*Administrative Patent Judges.*

SIU, *Administrative Patent Judge*

DECISION ON APPEAL<sup>1</sup>

Antor Media Corporation<sup>2</sup> appeals under 35 U.S.C. §§ 134(b) and 306 from a final rejection of claims 1-29. We have jurisdiction under 35 U.S.C. §§ 134(b) and 306.

STATEMENT OF THE CASE

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” shown on the PTOL-90A cover letter attached to this decision.

<sup>2</sup> Antor Media Corporation is the real party in interest.

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and 90/009,261

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This proceeding arose from five separate third party requests for *ex parte* reexamination of U.S. 5,734,961. The Office granted the requests and merged the five proceedings (i.e., Reexamination Control 90/007,839; 90,007,936; 90/007,942; 90/007,957; and 90/009,361).

Patentee's invention relates to transmitting information from a server to subscribers via a high data digital telecommunications network (Spec. Col. 1, ll. 15-18).

Representative claim 1 reads as follows:

1. Method of receiving information from one of a plurality of information systems via a high data rate telecommunication network in response to a request from one of plural subscriber stations, said method comprising the steps of:

initiating a two-way transmission from subscriber computer means of said one of said plural subscriber stations to one of said information systems via said telecommunication network,

outputting on output means of said one of said plural subscriber stations data related to plural information stored at one of said information systems,

selecting at said one of said plural subscriber stations at least one of said information by means of input; means of said one of said plural subscriber stations and transmitting a signal identifying said at least one selected information from said subscriber computer means to a selected information system via said telecommunication network,



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being unpatentable over the combination of Ghafoor and Huang;

(3) claim 25 under 35 U.S.C. § 103(a) as being unpatentable over Ghafoor and either Barrett or Huang and, in the alternative, over Huang and Barrett;

(4) claims 1-3, 5, and 13-15 under 35 U.S.C. § 102(b) as being anticipated by MINOS; and

(5) claims 1-29 under 35 U.S.C. § 103(a) as being unpatentable over Barrett and MINOS.

## ISSUES

Appellant argues that “Ghafoor is . . . not enabled with respect to the methods and systems claimed by Castille” (App. Br. 20) and that MINOS “is non-enabling because it did not put the public in possession of the claimed invention before the date of the invention” (App. Br. 36).

Appellant also argues that Ghafoor “does not teach all elements of the claim” (App. Br. 21, 25-26), fails to disclose “that the plural information storage means contain sounds and the transducer means contain speaker means” (App. Br. 25-26), fails to disclose “images and video display means” (App. Br. 26), and fails to disclose “a screen plotting means” (App. Br. 26). Appellant also argues that the combination of Ghafoor and Barrett fails to teach or suggest “subband decoding,” or “a way to interface ISDN to a workstation of the mini-computer system of Barrett” (App. Br. 30).

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Appellant argues that Huang fails to disclose the claimed invention because Huang is directed towards radiological systems, and teaches away from allowing sound as the data of interest” (App. Br. 31).

Appellant argues that MINOS “does not teach a plurality of information systems” or “a workstation retrieving information from one of a plurality of information systems (App. Br. 38) and that “the combination of Barrett in view of MINOS does not teach [or suggest] a plurality of information systems” (App Br. 39).

Appellant argues that “nothing in Ghafoor would merit a combination of Huang and Ghafoor” (App. Br. 28), that “Huang cannot be combined with Ghafoor without destroying its intended function” (App. Br. 29), that “Huang teaches away from the . . . system taught by Ghafoor” (*id.*), that it would not have been obvious to one of ordinary skill in the art to combine the Huang and Barrett references because “Huang teaches away from a printer by being focused on digital images and providing an image database solution” and that “[e]ven if it did not, the printer of Barrett is not of the high quality specific type that would be needed by Huang” (App. Br. 34), that “[a]dding a printer to Huang would be superfluous and would make the system described redundant” (*id.*), and that “[t]here is no reason that one skilled in the art would have been prompted to combine the elements of MINOS and Barrett” (App. Br. 39).

