

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HENRY C. YUEN
and DANIEL S. KWOH

Appeal No. 1996-3600
Application 08/284,371¹

HEARD: SEPTEMBER 13, 1999

Before JERRY SMITH, LALL and DIXON, Administrative Patent
Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed August 1, 1994. According to applicants, this application is a continuation of Application 07/676,934, filed March 27, 1991, now Patent No. 5,335,079, issued August 2, 1994, which is a continuation-in-part of Application 07/371,054, filed June 26, 1989 (abandoned); which is a continuation-in-part of Application 07/289,369, filed December 23, 1988 (abandoned).

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This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 106-127, 133-162 and 168-175. Claims 1-105 have been cancelled. Claims 128-132 and 163-167 have been indicated as containing allowable subject matter and are merely objected to as depending from rejected claims.

The disclosed invention pertains to a method and apparatus for programming and automatically recording video signals such as in a video tape recorder. An input receives signals representative of channel, date, time of day and program length in a compressed form. A decoder decodes and expands this data into the signals necessary to control a video recorder.

Representative claim 106 is reproduced as follows:

106. A system for programming and automatically recording programs transmitted using video signals, by a video recorder, under control of sets of channel, date, time-of-day and program length commands, the system comprising:

an input for receiving compressed coded indications into said system, each compressed coded indication incorporating the data represented in a set of individual channel, date, time-of-day and program length commands, wherein each of one or more of said compressed coded indications has a length that is less than the length of the concatenation of said

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incorporated individual channel, date, time-of-day and program length commands; and

a decoder for decoding and expanding each of one or more of said compressed coded indications into said set of individual channel, date, time-of-day and program length commands for control of the video recorder.

The examiner relies on the following references:

Welles, II (Welles)	4,623,887	Nov. 18, 1986
Beyers, Jr. (Beyers)	4,641,205	Feb. 03, 1987
Young	4,977,455	Dec. 11, 1990

(filed July 15, 1988)

Claims 106-127, 133-162 and 168-175 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Beyers in view of Welles with respect to all the claims and additionally adds Young with respect to claims 140, 141, 174 and 175.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

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We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 106-127, 133-162 and 168-175. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1,

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17, 148 USPQ 459, 467 (CCPA 1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

With respect to independent claims 106 and 142, the examiner cites Beyers as teaching a system for programming and automatically recording video signals. The system of Beyers

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automatically records programs by entering data into the system individually for channel, date, time of day and program length. The examiner notes that Beyers does not teach that the coded data is compressed, that a decoder is used to expand the coded information, and that the compressed codes are entered into the system as recited in claims 106 and 142 [answer, pages 4-7]. Welles teaches a universal remote control which can learn the commands of other remote controls. After the universal remote control of Welles learns the commands of another remote control, the learned commands are stored in memory in a compressed form to save memory space. The examiner concludes that it would have been obvious to substitute the universal remote control of Welles for the Beyers remote control to gain the advantage of reducing the number of remote control units as taught by Welles [id., pages 7-9].

Appellants' first argument is that Beyers fails to disclose either of the elements or steps of independent claims 106 and 142. Beyers teaches a conventional on-screen remote control unit for a video recorder in which channel, date, time

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of day and program length commands are sequentially entered into the remote control unit [see column 9, line 40 to column 11, line 8]. Thus, appellants are correct that the system of Beyers neither receives compressed coded indications of channel, date, time of day and program length, nor decodes and expands such information into a set of individual commands as recited in claims 106 and 142.

As noted above, Welles was cited by the examiner for its teaching of compressed data. Appellants argue that the compression of data in Welles has nothing to do with compressing coded indications of channel, data, time of day and program length information as recited in claims 106 and 142. Appellants are again correct that the only compression of data in Welles occurs after the data has already been entered into the system. The Welles universal remote only "learns" the meaning of the individual inputs of a master remote, and this learned information is simply stored in compressed form to save memory space. There is no compression of coded indications representative of channel, data, time of day and program length information in Welles.

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The examiner's proposal to replace Beyer's remote with Welles' remote makes no sense to us. Even if the Welles remote has been programmed to learn the commands of the Beyers remote, the Welles remote in combination with the Beyers system will not have the input and decoder as recited in claims 106 and 142. In other words, the Welles remote will simply operate as the Beyers remote, and programming the Welles remote cannot provide input and decoding functions to the Beyers system which the Beyers system did not have in the first place.

Furthermore, we can find no motivation whatsoever for combining the teachings of Beyers with those of Welles. It would appear that nothing can be gained by using a universal remote in Beyers that has anything to do with the claimed invention. Even if the teachings are combined, however, the recitations of independent claims 106 and 142 are not met by the combined teachings of these references as discussed above.

Since the teachings of Beyers and Welles, singly or in combination, do not teach or suggest the features of independent claims 106 and 142, we do not sustain the

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rejection of these claims or of any of the claims which depend therefrom. With respect to the rejection of claims 140, 141, 174 and 175 using the additional teachings of Young, since Young does not cure the deficiencies in the combination of Beyers and Welles, the rejection of these claims is also not sustained.

In summary, the evidence presented by the examiner does not support the rejection of claims 106-127, 133-162 and 168-175 under 35 U.S.C. § 103. Therefore, the decision of the examiner rejecting these claims is reversed.

REVERSED

	Jerry Smith)	
	Administrative Patent Judge)	
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)	
	Parshotam S. Lall)	BOARD OF
PATENT	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
	Joseph L. Dixon)	

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Administrative Patent Judge)

JS/cam

Christie, Parker & Hale
P. O. Box 7068
Pasadena, CA 91109-7068