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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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KINNEY C. BACON, HAMAN R. THOMAS, DAVID B. LETT,
ROBERT O. BANKER, AND MICHAEL P. HARNEY

Appeal No. 1998-0460
Application No. 08/480,765

ON BRIEF¹

Before THOMAS, BARRETT, and BARRY, Administrative Patent Judges.
BARRY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the final rejection of claims 12-63 and 68-70. We affirm-in-part.

¹ The oral hearing set for February 22, 2000 was waived by appellants in the facsimile communication received on February 1, 2000.

BACKGROUND

Subscription television systems permit subscribers to receive broadcasts of television programs. A subscriber terminal, commonly called a set-top box, is integral to the systems. A subscription television system may include several hundred thousand terminals.

Each terminal is controlled by an internal, programmable microcontroller. A control program for the microcontroller is stored in a memory inside the terminal. Heretofore, the control program could be changed only by physically replacing the memory. Because such replacement required a technician to visit each subscriber, however, the arrangement was expensive and inconvenient.

The invention at issue in this appeal reprograms a terminal from a remote location. More specifically, a head end sends to the terminal a command specifying a channel over which a control program is to be downloaded, the number of

transactions required to download the program, and the memory space where the program is to be stored.

Claim 12, which is representative for our purposes, follows:

12. A method of downloading program code to change the control program for a computer in a subscriber terminal of a subscription television system, the method comprising the steps of:

providing a memory in the subscriber terminal for storing the control program;

storing in the memory a boot code program operative for downloading new program code for at least a portion of the control program of the computer into the memory from a remote location, the control program operative for controlling predetermined features of the subscriber terminal;

activating the boot code program in response to a predetermined condition;

operating the computer under control of the boot code program to download the new program code from the subscription television system; and

storing the new program code in the memory.

The references relied on in rejecting the claims follow:

Cheung 1984	4,430,669	Feb. 7,
Bacon et al. (Bacon) 1995	5,440,632	Aug. 8,

(filing date Mar. 28,
1994).

Claims 12-16, 18, 34-63, and 68-70 stand rejected "under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over Cheung" (Final Rejection at 3.) Claims 17 and 19-33 stand rejected under the doctrine of obviousness-type double patenting "as being unpatentable over claim [sic] of U.S. Patent No. 5,440,632." (Id. at 4.) Rather than repeat the arguments of the appellants or examiner in toto, we refer the reader to the brief and answer for the respective details thereof.

OPINION

In reaching our decision in this appeal, we considered the subject matter on appeal and the rejections advanced by the examiner. Furthermore, we duly considered the arguments and evidence of the appellants and examiner. After considering the totality of the record, we are persuaded that the examiner erred in rejecting claims 12-16, 18, 34-63, and

68-70. We are not persuaded, however, that he erred in rejecting claims 17 and

19-33. Accordingly, we affirm-in-part. Our opinion addresses the following issues seriatim:

- anticipation and obviousness of claims 12-16, 18, 34-63, and 68-70
- obviousness-type double patenting of claims 17 and 19-33.

First, we address the anticipation and obviousness of claims 12-16, 18, 34-63, and 68-70.

Anticipation and Obviousness of Claims 12-16,
18, 34-63, and 68-70

We begin by noting standards for anticipation and obviousness. Rowe v. Dror, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997), established the following standard for anticipation.

A prior art reference anticipates a claim only if the reference discloses, either expressly or inherently, every limitation of the claim. See Verdegaal Bros., Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "[A]bsence from the reference of any claimed element negates anticipation." Kloster Speedsteel AB v. Crucible, Inc., 793 F.2d 1565, 1571, 230 USPQ 81, 84 (Fed. Cir. 1986).

In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993), in turn, established the following standard for obviousness.

In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. Id. "A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." In re Bell, 991 F.2d 781, 782, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting In re Rinehart, 531 F.2d 1048, 1051, 189 USPQ 143, 147

(CCPA 1976)). If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

With these standards in mind, we address the examiner's rejection and the appellants' argument.

At the outset, we observe that the examiner fails to map the exact and complete language of the claims to the teachings of the Cheung. He also neglects to identify the language of the claims missing from the reference that is required in the obviousness rejection analysis. In addition, the examiner omits an explanation of how he proposes to modify Cheung or why one of ordinary skill in the art would have been motivated to do so.

The appellants argue, "the Cheung patent does not disclose or contemplate the operation of downloading new program code for the control program of the computer that operates and controls the features of the subscriber terminal" (Appeal Br. at 15.) The examiner replies, "In Cheung though, the entertainment program codes still can be said to

change the operating control program of CPU 26 by providing different parameters, rather than different executable instructions." (Examiner's Answer at 4.)

The examiner misinterprets the scope of claims 12-16, 18, 34-63, and 68-70. "[W]hen interpreting a claim, words of the claim are generally given their ordinary and accustomed meaning, unless it appears from the specification or the file history that they were used differently by the inventor." In re Paulsen, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994) (citing Carroll Touch, Inc. v. Electro Mechanical Sys., Inc., 15 F.3d 1573, 1577, 27 USPQ2d 1836, 1840 (Fed. Cir. 1993)).

