

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

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4 UNITED STATES PATENT AND TRADEMARK OFFICE

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7 BEFORE THE BOARD OF PATENT APPEALS
8 AND INTERFERENCES

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11 *Ex parte* KENJI TAGAWA, MASAYUKI KOZUKA, MASATAKA MINAMI,
12 and TETSUO MAEDA

13 _____
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15 Appeal 2007-0992
16 Application 09/436,656
17 Technology Center 3600

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20 Decided: June 11, 2007

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23 Before WILLIAM F. PATE, III, MURRIEL E. CRAWFORD, and ANTON W.
24 FETTING, *Administrative Patent Judges*.

25 FETTING, *Administrative Patent Judge*.

26 DECISION ON APPEAL

27
28 STATEMENT OF CASE

29
30 This appeal involves claims 22-24, 26-28 and 43-48, the only claims under
31 consideration¹ pending in this application. We have jurisdiction over the appeal
32 pursuant to 35 U.S.C. §§ 6 and 134.

33
34 We REVERSE.

¹ Claims 49-54 are withdrawn from consideration.

1 The Appellants invented a data conversion apparatus in a copyright protection
2 system in which, when audio data is recorded by copying, the audio data is
3 converted to the same data format as that of network distribution data. In this
4 manner, the data format is standardized so as to protect a copyright of non-
5 ciphered audio data as well as ciphered. (Specification 1). An understanding of
6 the invention can be derived from a reading of exemplary claim 22, which is
7 reproduced below.

8 22. A data conversion apparatus for use with an external recording
9 apparatus and an external equipment, and for use in converting data
10 including audio contents to superdistribution format data and
11 outputting the superdistribution format data to be supplied to the
12 external recording apparatus to be recorded therein,
13 said superdistribution format data including said audio contents and
14 attribute information which represents at least a charge condition
15 permitting creation of a copy of the audio contents, and including
16 identification information identifying a user of the data conversion
17 apparatus,
18 said data conversion apparatus comprising:
19 a data transmission/receiving section for transmitting and receiving
20 data to and from the external equipment;
21 a data format judging section for judging whether or not data received
22 by said data transmission/receiving section is of a superdistribution
23 format;
24 an attribute information obtaining section for identifying the audio
25 contents of the data and obtaining attribute information corresponding
26 to the identified audio contents from the external equipment via said
27 data transmission/receiving section;
28 a user ID storage section storing the identification information
29 identifying the user of the data conversion apparatus;
30 a ciphering section ciphering the attribute information obtained from
31 the external equipment and the identification information stored in
32 said user ID storage section;

1 a data format conversion section adding said ciphered attribute
2 information and identification information to the audio contents and
3 thereby converting the audio contents together with the obtained
4 attribute information to the superdistribution data format; and
5 a controller for controlling said data transmission/receiving section,
6 data format judging section, attribute information obtaining section
7 and data format conversion section,
8 wherein, in a case where said data format judging section judges that
9 the received data is not of the superdistribution format, said controller
10 controls said attribute information obtaining section so as to obtain the
11 attribute information corresponding to the audio contents from the
12 external equipment, and wherein said controller controls said data
13 format conversion section so as to convert the audio contents of the
14 received data together with the obtained attribute information into the
15 superdistribution format data, so that the resultant data converted to
16 the superdistribution data format is outputted and supplied to the
17 external recording apparatus,
18 wherein said data transmission/receiving section includes a data read-
19 out portion for reading the data out of a disc medium recorded with
20 the data containing the audio contents and includes a network
21 interface which receives the attribute information corresponding to the
22 audio contents from an external server via a digital network, and
23 wherein said attribute information obtaining section obtains
24 identification information read out of the disc medium and transmits
25 the obtained information to the external server via the digital network
26 and receives attribute information corresponding to the audio contents
27 recorded in the disc medium identified by the identification
28 information from the external server.

29
30 This appeal arises from the Examiner's final rejection, mailed April 4, 2005.
31 The Appellants filed a Brief in support of the appeal on June 2, 2006, and the
32 Examiner mailed an Answer to the Appeal Brief on October 5, 2006.

