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United States Court of Appeals for the Federal Circuit

03-1372
(Serial No. 09/515,060)

IN RE RAYMOND ANTHONY JOAO

DECIDED: November 5, 2003

Before MAYER, Chief Judge, NEWMAN and LINN, Circuit Judges.

PER CURIAM.

Appellant Raymond Anthony Joao seeks review of a decision of the United States Patent and Trademark Office Board of Patent Appeals and Interferences sustaining a rejection of Joao's application as obvious under 35 U.S.C. § 103(a). We affirm.

Because Joao's arguments focus on the teachings of the prior art, our obviousness inquiry focuses on whether the board's factual findings as to those teachings are supported by substantial evidence. See In re Berg, 320 F.3d 1310, 1312 (Fed. Cir. 2003). The PTO has the burden under section 103 to establish a prima facie case of obviousness, and it can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. In re Fine, 837 F.2d 1071, 1074 (Fed. Cir. 1988). In this case the PTO satisfied this burden by showing that the teachings of

Dunn and Houstis expressly provide motivation to combine the features of both references and that both are within similar fields of endeavor.

Joao does not dispute that all of the limitations of representative claim 1 are found in the combination of Houstis and Dunn. Instead, he contends only that these references were improperly combined, using hindsight reconstruction, without evidence to support the combination and in the face of a contrary teaching in Houstis. Joao repeatedly relies on a single passage found in Houstis, claiming the Houstis system is “radically different” from prior art distance education systems, which include cable television-based systems.

The board properly determined that one of ordinary skill would have been motivated to add the reminder or playback teachings of Dunn to Houstis to remind the viewer of the video content that was last shown before the video stopped. Joao relies upon Houstis disclosing that “[t]he proposed approach, as will become clear in the following pages, differs radically from the above TV-based traditional ones.” This statement, however, does not teach away from combining a traditional cable system, like Dunn, with the interactive multimedia system disclosed in Houstis. Instead, Houstis teaches that its proposed interactive multimedia system (primarily Internet based), which enables users to view educational materials at any desired time, is “radically different” from traditional distance learning practices, such as satellite transmissions of live classroom lectures shown on some local cable channels that require users to observe lectures at predetermined times. In contrast, one skilled in the art would find Houstis directly analogous to Dunn, which discloses an interactive entertainment network system capable of connecting to multiple user interface units that allow users to stop a program and later return with a predetermined portion of the program being repeated. The technology and function of each reference overlap considerably. Additionally, Houstis and Dunn provide related teachings that defeat Joao’s teaching away arguments while simultaneously showing that the two references are in the same field of endeavor. Houstis teaches a system that permits a user to learn from an interactive multimedia system at a “self-paced” speed, while Dunn’s reminder and playback features are not only compatible with such a system but would be viewed as a highly desirable combination to one skilled in the art.