Here, claims 12-16, 18, and 34-36 each specify in pertinent part the following limitations:

A method of downloading program code to change the control program for a computer in a subscriber terminal of a subscription television system, the method comprising the steps of:

...
... downloading new program code for at least a portion of the control program of the computer ..., the control program operative for controlling

predetermined features of the subscriber terminal

....

Similarly, claims 38-56 each specify in pertinent part the following limitations: "program code for the control program of said processor, said control program operative for controlling predetermined features of the subscriber terminal; and ...

downloading new program code" Also similarly, claims 57-62 each specify in pertinent part the following limitations:

A method of downloading program code to change the control program for each computer in a selected set comprising one or more subscriber terminals in a subscriber base of a subscription television system, the method comprising the steps of:

...
determining the selected set of subscriber terminals in the subscriber base for receiving new program code for the control program;

...
in response to determination by a particular subscriber terminal that it is a member of the selected set, operating the computer associated with the particular subscriber terminal to download the new program code from the subscription television system

In addition, claim 63 similarly specifies in pertinent part the following limitations:

A method of downloading program code to change the control program for the computer of the subscriber terminals in a subscriber base of a subscription television system, the method comprising the steps of:

...
globally transmitting the new program code to each subscriber terminal in the subscriber base ...;

...
in response to determination by a subscriber terminal that the new program code is globally transmitted, operating the computer associated with the subscriber terminal to download the new program code from the subscription television system

Furthermore, claims 68-70 each specify in pertinent part the following limitations:

A method of downloading program code to change the control program for a computer in a subscriber terminal of a subscription television system, the method comprising the steps of:

...

... a download routine operative for downloading new program code for at least a portion of the control program of the computer into the memory from a remote location;

...

in response to receipt of the download immediate command, operating the computer under control of the download routine to download the new program code

....

Because neither the specification nor the file history defines the term "code" nor suggests that the appellants sought to assign a meaning to the term different from its ordinary and accustomed meaning, that is the meaning we must give it. Code is "a generic term for program instructions" Microsoft Press Computer Dictionary 78 (1994) (copy attached). A program is "a sequence of instructions that can be executed by a computer." Id. at 319. In view of these meanings, the common claim limitations recite downloading "program code" instructions used to change a control program executed by a processor.

The examiner fails to show a teaching or suggestion of the limitations in the prior art. Although Cheung teaches downloading, it does not teach downloading program instructions or using the download to change a control program executed by a processor. Rather than downloading program instructions, the reference's television receiver downloads data that represent operating parameters. Specifically, a "subscriber identification number, station identification number and time of future special program broadcast is stored" Col. 9, ll. 11-14.

Instead of changing a control program, moreover, Cheung's receiver uses the downloaded data to tune into and descramble a broadcast. Specifically, "the time of broadcast of the special program as well as other identifying information, transmitted with the subscriber identification number, is stored in memory and recalled at the time of the special broadcast for tuning the frequency associated with the special broadcast." Col. 2, ll. 40-45. In addition, "the [receiver's] memory 36 must have been previously programmed

with information regarding the broadcast being received to permit unscrambling of the video and audio signals thereby restoring a correct video signal for modulating on a signal within the pass band of the television receiver by modulator 34." Col. 10, ll. 21-26.

The absence of a showing of the claimed limitations of downloading program instructions used to change a control program executed by a processor negates anticipation. Therefore, we reverse the rejection of claims 12-16, 18, 34-63, and 68-70 under 35 U.S.C. § 102. Because the reference neither teaches downloading program instructions nor a downloading program code to change a control program executed by a processor, we are not persuaded that teachings from the prior art would appear to have suggested the same claimed limitations. Therefore, we reverse the rejections of the same claims under 35 U.S.C. § 103. Next, we address the obviousness-type double patenting of claims 17 and 19-33.

Obviousness-Type Double Patenting of Claims 17 and 19-33

The appellants do not contest the rejection of claims 17 and 19-33 under the doctrine of obviousness-type double patenting. They instead state, "Applicants will either submit a terminal disclaimer or cancel the claims rejected under obviousness type double-patenting." (Appeal Br. at 21.) We are not persuaded that the examiner erred in rejecting claims 17 and 19-33 under the doctrine of obviousness-type double patenting over Bacon. Therefore, we affirm pro forma the rejection.

Our affirmance is based only on the arguments made in the brief. Arguments not made therein are not before us, are not at issue, and are considered waived.

CONCLUSION

To summarize, the rejection of claims 12-16, 18, 34-63, and 68-70 stand rejected under 35 U.S.C. § 102(b) is reversed. The rejection of claims 12-16, 18, 34-63, and 68-70 under 35 U.S.C. § 103 is also reversed. The rejection of claims 17 and 19-33 under the doctrine of obviousness-type double patenting is affirmed. Accordingly, we affirm-in-part.

No period for taking subsequent action concerning this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

JAMES D. THOMAS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LEE E. BARRETT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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)	
LANCE LEONARD BARRY)	
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