1 PRIOR ART

2 The prior art reference of record relied upon by the Examiner in rejecting the
3 appealed claims is:

4 Imai US 5,870,467 Feb. 9, 1999

5 REJECTION

6 Claims 22-24, 26-28, and 43-48 stand rejected under 35 U.S.C. § 102(e)² as
7 anticipated by Imai.

8
9 ISSUES

10 The Examiner finds that Imai shows a data conversion apparatus 100 with a
11 data transmission/receiving section/means 11; a data format judging section/means
12 3; an attribute information obtaining section/means 4; a user ID storage
13 section/means storing identification information identifying the user of the data
14 conversion apparatus, necessarily present in order to perform the disclosed
15 "authentication"; a ciphering section/means 132 for ciphering the attribute
16 information, necessarily present in order to "protect" the data; a data format
17 conversion section/means 5 for adding the ciphered attribute information and
18 identification information to the audio contents; and, a controller 1. The Examiner
19 further finds that the data transmission/receiving section/means of Imai includes a
20 data read-out portion 6 and a network interface 102. (Answer 4).

² It is unclear why the Examiner does not also reject the claims under paragraph (a) of Section 102 given that Imai's publication date antedates the Nov. 9, 1999 filing date of the instant application. We find no claim for the benefit of an earlier filing date in the record.

1 The Examiner contends that, in making this rejection, the functional language
2 in the claim has been deemed merely intended usage of the invention, and
3 therefore afforded little patentable weight. The Examiner further contends that the
4 apparatus of Imai is inherently capable of performing the recited functions.
5 (Answer 4).

6 The Appellants contend that Imai fails to show

- 7 • a data format judging section for judging whether or not data received by
8 said data transmission section is of a super distribution data format (Br. 9-
9 10);
- 10 • an attribute information obtaining section for identifying the audio contents
11 of the data and obtaining attribute information corresponding to the
12 identified audio contents from the external equipment via a data
13 transmission/receiving section (Br. 10-13);
- 14 • a user ID storage section storing identification information identifying the
15 user of the data conversion apparatus (Br. 13-14);
- 16 • a ciphering section ciphering the attribute information obtained from the
17 external equipment and the identification information stored in the user ID
18 storage section (Br. 14-15);
- 19 • a data format conversion section adding said ciphered attribute information
20 and identification information to the audio contents and thereby converting
21 the audio contents together with the obtained attribute information to the
22 super distribution format (Br. 15-16); and
- 23 • that in a case where the data format judging section judges that the received
24 data is not of the super distribution format, the controller controls the

1 attribute information obtaining section so as to obtain the attribute
2 information corresponding to the audio contents from the external
3 equipment, and wherein the controller controls the data format conversion
4 section so as to convert the audio contents of the received data together with
5 the obtained attribute information into the super distribution format data, so
6 that the resultant data converted to the super distribution data format is
7 outputted and supplied to the external recording apparatus (Br. 16-17).

8 Thus, the issues pertinent to this appeal are whether the rejection of claims 22-
9 24, 26-28, and 43-48 under 35 U.S.C. § 102(e) as anticipated by Imai is proper,
10 and in particular, whether Imai describes the claimed subject matter the Appellants
11 contend is missing.

12
13 **FACTS PERTINENT TO THE ISSUES**

14 The following Findings of Fact (FF), supported by a preponderance of
15 evidence, are pertinent to the above issues.

16 *Claim Construction*

17 01. The term "super distribution data" means distribution data ciphered to an
18 AAC (Advanced Audio Coding) format, the ciphering including at least
19 royalty charge attribute information, and for which the data is deciphered
20 by completing the royalty charging process. (Specification 16).

21 *Imai*

22 02. Imai refers to the super distribution format as an example of a
23 mechanism to prevent unauthorized distribution of data in its Description
24 of the Background Art (Imai, col. 2, l. 54 – col. 3, l. 12).