Thus, we identify the following issues:

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- 1) Does the Ghafoor reference provide an enabling disclosure of claims 1-3, 5-7, 9, 11-15, 17-19, 21-24, and 26-29?
- 2) Does the MINOS reference provide an enabling disclosure of claims 1-3, 5, and 13-15?
- 3) Did the Examiner err in finding that Ghafoor discloses the features recited in claims 1-3, 5-7, 9, 11-15, 17-19, 21-24, and 26-29?
- 4) Did the Examiner err in finding that Huang discloses the features recited in claims 1-3, 5-7, 9, 11-15, 17-19, 21-24, and 26?
- 5) Did the Examiner err in finding that MINOS discloses the features recited in claims 1-3, 5, and 13-15?
- 6) Did the Examiner err in finding that the combination of Ghafoor and Barrett discloses or suggests the features recited in claim 25?
- 7) Did the Examiner err in finding that it would have been obvious to one of ordinary skill in the art to have combined the Ghafoor and Huang references?
- 8) Did the Examiner err in finding that it would have been obvious to one of ordinary skill in the art to have combined the Huang, Barrett, and Ghafoor references?
- 9) Did the Examiner err in finding that it would have been obvious to one of ordinary skill in the art to have combined the MINOS and Barrett references?

Only those arguments actually made by Appellant have been considered in this decision. Arguments which Appellant could have made

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but chose not to make in the Brief have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

### FINDINGS OF FACT

1. Ghafoor discloses a “multiprocessor based architecture for a heterogeneous multimedia database (HMD) system” (Abstract).
2. Ghafoor discloses a user “workstation . . . to display multiple data to the user in the desired format” that is “able to interface with the communication network and support communication protocols in order to interact with the central controller and multimedia servers” (pg. 462, col. 2, 2.2. User Workstation).
3. Huang discloses “storage and retrieval of radiographic images” (pg. 397).
4. Huang discloses operations to “define a particular patient of interest, request to view a set of images for the patient, and . . . perform some sort of image processing” (Pg. 406).
5. Huang discloses that information is “transmitted to a storage device . . . and later . . . available for retrieval, display, manipulation, and review” (Pg. 409).

### PRINCIPLES OF LAW

“To be enabling under § 112, a patent must contain a description that

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enables one skilled in the art to make and use the claimed invention.” *Atlas Powder Co. v. E. I. Du Pont de Nemours & Co.*, 750 F.2d 1569, 1576 (Fed. Cir. 1984) (citing *Raytheon Co. v. Roper Corp.*, 724 F.2d 951, 960 (Fed. Cir. 1983)). “That some experimentation is necessary does not preclude enablement; the amount of experimentation, however, must not be unduly extensive.” *Id.* (citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1557 (Fed. Cir. 1983); *In re Angstadt*, 537 F.2d 498, 503 (CCPA 1976)).

Anticipation is established when a single prior art reference discloses, expressly or under the principles of inherency, each and every limitation of the claimed invention. *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1347 (Fed. Cir. 1999); *In re Paulsen*, 30 F.3d 1475, 1478-79 (Fed. Cir. 1994).

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007).

## ANALYSIS

*(1) Enablement of the Ghafoor reference*

*Claims 1-3, 5-7, 9, 11-15, 17-19, 21-24, and 26-29*

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Appellant argues that the Ghafoor reference is “not enabled with respect to the methods and systems claimed by Castille” (App. Br. 20) because “it [the Ghafoor reference] merely describes the overall architecture of the desired system, and does not seek to teach actual implementation” (App. Br. 21) and fails to enable the claimed invention “in reference to ‘output means’, input means’ and ‘transducer means’” (App. Br. 22).

