

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.



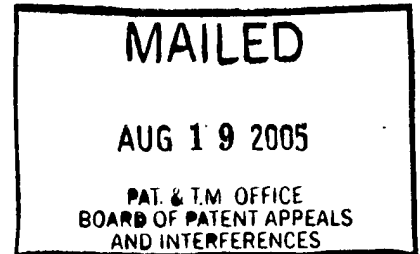
UNITES STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HERMAN MATHIAS

Appeal No. 2005-1851
Application 09/612,788

HEARD
August 10, 2005



Before THOMAS, BLANKENSHIP, AND MACDONALD, **Administrative Patent Judges**.

Per curiam.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-25 and 27-30. Claim 26 has been canceled.

We AFFIRM.

Claims 2, 11, 12, 14, 23, and 24 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of AG-1991 and AAPA.

Claims 3, 5-10, 13, 15-20, and 29 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of AG-1991 and Mantha.¹

Throughout our opinion, we make references to the Appellant's briefs, and to the Examiner's Answer for the respective details thereof.²

OPINION

With full consideration being given to the subject matter on appeal, the Examiner's rejections and the arguments of the Appellant and the Examiner, for the reasons stated *infra*, we affirm the Examiner's rejection of claims 1, 4, 21, 22, 25, 27, 28, and 30 under 35 U.S.C. § 102, and we affirm the Examiner's rejection of claims 2, 3, 5-20, 23, 24, and 29 under 35 U.S.C. § 103.

Only those arguments actually made by Appellant have been considered in this decision. Arguments that Appellant could have made but chose not to make in the brief have not been considered. We deem such arguments to be waived by Appellant [see 37 CFR § 41.37(c)(1)(vii) effective September 13, 2004 replacing 37 CFR § 1.192(a)].

Appellant has indicated that for purposes of this appeal the claims stand or fall together in two groupings:

¹ The Examiner lists claims 13 and 15-20 together with claims 3, 5-10, and 29 as rejected on the same grounds. We note that the grounds of rejection of claims 13 and 15-20 should include all the references applied to claim 11 from which they depend. Given Appellant has not complained of the Examiner's oversight, Appellant has waived the right to raise that issue.

² Appellant filed an appeal brief on June 28, 2004. Appellant filed a reply brief on April 25, 2005. The Examiner mailed an Examiner's Answer on March 10, 2005.

Claims 1-10, 21-22, 25, and 27-30 as Group I; and

Claims 11-20 and 23-24 as Group II.

See page 4 of the brief. Appellant argues each group of claims separately and explains why the claims of each group are believed to be separately patentable. Further, Appellant separately argues the rejections that rely on the Mantha reference (Claims 3, 5-10, 13, 15-20, and 29). See pages 19-21 of the brief. Appellant has fully met the requirements of 37 CFR § 1.192 (c)(7) (July 1, 2002) as amended at 62 Fed. Reg. 53169 (October 10, 1997), which was controlling at the time of Appellant's filing of the brief. 37 CFR § 1.192 (c)(7) states:

Grouping of claims. 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 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.

We will, thereby, consider Appellant's claims as standing or falling together in four groups based on the grounds of rejection and Appellant's arguments, and we will treat:

Claim 1 as a representative claim of Group I (claims 1, 4, 21, 25, 27, 28, and 30);

Claim 2 as a representative claim of Group II (claim 2);

Claim 11 as a representative claim of Group III (claim 11, 12, 14, and 23-24); and

Claim 3 as a representative claim of Group IV (claims 3, 5-10, 13, 15-20, and 29).

If the brief fails to meet either requirement, the Board is free to select a single claim from each group and to decide the appeal of that rejection based solely on the selected representative claim.

In re McDaniel, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002). **See also In re Watts**, 354 F.3d 1362, 1368, 69 USPQ2d 1453, 1457 (Fed. Cir. 2004).

I. Whether the Rejection of Claims 1, 4, 21, 25, 27, 28, and 30 Under 35 U.S.C. § 102 is proper?

It is our view, after consideration of the record before us, that the disclosure of AG-1991 does fully meet the invention as recited in claims 1, 4, 21, 25, 27, 28, and 30. Accordingly, we affirm.

With respect to independent claim 1, Appellant argues at pages 10-13 of the brief and pages 2-8 of the reply brief, that in AG-1991, the insert is not “displayed over the broadcasted image of the sporting event” as required by claim 1. Rather, Appellant contends “these updates appear on the viewing screen only during commercial breaks, during breaks for interviews or after the competition had ceased.” For purposes of our decision we will treat Appellant’s argument above as being persuasive as to the teaching of the AG-1991 prior art. However, even accepting this as a given, we find Appellant’s overall argument unpersuasive.³

It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. **See In re King**, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) and **Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.**, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

In our review of the AG-1991 reference, we find the reference teaches everything recited in claim 1 except the limitation “sporting” as argued by Appellant. We note that Appellant does

³ We also note that it appears to us that a strong case can be made that a broadcasted sporting event includes commercial breaks, interview breaks, and the period immediately after the competition has ceased.

not argue otherwise. Specifically, Appellant does not argue that AG-1991 fails to teach the insert is displayed over the broadcasted image of an event (contestant interview). Rather, Appellant argues AG-1991 fails to teach the event is a sporting event at the time of the display of the insert. As previously stated, we will take as a given that in AG-1991 the broadcasted television program image (nonfunctional descriptive material) is an event, but not a sporting event. Therefore, AG-1991 does not explicitly teach nonfunctional descriptive material in the form of a sporting event. However, our reviewing court has held that nonfunctional descriptive material cannot lend patentability to an invention that would have otherwise been anticipated by the prior art. **In re Ngai**, 367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004). Cf. **In re Gulack**, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability).