- 1 03. Imai goes on to state that the background art, including the super
2 distribution format, only protects programs, and does not protect pictures
3 and novels, because the program that reads such data can manage the
4 copyright data improperly (Imai, col. 3, ll. 13-26).
- 5 04. Imai does not refer to the super distribution format anywhere else, and in
6 particular, makes no reference to it in conjunction with its description of
7 its data protection process.
- 8 05. Imai discloses an input/output management apparatus 10 for controlling
9 data input and data output to and from an input/output requesting
10 program 11 (Imai, Fig. 2; col. 8, ll. 15-18).
- 11 06. Imai's input/output management apparatus 10 comprises a data
12 input/output request reception unit 1 for receiving data input/output
13 requests from the program 11; a data input unit 2 for entering data into
14 the program 1 via the input/output request reception unit 1; a protected
15 data judgment unit 3 for judging whether each data input entered into the
16 program 11 is a protected data or not; a protected data input recording
17 unit for recording each input of the protected data detected by the
18 protected data judgment unit 3; an output permission judgment unit 5 for
19 judging whether data output from the program 11 requested via the
20 input/output request reception unit 1 is permitted or not according to the
21 input of the protected data recorded in the protected data input recording
22 unit 4; and a data output unit 6 for outputting data from the input/output
23 requesting program 11 which is judged to be permitted by the output
24 permission judgment unit (Imai, Figs. 1, 2 and 25; col. 8, ll. 18-34).

- 1 07. The data input/output management apparatus 10 of Imai described above
2 operates according to the flowchart as shown in Fig. 2. In particular, as
3 shown in steps S21 and S22 of Fig. 2, when the input/output requesting
4 program 11 issues a request for data input/output, the input/output
5 request reception unit 1 receives this request, and judges an ID of the
6 request program 11 and a type of the request, i.e., whether the request is
7 for data input or for data output (Imai, col. 8, ll. 39-44).
- 8 08. If it is judged at the input/output request reception unit 1 that the
9 received request is a data input request, the data input unit 2 reads out
10 the requested data from the recording medium (Imai, step S23 in Fig. 2;
11 col. 8, l. 65 - col. 9, l. 3).
- 12 09. After the requested data has been read by the data input unit 2, the
13 protected data judgment unit 3 then judges whether the requested input
14 data is a protected data or not by examining the header of the data (Imai,
15 step S24 in Fig. 2; col. 9, ll. 9-10).
- 16 10. As explained in Imai, the protected data judgment unit 3 of Imai is able
17 to determine whether a piece of data is protected or not based on either
18 (1) the header of the data, (2) the name of the file in which the data is
19 contained, or (3) according to a recording position of the data in a
20 recording medium (Imai, col. 9, ll. 8-16).
- 21 11. If the data judgment unit 3 determines that the data is protected, a record
22 of the input is made in the protected data input recording unit 4 by
23 storing an ID of the requesting program 11 in the protected data input
24 recording unit 4 (Imai, step S23 of Fig. 2; col. 9, ll. 42-55).

- 1 12. In contrast, if the data is not determined to be protected, then no record
2 is made in the protected data input recording unit 4 (Imai, col. 9, ll. 45-
3 48).
- 4 13. Next, the requested data is transferred to the input/output requesting
5 program 11 (Imai, step S26 of Fig. 2; col. 9, ll. 64-65).
- 6 14. On the other hand, when a data output request is received at the
7 input/output request reception unit 1, the output permission judgment
8 unit 5 checks whether the ID of the requesting program 11 is stored in
9 the protected data input recording unit 4 (Imai, step S27 of Fig. 2; col.
10 10, ll. 10-16).
- 11 15. If the ID is not stored in the protected data input recording unit 4, then
12 the data is output (Imai, step S28 of Fig. 2; col. 10, ll. 16-20).
- 13 16. However, if the ID is stored in the protected data input recording unit 4,
14 this implies that the requesting program 11 has previously read protected
15 data (Imai, col. 10, ll. 22-27).
- 16 17. Whether Imai's data can be output is based on the type of requested
17 output target. For example, when the requested output target is an
18 output device such as a display device from which the data cannot be
19 directly read by another program, the data output request is permitted
20 and the requested data is output to the specified output target (Imai, steps
21 S29, S30 and S31 of Fig. 2; col. 10, ll. 27-30).
- 22 18. Conversely, if it is determined that the output target is not a display
23 device, the data output request is refused because there is a possibility

1 for the Board to “appl[y] the mode of claim interpretation that is used
2 by courts in litigation, when interpreting the claims of issued patents
3 in connection with determinations of infringement and validity.” *In re*
4 *Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320[, 1322] (Fed. Cir. 1989);
5 accord *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023 (Fed.
6 Cir. 1997) (“It would be inconsistent with the role assigned to the
7 PTO in issuing a patent to require it to interpret claims in the same
8 manner as judges who, post-issuance, operate under the assumption
9 the patent is valid.”). Instead, as we explained above, the PTO is
10 obligated to give claims their broadest reasonable interpretation
11 during examination.

