

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. 40

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HIROFUMI ITO and SHINICHI YAMASHITA

Appeal No. 2004-0887
Application No. 09/304,644

ON BRIEF

Before OWENS, DIXON, and GROSS, *Administrative Patent Judges*.
OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal is from the final rejection of claims 81-94, which are all of the claims pending in the application.

THE INVENTION

The appellants claim a method and computer readable medium for distributing digital content on a computer network.

Claims 81 and 94, which claim the method, are illustrative:

81. A method for distributing a digital content on a computer network, said method comprising:

receiving via the computer network a request for a digital content from an information terminal, the request identifying the information terminal or a user thereof;

obtaining an encoded version of the digital content;
generating a decoding program such that ID information representing the information terminal or user is embedded therein, and wherein the decoding program is programmed to

perform the function of decoding the encoded digital content at the information terminal to produce a decoded digital content having the ID information imprinted therein without additional ID verification being performed at the information terminal by the user thereof;

transmitting via the computer network the decoding program to the information terminal; and

transmitting via the computer network the encoded digital content to the information terminal in response to the request.

94. A method for distributing digital content, comprising:
receiving a request for digital content from an information terminal;

obtaining an encoded version of the digital content;

generating a decoding program that can concurrently decode the encoded digital content, read an identification code from the information terminal, and imprint the identification code on the digital content;

sending the encoded digital content and the decoding program to the information terminal; and

concurrently decoding the encoded digital content, reading an identification code from the information terminal, and imprinting the identification code on the digital content at the information terminal.

THE REFERENCES

Löfberg	4,528,588	Jul. 9, 1985
Holmes	5,287,407	Feb. 15, 1994
Klingman	5,729,594	Mar. 17, 1998
		(filed Jun. 7, 1996)

R.G. van Schyndel et al. (van Schyndel) "A Digital Watermark", IEEE (1994).

Ingemar J. Cox et al. (Cox), "Secure Spread Spectrum Watermarking for Images, Audio and Video", IEEE (1996).

THE REJECTIONS

The claims stand rejected under 35 U.S.C. § 103 as follows:

claims 81, 82, 86, 88-92 and 94 over Löfberg in view of Holmes;

claims 83, 84 and 85 over Löfberg in view of Holmes, Cox and van

Schyndel; and claims 87 and 93 over Löfberg in view of Holmes and

Klingman.

OPINION

We reverse the rejections of claims 81-93 and affirm the rejection of claim 94.

Claims 81-93

We need to address only the independent claims, i.e., claims 81, 89, 91 and 93. These claims require a decoding program which has ID information representing an information terminal or user embedded therein and which decodes encoded digital content at the information terminal to produce a decoded digital content having the ID information imprinted therein without additional ID verification being performed at the information terminal by the user.

The examiner argues (answer, page 4):

The prior art of Löffberg discloses the recited decoding program having embedded ID information representing the terminal or user therein. The recited decoding program is generated at the Rent Terminal (RT in Fig. 1) in Löffberg. It is in the form of a Data Carrier. That this element functions as the decoding program having embedded ID information is disclosed at column 8, lines 49-65. See in particular line 52 which discloses "decoding information".

Löffberg does not disclose that the data ID carrier contains a decoding program but, rather, merely discloses that the data carrier ID contains decoding information or a decoding key (col. 8, lines 49-54; col. 9, lines 6-12; col. 13, lines 19-21). Löffberg discloses that the decoding is carried out in decoder 25 which is in the supplementary or auxiliary device AU of the user (col. 9, lines 23-28; col. 9, line 66 - col. 10, line 7; col. 13,

lines 19-29). The examiner, therefore, has not established that Löffberg meets the appellants' claim requirement of a decoding program having ID information representing the information terminal or user embedded therein.

The examiner argues (answer, pages 4-5):

The Löffberg patent also discloses that the decoding program disclosed therein functions to decode the encoded digital content and produce decoded digital content having the ID information imprinted therein without additional ID verification being performed at the information terminal. See column 13, lines 19-29, which describe that the decoding information and ID are transferred to the device AU of the user. There is no portion in that description that any additional ID verification is performed at the information terminal by the user thereof. Column 13, lines 63-68 describes that the user information terminal may be supplemented by a user ID input, but that is not a teaching away from the earlier embodiment disclosed. Column 14, lines 10-14 also describes that the whole of user ID input may be completely dispensed with by using an "active" card, i.e. a smart card.