The Examiner finds “intrinsic evidence” (Ans. 45), including the Specification of the ‘961 patent that, according to the Examiner, establishes a state of the prior art that demonstrates that Ghafoor provides sufficient enabling disclosure for claimed elements such as “the claim term ‘high data rate telecommunications network’” (Ans. 45-46), “the claimed ‘subscriber workstation’” (Ans. 46), “an ‘output means’” (*id.*), “[t]he claimed ‘input means’” (*id.*), and “[t]he claimed ‘transducer means’” (*id.*), with respect to the relative level of skill in the art. The Examiner further cites various working examples disclosed by Ghafoor including, for example, an “input device, such as a keyboard” (Ans. 46), a component that “transduces an input signal using a conventional, generic means” (*id.*), an “output device, such as a video screen, headphone, loudspeaker, or electronic printer structure” (*id.*), and “high-bandwidth networks” (Ans. 45).

The Examiner further finds that Ghafoor discloses details of a “conventional workstation” as recited in the claims of the ‘961 patent (Ans. 47) and disclosed in the Specification of the ‘961 patent as being previously known to those of skill in the art (Ans. 48).

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We agree with the Examiner. “To be enabling under § 112, a patent must contain a description that enables one skilled in the art to make and use the claimed invention.” *Atlas Powder Co*, 750 F.2d at 1576. “Whether undue experimentation is needed is not a single, simple factual determination, but rather is a conclusion reached by weighing many factual considerations.” “Factors to be considered in determining whether a disclosure would require undue experimentation . . . include (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims.” *In re Wands*, 858 F.2d 731, 737 (Fed.Cir. 1988). These factors are “commonly referred to as ‘the *Wands* factors’” *Warner-Lambert Co. v. Teva Pharm. USA, Inc.*, 418 F.3d 1326, 1337 (Fed. Cir. 2005) and “are a useful methodology for determining enablement . . . .” *Enzo Biochem, Inc. v. Calgene, Inc.*, 188 F.3d 1362, 1372 (Fed. Cir. 1999).

As described above, Appellant argues that the Ghafoor reference fails to provide an enabling disclosure of the claimed subject matter and also submitted an affidavit by an expert ( “Declaration of Dr. Ray Mercer” dated February 14, 2008, hereinafter “Mercer Dec’1”) who rendered a conclusion similar to that of Appellant (App. Br 20).

Claim 1 recites, for example, initiating a two-way transmission, outputting data at a station, selecting and identifying the information,

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transmitting a signal to a system, and receiving signals at the station.

Appellant fails to demonstrate that Ghafoor does not provide an enabling disclosure for any of the features recited in claim 1. Rather, Appellant merely argues that Ghafoor “[uses] equivocal language, such as ‘should’ . . . and ‘assume’” (Response to Non-Final Office Action in Ex Parte Reexamination, dated February 14, 2008 at 27, hereinafter “OA 2/14/08”), does not “specifically . . . address performance issues of their system” (*id.* 28), tries “to predict future trends” (*id.*), supposedly “fails to teach how to perform object integration” (*id.*), provides “no detail . . . on how heterogeneous data integration . . . is achieved” (*id.*), “provide no suggestion as to how the temporal timing may be maintained” (*id.* 29), “does not teach a suitable network connection to its workstation” (*id.* 32), and “does not teach a suitable user workstation or other device for use with the network” (*id.*). Appellants further argue that “Patent Owner’s Attorneys discussed their inability . . . to understand the query function using objects (O<sub>c</sub>:O<sub>1</sub>) on page 465 of *Ghafoor*” (*id.* 31). Even assuming Appellant’s contentions to be true that Ghafoor utilizes the terms “should” and “assume” and attempts to “predict future trends,” we are not persuaded that the use of such terms demonstrates the need for one of ordinary skill in the art to engage in undue experimentation to perform the claimed invention, particularly in view of the level of skill in the art or the predictability of the art, for example, with respect to the Ghafoor reference. Also, as the Examiner points out, none of the specific features (e.g., object integration or temporal timing) cited by

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Appellant are found in the claims (Ans. 49).