12 *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1369, 70 USPQ2d 1827, 1834
13 (Fed. Cir. 2004).

14 15 *Anticipation*

16 "A claim is anticipated only if each and every element as set forth in the claim
17 is found, either expressly or inherently described, in a single prior art reference."
18 *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d
19 1051, 1053 (Fed. Cir. 1987). "When a claim covers several structures or
20 compositions, either generically or as alternatives, the claim is deemed anticipated
21 if any of the structures or compositions within the scope of the claim is known in
22 the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed.
23 Cir. 2001). "The identical invention must be shown in as complete detail as is
24 contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226,
25 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as
26 required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of
27 terminology is not required. *In re Bond*, 910 F.2d 831, 832, 15 USPQ2d 1566,
28 1567 (Fed. Cir. 1990).

ANALYSIS

Claims 22-24, 26-28, and 43-48 rejected under 35 U.S.C. § 102(e) as anticipated by Imai.

With regard to the data format judging element, the protected data judgment unit 3 is responsible for determining whether a piece of data is protected or not, by examining, for example, the header of the data to determine whether the header is of a prescribed format (FF10). Thus, while the protected data judgment unit 3 of Imai is able to determine whether data is protected or not, the protected data judgment unit 3 is not disclosed as being able to judge whether or not data is of a super distribution format. The Examiner has taken the position that the data judgment unit 3 of Imai is inherently capable of judging whether or not data is of a super distribution format, but has provided no evidence, or even a logical argument to support this assertion. The super distribution format is a specific, not a generic, format (FF01). Thus, some program that recognizes how to find and create data in this format is necessary to perform this claim element, and the Examiner has not shown that Imai describes such a program with its disclosed process. Thus, we do not find that the Examiner has shown that Imai describes the claimed format judging element.

With regard to the audio attribute finding element, the Examiner has taken the position that the protected data input recording unit 4 of Imai corresponds to the attribute information obtaining section as claimed. In other words, the Examiner has taken the position that the protected data input recording unit 4 of Imai is inherently capable of identifying audio contents of the data and obtaining attribute information corresponding to the identified audio contents from the external equipment via a data transmission/receiving section (Answer 9).

1 Based on the description of the protected data input recording unit 4 (FF11-
2 FF16), it is clear that while the protected data input recording unit 4 of Imai is
3 capable of storing an ID of the requesting program 11 if it is determined that the
4 data input to the data input unit 2 is protected, there is absolutely no disclosure in
5 Imai that the protected data input unit 4 of Imai is inherently capable of identifying
6 audio contents of the data and obtaining attribute information corresponding to the
7 identified audio contents from external equipment via a data transmission/receiving
8 section. Presumably, the Examiner is contending that audio data must inherently
9 be found to be played. However, Imai makes no reference to playback of the data,
10 and makes no reference to finding audio data. Thus, we do not find that the
11 Examiner has shown that Imai describes the claimed audio attribute finding
12 element.

13 With regard to the user ID identifying claim element, Imai relies on an ID to
14 determine whether to output protected data (FF14-16). The Examiner contends
15 that the claimed subject matter is sufficiently broad to read on this ID. We note
16 that there is no lexicographic definition of a user in the Specification, and that the
17 program that is running may be construed as an alias for the person operating the
18 program. Thus, we find that the Appellants have not shown that the Examiner
19 erred in finding that Imai describes the claimed user ID element.

20 With regard to the claimed ciphering element, Imai describes writing data in a
21 protected form (FF11). This protected form is ciphered data. However, the
22 claimed subject matter ciphers the attribute data that identifies the audio contents
23 in the data. As we found, *supra*, Imai does not describe such audio attribute data.
24 Thus, we do not find that the Examiner has shown that Imai describes the claimed
25 audio attribute ciphering element.

