

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte THOMAS J. ATON

---

Appeal No. 1997-1011  
Application No. 08/250,631<sup>1</sup>

---

ON BRIEF

---

Before BARRETT, FLEMING, and GROSS, Administrative Patent Judges.  
GROSS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 22, which are all of the claims pending in this application.

The appellant's invention relates to a communication system in which icon strings of information such as network identifiers or program titles are displayed with standard broadcasts. Claim

---

<sup>1</sup> Application for patent filed May 27, 1994. According to appellant, this application is a continuation of Application No. 07/678,570, filed March 28, 1991, now abandoned.

Appeal No. 1997-1011  
Application No. 08/250,631

1 is illustrative of the claimed invention, and it reads as follows:

1. A communication system comprising:

a transmitter for broadcasting communication signals having an information content, comprised of a standard broadcast format in addition to an associated icon string, said associated icon string being transmitted with the communication signal;

a receiver for receiving and processing said communication signals, said receiver comprising;

circuitry for processing said standard broadcast format portion of said communication signals in preparation for a display of said signals,

circuitry for stripping said associated icon string comprised of both close caption text and other icons from said communication signal,

decoding/processing circuitry for decoding and processing of said other icons, and

at least one display for the simultaneous display of said communication signals and said other icons, wherein said other icons displayed is the source information such as a network identifier or station call letters or a program title.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Niioka et al. (Niioka)	4,392,246	Jul. 05, 1983
Seth-Smith et al. (Seth-Smith)	4,890,319	Dec. 26, 1989
Takarada <sup>2</sup>	JP 60-103888	Jun. 08, 1985

---

<sup>2</sup> Takarada is the inventor name printed on the abstract and used by the examiner in the rejection, although Masao Kita and Tomoyoshi Kurisaki are the inventor names listed on the translation. We will refer to the reference as Takarada for purposes of our decision.

Appeal No. 1997-1011  
Application No. 08/250,631

Claims 1 through 22 stand rejected under 35 U.S.C. § 103 as being unpatentable over Takarada in view of Niioka, further in view of Seth-Smith with respect to claims 16 and 17.

Reference is made to the Examiner's Answer (Paper No. 27, mailed May 21, 1996) and the Supplemental Examiner's Answer (Paper No. 29, mailed November 25, 1996) for the examiner's complete reasoning in support of the rejections, and to appellant's Brief (Paper No. 26, filed January 23, 1996) and Reply Brief (Paper No. 28, filed July 26, 1996) for appellant's arguments thereagainst.

#### OPINION

As a preliminary matter, we note that appellant indicates on page 5 of the Brief that the claims do not stand or fall together. Appellant supplies arguments as to the separate patentability of claims 11 and 16, but does not mention claim 12, and merely reproduces the limitations recited in each of claims 2 through 10, 13 through 15, and 17 through 22. 37 CFR § 1.192(c)(7) (1995), which was controlling at the time of appellant's filing the Brief, states,

For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the

Appeal No. 1997-1011  
Application No. 08/250,631

claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable (underlining added for emphasis).

Therefore, we will consider the claims according to the following groups, (1) claims 1 through 10, 14, 15, and 19 through 21, (2) claims 11 through 13, (3) claims 16 and 17, and (4) claims 18 and 22, with claims 1, 11, 16, and 18 as representative.

We have carefully considered the claims, the applied prior art references, and the respective positions articulated by appellant and the examiner. As a consequence of our review, we will reverse the obviousness rejection of claims 1 through 22.

Appellant's sole argument with respect to claim 1 (Reply Brief, pages 1-2) is that neither Takarada nor Niioka discloses transmitting icons which display the source information, such as a network identifier, station call letters, or a program title. The examiner asserts (Answer, page 3) that it would have been obvious in view of the teachings of Niioka to use network identifiers as Takarada's character data.

