

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ZACHARY DAVID DIMENSTEIN

Appeal No. 2004-1324
Application No. 09/495,116¹

HEARD: JANUARY 11, 2005

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

DECISION ON APPEAL

This is a decision on appeal from the Examiner's final rejection of claims 14, 15, 17-19, 21-31, 33-35, 37-43, 45-47 and 49-56. Claims 1-13 have been indicated by the Examiner as being allowable while claims 16, 20, 32, 36, 44 and 48 have been canceled.

We reverse.

¹ Application for patent filed February 01, 2000, which claims the filing priority benefit under 35 U.S.C. § 119 of Provisional Application No. 60/118,133, filed February 1, 1999.

BACKGROUND

Appellant's invention is directed to a method and apparatus for distributing lawfully available copies of files over the internet. An understanding of the invention can be derived from a reading of exemplary independent claim 14, which is reproduced as follows:

14. A method of ensuring that downloading over an Internet of a file designated by user is an authorized downloading, comprising the steps of:

- (a) providing a central server with an Approved Web Site Database comprising a list of servers authorized to be source of files for downloading over the Internet;
- (b) receiving at said central server from the user an IP address of an additional server providing the file designated by the user as downloadable data;
- (c) determining whether the IP address of the additional server is on the Approved Web Site Database;
- (d) when it is determined that the IP address of the additional server is on the Approved Web Site Database, notifying the user that downloading from the additional server is authorized; and
- (e) downloading the file designated by the user from the additional server;

wherein step (d) further comprises transmitting at least one of an encryption key and encryption information unique to the file designated by the user from said central server to a personal computer of the user.

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The Examiner relies on the following references in rejecting the claims:

Toader	5,774,869	Jun. 30, 1998
Alles et al. (Alles)	6,425,010	Jul. 23, 2002 (filed Jan. 22, 1999)
Kupka et al. (Kupka)	6,434,535	Aug. 13, 2002 (filed Nov. 13, 1998)

Claims 14, 15, 17-19, 21-31, 33-35, 37-43, 45-47 and 49-56 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Alles, Toader and Kupka.

We make reference to the answer (Paper No. 16, mailed October 28, 2003) for the Examiner's reasoning and to the appeal brief (Paper No. 15, filed July 23, 2003) and the reply brief (paper No. 17, filed December 18, 2003) for Appellant's arguments thereagainst.

OPINION

The Examiner relies on Alles for teaching the claimed method steps except for accessing over the Internet that would comprise downloading over the Internet which is disclosed by Toader as allowing the authorized user to download information (answer, pages 4 & 5). The Examiner further relies on Kupka for teaching the transmission of encryption key and encryption information which would have prevented unauthorized access to the information being transmitted over the internet (answer, page 6).

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Appellant argues that the Examiner provides no technical principle for the proposed combination and for using any encryption techniques in the method of Alles (reply brief, page 6). Appellant specifically relies on the way Alles is intended to have the sponsor publicize its products and/or services and argues that incorporating some type of encryption capability would be contrary to the purpose of the reference (reply brief, page 5). Appellant further asserts that Kupka, instead of publicizing the advertisement material related to products and/or services, limits the distribution or copying of information only to the prepaid customers (id.).

In response to Appellant's arguments, the Examiner asserts that Alles is indeed concerned with the security issues by disclosing that a login process by the users is required (answer, page 7). Furthermore, the Examiner concludes that the security and encryption measures of Kupka coupled with the security concerns of Alles are not contrary to the purpose of Alles with regard to publicizing its products and/or services (id.).

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). In considering the question of the obviousness of the claimed invention in view of the prior art

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relied upon, the Examiner is expected to make the factual determination set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. See also In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). Such evidence is required in order to establish a prima facie case. In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). The Examiner must not only identify the elements in the prior art, but also show "some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead the individual to combine the relevant teachings of the references." In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

A review of the applied prior art confirms that Alles and Toader relate to providing free Internet access to users for free in exchange for presenting sponsor-paid advertising to the users. The only measure of security in these two references relates to the login process for identifying the user who has previously registered (col. 3, lines 13-18 of Alles and col. 4, lines 6-8 of Toader). As pointed out by Appellant (reply brief, page 5), the

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main purpose of the sponsor is to publicize its products and/or services to those users who are on the list of registered users.

Kupka, on the other hand, checks a user's information against the registered list for prepayment confirmation (col. 2, lines 48-65), but does not provide any such authorized list for the sites that could be the source of the file for downloading. Therefore, Kupka's teachings, at best, would be applicable to the user's access to the Internet after the user has already browsed through the sponsor's advertisements. Thus, although we agree with the Examiner that Kupka's process for downloading encrypted files could be used when users attempt to download protected files, we are not convinced that its combination with the free Internet access of Alles and Toader would produce the claimed subject matter.

As discussed above, Kupka allows the prepaid and registered users to download protected files whereas Alles and Toader grant free access to the Internet to users registered by the sponsor web site. In concluding that the combination would have taught the claimed subject matter, the Examiner attempts to forge a combination of a free Internet access and a prepaid registry for eliminating the transmission of personal data each time a download is requested. Thus, assuming, arguendo, that it would have been obvious to combine Alles and Toader with Kupka, as held

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by the Examiner, the combination would still fall short of teaching or suggesting the claimed authorizing the download from the Approved Web Site and transmitting its encryption data. Accordingly, as the Examiner has failed to set forth a prima facie case of obviousness, we do not sustain the 35 U.S.C. § 103 rejection of 14, 15, 17-19, 21-31, 33-35, 37-43, 45-47 and 49-56 over Alles, Toader and Kupka.

CONCLUSION

In view of the foregoing, the decision of the Examiner rejecting claims 14, 15, 17-19, 21-31, 33-35, 37-43, 45-47 and 49-56 under 35 U.S.C. § 103 is reversed.

REVERSED

JAMES D. THOMAS)	
Administrative Patent Judge)	
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