

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte JEREMY A. KENYON

Appeal No. 2004-0927
Application No. 09/399,064

ON BRIEF

Before BARRETT, BARRY, and LEVY, *Administrative Patent Judges*.
BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

A patent examiner rejected claims 1-42. The appellant appeals therefrom under 35 U.S.C. § 134(a). We reversed.

BACKGROUND

The invention at issue on appeal concerns the creation, distribution, and consumption of "content." Such content includes "motion pictures, music, games, etc., in single or multiple media formed from selected combinations of audio, video, graphics, texts, data and so forth." (Spec. at 1.)

Figure 1 of the appellant's specification shows a "performance promoter centric approach known in the art." (*Id.*) According to this approach, a content creator 102 (e.g., a producer) creates and distributes content 104 (e.g., a motion picture) to a promoter 106 (e.g., a cinema). A player manufacturer 108 develops, manufactures, and distributes a player 110 (e.g., a motion picture projector) to the promoter. The promoter uses the player to render the content for consumption by consumers 112 (e.g., cinema goers). (*Id.* at 1-2.)

In contrast, Figure 4 of the specification shows the appellant's "player-centric" method for creating, distributing, and consuming content. More specifically, a computer implemented-content authoring tool ("CI-CAT") 403 is distributed to a content creator 402. To help compensate the developer 408 of the CI-CAT, the tool embeds control data in content 404 created therewith. A computer implemented-content player ("CI-CP") 402 is provided to a consumer 412. Upon rendering the content, the CI-CP recovers the control data therefrom and uses the recovered data to report rendering of the content. (*Id.* at 5.)

A further understanding of the invention can be achieved by reading the following claim.

1. A computer implemented content creation, distribution and consumption method comprising:

providing a computer implemented-content authoring tool (CI-CAT) to a content creator, the CI-CAT including an identification function for embedding control information in a content created using the CI-CAT, to facilitate compensating a developer of the CI-CAT;

providing a computer implemented-content player (CI-CP) to a consumer, the (CI-CP) including a recovery function for recovering said control information from the content when the content is rendered by the player, and a reporting function for reporting rendering of the content using said recovered control information;

receiving the content by the consumer, and rendering the content using the CI-CP; and

recovering the control information, and

reporting the rendering of the content using said recovered control information, by the CI-CP.

Claims 1, 6-11, 15-19, 22-25, 30-34, and 39-42 stand rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 5,892,900 ("Ginter"). Claims 2-5, 12-14, 20, 21, 26-29, and 35-38 stand rejected under 35 U.S.C. § 103(a) as obvious over Ginter and U.S. Patent No. 5,825,883 ("Archibald").

OPINION

Rather than reiterate the positions of the examiner or the appellant *in toto*, we focus on the point of contention therebetween. To wit, the examiner asserts that "Ginter et al. define content authoring or creating as, 'placing content into VDE containers with associated control information' ('900, column 12, lines 39-41) in other words creating a container," (Examiner's Answer at 8.) He then cites, (*id.* at 9), the following passage from the reference: "[a] repository **service may supply VDE authoring tools** to content creators, publishers, distributor, and/or value adding providers **such that they may apply rules and controls that define some or all of the guidelines managing use of their content and so that they may place such content into VDE content container objects.**" Col. 308, ll. 29-35. The appellant argues, "[i]t is the VDE containers that are 'authored,' not the content. At no point is the content creator's content being created by the VDE authoring tools provided by the repository. " (Reply Br. at 5.)

In addressing the point of contention, the Board conducts a two-step analysis. First, we construe claims at issue to determine their scope. Second, we determine whether the construed claims are anticipated or would have been obvious.

1. CLAIM CONSTRUCTION

"Analysis begins with a key legal question — *what is the invention claimed?*" *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987). Here, claim 1 recites in pertinent part the following limitations: "providing a computer implemented-content authoring tool (CI-CAT) to a content creator, the CI-CAT including an identification function for embedding control information in a content created using the CI-CAT, to facilitate compensating a developer of the CI-CAT. . . ." Claims 11, 18, 24, 25, and 34 recite similar limitations. Accordingly, claims 1, 11, 18, 24, 25, and 34 require a computer implemented tool for authoring content.

2. ANTICIPATION AND OBVIOUSNESS DETERMINATIONS

"Having construed the claim limitations at issue, we now compare the claims to the prior art to determine if the prior art anticipates those claims." *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349, 64 USPQ2d 1202, 1206 (Fed. Cir. 2002). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (citing *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 715, 223 USPQ 1264, 1270 (Fed. Cir. 1984); *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220

USPQ 193, 198 (Fed. Cir. 1983); *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 771, 218 USPQ 781, 789 (Fed. Cir. 1983)). "[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).

Here, Ginter discloses a "virtual distribution environment' (called 'VDE' . . .) that secures, administers, and audits electronic information use." Col. 2, ll. 19-22.

The "VDE can be used to protect the rights of parties who create electronic content such as, for example: records, games, movies, newspapers, electronic books and reference materials, personal electronic mail, and confidential records and communications." Col. 4, ll. 13-17. More specifically, "the virtual distribution environment 100, in a preferred embodiment, may package information elements (content) into a 'container' 302 so the information can't be accessed except as provided by its 'rules and controls.'" Col. 59, ll. 8-12.

"One possible arrangement of VDE nodes involves use of one or more 'repositories.' A repository, for example, may serve as a location from which VDE participants may retrieve VDE content containers." Col. 307, ll. 24-27. The second passage quoted by the examiner explains that "[a] repository service may

supply VDE authoring tools to content creators, publishers, distributors, and/or value adding providers such that they may apply rules and controls that define some or all of the guidelines managing use of their content and so that they may place such content into VDE content container objects." Col. 308, ll. 29-35. Rather than being used to author, i.e., create, content, the VDE authoring tools relied on by the examiner are used to place existing content into VDE containers. The first passage quoted by the examiner confirms this distinction by defining "**VDE** content authoring," col. 12, l. 39 (emphasis added), as "placing content into VDE containers with associated control information. . . ." *Id.* at ll. 39-40.

The absence of a computer implemented tool for authoring content negates anticipation. Therefore, we reverse the anticipation rejection of claim 1; of claims 6-10, which depend therefrom; of claim 11; of claims 15-17, which depend therefrom; of claim 18; of claims 19, 22, and 23, which depend therefrom; of claim 24; of claim 25; of claims 30-33, which depend therefrom; of claim 34; and of claims 39-42, which depend therefrom.

"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 Rijckaert*, 9 F.3d 1531,

1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993) (citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992)). "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, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)).

Here, the examiner does not allege, let alone show, that the addition of Archibald cures the aforementioned deficiency of Ginter. Absent a teaching or suggestion of a computer implemented tool for authoring content, we are unpersuaded of a *prima facie* case of obviousness. Therefore, we reverse the obviousness rejection of claims 2-5, 12-14, 20, 21, 26-29, and 35-38.

CONCLUSION

In summary, the rejection of claims 1, 6-11, 15-19, 22-25, 30-34, and 39-42 under § 102(e) is reversed. The rejection of claims 2-5, 12-14, 20, 21, 26-29, and 35-38 under § 103(a) is also reversed.

REVERSED

LEE E. BARRETT
Administrative Patent Judge

LANCE LEONARD BARRY
Administrative Patent Judge

STUART S. LEVY
Administrative Patent Judge

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