In addition, Appellant does not address the *Wands* factors and “fails to recognize that prior art references must be ‘considered together with the knowledge of one of ordinary skill in the pertinent art.’” *In re Paulsen*, 30 F.3d at 1480. Similar to the situation in *Paulsen* (in which a prior art reference “only discloses a box for a calculator”), the skill level of artisans involved in data transmission and contemplating Ghafoor’s teachings was “quite advanced.” *Id.* Appellant and Mr. Mercer do not aver that they were aware of the skill level involved in information transmission at the time of the invention and do not address the skill level.

Appellant’s technical expert similarly sets forth little or no factual basis upon which to support a conclusion of non-enablement. Mr. Mercer concludes that the reference is “forward-looking” and “intended to stimulate discussion rather than teach how to implement the technology” (See Mercer Dec’1 ¶ 10). However, Mr. Mercer fails to set forth a sufficient factual foundation to support a conclusion reflecting the proper legal standard for enablement based on undue experimentation under the *Wands* factors.

Appellant generally cites the *Wands* factors (App. Br. 20) but makes no attempt to consider the factors with respect to the present case and does not apply the *Wands* factors to render a determination of “undue experimentation,” such as the level of skill involved, the quantity of experimentation necessary, the predictability or unpredictability of the art, the breadth of the claims, etc. Accordingly Appellant has not established

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that Ghafoor constitutes a non-enabling anticipatory reference.

*(2) Enablement of the MINOS reference*

*Claims 1-3, 5, and 13-15*

Appellant argues that MINOS “is non-enabling because it did not put the public in possession of the claimed invention before the date of the invention” (App. Br. 36).

The Examiner finds that, given the level of skill in the art and the state of the prior art, the MINOS reference would have been enabling to one of ordinary skill in the art to practice the claimed invention without undue experimentation (Ans. 54-56).

We agree with the Examiner. Appellant asserts that because MINOS allegedly discloses a telephone network that “is separate from the digital data network” that an “indication of the current state of the art” is provided (App. Br. 36). However, Appellant fails to indicate what the “current state of the art” is indicated to be based on a telephone network being separate from a digital data network. Appellant appears to argue that the “current state of the art” indicates that “MINOS would require experimentation” (App. Br. 36) but fails to demonstrate, or even assert, that one of ordinary skill in the art would have to engage in *undue* experimentation to achieve the claimed invention. Thus, we agree with the Examiner that Appellant’s assertion “fails to even address whether the additional experimentation

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would have been undue” (Ans. 55). As noted above, Appellant fails to address the *Wands* factors with respect to the claimed invention.

Similarly, Appellant argues that MINOS discloses a “query interface [that] was not fully developed” (App. Br. 37) and “problems . . . to be solved . . . [that] were so substantial” (App. Br. 37), but fails to specify the alleged “problems” or show how such alleged “problems” or other factors would have required undue experimentation on the part of one of skill in the art given the MINOS reference.

Appellant’s technical expert (Dr. Ray Mercer) similarly fails to set forth a factual basis upon which to support a conclusion of non-enablement. Dr. Mercer generally states that “[o]ne of ordinary skill in the art . . . would not have been able to make or use the system . . . without undue experimentation” (Mercer Dec’1 ¶ 21) but does not mention or apply the *Wands* factors to render that determination, such as level of skill in the art, quantity of experimentation necessary, predictability or unpredictability of the art, breadth of the claims, etc.

Accordingly, Appellant has not established that MINOS constitutes a non-enabling anticipatory reference.

*(3) Anticipation under 35 U.S.C. § 102(a) and § 102(b) by Ghafoor  
Claims 1-3, 5-7, 9, 11-15, 17-19, 21-24, and 26*

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Appellant argues that “Ghafoor does not . . . describe ‘a system for transmitting information from a server to subscribers via a high data digital telecommunications network’” (App. Br. 21).

Even assuming that the claims recite “a system for transmitting information from a server to subscribers via a high data digital telecommunications network” as Appellant contends, as the Examiner points out, Ghafoor discloses a system including a “workstation . . . to display multiple data to the user” (pg. 462, col. 2) and a communication network “to interconnect geographically dispersed servers and users with broadband multimegabit services” (pg. 462, col. 2) over which data is transmitted. Ghafoor discloses a system in which geographically dispersed user workstations exchange data with servers via high speed data communication networks which we find indistinguishable from the feature disputed by Appellant. Nor has Appellant stated any differences.