Löffberg discloses transferring, at the place of the user, personal identification information and the decoding information or key to decoder 25 (col. 13, lines 19-21). This transfer, because it is a performance of ID verification at the information terminal by the user in addition to any ID information that would be embedded in the decoding program, is excluded by the appellants' claims 81-93. As for the examiner's argument that Löffberg discloses dispensing with the user ID input and, instead, using an active card, Löffberg discloses that the active card contains personal identification information (col. 4, lines 47-54; col. 14, lines 51-58). Hence, the active card also provides

additional ID verification at the information terminal by the user and, consequently, is excluded by the appellants' claims 81-93.

The examiner states that "[t]he Holmes reference was cited as evidence that at the time of [the] invention artisans of ordinary skill in the art were well aware that computer programs, known to be stored and distributed by way of computer readable mediums such as floppy disks, see column 2, lines 14-18, were increasingly being transmitted over computer networks, col. 2, lines 21-23)" (answer, page 5). The examiner does not rely upon Holmes, or upon Klingman, van Schyndel or Cox, for any disclosure that remedies the above-discussed deficiencies in Löffberg. Accordingly, we reverse the rejections of claims 81-93.

Claim 94

Löffberg discloses a method for transmitting a coded information signal from a signal source to a signal receiver at which the information signal is decoded, and teaches that the method is applicable to the protection of software for personal computers (col. 1, lines 7-10 and 24-27; col. 4, lines 1-15). Holmes teaches that it was known in the art to protect software files copied from one computer to another in a network (col. 2, lines 17-23).

The appellants present no argument that Löffberg and Holmes would have failed to fairly suggest, to one of ordinary skill in the art, sending encoded digital content from a computer to a

computer that requested the content, and decoding the digital content at the requesting computer. Löffberg discloses that, at the place of the user, content is simultaneously decoded and marked with personal identification information that has been stored in a memory (col. 13, lines 19-28). Thus, Löffberg would have fairly suggested, to one of ordinary skill in the art, for content that is sent from a computer to a requesting computer, storing the personal identification information at the requesting computer and, at the requesting computer, concurrently reading the personal identification from that storage, decoding the content, and marking the content with the personal identification information.

The appellants argue that Löffberg and Holmes fail to disclose or suggest sending the decoding program along with encoded digital content (brief, page 19; reply brief, page 4). Claim 94, however, does not require that the digital content and the decoding program are sent together. The claim merely requires "sending the encoded digital content and the decoding program to the information terminal", which encompasses sending the encoded digital content and the decoding program from different sources and at different times. Because, as discussed above, Löffberg and Holmes would have fairly suggested, to one of ordinary skill in the art, decoding content at a requesting computer, those references would have fairly suggested, to such a person, decoding the content using a decoding program which has

been sent to the requesting computer in some manner, such as from a floppy disk or from a computer which is the same or different than the one sending the digital content.

The appellants argue that neither Löffberg nor Holmes discloses all the limitations of claim 94 (brief, pages 19-20). This argument is deficient in that the appellants are attacking the references individually when the rejection is based on a combination of references. See *In re Keller*, 642 F.2d 413, 426, 208 USPQ 871, 882 (CCPA 1981); *In re Young*, 403 F.2d 754, 757-58, 159 USPQ 725, 728 (CCPA 1968).

We therefore conclude that the invention claimed in the appellants' claim 94 would have been obvious to one of ordinary skill in the art within the meaning of 35 U.S.C. § 103. Accordingly, we affirm the rejection of claim 94.

DECISION

The rejection under 35 U.S.C. § 103 of claims 81, 82, 86, 88-92 and 94 over Löffberg in view of Holmes is reversed as to claims 81, 82, 86, 88-92 and affirmed as to claim 94. The rejections under 35 U.S.C. § 103 of claims 83, 84 and 85 over Löffberg in view of Holmes, Cox and van Schyndel, and claims 87 and 93 over Löffberg in view of Holmes and Klingman, are reversed.

Application No. 09/304,644
Appeal No. 2004-0887

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

Terry J. Owens)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
Joseph L. Dixon)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
Anita Pellman Gross)	
Administrative Patent Judge)	

TJO/eld

Application No. 09/304,644
Appeal No. 2004-0887

Fleshner & Kim, LLP
P.O. Box 221200
Chantilly, VA 20153