1 With regard to the claimed data format conversion element, the Examiner has
2 taken the position that the output permission judgment unit 5 corresponds to the
3 data format conversion unit as claimed. In other words, the Examiner has taken the
4 position that the output permission judgment unit 5 of Imai is inherently capable of
5 adding ciphered attribute information and identification information to audio
6 contents and thereby converting the audio contents together with the obtained
7 attribute information to the super distribution format (Answer 4, 11). The
8 Examiner has provided no evidence, or even a logical argument to support this
9 assertion, other than to assert that audio content of a CD are data in a disc medium,
10 and that recording in super distribution format is one of Imai's disclosed intended
11 purposes. The super distribution format is a specific, not a generic, format (FF01).
12 Thus, some program that recognizes how to find and create data in this format is
13 necessary to perform this claim element, and the Examiner has not shown that Imai
14 describes such a program with its disclosed process. Although, as the Examiner
15 asserts, Imai does describe the super distribution format, this is described as an
16 alternative to, rather than part of, Imai's disclosed process (FF0-04). Thus, we do
17 not find that the Examiner has shown that Imai describes the claimed format
18 judging element.

19 With regard to the claimed element that in the case where said data format
20 judging section judges that the received data is not of the super distribution format,
21 a controller converts the audio contents of the received data together with the
22 obtained attribute information into the super distribution format data, the Examiner
23 contends that the attribute information obtaining section/means 4 of Imai indeed
24 performs the steps of "identifying," as in ascertaining the origin, nature, or
25 definitive characteristics of, the audio contents of the data. The Examiner further

1 bases this contention on the assertion that the device necessarily ascertains and
2 determines the nature of the data, because the data is digital data in a recognizable,
3 coherent, useable format, as opposed to random background noise. The Examiner
4 further contends that "obtaining" attribute information, e.g., the ID of the
5 file/dataset, etc., corresponding to the identified audio contents (the file/dataset)
6 from the external equipment via a data transmission/ receiving section arises
7 because the device necessarily sends and receives data, and thus, is inherently
8 capable of transmitting and receiving data via a data transmission/receiving
9 section).

10 The Examiner does not contend that Imai shows that, as claimed in the present
11 application, where the received data is not of the super distribution format, the
12 controller obtains the attribute information corresponding to the audio contents
13 from the external equipment, and converts the audio contents of the received data
14 together with the obtained attribute information into the super distribution format
15 data, so that the resultant data converted to the super distribution data format as
16 claimed. The super distribution format is a specific, not a generic, format (FF01).
17 Thus, some program that recognizes how to determine whether data is in this
18 format, and find and create data in this format is necessary to perform this claim
19 element, and the Examiner has not shown that Imai describes such a program with
20 its disclosed process. Further, Imai preserves the protection or lack thereof status
21 of the input data, rather than converting unprotected data to protected as claimed
22 (FF17-21).

23 Thus, we do not find that the Examiner has shown that Imai describes the
24 claimed element that in the case where said data format judging section judges that
25 the received data is not of the super distribution format, a controller converts the

1 audio contents of the received data together with the obtained attribute information
2 into the super distribution format data.

3
4 **CONCLUSIONS OF LAW**

5 From the above facts and analysis, we conclude that the Examiner erred in
6 finding the claimed data format judging, attribute information obtaining, ciphering,
7 and data format conversion sections, and the claimed operation of the controller in
8 a case where the data format judging section judges that the received data is not of
9 the super distribution format to be shown by Imai. Therefore, we conclude that the
10 rejection of claims 22-24, 26-28, and 43-48 under 35 U.S.C. § 102(e) as
11 anticipated by Imai is erroneous, and in particular that Imai fails to anticipate all of
12 the elements of the claimed subject matter.

13 Accordingly we do not sustain the Examiner's rejection of claims 22-24, 26-28,
14 and 43-48 under 35 U.S.C. § 102(e) as anticipated by Imai.

15
16 **DECISION**

17 To summarize, our decision is as follows:

- 18 • The rejection of claims 22-24, 26-28, and 43-48 under 35 U.S.C. § 102(e) as
19 anticipated by Imai is not sustained.

20 **REVERSED**
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Appeal 2007-0992
Application 09/436,656

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5 WENDEROTH LIND & PONACK

6 2033 "K" STREET N W

7 SUITE 800

8 WASHINGTON, DC 20006

9