Common situations involving nonfunctional descriptive material are:

- a computer-readable storage medium that differs from the prior art solely with respect to nonfunctional descriptive material, such as music or a literary work, encoded on the medium,
- a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (i.e., the descriptive material does not reconfigure the computer), or
- a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention.

Thus, if the prior art suggests storing a song on a disk, merely choosing a particular song to store on the disk would be presumed to be well within the level of ordinary skill in the art at the time the invention was made.

We agree with the Examiner that the prior art anticipates claim 1 because it teaches each and every limitation of the claim. The difference between the prior art and the claimed invention is simply a rearrangement of nonfunctional descriptive material (the particular broadcasted image). Therefore, we will sustain the Examiner's rejections under 35 U.S.C. § 102 and 35 U.S.C. § 103.

II. Whether the Rejection of Claim 2 Under 35 U.S.C. § 103 is proper?

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 have suggested to one of ordinary skill in the art the invention as set forth in claim 2. Accordingly, we affirm.

With respect to dependent claim 2, Appellant presents no arguments in addition to those presented for claim 1. We have addressed those arguments above, and have found them to be unpersuasive.

Therefore, we will sustain the Examiner's rejection under 35 U.S.C. § 103.

III. Whether the Rejection of Claims 11, 12, 14, and 23-24 Under 35 U.S.C. § 103 is proper?

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 have suggested to one of ordinary skill in the art the invention as set forth in claims 11, 12, 14, and 23-24. Accordingly, we affirm.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a **prima facie** case of obviousness. **In re Oetiker**, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). **See also In re Piasecki**, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. **In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellant. **Oetiker**, 977 F.2d at 1445, 24 USPQ2d at 1444. **See also Piasecki**, 745 F.2d at 1472, 223 USPQ at 788.

An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. “In reviewing the [E]xaminer’s decision on appeal, the Board must necessarily weigh all of the evidence and argument.” **Oetiker**, 977 F.2d at 1445, 24 USPQ2d at 1444. “[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency’s conclusion.” **In re Lee**, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

With respect to dependent claim 11, at pages 16-19 of the brief, Appellant again argues the “sporting event” distinction discussed above. We again find the argument unpersuasive for the reasons noted above.

Appellant also argues on page 18-19, that the selection step is neither shown nor suggested by the AAPA or by the prior art reference cited by the Examiner. Notwithstanding Appellant’s arguments to the contrary, Appellant admits at lines 12-16 of page 19, “the [AG-1991] reference could be combined with the admitted prior art [AAPA] to reject the claims at issue” if Appellant were claiming as his invention “using color coded icons during intermissions in the broadcast of sporting events.” Given we have already held that there is no patentable difference between a broadcasted image of an interview (during intermission) and the broadcasted image of a sporting event, and Appellant admission that the references could be combined to reject “using color coded icons during intermissions in the broadcast”, we take this as an admission that the rejection is correct.

Therefore, we will sustain the Examiner’s rejection under 35 U.S.C. § 103.

IV. Whether the Rejection of Claims 3, 5-10, 13, 15-20, and 29 Under 35 U.S.C. § 103 is proper?

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 have suggested to one of ordinary skill in the art the invention as set forth in claims 3, 5-10, 13, 15-20, and 29. Accordingly, we affirm.

With respect to dependent claim 3, Appellant argues at pages 19-21 that it is not reasonable to combine Mantha with the AG-1991 reference.

In our review of the references, we find AG-1991 teaches the background (nonfunctional descriptive material) on the icon is color-coded to a uniform color of a contestant. AG-1991 does not explicitly teach nonfunctional descriptive material in the form of letters representing each contestant name can be color-coded. However, as previously discussed, nonfunctional descriptive material cannot lend patentability to an invention that would have otherwise been taught by the prior art. We find that since AG-1991 teaches nonfunctional descriptive material on the icon is color-coded to a uniform color of a contestant, AG-1991 teaches all the limitations of claim 3.

It is our view that Mantha is merely cumulative to the teachings of AG-1991. Therefore, Mantha is not necessary for a proper rejection under 35 U.S.C. § 103 of representative claim 3, as AG-1991 discloses all that is claimed. A disclosure that anticipates under 35 U.S.C. § 102 also renders the claim unpatentable under 35 U.S.C. § 103, for “anticipation is the epitome of obviousness.” **Jones V. Hardy**, 727 F.2d 1524, 1529, 220 USPQ 1021, 1025 (Fed. Cir. 1984). See also **In re Fracalossi**, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982); **In re Pearson**, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974).⁴ Accordingly, the Examiner’s obviousness rejection of representative claim 3 is sustained based on AG-1991 alone.

Alternatively, since AG-1991 teaches all the limitations of claim 3 as discussed above, its teachings provide more than sufficient basis to combine the cumulative teachings of Mantha with the AG-1991 reference in a rejection under 35 U.S.C. § 103.

Therefore, we will sustain the Examiner’s rejection under 35 U.S.C. § 103.

⁴ The Board may rely on less than all of the references applied by the Examiner in an obviousness rationale without designating it as a new ground of rejection. **In re Bush**, 296 F.2d 491, 496, 131 USPQ 263, 266-67 (CCPA 1961); **In re Boyer**, 363 F.2d 455, 458 n.2 150 USPQ 441, 444 n.2 (CCPA 1966).

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WADDEY & PATTERSON
414 UNION STREET, SUITE 2020
BANK OF AMERICA PLAZA
NASHVILLE TN 37219