Appellant further argues “[i]f all of the elements of the claim are disclosed in Ghafoor, there seems to be little incentive to combine Ghafoor with Huang” (App. Br. 22), however, Appellant fails to indicate any specific claimed features that Ghafoor fails to disclose. Therefore, we are not persuaded by Appellant’s argument.

Appellant argues that “Ghafoor does not teach ‘outputting data related to plural information’” (App. Br. 23) because Ghafoor discloses “plural information, and not data related to plural information” (App. Br. 24). We are not persuaded by Appellant’s argument because if Ghafoor discloses

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“plural information,” then this information must be related to the information that the plural information represents, i.e., Appellant has not demonstrated that the information in Ghafoor is unrelated to itself nor do we find that the information in Ghafoor is unrelated to itself.

Appellant also argues that “Ghafoor fails to teach initiating a two-way transmission from a subscriber computer station” but fails to demonstrate how a user workstation (i.e., subscriber computer station) exchanging information over a high speed data communication network with a server (as described above in Ghafoor) supposedly differs from the disputed claimed feature. Nor do we find any difference between the two seemingly identical features.

We therefore do not find Appellant’s arguments to be compelling and we find no error in the rejection of claims 1-3, 5-7, 9, 11-15, 17-19, 21-24, and 26.

#### *Claims 27-29*

Appellant argues that “[s]peaker means are not mentioned in Ghafoor” and that Ghafoor fails to disclose “images and video display means” or “screen plotting means” (App. Br. 26).

The Examiner finds that Ghafoor discloses data transmission in a system in which the data includes “full-motion video signals as well as audio signals” (pg. 461, col. 2) and a user workstation can “display multiple data to the user in the desired format” (pg. 462, col. 2) to provide, for example,

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“images, graphs, maps, charts, etc.” (id.). Since Ghafoor discloses providing audio, video, images, graphs, maps, or charts on output devices and since speakers provide sound, displays for images and video provide images and video, and screen plotting devices provide other images such as graphs, maps, and charts, we agree with the Examiner that, in the absence of specific structure disclosed in the Specification for the various output means, Ghafoor discloses devices that constitute speaker means (for output of audio), images and video display means (for output of images and video), and screen plotting means (for output of charts, maps, etc., for example).

We therefore do not find Appellant’s arguments to be compelling and we find no error in the rejection of claims 27-29.

*(4) Anticipation under 35 U.S.C. § 102(a) and § 102(b) by Huang  
Claims 1-3, 5-7, 9, 11-15, 17-19, 21-24, and 26*

Appellant argues that Huang fails to disclose “sound as the data of interest” (App. Br. 31). However, Appellant fails to indicate that any of the disputed claims recite that sound must be the “data of interest.” Since Appellant has not shown that sound must be the data of interest in the disputed claims, we find no relevance in Appellant’s argument that Huang supposedly fails to disclose this feature.

In addition, while Appellant argues that the Specification provides an example in which data includes audio data (App. Br. 31-32), we note that, “a particular embodiment appearing in the written description may not be read

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into a claim when the claim language is broader than the embodiment.”  
*Superguide Corp. v. DirectTV Enter., Inc.*, 358 F.3d 870, 875 (Fed. Cir.  
2004).

Similarly, Appellant argues that “Huang cannot teach speaker means”  
(App. Br. 33) but none of the disputed claims recite “speaker means.”

We therefore do not find Appellant’s arguments to be compelling and  
we find no error in the rejection of claims 1-3, 5-7, 9, 11-15, 17-19, and 21-  
24, and 26.

