

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

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YOICHIRO SAKO, AKIRA KURIHARA,
YOSHITOMO OSAWA, ISAO KAWASHIMA, and
HIDEO OWA

Appeal No. 2004-0174
Application No. 09/789,405

ON BRIEF

Before JERRY SMITH, FLEMING, and DIXON, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 70-102, which are all of the claims pending in this application.

We REVERSE.

Appellants' invention relates to a method and apparatus for transmitting and receiving a decoding key encoded with specific information to decode encrypted information of a record medium. An understanding of the invention can be derived from a reading of exemplary claim 70, which is reproduced below.

70. An information providing and collecting system comprising:

information transmitting means for establishing a connection between an information providing side and an information collecting side;

transmitting and receiving means for transmitting and receiving information between said information providing side and said information collecting side through said information transmitting means;

information medium reading means for reading information of a non-unique information medium having encoded information recorded thereon;

key encoding means which uses a plurality of specific information possessed by said information collecting side and transmitted from said information collecting side so as to encode key information required to decode said encoded information of the information medium, wherein said plurality of specific information is non-specific to said information medium, and includes a user ID, a user password and a medium reading apparatus ID;

encoded-key decoding means located at the collecting side for receiving encoded key information electronically transmitted from said information providing side and for decoding the encoded key information by using said specific information; and

encoded-information decoding means for decoding said encoded information read from said information medium by using said decoded key information.

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The prior art of record relied upon by the examiner in rejecting the appealed claims is as follows:

Hartman, Jr. (Hartman)	5,224,166	Jun. 29, 1993
Chou et al. (Chou)	5,337,357	Aug. 9, 1994
McCarty	5,666,411	Sep. 9, 1997

Claims 70-72, 75-77, 80-85, 88-90 and 93-99 stand rejected under 35 U.S.C. § 103 as being unpatentable over Chou in view of Hartman. Claims 100-102 stand rejected under 35 U.S.C. § 103 as being unpatentable over Chou in view of Hartman in view of appellants' own admission. Claims 73, 74, 78, 79, 86, 87, 91, and 92 stand rejected under 35 U.S.C. § 103 as being unpatentable over Chou in view of Hartman in view of McCarty.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 17, mailed Apr. 23, 2003) for the examiner's reasoning in support of the rejections, and to appellants' brief (Paper No. 15, filed Feb. 11, 2003) and reply brief (Paper No. 18, filed Jun. 23, 2003) for appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we make the determinations which follow.

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In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness. **See In re Rijckaert**, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A *prima facie* case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. **See In re Lintner**, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is *prima facie* obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. **See In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See **In re Warner**, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), **cert. denied**, 389 U.S. 1057 (1968). Our reviewing court has repeatedly cautioned against employing hindsight by using the appellant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. **See, e.g., Grain Processing**

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Corp. v. American Maize-Prods. Co., 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

When determining obviousness, "the [E]xaminer can satisfy the burden of showing obviousness of the combination 'only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in art would lead that individual to combine the relevant teachings of the references.'" **In re Lee**, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002), citing **In re Fritch**, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" **In re Dembiczak**, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). "Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact." **Dembiczak**, 175 F.3d at 999, 50 USPQ2d at 1617, citing **McElmurry v. Arkansas Power & Light Co.**, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993) .

Further, as pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is the claim." **In re Hiniker Co.**, 150 F.3d 1362,1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Therefore, we look to the limitations set forth in independent claim 70.

From our review of appellants' claimed invention, appellants' arguments and the examiner rejection and response to these arguments, we find that the examiner has not

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established a ***prima facie*** case of obviousness of the invention as recited in independent claim 70. Appellants have argued throughout the brief and reply brief that the examiner has not shown where the prior art teaches or fairly suggests the recited limitation of

key encoding means which uses a plurality of specific information possessed by said information collecting side and transmitted from said information collecting side so as to encode key information required to decode said encoded information of the information medium, wherein said plurality of specific information is non-specific to said information medium, and includes a user ID, a user password and a medium reading apparatus ID. [Emphasis added.]

In the reply at page 2, appellants argue that the examiner has not responded to all of appellants' arguments and the examiner has not shown where or how the prior art teaches or fairly suggests use of "a medium reading apparatus ID" as part of the key encoding means and the use of information non-unique/specific to the medium. We agree with appellants.

Additionally, we do note the examiner's use of official notice in the final rejection in the new grounds of rejection necessitated by amendment seems to rely upon a handbook that is not properly presented as prior art to the earliest filing date of Jun. 27, 1996. Upon return of the file to the examiner, we leave it to the examiner and appellants to determine this. Here, we do not reach this argument since we find that the examiner has not set forth a ***prima facie*** case of obviousness of the invention as recited in independent claim 70. Even if we were to find the examiner's use of official notice

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with the Schneider book at pages 170-174 that the use of name, initials and other personal information was known and combinable with the teachings of Chou and Hartman, the examiner has still not shown a teaching of the use of the “media reader apparatus ID” nor has the examiner provided a convincing line of reasoning as to why it would have been obvious to one of ordinary skill in the art at the time of the invention to use this ID in the encoding. (Answer at pages 9-12.) Therefore, we cannot sustain the rejection of independent claim 70 and its dependent claims. Similarly, we cannot sustain the rejection of independent claims 75, 80, 83, 88, 93, 96, 97, 98, and 99 and their respective dependent claims that also claim the media reading apparatus ID.

CONCLUSION

To summarize, the decision of the examiner to reject claims 70-102 under

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35 U.S.C. § 103 is reversed.

REVERSED

JERRY SMITH
Administrative Patent Judge

MICHAEL R. FLEMING
Administrative Patent Judge

JOSEPH L. DIXON
Administrative Patent Judge

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FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE- 10TH FL.
NEW YORK, NY 10151