Takarada discloses (translation, page 4-5) a transmitter (transmission circuit 2), which transmits communication signals (character data  $V_d$  and video signals  $V_f$ ), a receiver (antenna 11), stripping circuitry (processing circuit 13, which separates video signals  $V_f$  from the remaining signals  $V_o$ ), and a display

Appeal No. 1997-1011  
Application No. 08/250,631

(picture tube 15). Takarada, however, includes a single type of character data (which appears to be for close captioning) and does not describe source information as the character data. Claim 1, on the other hand, requires two types of icons, close captioning and source data. Niioka discloses providing a broadcast wave receiving system with a display of channel receiving information, such as the call signs of the stations, to inform the user of the name or call sign of a channel as it is received. Niioka, however, does not transmit the call signs with the broadcast. Rather, Niioka presets and stores the information at the receiver and compares the frequency of the received broadcast with frequency data stored with the call signs.

We find no motivation in either reference for transmitting the network identifiers with the broadcast signals, as the disclosure of Niioka is limited to presetting such information at the receiver. Additionally, neither reference discloses transmitting both close captioning and source data as the character data, as Takarada transmits only one type of character data and Niioka does not transmit any type of icon or character data. Accordingly, the examiner has failed to establish a prima facie case of obviousness. Therefore, we cannot sustain the rejection of claims 1 through 10, 14, 15, and 19 through 21.

Appeal No. 1997-1011  
Application No. 08/250,631

Claim 11 does not specify that the icons display source information, but still requires two kinds of icons, including close captioning. As explained above, Takarada is limited to a single type of character data, and Niioka does not teach transmitting any. Also, claim 11 recites separating the icons by function, and storing them in function specific memory circuits. The examiner asserts (Answer, page 6) that Takarada's memory 24 is a function specific memory, thereby meeting the claim limitation. Appellant contends (Reply Brief, page 4) that neither reference discloses such function specific memories. As Takarada transmits only one type of character data, Takarada requires only one type of memory. Consequently, memory 24 is a single memory rather than plural memory circuits, as recited in claim 11, and is not function specific. Accordingly, we cannot sustain the rejection of claim 11, nor claims 12 and 13, which are grouped therewith.

Claim 18 again recites two kinds of icons including close captioning. As explained above, neither reference discloses transmission of two types of icons. Further, the examiner has failed to address the additional limitation of turning on automatically to down-load the icons for at least one channel. The examiner asserts (Answer, page 4) in regard to claim 22 (which further limits claim 18) that automatically turning on the

Appeal No. 1997-1011  
Application No. 08/250,631

receiver in the middle of the night would have been obvious because the operator might preprogram the system to turn on and receive icons for later. However, in the absence of the second type of icon, we find no motivation for down-loading such icons by automatically turning on the receiver. Accordingly, we cannot sustain the rejection of claim 18 nor the rejection of claim 22, which is grouped therewith.

Claims 16 and 17 include the same limitations as claim 11, with the addition of a non-volatile memory for one of the function specific memories. Seth-Smith, which was applied for a teaching of non-volatile memory, does not cure the deficiencies discussed above. Thus, we cannot sustain the rejection of claims 16 and 17.

The examiner should consider the attached disclosure on pages 80-81 of Television Electronics: Theory and Servicing, eighth edition, by Milton S. Kiver and Milton Kaufman, published in 1983, in determining the obviousness of the claims. For example, in reference to claim 1, pages 80-81 indicate that information which may be transmitted and displayed visually with program related data signals include text for deaf viewers (close captioning) and channel number or other broadcast messages (which, broadly interpreted, could include source data).

Appeal No. 1997-1011  
Application No. 08/250,631

CONCLUSION

The decision of the examiner rejecting claims 1 through 22 under 35 U.S.C. § 103 is reversed.

REVERSED

LEE E. BARRETT	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
MICHAEL R. FLEMING	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
ANITA PELLMAN GROSS	)	
Administrative Patent Judge	)	

vsh

Appeal No. 1997-1011  
Application No. 08/250,631

TEXAS INSTRUMENTS, INC.  
M/S 219  
P.O. BOX 655474  
DALLAS, TX 75265