*(5) Anticipation under 35 U.S.C. § 102(b) by MINOS*  
*Claims 1-3, 5, and 13-15*

Appellant argues that “[t]here is no teaching in MINOS of a  
workstation retrieving information from one of a plurality of information  
systems” (App. Br. 38). As the Examiner states, MINOS discloses  
prefetching of pages, searching in signature files, and returning object  
identifiers and miniatures to the client workstation by the storage and  
retrieval subsystem in a distributed database system (Section 2.1 and 3.2;  
Ans. 56). Since Appellant has failed to demonstrate any differences between  
an information system in which requested data is transmitted from databases  
(i.e., “information systems”) to a user workstation (MINOS) and the claimed  
feature of receiving data at a subscriber station from an information system  
(or a database), we agree with the Examiner that MINOS discloses this  
feature.

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We therefore do not find Appellant's arguments to be compelling and we find no error in the rejection of claims 1-3, 5, and 13-15.

*(6) Obviousness under 35 U.S.C. § 103(a) over Ghafoor and Barrett*

*Claim 25*

Appellant argues that the rejection of claim 25 "is improper as the references combined do not show or suggest . . . subband decoding . . . [or] a way to interface ISDN to a workstation" (App. Br. 30). However, Appellant has not demonstrated that claim 25 requires these features. Claim 25 recites plural information storage means that contain documents and a transducer means that includes printing means that converts signals into writing. Claim 25 does not appear to recite "subband decoding" or "a way to interface ISDN to a workstation."

Therefore, we find Appellant's argument not persuasive.

*(7) Obviousness under 35 U.S.C. § 103(a) over Ghafoor and Huang*

*Claims 1-3, 5-7, 9, 11-15, 17-19, and 21-29*

As described above, Ghafoor discloses a system in which a user at a workstation obtains data over a high speed data communication network from databases (FF 1-2) and Huang discloses a system in which a user at a workstation obtains data over a network (FF 3-5). We agree with the Examiner that both Ghafoor and Huang are in the same field of endeavor. In addition, both Ghafoor and Huang disclose known elements performing their

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known functions of requesting and receiving data over a network that combine to provide the predictable result of receiving requested data over a network at a user or subscriber station. “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR Int’l Co.*, 550 U.S. at 416.

Appellant argues that “Huang cannot be combined with Ghafoor without destroying its intended function” (App. Br. 29). We disagree with Appellant’s contention because Huang’s “intended function” of requesting data and receiving the requested data over a network is the same as that of Ghafoor, namely, to request data and receive the requested data over a network. Appellant has not demonstrated how Ghafoor destroys an intended function when the intended function is the same as that of Ghafoor.

Appellant argues that “Huang teaches away from the heterogeneous multimedia database system taught by Ghafoor” (App. Br. 29). “A reference may be said to teach away when a person of ordinary skill, upon [examining] the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” *Para-Ordnance Mfg., Inc. v. SGS Importers Int’l, Inc.* 73 F.3d 1085, 1090 (Fed. Cir. 1995) (quoting *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994)). In this case, Appellant has not indicated that Huang (or Ghafoor) discourages a person of ordinary skill from following the path set out in either of the references. Rather, both Huang and Ghafoor disclose systems in which a user may request and

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receive data, the Huang reference further indicating that the data may include radiographic image data.

We therefore do not find Appellant's arguments to be compelling and we find no error in the rejection of claims 1-3, 5-7, 9, 11-15, 17-19, and 21-29.

*(8) Obviousness under 35 U.S.C. § 103(a) over Ghafoor, Huang and Barrett Claim 25*

The Examiner finds that Barrett discloses "receiving 'writing' information . . . and transducer means (such as the disclosed laser printer)" (Ans. 14). Appellant asserts that "the three references [Ghafoor, Huang, and Barrett] [are] from different fields" (App. Br. 34) but fails to provide support for the assertion. We also disagree with Appellant because each of Ghafoor, Huang, and Barrett disclose data retrieval systems in which a user requests data and receives data over a network. Thus, contrary to Appellant's assertion, Ghafoor, Huang, and Barrett are all from the same field, namely, the field of data retrieval over a network.

Appellant also argues that "Huang teaches away from a printer" (App. Br. 34) but fails to provide a rationale in support of this statement. For example, Appellant fails to indicate how one of skill in the art would be discouraged from following the path set out in the reference" *Par Ordnance Mfg., Inc.*, 73 F.3d at 1090.

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Appellant also argues that “the printer of Barrett is not of the high quality specific type that would be needed by Huang” and that “[a]dding a printer to Huang would be superfluous and would make the system described redundant” (App. Br. 34). First, we find no logic in Appellant’s contradictory arguments that Huang both requires a high quality printer and teaches away from a printer, and that adding a printer would be “superfluous.” Second, even assuming that Huang requires a high quality printer, Appellant has not demonstrated how Barrett’s explicit disclosure of the use of a printer (which Appellant alleges is required by Huang) does not render the disputed feature of a “printer means” obvious.

We therefore do not find Appellant’s arguments to be compelling and we find no error in the rejection of claim 25.

*(9) Obviousness under 35 U.S.C. § 103(a) over MINOS and Barrett*

*Claims 1-29*

The Examiner finds that one of ordinary skill in the art would have been motivated to combine Barrett and MINOS “to ‘allow the transfer of various types of digitized data . . .’” and that “efficiency would have been increased because ‘integrated communications [such as ISDN] allow the transfer of all data types on one communication network’” (Ans. 24).

Appellant argues that “[t]here is no reason that one skilled in the art would have been prompted to combine the elements of MINOS and Barrett” (App. Br. 39) but fails to provide a rationale in support of this contention or

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to demonstrate that the motivation to combine the references provided by the Examiner is in error. Nor do we independently find any error in the Examiner's findings.

The Examiner finds that “the patent owner has failed to provide sufficient evidence that the alleged commercial success . . . was directly derived from the invention as claimed” (Final Office Action, 3/25/09). We agree with the Examiner because while Appellant argues that various corporations have “taken licenses to the claimed subject matter” (App. Br. 41), “the mere existence of . . . licenses is insufficient to overcome the conclusion of obviousness” (*Sibia Neurosciences, Inc., v. Cadus Pharmaceutical Corp.*, 255 F.3d 1349, 1358 (Fed. Cir. 2000)). Also, while Appellant has asserted that certain corporations have “taken licenses,” Appellant has not asserted any specific reasons for the alleged actions of the cited corporations with regard to the claimed invention or a nexus between the merits of the invention and the alleged licenses. “[O]nly little weight can be attributed to such evidence [secondary considerations] if the patentee does not demonstrate ‘a nexus between the merits of the invention and the licenses of record.’” *In re GPAC Inc.*, 57 F.3d 1573, 1580 (Fed. Cir. 1995) (citing *Stratoflex, Inc., v. Aeroquip Corp.*, 713 F.2d 1530, 1539 (Fed. Cir. 1983)).

We therefore do not find Appellant's arguments to be compelling and we find no error in the rejection of claims 1-29.

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### CONCLUSIONS

We conclude that the Ghafoor reference and the MINOS reference provide enabling disclosures of the claimed subject matter; Ghafoor discloses the features recited in claims 1-3, 5-7, 9, 11-15, 17-19, 21-24, and 26-29; Huang discloses the features recited in claims 1-3, 5-7, 9, 11-15, 17-19, 21-24, and 26; MINOS discloses the features recited in claims 1-3, 5, and 13-15; the combination of Ghafoor and Barrett discloses or suggests the features recited in claim 25; it would have been obvious to one of ordinary skill in the art to have combined the Ghafoor and Huang references; it would have been obvious to one of ordinary skill in the art to have combined the Huang, Barrett, and Ghafoor references; and it would have been obvious to one of ordinary skill in the art to have combined the MINOS and Barrett references.

### DECISION

The decision of the Examiner to reject claims 1-29 is **AFFIRMED**.

Requests for extensions of time in this *ex parte* reexamination proceeding are governed by 37 C.F.R. § 1.550(c). *See* 37 C.F.R. § 41.50(f).

**AFFIRMED**

ack

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